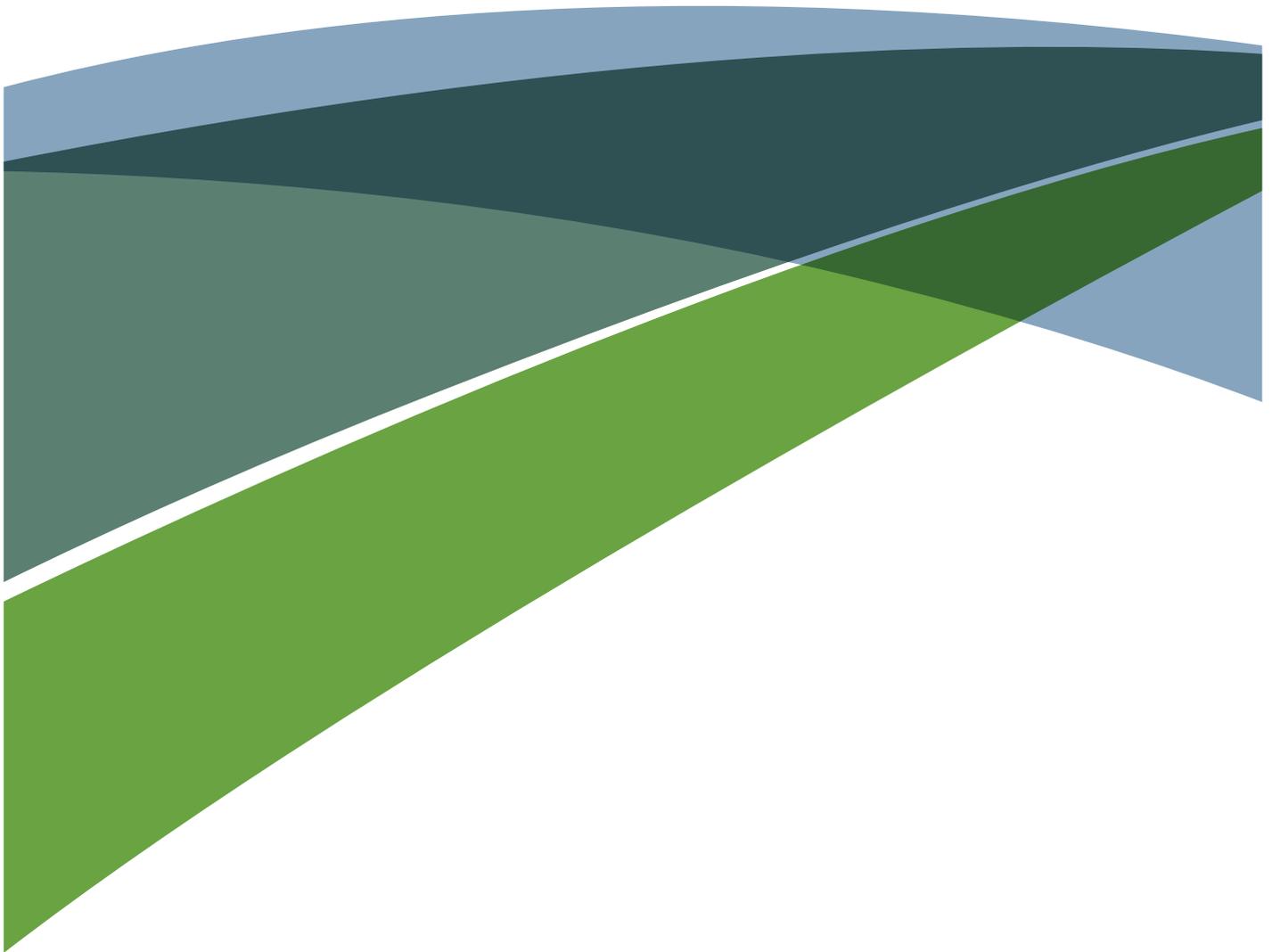




Intellectual  
Property  
Office

# Trade Marks Manual



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## **1. Preliminary check of the application form**

We check every application to make sure that it meets the requirements for filing stated in the Act and Rules. Some requirements are essential in order to obtain a filing date. Others are not essential for filing date purposes but must still be met before we can send an application on to examination. If the requirements have been met, the filing date is the date when we received the application. If the filing requirements have not been met, the filing date will be the date when we receive the last document which puts the application in order.

### **1.1 Essential requirements for filing date - Section 32(2) of the Act**

We give an application a filing date as soon as all the essential filing requirements are met. These are as follows (the paragraph letter corresponds to that in Section 32(2)):

#### **(a) a request for registration of a trade mark**

A request for registration is generally taken to be the provision of form TM3 which in itself requests registration. However, if we get a letter which clearly states that a request for registration of a trade mark is sought, this would be sufficient to meet this requirement.

#### **(b) the name and address of the applicant**

The name and address of the applicant (who becomes the 'proprietor' once the mark is registered) must be supplied. The name of the applicant must be the correct legal name (particularly in the case of companies) and not a trading name or style. Further guidance on the acceptability (or otherwise) of certain types of applicant is given in paragraph 5 below.

#### **(c) a statement of the goods or services for which it is sought to register the trade mark**

An application must include a list, or statement, of all goods and services (the specification) for which an applicant uses or intends to use the trade mark. It is not essential to provide a class number in order to obtain a filing date, but this is a requirement which must be met before the application can proceed further. The specification will not be examined in any detail at this stage; a detailed examination will be made by a trade mark examiner, but if the specification is not clear we will contact the applicant to clarify the specification.

#### **(d) a representation of the trade mark**

A representation of the mark (or marks in the case of a series) in the format that registration is sought must be provided.

### **1.2 Non-essential requirements for filing date**

#### **1.2.1 Use or bona fide intention to use - Section 32(3)**

Every applicant must be either currently using the trade mark (or allowing someone else to use it with their consent) or have a *bona fide* (good faith) intention to use it in relation to the goods or services requested. The declaration on the application form, stating this, must be signed by the applicant or their representative.

### **1.2.2 Application fee and class fees - Section 32(4) and Rules 5 & 13**

The applicant must pay a basic application fee covering the first, or only, class in the application. If further classes are requested, each extra class is subject to a class fee. As this requirement is not essential for filing date purposes, payment does not have to be sent with the application form.

### **1.2.3 Form TM3 to be used - Rule 5**

If we get a request for registration of a mark which contains all the essential requirements for allocation of a filing date, we will allow one month for these details to be transferred to an official application form TM3, or an acceptable replica of that form (Rule 3(2)), and for this form to be returned.

### **1.2.4 Application to specify the class - Rule 8(2)**

The application must specify the class of the Nice classification system, as set out in Schedule 3 of the Rules, to which it relates. This is used to allocate class numbers to the specification

### **1.2.5 Address for service**

If the applicant is not based in the UK, and not represented by someone based in the UK, they must provide an address in the EC or EEA with which we can correspond. Applicants based in the Channel Islands and the Isle of Man will not be asked to provide an address for service in the UK.

### **1.3 Dealing with deficient applications**

If any filing requirements are not met, we send the applicant a letter, stating why the application is not acceptable and allowing one month to remedy the deficiency. This letter is issued under the provisions of Rule 13, or Rule 11 in the case of lack of an address for service in the UK.

If the deficiency is not remedied within the one month period, the application will either be:

- deemed never to have been made, in respect of essential requirements; or
- treated as withdrawn, in respect of requirements which are not essential for obtaining a filing date.

Note : The one month period runs from the date we issue the deficiency letter and cannot be extended (Rule 77).

## **2 Other queries or objections raised at new application stage**

### **2.1 Inconsistencies in the application form**

We check to make sure that information on the application form is consistent and logical. Common errors include:

- number of marks in the series differs from the number of marks provided;
- inaccurate priority claim, for example. based on earlier UK filings;
- a statement that the mark is a certification or collective mark but does not appear to be so;
- obvious errors in the mark or specification; and
- mark type, if stated does not match the mark.

We try to resolve most inconsistencies by a phone call, primarily as a matter of customer care, to the applicant or their representative. However, it is the responsibility of applicant to ensure that they have completed their application form correctly.

## **2.2 Mark type**

We allocate a mark type to every application. This is an administrative action which aids the search for similar marks. If the mark type is unclear from the answer on the form, we will resolve this before we record the information on the application form. We may refuse requests by applicants to correct this information at a later stage. If the application is for a series, we will allocate the mark type which describes the most complex mark in the series.

The mark types are:

Word only

Figurative

3D

Hologram

Sound

Colour

Other

## **2.3 Graphical representation**

The applicant must provide a representation of the mark in order to secure a filing date (Section 32(2)(d) refers). To be represented graphically, marks should be presented in a way that is 'clear, precise, self-contained, easily accessible, durable and objective' (see Sieckmann, ECJ case C-273/00). If this is not the case, we will raise this as a filing deficiency. If an acceptable representation is filed within the prescribed one-month period, the filing date will be the date when we get the satisfactory representation. If the deficient mark is one of a series of marks, an instruction to delete the offending mark within the one-month period will allow the

application to keep the original filing date. If the offending mark is not deleted, we will deal with the application as described in paragraph 3.3 above.

## **2.4 Guidelines for particular types of mark**

### **2.4.1 Series**

An application can be filed as a series of marks.

A series of marks means a number of trade marks which resemble each other as to their material particulars and differ only as a matter of non distinctive character which would not affect the identity of the trade mark.

An application can include a maximum of six marks. The first & second marks are included in the application fee, any additional marks would attract a fee.

### **2.4.2 Marks consisting exclusively of colour(s)**

Marks consisting exclusively of a colour or colours may be represented by giving a written description of the colour(s), for example, dark blue and light green, in the box on the form, and by stating what those colours are, using an internationally recognized colour identification system, such as Pantone®, Focoltone®, Munsell Color® or Toyo®.

Where marks consist of a colour or colours applied to the goods or their packaging, or to other commercial items, an appropriate description should be included as part of the representation of the mark. Where colour is applied to the whole, or substantially the whole, surface of the item in question, a statement to this effect will suffice. In other cases a picture or diagram may be necessary to identify the area(s) of the item to which the colour or colours are applied.

Where marks consist of a combination of colours in the abstract, without contours, the representation must also include 'a systematic arrangement associating the colours in a predetermined and uniform way' (see Heidelberg Bauchemie GmbH, ECJ case C-49/02). So, for example, where a mark consists of colours used in various applications, but always as stripes, the representation of the mark should indicate that the colours (as properly defined) are used as stripes and must indicate the order in which the colours appear in the stripes, that is, blue, then red, then green.

### **2.4.3 Figurative marks**

If a mark is shown in colour, the mark will be registered in these colours. Other than in the types of trade mark described in paragraph 2.4.1 above, there is usually no need to provide a written description of the colours that appear in a trade mark consisting of a picture or a device (but see paragraph 2.3 above). If written colour identification codes are included in the application they will be recorded as part of the representation of the trade mark.

If a mark is shown in black and white, we will not consider these colours are a feature of the mark unless the applicant states otherwise in which case the trade mark will subsequently be published and registered with an indication that the colours black and white are a feature of the trade mark.

#### **2.4.4 Three-dimensional marks**

Applicants must state in the form if they are applying for a three-dimensional mark. It is unlikely that a mere description of a three-dimensional article would ever be sufficiently precise to meet the requirements of the Act. Usually, we will not give a filing date to applications describing three-dimensional marks in words until a pictorial representation of the shape is supplied.

If the subject matter consists of the overall shape of the goods, or a container, it is difficult to represent the shape by a single front view which may not show whether it has a round profile or is four sided. Unless the subject matter can be demonstrated by a single perspective view, multiple views of the shape are necessary (no more than six as a general rule). The more complex the shape, the more likely it is that multiple views will be necessary. When multiple views are shown, each view should be named, for example, front view, side view.

Three-dimensional marks may be represented by a picture, or pictures, and words which describe the subject matter of the proposed registration. However, attempts to put forward pictures as mere examples of the shape described in words usually do not meet the requirement for 'a clear and precise' representation of the mark. In such cases, the application may be refused a filing date until any deficiency is corrected. If the subject matter consists of only part of a shape (such as a lid for a container), or the position of something (such as a label) attached to a three-dimensional object, it will not usually be necessary for the representation of the mark to show more of the shape than is necessary to disclose the subject matter, in these examples, the shape of the lid or the position of the label.

If a three-dimensional mark is represented by a perspective or other view(s) which discloses the essential particulars of the shape in question, it will not usually be necessary to confirm that the shape appears the same from other views. The same applies to three-dimensional marks incorporating labels. It is assumed that only those features visible from the representation form part of the subject matter; whether a container has another label on the back is irrelevant.

#### **2.4.5 Sound marks**

Sounds must be capable of being regarded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically. Sound marks, like smell marks, are not in themselves capable of being perceived visually, but they must nevertheless fulfil the requirements of being represented graphically on the application form. The representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. It is sufficient that the sign is easily intelligible, even if not immediately so. (See *Shield*, ECJ case C-283/01) To this end:

- applications for sound marks must clearly state that they are sound marks, otherwise the application will be examined as if it were a word and/or device mark (for example, in the case of musical notation); and
- graphic representation requirements are met by representation of the sign by a musical staff divided into measures and showing, in particular, a clef, musical notes and rests, indicating relative value, and sharps, flats and naturals (accidentals). This will render the timing and pitch intelligible.

The requirements of Section 1(1), and therefore Section 3(1)(a), are not met by a written description of the sound, for example, that the sign comprises a particular piece of music, or a list of the notes of which it is comprised, or the sound an animal makes. Simple sequential musical notation without indications as to timing and pitch, will also not meet the necessary requirements. If the musical instrument used to produce the sound forms part of the mark this should be stated.

The Registrar has not taken a position on sonograms and their acceptance is dependent upon whether they can be properly regarded as analogous to musical notation, particularly when it comes to the ease of reproducing the sound accurately from the sonogram.

#### **2.4.6 Moving images**

Movement marks require the same degree of clarity of representation as any other application, that is, the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (Sieckmann criteria, see paragraph 2.3 above).

Movement marks can be graphically represented by a series of still images and each case may have its own individual requirements, but the representation of the mark should include:

- that the mark is a moving image;
- what the image depicts, that is, what the change in appearance is;
- how many images are involved in the complete sequence of movement;
- what the sequential order is of the images; and
- that there is a single sequence of movement (not variable).

#### **2.4.7 Holograms**

For multiple feature hologram marks to meet the graphical representation requirements, the application form must contain representations of each of the various views depicted in the hologram. This will ensure that third parties can clearly see all the material features of the mark. For a very simple image, where the essential features do not change according to the angle at which it is viewed, multiple views may not be necessary and a single representation may be acceptable.

### **3 The applicant**

A registered trade mark and an application for registration are both personal property (Sections 22 and 27 refer). This means that an applicant must be an individual (a natural person) or some sort of legal person, capable of owning property in their own name.

Where there appears to be some doubt as to an applicant's legal status, we may ask for confirmation that the applicant has the necessary standing to hold property. If the application is made on behalf of an unincorporated association, it is important to remember that the association as such may not be capable of owning the application or the trade mark: unless the association is in the nature of a partnership, this can only be done by specified persons acting as trustees for the association. Similarly, an application on behalf of an unincorporated charitable trust must be made by the trustees. An application in the name of a body calling itself a 'trust' or a 'club' is liable to give rise to such a request for clarification.

We use the following guidelines when considering whether to question the legal status of an applicant:

#### **Companies/corporate bodies**

Any form of company, that is, a business incorporated into a legal entity as distinct from its members or directors, is capable of holding property in its own name.

## **Partnerships**

Partnerships (including limited liability partnerships, partnerships governed by an agreement and partnerships at will) are allowed to be recorded as applicants. If the applicant is a partnership, we will require that this be stated in the application, after the name of the partnership, for example, 'Boggles (a partnership)'. In the case of a partnership at will, it is necessary to list the partners who make up the partnership because (in the absence of an agreement) the legal personality of the proprietor will change every time a partner changes.

## **Other unincorporated bodies**

Other unincorporated bodies such as trading names do not have the capacity to hold property in their own name.

## **Trustees**

Where an application is made by a trustee or trustees, for the benefit of another person (or body of persons), it should be noted that only the name of the trustees will be entered on register. That is because Section 26 prohibits the entry of merely beneficial interests. Accordingly, the register will contain only the name of the legal owner of a mark, even where the beneficial owner is another person or body. Furthermore, that will still be the case, even where the beneficial owner is itself a person capable of owning property in its own right. Thus, wherever it is intended that the trade mark is to be held on trust for someone other than the legal owner, that legal owner (the trustee), rather than the beneficial owner (the person for whom the property is held), should be listed as the applicant.

## **Registered charities**

The mere fact that an organisation is a registered charity may not entitle the organisation to hold property; some other form of legal personality may be needed before it possesses property holding powers. However, the Registrar will accept an assurance from the filer that a registered charity has the necessary status to hold property in its own name.

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## 1. Introduction

The registration system in the United Kingdom is based on an internationally agreed system of classes covering different areas of trade in goods and provision of services. This guide sets out the purpose of classification, the legal framework and general principles to observe in classification.

## 2. The purpose of classification

In order to allow efficient searching of trade marks the UK uses “The International Classification of Goods and Services”, also known as the “Nice Classification”. The International Classification is administered by the World Intellectual Property Organisation (WIPO) and is used by over 140 countries throughout the world and by organisations such as The Office for Harmonization in the Internal Market (OHIM). Of these countries 83 are party to the Nice Agreement and 66, although not party to it, use the Nice Classification for their classification purposes. The system comprises 45 classes and groups together broadly similar goods or services into categories which assists the registry carrying out efficient searches of the register. Classes 1 – 34 contain goods and classes 35 – 45 contain services. It also allows businesses to check whether there are registered marks that conflict with marks they are using, or propose to use, in respect of particular goods or services. Whilst classification may be seen as an administrative tool its importance to applicants in relation to determining the boundaries of infringement rights cannot be stressed too highly. If the classification of the goods or services on an application is made incorrectly, the validity of any rights stemming from a subsequent registration might be called into question at a later date. This could result in a mark being the subject of proceedings to remove it from the register.

The Classification Team's ability to meet time related targets is dependent upon the detail of information that is provided. If full details are provided about the goods or services to be classified this should result in a faster turn round time.

### **Current Classification contact points:**

Telephone - (01633) 811148 or 811135  
E-mail - [TMClassificationEnquiries@ipo.gov.uk](mailto:TMClassificationEnquiries@ipo.gov.uk)  
Fax - (01633) 811177

### Web site information:

[www.ipo.gov.uk/t-class-guide.htm](http://www.ipo.gov.uk/t-class-guide.htm) - this will provide you with general information and an overview of the 45 classes of goods and services.

<http://tmclass.tmdn.org/ec2/> - this will provide a classification search database, which will help you to correctly classify the goods and services that you intend to use your trade mark on.

## 3. Legal framework and general principles

### 3.1 The classes

Goods and services are divided into 45 classes - 1 to 34 for goods and 35 to 45 for services.

Classification is set out in detail in the "International Classification of Goods and Services" published by WIPO (10<sup>th</sup> edition, published in 2011). As a supplement to the WIPO list, the Registry has prepared its own classification tool called Trade Mark Classification Search which is accessible on the Trade Marks part of the Office's website and can be found at: [www.ipo.gov.uk/tm/t-find/t-find-class.htm](http://www.ipo.gov.uk/tm/t-find/t-find-class.htm) . Compiled from information held on the Register, this searchable database represents the Registrar's view on the classification of goods or services. It contains over seventy five thousand entries (including all the entries found in the current edition of the WIPO list) and is a valuable aid in the classification of goods and services and the framing of specifications.

To access Trade Mark Classification Search Tool, click on to [www.ipo.gov.uk](http://www.ipo.gov.uk) - then the Trade Marks button - then On-line TM Services and finally Classification. Once you reach the Tool, help is given on how to access information from the database.

### 3.2 The International Classification (Nice Classification)

The "International Classification of Goods and Services" list is currently in its Tenth Edition, which came into force on 1<sup>st</sup> January 2012, and is divided into two parts. Part 1 consists of two alphabetical lists, one for goods and one for services. Part 2 lists the classes in numerical order and under each class lists goods and services class in alphabetical order.

The legal status for use of the International Classification in the UK is set out in the statute. Section 34(1) of the Trade Marks Act states:

Goods and services shall be classified for purposes of the registration of trade marks according to a prescribed system of classification.

And, under Rule 7 of the Trade Marks Rules 2008:

(1) The prescribed system of classification for the purposes of the registration of trade marks is the Nice Classification.

(2) When a trade mark is registered it shall be classified according to the version of the Nice Classification that had effect on the date of application for registration.

Trade mark registrations may be obtained in the UK from three organisations namely the UK Registry, WIPO (through the Madrid Protocol) and OHIM. All of these organisations classify goods and services in accordance with the International Classification as administered by the WIPO.

### 3.3 The Registrar's decision is final

Section 34(2) of the Act states:

Any question arising as to the class within which any goods or services fall shall be determined by the registrar, whose decision shall be final.

Although the UK registry follows the International Classification, ultimately Section 34(2) of the Act gives the registrar the power to decide any question arising "as to the class within which any goods or services fall". The same principle applies to Community Trade Mark applications before OHIM, an organisation which also makes its own discretion to determine classification issues. The International Classification is not fully comprehensive and in the absence of an item being specified in the list of goods and services, the registrar has to decide the appropriate class. In the GE Trade Mark case (1969 RPC 418) in Graham J. said:

“This section, in my judgment, is dealing with administrative matters and enables the registrar to decide without appeal in which class any particular goods must be registered. It does not oust the jurisdiction of the court to decide, as in the present case, whether any goods as to which there is a dispute properly fall within the specification”.

However, it should be noted that this power does not apply to International Registrations that are designated to the UK. Under the Madrid Protocol, WIPO is responsible for the classification of items which are included in specifications on the International Register.

### 3.4 Changes to the classification

Section 65 of the Act enables the registrar to make rules concerning changes to the classification.

Sub-section (1) says:

Provision may be made by rules empowering the registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks.

From time to time changes to the International Classification are made and these are published on our website. However, each application is classified by reference to the classification which is in force at the time of application and consequently changes are not made retrospectively to existing registrations unless the registrar considers it necessary for existing entries on the register to accord with the new classification (Section 65(2)). Applications made before that date are subject to the old classification. This practice is well established, see the Australian Wine Importers case (6 RPC 311), Cal-U-Test (1967 FSR 39), GE Trade Mark case (1969 RPC 418) and more recently in the Avenet Incorporated v. Isoact Limited case (1998 FSR 16), in which Jacob J. said:

“It is settled, at least at first instance,...one has to look at the Trade Mark Registry practice to see whether the registrar in practice at the time of registration included the particular service or goods within that class (see GE Trade Mark 1969 RPC 418 at 458).”

In the Cal-U-Test case the classification had changed since the date of registration but the case was decided with reference to the practice at the date of registration. When a new edition of the classification has been published special care must be taken to note items that have changed class. When searching for earlier marks the classification at the date of registration of any conflicting mark is the relevant one. Examiners should familiarise themselves with changes that have taken place and may have to adjust the search accordingly.

Changes to the classification are usually made following meetings at WIPO at which the UK is represented. WIPO now aims to revise the classification every three or five years and to issue a new edition of its list following decisions made by the Preparatory Working Group as confirmed by the Committee of Experts. The 10<sup>th</sup> edition of the International Classification became effective on 1<sup>st</sup> January 2012. The purpose of amending the classification is mainly to remove anomalies and inconsistencies that have been found and to make improvements with new entries. We are always willing to consider suggestions to improve the classification and where fundamental changes are proposed, consultations will take place with the users of the office.

### **3.5 Need for clarity in specifications**

Rule 8(2)(a) and (b) states:

(2) Every application shall specify-

(a) the class in the Nice Classification to which it relates; and

(b) the goods or services which are appropriate to the class and they shall be described in such a way as to indicate clearly the nature of those goods or services and to allow them to be classified in the classes in the Nice Classification.

Following the Postkantoor (C-363/99) decision it is clear that the scope of registered rights must be determined with legal certainty. Clarity and consistency of treatment is the aim when dealing with specifications. This is desirable for all the users of the office. It is unacceptable that searchers should be inconvenienced by specifications which do not make it clear what goods or services are covered. Examiners must satisfy themselves that all the terms of a specification are understandable. The Examiner may require some explanation of the terms used by the applicant, but this does not necessarily mean that the term is inappropriate.

The test to be applied is whether the applicant's descriptions of his goods or services are such that permit an average person engaged in the relevant trade to clearly ascertain the nature of the goods or services for which the applicant seeks to register his trade mark, without the need for further explanation.

Though it is preferable that terms be defined in mainstream dictionaries, it is acceptable to use terms found in specialist dictionaries or other works. Also many terms are used which are common in particular trades and can be accepted in specifications providing they are clearly understood and fall in the class of the application. Even if a particular term does not appear in a specialist dictionary it may be accepted on the basis that it is widely understood, for example when a new term of art is prevalent on the internet.

Examiners should not allow an item in a specification unless they are satisfied the descriptions of goods or services satisfies the test described above and that the goods or services fall in the class or classes designated on the application form.

### **3.6 Meaning of terms contained in specifications**

In *British Sugar PLC-v-James Robertson & Sons Ltd* (1996 RPC 280) (the TREAT decision) Jacob J said:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

In the *OFREX* case (1963 RPC 169-171), Pennycuik J. made the following comments concerning the scope of the term “stationery”:

“What is said is that staples do not come within class 39 [refers to the UK classification in force 1876-1938] as an item of stationery.... in order to answer that question, the first step I think is to look at the ordinary meaning of the word “stationery”, which as defined in the Oxford English Dictionary is: “the articles sold by a stationer; writing materials, writing table appurtenances, etc”. I feel no doubt that staples are stationery, according to the ordinary meaning of the word”.

And in the *MINERVA* case (2000 FSR 734) Jacob J. made the following comments concerning printed matter:

“The specification of goods poses difficulties. “Printed matter” as a pure matter of language, I suppose, covers anything upon which there is printing. In a sense, every trade mark for whatever goods could also therefore be registered for printed matter if one reads “printed matter” perfectly literally. Every packet has printed matter on it. “Printed Matter” cannot in my judgment mean merely that the trade mark is printed on something. For example, if there is a registration for “printed matter” but the only use is on labels for, say, soap or bananas, there has not been use for printed matter. On the other hand, the kind of printed forms and other things produced by these proprietors seem to be perfectly well described as “printed matter”. People buy them for what is printed on them. However, there is a very big difference between that sort of printed matter and printed matter of a literary character.”

### **3.7 Class to be taken into account when interpreting specifications**

Care must be taken concerning the scope of what a particular item covers when viewed in the context of the class in which it is applied or registered. For example, a registration in respect of “articles of clothing” in Class 25 does not include “articles of clothing for protection against accidents” in Class 9. Similarly, an application for “cases” in Class 18 could not include within its scope “violin cases” in Class 15. In the Court of Appeal, Lord Justice Mummery observed in the case of *Altecnic Ltd’s* application (2002 RPC 34) - commonly referred to as the *CAREMIX* decision – at paragraph 45:

“In my judgment, the registrar is entitled to treat the class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods. The application is a considered statement of the applicant which, on ordinary principles of the construction of documents, has to be read as a whole to determine its meaning and effect. The fact that the internationally agreed Nice Classification System has been devised to “serve exclusively administrative purpose” (see, for example, Rule 2(4) of the Commission Regulation 2868/95EC) does not mean that the selection by the applicant of one or more class numbers in his application has to be totally ignored in deciding, as a matter of construction of the application, what the application is for and whether it can be properly amended. I would reject the submission of Mr Purvis that it is only permissible to take account of the class number when it expressly (or implicitly) referred to in the “specification of goods” column of Form TM3, as in the examples helpfully discussed by Jacob J in *British Sugar PLC -v- James Robertson & Sons Limited* [1996] RPC 280 at p289 (eg consideration of the relevance of the practice of the registrar at the date of registration of adding to the list “All included in this class” and “All included in class X”). That kind of case is no doubt a stronger one for interpretation of the application by reference to the class number, but I fail to see why it should be the only kind of case in which the class number can be taken into account by the registrar or why the registrar should have to ignore the class number which the applicant (or his advisers on his behalf) have inserted in the Form TM3 as part of the required expression of the applicant’s case in relation to the registration of the trade mark.”

### **3.8 Interpreting specifications of services**

In relation to descriptions of services, extra care should be taken when defining the scope of a specification. In the *Avenet Incorporated v. Isoact Limited* case (1998 FSR 16), Jacob J. said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

### **3.9 Interpreting the WIPO class headings**

The use of WIPO class headings as statements of goods or services may lead to confusion concerning the scope of protection provided. In the context of the Nice International Classification, it is clear that the headings to the classes are intended to convey general indications relating to the fields to which goods or services belong (see General Remarks, Nice Classification 10<sup>th</sup> edition, page 3).

When a class heading is used as a specification, it loses its capacity to function as a class heading and becomes part of an application or registration as a statement of goods or services. It follows that the question of what a class heading includes or does not include is irrelevant and interpretation of the statement of goods or services may only be made by reference to the goods or services included in that statement.

It is a common misunderstanding that a WIPO class heading always includes all the goods or services in a particular class and some applicants may be misled into thinking there is no need to be specific when making an application. For instance, the heading for Class 15 is “Musical instruments”. The goods “stands for musical instruments” are also proper to this class but are not covered by the scope of the heading. Likewise the heading for Class 12, “Vehicles; apparatus for locomotion by land, air or water” makes no reference to “Repair outfits for inner tubes.” In Class 20, the item “sleeping bags for camping” is not covered by “furniture”.

### **3.10 Intention to use the mark on all the goods or services within a claimed specification**

Section 3(6) of the Act states:

A trade mark shall not be registered if or to the extent that the application is made in bad faith.

During the passage of the Trade Marks Bill, Parliament was informed that a circumstance where bad faith might be found included instances where the applicant has no bona fide intention to use the mark, or intends to use it, in relation to the whole range of goods and services listed in an application.

In the Mercury Communications case (1995 FSR 850) Laddie J, said:

“In my view it is thoroughly undesirable that a trader who is in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those far removed from his own area of interest. If he does he runs the risk of his registration being attacked on the grounds of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

These comments were quoted with some approval by Walker J. in the Roadrunner case (1996 FSR 818) in relation to Section 3(6) of the Act. He said:

“Counsel have not been able to refer me to any material which shows the legislative purpose behind the Directive’s reference to bad faith. The recitals of the Directive make clear that it is intended to achieve partial (not total) harmonisation of trade mark law within the European Union. The recitals refer to it being essential to require ‘that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical to all Member States’ and the need to ‘require that registered trade marks must actually be used or, if not used, be subject to revocation’.”

“I find it impossible to get any clear guidance from these general recitals. They do however provide some support for Laddie J.’s observations in Mercury, which I have already cited, that unduly wide specifications may not be possible under the 1994 Act.”

In line with Section 32(3) of the Act, the application form TM3 requires the applicant to state that:

...the trade mark is being used, by the applicant or with his or her consent, in relation to those goods or services, or that he has a **bona fide** intention that it should be so used.

In relation to what is meant by intention, in the case of DUCKER'S trade mark (45 RPC page 402), the Master of the Rolls, Lord Hanworth, quoting the BATT'S trade mark case said:

"a man must have an intention to deal, and meaning by the intention to deal some definite and present intention to deal in certain goods or descriptions of goods; I agree that the goods need not be in being at the moment, and that there is futurity indicated in the definition; but the mark is to be a mark which is to be definitely used or in respect of which there is a resolve to use it in the immediate future upon or in connection with goods. I think that the words "proposed to be used" mean a real intention to use, not a mere problematical intention, not an uncertain or indeterminate possibility, but it means a resolve or settled purpose which has been reached at the time when the mark is to be registered."

He went on to ask what is the meaning of "bona fide"? and said:

"I think that must mean a real intention in the sense which I have already explained and if it is not found that there was a real resolve, intention and purpose, then it is shown that originally the mark was put upon the Register at a time when it ought not to have been put on, because there was not a sincere purpose to make use of the mark in connection with goods".

Accordingly, applications will normally be accepted even if they cover goods or services in many classes. However, in extreme cases, or where vague and wide terminology is used, the registrar will raise an objection under Rule 8(2) of the Act on the basis that the statement on the application form appears to have been made in bad faith.

See Classification Desk Instruction at 2.15 which gives detailed guidance on the criteria and procedures for raising objections under Rule 8(2).

### **3.11 Widening of a specification after filing not allowed**

Section 39(2) states:

In other respects, an application may be amended, at the request of the applicant, only by correcting-

- (a) the name or address of the applicant,
- (b) errors of wording or of copying, or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

The widening of a specification after filing an application could disadvantage other applicants who have searched the pending marks index and is therefore not permitted. See Classification Desk Instruction at 2.3 to 2.13 which sets out practice in relation to changes to specifications of applications and paragraph 3.1 which deals with amendment of specifications of registrations.

### **3.12 Case law:**

#### **Retail, wholesale and shopping centre services**

In [Case C-418/02 \(Praktiker\)](#), reference for a preliminary ruling under Article 234 EC from the Bundespatentgericht (Germany), was made to the European Court of Justice in relation to an application from Praktiker Bau- und Heimwerkermärkte AG, concerning the registration of a trade mark in respect of services provided in connection with retail trade.

In reply to the questions asked of it, the Court ruled in its judgment issued on 7 July 2005 that:

1. The concept of 'services' referred to by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, in particular in Article 2, covers services provided in connection with retail trade in goods.
2. For the purpose of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details must be provided in connection with regard to the goods or types of goods to which those services relate."

#### **Scope and effect of the Praktiker decision**

The services provided by retailers are recognised by the Court as being “all activity carried out by the trader for the purpose of encouraging the conclusion of a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the above mentioned transaction with the trader in question rather than with a competitor”.

Accordingly, these are the services covered by a “retail services” type registration.

The Court stated that it is not necessary to specify in detail the retail services for which registration is sought. Rather general wording may be used. In that connection the Court cited with approval the wording in the explanatory note to Class 35 of the International Classification, namely, “the bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods.”

Having recognised that there is no barrier to the registration of services connected with the retail trade in goods, the Court did not draw any distinction between the various forms of retail services (for example, supermarkets, department stores, specialist retail outlets, mail order, electronic shopping etc). Whereas in the past it was a requirement in the UK to specify the precise nature of the retail services being provided, the Court makes it clear that this is not

required and that the emphasis is to be placed on the nature of the goods supplied in connection with the services.

Consequently, it is necessary to specify the goods or types of goods in **all** cases. The mark Praktiker was filed for registration in relation to, inter alia, retail services in connection with the “building, home improvement and gardening goods for the do-it-yourself sector”. The Court approved this as being sufficient to identify the types of goods connected with the services applied for.

Consequently, an indication of the types of goods concerned with the services will be sufficient, although applicants may list the associated goods in more detail if they so wish. Note that a registration for retail services does not cover the sale of goods themselves and therefore if applicants require protection for their marks to include the transaction that occurs between the customer and the retailer at the point of sale, it will be advisable to file in the appropriate goods classes in respect of those items that are being sold under the trade mark.

### **What is acceptable**

The following paragraphs provide guidance on what is (and what is not) acceptable and the effect of the revised practice on pending applications and existing registrations.

#### **Acceptable**

The bringing together, for the benefit of others, of a variety of [indicate goods or types of goods], enabling customers to conveniently view and purchase those goods; The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase [indicate goods or types of goods];

Retail services connected with [indicate goods or types of goods];

Retail services connected with the sale of [indicate goods or types of goods];

Retail store services in the field of [indicate goods or types of goods];

Department store retail services connected with [indicate goods or types of goods] as in, for example:

Department store services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products;

Shop retail services connected with [indicate goods or types of goods];

Mail order retail services connected with [indicate goods or types of goods];

Electronic shopping retail services connected with [indicate goods or types of goods];

Retail clothing shop services;

Stationery shop retail services connected with the sale of stationery, printed matter, computer equipment and peripherals and home entertainment products;

The bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods from a clothing and clothing accessories catalogue by mail order or by means of telecommunications.

**Not acceptable**

Sale of electrical and electronic goods for industrial use [the sale of goods is not a service];

Trade in building products [trading in goods is not a service];

Retailing [retailing goods is not a service per se];

Retailing of cars [retailing of goods is not a service];

Retail services for the sale of foods [sale of goods is not a service];

Retail off licences specialising in the sale of alcoholic beverages [sales are not a service];

Online marketplace for the sale of goods [not a service per se];

Online marketplace connected with the sale of goods [not a service per se];

Resale of goods [not a service per se];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods specialising in [indicate goods or types of goods]

Shops [not a service per se];

Factory shops [not a service per se];

Shopkeeping [not a service per se];

Merchandising [not a service per se];

Distributorship [not a service per se];

Sales services [not a service per se];

Direct selling [not a service per se];

Mail order [not a service per se];

Television shopping [not a service per se];

Electronic shopping [not a service per se];

Computer shopping [not a service per se];

E-commerce [not a service per se] ;

Retail services [unqualified] ;

Retail store services [unqualified];

Department store services [unqualified];

Mail order catalogue services [unqualified];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those [unqualified] goods; The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store [“department store” does not identify the types of goods];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise internet web site [“general merchandise” does not identify the types of goods];

Retail services connected with the sale of electrical and electronic goods [the terms “Electrical” and/or “Electronic” are too vague without further indication to define types of goods];

Retail services connected with stationery products and the like goods [“and the like goods” fails to identify the goods or types of goods];

### **Wholesale services**

The Court’s judgment did not include any observations concerning the acceptability of services provided by wholesalers. However, the same practice will apply as for retail services and it will be necessary to specify the goods or types of goods, as in, for example:

Wholesale services connected with the sale of [indicate goods or types of goods]

### **Where the specification is deficient**

For descriptions which identify retail services but which do not clearly indicate the goods or types of goods connected with the services, an objection will be raised under section 1(1) and/or rule 8(2)(b) (because such claims do not clearly identify “services” within the meaning of section 1(1) of the Act). Similarly, specifications which include descriptions that adequately identify the goods, but fail to define the retail services, (for example, “sale of clothing”) will face similar objections.

### **Effect on pending applications**

In order to comply with the Courts judgement, pending applications that do not conform with the revised practice will require amendment (except those applications that have already been fully accepted and which include specifications agreed under the previous practice).

Examiners will write to applicants or their representatives and allow sufficient time in which to make proposals to amend their specifications.

### **Effect on registrations**

Owners of registered marks may request a restriction of their specifications (in order to comply with the revised practice). For example, a registration in Class 35 for: “The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store” could be amended by requesting part surrender of the specification (using Form TM23) as in, for example:

“Surrendered in respect of all services except the bringing together, for the benefit of others, of a variety of [ state goods or types of goods ] , enabling customers to conveniently view and purchase those goods in a department store”;

### **Absolute Grounds for refusal**

Retail stores are commonly named after their geographical location. Retail services will therefore be classified as a local service and applications to register geographical place names as trade marks for such services will normally be objected to.

### **Shopping Centre Services**

In the judgement of the High Court in *Land Securities plc (and others) (CH2008 APP 0278/0279/0281)* it was recognised that the services provided by the operator of a shopping centre are those which "make the shopping centre as a whole an attractive place for the consumer to come and spend money. In that manner the operator generates a goodwill associated with the name or mark under which the shopping centre trades. To that extent, the shopping centre operator is providing services".

In reaching its decision, the Court focused on the following terms which made up the opening section of the specification in question:

"The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and other services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall;"

Having decided that the operator of a shopping centre or mall does provide a service within the meaning of the Trade Marks Act 1994, the Court then went on to consider whether the terms applied for are sufficiently clear for the purposes of satisfying rule 8(2)(b) of the Trade Marks Rules. Ultimately, the Court found that the majority of those terms did satisfy the relevant criteria, although objections were upheld against the references to "and other services" and "such facilities" on the basis that they are broad, non-specific and unclear (paragraphs 50-51 of the decision refer).

Based on guidance set out in this decision, the Registrar **will accept** the following specifications:

The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and [other clearly defined *related* services], enabling customers to conveniently view and purchase goods and make use of and purchase such services in a shopping centre or mall.

The bringing together for the benefit of others, via the internet, of a variety of retailers and [other clearly defined *related* services] through a virtual shopping mall, enabling customers to conveniently view and purchase goods and make use of and purchase such services by means of telecommunications.

In the above examples, the reference to "other clearly defined *related* services" refers to those services which are conventionally offered within a shopping centre to complement the primary activity of providing retail outlets. To illustrate this point, the Court acknowledged facilities as child care, language assistance, car cleaning, restaurants and cinemas as being services typically provided within a retail environment (paragraphs 13 and 28 of CH2008 APP 0278/0279/0281 refer). It is important to emphasise that any reference to such services included as part of a wider shopping centre-type specification will not equate to a claim to the provision of those services *per se*. To illustrate this point, the Registrar will not consider a class 35 claim to "the provision of restaurant facilities" (where it is made as part of a wider claim covering the services of a shopping centre operator) to be the same as a claim to "restaurant services" which are proper to class 43.

It should also be noted that the specifications presented above **do not** exhaustively list the specific goods which are likely to be provided by outlets situated within the shopping centre or mall. Notwithstanding the fact that the listing of goods remains a requirement of more conventional retail claims, the Registrar does not consider it to be a necessary requirement in relation to claims for the operation of shopping centres and malls.

By contrast, applicants should note that the following example specification **would not be accepted**:

The bringing together for the benefit of others, of a variety of retail outlets and other services enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall. It is important to stress that the judgement in *Land Securities* did not focus on "the bringing together of services" *per se*, but only "the bringing together of services within a shopping centre or mall" (including the virtual type). As a consequence, specifications which involve the bringing together of services in some other manner will be judged on a case by case basis and referred to classification section where necessary.

## 4 The History of Classification

**The purpose of this information is to provide a breakdown on the history of the Classification system and the amendments made to the system throughout the years.**

### 4.1 The classification used from 1876 to 1938

When the registration of trade marks started in the UK in 1876 a system of 50 classes was used as a basis for the registration process. The classes used are shown in the Rules adopted at the time of the first Trade Marks Act. This system was in use until 1938 when the new Trade Marks Act and Rules of that year became law. The class headings as they were in 1938 are shown in Schedule 2 of the Rules 2000 (unamended version).

Each edition of the Rules from 1876 to 1938 shows the classification in force at a particular date. The 50 class system remained essentially the same during that period. In 1938 the registry published a "Guide to the Classification of Goods under the Trade Marks Acts 1905-1919". This shows the class headings and gives an alphabetical list of goods together with their class numbers. This is the best published guide to the classification during this early period and is available for consultation at the registry.

### 4.2 The International Classification (from 1938 to present)

At the International Conference under the auspices of the United International Bureau for the Protection of Intellectual Property (BIRPI), a predecessor of WIPO, a new classification for international purposes was drawn up. The UK adopted this classification in 1938. The class headings were published as Schedule IV to the Trade Mark Rules of 1938 and came into force for applications made on or after 27th July 1938. At the same time the 1938 Trade Marks Act came into force.

This classification was set out in more detail in two publications, namely, "The Alphabetical Index to the Substituted Classification of Goods" and "The List of Goods in each of the Classes of the Substituted Classification of Goods". The 1938 classification was added to and amended from time to time and the following are the Trade Mark Journals in which amendments appear:

First list:	J3197, 5th July 1939
Second list:	J3223, 3rd January 1940
Third list:	J3249, 3rd July 1940
Fourth list:	J3275, 1st January 1941
Fifth list:	J3301, 2nd July 1941
Sixth list:	J3328, 7th January 1942

Seventh list: J3353, 1st July 1942  
Eighth list: J3380, 6th January 1943

Ninth list: J3406, 7th July 1943  
Tenth list: J3432, 5th January 1944

Eleventh list: J3458, 5th July 1944

Twelfth list: J3484, 3rd January 1945

Materials made of plastics which are used for substantially the same purpose as textile materials: J3600, 9th April 1947

Thirteenth list: J3647, 3rd March 1948

Fourteenth list: J3717, 6th July 1949

In 1950 a new index was published incorporating the above amendments. The following are the Trade Mark Journals in which amendments to this appear:

First list: J3769, 5th July 1950

Second list: J3789, 10th January 1951

Third list: J3919, 8th July 1953

An errata concerning tomato juice was published in J4026, 27th July 1955.

Fourth list J4100, 6th February 1957

Amendments about clock and watch cases and travelling rugs were published in J4180, 20th August 1958.

This classification remained in force until 1965 when a further revised consolidated version of the classification was published following signature of the Nice Agreement.

### **4.3 The Nice Agreement and amendments to the classification**

The International Classification became the subject of the Nice Agreement in 1957 when a number of countries, including the UK which was already using it, agreed to adopt it for the registration of marks. The UK formally ratified the original Nice Agreement in April 1963 and ratified a revised "Stockholm" text (Cmnd 4437, 1970) in March 1970. The agreement in its latest form is reproduced in the WIPO publication "International Classification of Goods and Services for the purposes of the Registration of Marks". WIPO was set up 1970.

The following editions of the International Classification have been published since the Nice Agreement:

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First edition	1963
Second edition	1971
Third edition	1981
Fourth edition	1983
Fifth edition	1987
Sixth edition	1992
Seventh edition	1997
Eighth edition	2002
Ninth edition	2007
Tenth edition	2012

The first and second editions were only published in French as the official text.

An official English translation was published separately in 1965. This was updated by amendments published in the following editions of the Trade Marks Journal:

J4655,	15th November 1967
J4777,	18th March 1970
J4827,	3rd March 1971 (amended to be consistent with the 2nd edition of the International Classification)
J4987,	27th March 1974
J5015.	9th October 1974

The third edition of the International Classification was published in both English and French with both languages being authentic texts. This became effective on 1st February 1981. No changes of goods or services from one class to another were involved.

The changes introduced in the fourth edition became effective on 1st June 1983 and are set out in Trade Marks Journal 5464, 1st June 1983.

The changes introduced in the fifth edition became effective on 1st January 1987 and are set-out in Trade Marks Journal 5639, 8th October 1986.

The changes introduced in the sixth edition became effective on 1st January 1992 and are set out in a supplement to Trade Marks Journal 5897, 30th October 1991.

The changes introduced in the seventh edition became effective on 1st January 1997 and are set out in Trade Mark Journals 6152, 20<sup>th</sup> November 1996, 6153, 27<sup>th</sup> November 1996 and 6154, 4<sup>th</sup> December 1996.

The changes introduced in the eighth edition became effective on 1st January 2002 and are set out in a supplement to Trade Marks Journal 6407, 28<sup>th</sup> November 2001.

**Other changes or announcements concerning classification and date of publication are:**

Low alcohol drinks - classified from 27<sup>th</sup> April 1987 by reference 1.2% instead of 2% (by volume) alcoholic content, Trade Marks Journal 5669, 6<sup>th</sup> May 1987.

Introduction of the practice known as "All included in class", Trade Marks Journals 5669 and 5770, 6<sup>th</sup> May and 13<sup>th</sup> May 1987 .

Babies' napkins of cellulose or those predominantly of cellulose - transferred to class 16, Trade Marks Journal 5674, 10<sup>th</sup> June 1987.

Publication of the first edition of the Guide to Classification of Service Marks in the United Kingdom, Trade Marks Journal 5772, 10<sup>th</sup> May 1989.

Rule 21 objections in relation to class 9 and class 16 goods, Trade Marks Journal 5844, 10<sup>th</sup> October 1990.

Safes, computer programs and welding apparatus, Trade Marks Journal 5853, 12<sup>th</sup> December 1990.

Changes in class involving various goods and services, Trade Marks Journal 5902, 4<sup>th</sup> December 1991.

Rule 21 objections in relation to class 9 and 16 goods, Trade Marks Journal 5937, 19<sup>th</sup> August 1992.

Classification of diagnostic apparatus and instruments, paper hats and protective pads, Trade Marks Journal 5965, 10<sup>th</sup> March 1993.

Classification of shower cubicles, shower stalls, shower trays/bases, bath screens, partitions and parts and fittings for showers, Trade Marks Journal 5973, 5<sup>th</sup> May 1993.

Publication of the second edition of the Guide to Classification of Service Marks, Trade Marks Journal 5997, 13<sup>th</sup> October 1993.

Conversion for registrations classified under Schedule 3 to Schedule 4 of the Trade Marks Rules 1986, Trade Marks Journal 6007, 12<sup>th</sup> January 1994.

Practice in relation to the classification of computer games apparatus, video games apparatus, computer games software, programmes and cartridges, Trade Marks Journal 6011, 9<sup>th</sup> February 1994.

Classification of on-line and internet services and associated goods: UK practice at May 1996, Trade Marks Journal 6128, 5<sup>th</sup> June 1996.

Classification of on-line and internet services and associated goods: UK practice at July 1999, Trade Marks Journal 6282, 23<sup>rd</sup> June 1999.

Classification of on-line and internet services and associated goods: UK practice at July 1999 - Supplementary Notice, Trade Marks Journal 6291, 25<sup>th</sup> August 1999.

Practice Amendment Circular 02/99 Adding a class or classes to an application.

Practice Amendment Circular 04/00 Classification of on-line and internet services and associated goods: UK practice at February 2000, Trade Marks Journal 6319, 15<sup>th</sup> March 2000.\*

Practice Amendment Circular 10/00 Examination of wide specifications and objections under Section 3(6) of the Act, Trade Marks Journal 6334, 28<sup>th</sup> June 2000.\*

Practice Amendment Circular 13/00 Retail Services, Trade Marks Journal 6350, 18<sup>th</sup> October 2000.

WIPO Committee of Experts of the Nice Union, Classification of Goods and Services - Restructuring of Class 42 and Classification of Beer, Trade Marks Journal 6356, 29<sup>th</sup> November 2000.

Practice Amendment Notice 08/02 Examination of wide specifications and objections under Section 3(6) of the Act (published on website only)

Practice Amendment Notice 06/04 Territorial and other limitations (published on website only)

Practice Amendment Notice 06/05 Retail services

Practice Amendment Notice 05/06 Wide and vague specifications

Practice Amendment Notice 07/06 Retail services: search of the register

Practice Amendment Notice 01/09 Shopping centre services

Practice Amendment Notice 03/13 List of goods/services and use of class headings.

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## **1 INTRODUCTION AND PURPOSE**

The purpose of these instructions is to give details on the classification team procedures and to ensure consistent and uniform working procedures are adopted. It sets out the best working practice for the various procedures and duties undertaken.

## 2 CLASSIFICATION WORKING PROCEDURES: APPLICATIONS

The three essential principles which need to be borne in mind when classifying and editing the specifications of an application are:

- the goods or services should fall within the class(es) shown on the application;
- the descriptions are clear, within the context of the class number specified, and are understandable, in order that a proper search of the register may be carried out;
- the range of goods/services is not outside the practice concerning wide specifications.

The following paragraphs detail the procedures which apply these principles. However, there may be applications with specifications that appear to conflict with the guidelines but which make it perfectly clear what goods or services in which class are covered. Specifications that meet these requirements are acceptable and should not be edited merely to bring them into line with the contents of this manual. This should be borne in mind at all times when considering any changes to a specification.

The examination and editing of specifications is carried out by the Examiner. Classification is an integral part of the examination function and it is the Examiner's responsibility to ensure that the application is correctly classified. Each examiner has an individual responsibility to ensure that the application under examination is correct in all respects - including its classification. It is recognised that on some occasions expert help may be needed when classifying difficult items or activities. To this end in addition to the “International Classification of Goods and Services” list, the Classification Team provides a networked and constantly updated classification database which is available on the website. The Team also provides advice to staff on difficult cases.

The classification and editing of specifications involves a number of checks which are listed in outline below but are dealt with more fully in the section referred to after each item. The guidelines for punctuation and editing indicate the ideal. However it must be emphasised that if specifications are clear and the goods or services are properly classified they should not be changed.

### 2.1 How to classify goods and services

First, consult the “International Classification of Goods and Services”. If the item is not listed then check the Registry’s Classification Search database at [www.ipo.gov.uk/tm/t-find/t-find-class.htm](http://www.ipo.gov.uk/tm/t-find/t-find-class.htm).

If no reference is found then consult the List of Classes together with the Explanatory Notes in the International Classification for those classes which are thought to be most appropriate. In the event that the item is still not capable of being classified, the following principles are used to determine its classification:

## GOODS

(a) A finished product is in principle classified according to its function or purpose. If the function or purpose of a finished product is not mentioned in any class heading, the finished product is classified by analogy with other comparable finished products, indicated in the Alphabetical List of the WIPO International Classification. If none is found, other subsidiary criteria, such as that of the material of which the product is made or its mode of operation, are applied.

(b) A finished product which is a multipurpose composite object (e.g., clocks incorporating radios) may be classified in all classes that correspond to any of its functions or intended purposes. If those functions or purposes are not mentioned in any class heading, other criteria indicated under (a), above, are to be applied.

(c) Raw materials, un-worked or semi-worked, are in principle classified according to the material of which they consist.

(d) Goods intended to form part of another product are in principle classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases, the criterion indicated under (a), above, applies.

(e) When a product, whether finished or not, is classified according to the material of which it is made, and it is made of different materials, the product is in principle classified according to the material which predominates.

(f) Cases adapted to the product they are intended to contain are in principle classified in the same class as the product. For example, cases for sunglasses – Class 9; cases for medical tools – Class 10; cases for rifles – Class 13; jewellery cases – Class 14 (not to be confused with trinket boxes – Class 20).

## SERVICES

(a) Services are in principle classified according to the branches of activities specified in the headings of the service classes and in their Explanatory Notes or, if not specified, by analogy with other comparable services indicated in the Alphabetical List of the WIPO International Classification.

(b) Rental services are in principle classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, covered by Class 38).

(c) Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Class. 39), business management consultancy (Class. 35), financial consultancy (Class. 36), beauty consultancy (Class. 44). The rendering of the advice, information or consultancy by electronic means (e.g., telephone, computer) does not affect the classification of these services.

## 2.2 Goods or services to be grouped together by class number

An application may be made in more than one class. Where an application relates to more than one class the statement of goods and/or services shall specify for each item each separate class for which registration is sought. If there are items proper to more than one class they should be grouped together by reference to their specified class number. In all cases the items or groups of items specified by class number should be listed in consecutive numerical order. Where goods or services do not relate to the class number(s) specified on the application form, the applicant may add an extra class or classes to his application subject to payment of the appropriate additional class fee(s)

If an application is filed without a class number and the goods fall in more than one class, for example, detergents, which can fall in classes 1, 3 and 5, the examiner will advise the applicant of the deficiency in the examination report (under Rule 13) in order to give the applicant the opportunity to amend the application to comply with Rule 8(2)(a) and 8(3) :

(2) Every application shall specify-

(a) the class in the Nice Classification to which it relates; and...

(3) If the application relates to more than one class in the Nice Classification the specification contained in it shall set out the classes in consecutive numerical order and the specification of the goods or services shall be grouped accordingly.

Note that it is the responsibility of the applicant to insert the class number on an application form and in cases of doubt, pre-filing advice is freely available from the Classification Team.

## 2.3 Editing vague or incomprehensible specifications or terms within specifications

The first thing to establish about any specification applied for is whether or not the goods or services for which cover is sought is understandable. If most of the specification is too vague and cannot be classified, details of the goods or services should be requested. If necessary, further information should be sought, such as in the form of brochures or pamphlets published by the applicant, which are directly relevant to the application. It puts the onus on the applicant to send this further information to help clarify what the specification is intended to cover and provide suitable wording for this.

If a class has been specified by the applicant this may enable an Examiner to edit a vague item so as to suggest an acceptable term. Such amendments must be brought to the applicant's attention in the examination report. If only a minority of terms are not understood these should be edited to something comprehensible or removed altogether and a note put on the examination report under the edited specification that.....(list items) are too vague and should be further explained if not covered by the edited specification.

For example:

Class 9 Computers; computer programs; tapes and discs, all being magnetic and for use in the recording of data; compusificators.

Offer in the examination report letter:

Class 9           Computers; computer programs; tapes and discs, all being magnetic and for use in the recording of data.

and add a note reading "Compusificators" is not understood and further explanation should be given if it is not covered by the above specification.

Note: if the term "compusificators" is explained and accepted or another term accepted in its place, the application may have to be re-searched by the Examiner.

If the specification is preceded by a class number it will be acceptable to allow certain terms which, without the class designation, would prove to be too vague to classify. For example, an application filed for:

Class 35           Information services

This is acceptable since these services can only relate to business, advertising, accounting etc in Class 35, whereas "information services" without any class designation is far too vague, encompassing information in relation to any activity or goods.

Other examples of goods or services that should not be queried are:

Class 3           Detergents (can only relate to detergents in that class);

Class 6           Building materials (only covers metallic goods);

Class 14          Badges (limited to badges of precious metal for wear);

Class 25          Protective clothing (class specified effectively excludes protective clothing in Class 9);

Class 33          Beverages (can only mean alcoholic beverages classified under this class);

Class 38          Rental services (edit to rental of telecommunications apparatus: that is all that is in this class).

However, specifications that are so vague or incomprehensible that it would be pointless to examine the application without clarification should be queried by getting more information from the applicant either using the examination report or, alternatively, it may be quicker and more convenient to speak to the applicant or their agent by telephone.

If the reply is not clear a letter seeking further clarification should be sent.

Examiners should not raise expectations which cannot be fulfilled. On a number of occasions in the past practitioner's have complained that they had provided further details about the goods on an application only to be told that it was not possible in the circumstances to add a class. In situations where Examiners have to raise a specification query they should consider the likely implications of such a request. It should be made clear from the outset whether a class or classes will be allowed to be added. For example, if an applicant files for "materials

for making tiles” under Class 17 there is no point in saying that “it might be possible to add a class” since there are a range of materials in Class 17 for use in making tiles.

## 2.4 Goods or services incorrectly classified by the applicant

If it is clear from the specification that there are goods or services that are obviously proper to other classes that the application does not cover, the applicant will be informed of the discrepancies in the examination report. For example, an application for:

Class 33 Wines, lager, stout, shandy and beer.

the applicant would be advised that "lager, stout, shandy and beer" are proper to Class 32 and invited to add a class thus extending the application to cover Class 32.

Similarly an application filed for:

Class 39 Arranging of travel; providing car hire; booking of accommodation for travellers.

would prompt the examiner to advise the applicant in the examination report that the service of "booking of accommodation for travellers" is proper to Class 43. Again the applicant has the option of extending the application to cover two classes. In the event of these discrepancies being raised at the examination report stage, the applicant will have an opportunity to add an extra class or classes (by filing a form TM3A) after examination. This applies even if a majority of the goods or services are not covered by the class or classes stated. Alternatively, the goods or services that are not covered by the present class or classes may be deleted.

It is the Examiner's responsibility to check that the classes listed adequately reflect the goods or services shown on the application and if necessary raise the question at the examination stage. This applies even in instances where the majority of the application is covered by the correct number of classes, for instance as in the specification shown in the example above: Class 39 Arranging of travel; providing car hire; travel insurance. In this example, it will be necessary to inform the applicant that "travel insurance" is a service proper to Class 36.

In the case of an application filed where the goods or services are correctly classified but could also be proper to other classes **no action will be taken**. For example, "valves" fall in ten classes, the classification being determined by purpose and material. If an application is received for e.g. Class 7 Valves, it will be assumed that the only goods required to be covered are valves in Class 7, i.e. valves being parts of machines and no mention made to valves falling in other classes.

## 2.5 Amendment of a specification of an application

For various reasons there may be need during an application's progress to amend the statement of goods or services. For example, a specification may have to be restricted in

order to overcome an objection or a class added because of incorrect classification. Section 39 of the Act sets out the principles which govern practice in this area:

(1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

(2) In other respects an application may be amended, at the request of the applicant, only by correcting-

- (a) the name or address of the applicant,
- (b) errors of wording or of copying, or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

The following paragraphs set out in detail the registrar's practice on restrictions, broadening in scope and adding and deleting classes in relation to applications.

## **2.6 Restriction of the goods or services**

Note that once a specification has been restricted it cannot subsequently be changed back to its original scope. Section 39(1) of the Act gives the applicant the right to restrict his specification at any time, but there is no corresponding right to reinstate goods or services that have been previously deleted. Because files are open to public inspection after publication, the applicant's written request for deletion of goods or services must be taken as irrevocable unless the applicant can show that the request to restrict the specification was a mistake. Evidence is required to show that a request was made by mistake, e.g. misunderstanding a client's instructions. A change of heart is not considered to be a mistake even though an error of judgement may have been made in requesting deletion of goods or services.

## **2.7 Adding a class or classes to an application: the law**

The parts of the legislation which govern practice in this area are:

Rule 8(4)

If the specification contained in the application lists items by reference to a class in the Nice Classification in which they do not fall, the applicant may request, by filing Form TM3A, that the application be amended to include the appropriate class for those items, and upon payment of such class fee as may be appropriate the registrar shall amend the application accordingly.

and

## Section 39(2)

In other respects, an application may be amended, at the request of the applicant, only by correcting -

- (a) the name or address of the applicant,
- (b) errors of wording or of copying, or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or service covered by the application.

## 2.8 Adding a class or classes to an application: practice

Put in simple terms, a class may only be added when an application explicitly lists goods or services which are not in the class shown on the application form, with the proviso that the addition of any class is a correction which does not broaden the scope of the specification as filed. You cannot add a class where items **may** be in another class but, at the same time, may also be covered by the specification as filed.

Rule 8 and Section 39(2) of the Act have to be read together. It is clear that these provisions only allow the addition of a class where the specification explicitly lists goods or services which are in a different class and have been included only because of an error of wording or copying or as an obvious mistake.

Therefore, in most cases, an applicant may only be invited to make a specification explicit within the boundary of the class of goods or services which appears on the application form.

For instance, an applicant who filed for “non-alcoholic beverages” in Class 30 could not add Class 32 after filing in order to cover, e.g. “orange juice”, since “tea” and “coffee” are beverages which come within the scope of Class 30. To permit such an addition does not satisfy Rule 8(3) and moreover, would extend the goods (only Class 30 beverages have been applied for) and thus would be contrary to Section 39(2). However, Class 32 could be added if the specification was filed as “non-alcoholic beverages and orange juice”, but only for “orange juice”.

In the case of an application filed in Class 27 for “computer hardware; and all other goods/services in this class”, it would be possible to allow the addition of any class in which “Computer hardware” falls in (since no “computer hardware” is appropriate in Class 27). Concerning the “all other goods in this class”, the applicant would be required to specify which Class 27 goods require protection. With regard to “all other services in this class” this would have to be deleted since there are no services in Class 27 (which is self evidently a goods class).

Note that when applicants are invited to file a TM3A to add a class or classes, they should be informed that the mark has not been examined in respect of the goods or services that have been identified as being incorrectly classified. Examination of these items may only take place on receipt of the TM3A.



It may be the case that there are insufficient classes to cover all the goods or services.

For example:

Deodorants for personal use; perfumes.	Class 3
Air freshening preparations; room deodorants.	Class 5
Air deodorising apparatus; deodorising apparatus for personal use.	Class 11

In this example "deodorising apparatus for personal use" falls into Class 21 but the application only covers Classes 3, 5 and 11. This will be brought to the applicant's attention in the examination report and the applicant will be given the opportunity to file a TM3A ("Request for additional classes following examination") and add Class 21. Alternatively, the applicant will have the option to delete the goods from the specification.

## **2.12 Amendment of a specification of an application after publication**

The scope to amend a published application is governed by Section 39 of the Act and Rule 25, the relevant parts of which read:

Section 39:

- (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.
- (2) In other respects, an application may be amended, at the request of the applicant, only by correcting-
  - (a) The name and address of the applicant
  - (b) Errors of wording or of copying, or
  - (c) Obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

Rule 25-

- (1) Where, pursuant to section 39, a request is made for amendment of an application which has been published in the Journal and the amendment affects...the goods or services covered by the application, the amendment or a statement of the effect of the amendment shall also be published in the Journal.
- (2) Any person claiming to be affected by the amendment may, within one month of the date on which the amendment or a statement of the effect of the amendment was published under paragraph (1), give notice to the registrar of objection to the amendment on Form TM7 which shall include a statement of the grounds of objection which shall, in particular, indicate why the amendment would not fall within section 39(2).

Therefore, once the specification of an application has been published and then subsequently amended, the amendment must also be published (but not the whole application).

### **2.13 Correction of an error in classification before registration**

If an error in classification is detected at the publication stage, the applicant should be contacted in order to rectify it before the mark is registered. It is in the interest of the applicant to ensure that his goods or services are in the correct class since such an error would result in his mark being overlooked when later filed applications are examined for potentially conflicting marks.

Moreover, in the event that a subsequent application is made for an international registration which is based on a UK application that includes incorrectly classified items, an irregularity notice will be issued by WIPO, thus delaying its progress.

### **2.14 Objections to broad claims: practice**

Objections under Rule 8(2) will be raised in **all classes** where a claim is made to "All goods" or "All services" - these descriptions are too broad and too vague and do not constitute a proper list of goods or services. Objection will also be taken in any class against specifications such as: "electric, electrical and/or electronic apparatus, appliances, devices, equipment and/or instruments" (whether listed separately or in combination).

Applications in the service classes which continue to include claims such as "services that cannot be classified in other classes" or "miscellaneous services" will continue to face an objection under Rule 8.

Applications for specifications that are drafted in the form of the headings to the International Classes will not, in the main, be subject to a broad specification check. The exceptions are Classes 7 and 45 (and if a specification in class 9 includes the terms "Electrical and electronic apparatus and instruments").

#### **Class 7**

Claims to "machines" without further qualification will be objected to. The following gives examples of descriptions which are acceptable, since in each case the end use of the machine has been identified:

Machines for agricultural purposes;

or Machines for use in manufacturing processes;

or Machines for the woollen industry

or other specific machines, e.g. washing machines.

## **Class 9**

Applications filed in Class 9 which continue to make reference to "electric, electrical and/or electronic apparatus appliances, devices, equipment and instruments" (formerly part of the class 9 heading before 2002) will be objected to - whether listed separately or in combination.

## **Class 45**

The class heading for Class 45 is:

Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

The final part of the heading, "personal and social services rendered by others to meet the needs of individuals" is considered too broad in scope and consequently an objection under Rule 8(2) will be raised against applications containing this description. Objections will also be taken against applications where specifications contain either "personal services" or "social services" as individual elements, e.g. "personal services rendered by others to meet the needs of individuals" or the like broad descriptions. The second part of the heading, "security services for the protection of property and individuals" is sufficiently precise and will not attract an objection.

In addition to the above, rule 8(2) objections may also be used to challenge other statements of goods or services that are considered too vague and/or too broad, for example against "retail services" in Class 35.

### **2.15 At what stage should a Rule 8(2) objection be raised?**

The Rule 8(2) objection should only be taken at the examination stage and if the Examiner so determines, the search may be restricted to the named goods. However, if only the named goods are searched, this must be brought to the attention of the applicant in the examination report - who may subsequently broaden the specification to cover more goods (providing the goods are within the ambit of the specification as originally filed).

As always though, each case is a matter of judgement for the Examiner and providing an "all class" search does not result in a waste of resources, the wider search option is available.

### **2.16 Dealing with replies to broad claim objections**

In dealing with replies to Rule 8(2) objections, examiners must consider the arguments submitted by applicants about each application on their merits. In some instances, applicants will rely on previous acceptances in order to justify a broad specification on a fresh application. This is not acceptable. The applicant should be reminded that each application has to be looked at on its own merits and that the question that needs to be addressed is "is this mark being used (or is there a definite intention to use) in relation to all the goods and/or services of this application"? There is normally no justification in accepting very wide specifications merely because the applicant states that the cover provided by its "house" mark is very wide. Again, each mark has to be looked at individually in relation to the goods and/or services claimed.

In the absence of any evidence showing use of the mark it may prove necessary to seek a witness statement or statutory declaration from the applicant which might satisfy us that the applicant has a bona fide intention to use the mark in relation to all the goods or services claimed. However, this should only be sought if the Examiner thinks that it is unlikely that the mark applied for would be used in trade or business in connection with **all** the goods or services claimed.

Rule 62(1) (a) of the Trade Marks Rules 2008 gives the Registrar authority to seek information:

“Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may-

- (a) Require a document, information or evidence to be filed within such period as the registrar may specify;

Any evidence submitted should be adequately identified, e.g. relevant passages underlined or similarly marked to show wide use of the mark or that the applicant's business is extensive in range.

## **2.17 All goods in Class: the Trademark Law Treaty and Regulations**

The Trademark Law Treaty, (which can be viewed on the WIPO web site at [www.wipo.int/treaties/en/ip/tl/trtdocs\\_wo027.html](http://www.wipo.int/treaties/en/ip/tl/trtdocs_wo027.html)) sets out international administration practice and procedure. In particular Article 9(1), Classification of Goods and/or Services states:

"Each registration and any publication effected by an Office which concerns an application or registration and which indicates goods and/or services **shall indicate the goods and/or services by their names**, grouped according to the classes of the Nice Classification, and each group shall be preceded by the number of the class of that Classification to which that group of goods or services belongs and shall be presented in the order of the classes of the said Classification".

The following sets out practice in relation to specifications that refer to "all goods" or "all services":

Where a claim to "all goods" or "all services" is made on an application, a Rule 8(2) objection will be raised. However, the Examiner should (with the exception of Classes 7 and 45 and for specific goods in Class 9) edit the specification to that of the appropriate class heading shown in the International Classification (but should not include any qualifications contained in parentheses). The applicant may decide to list specific goods or services as an alternative or in addition to the class heading. In relation to Classes 7 and 45, no proposals should be made and the applicant should be asked (in the examination report) to provide a statement of the goods or services.

For instance, a specification reading "All goods in Class 10" should be changed to reflect the class heading, namely:

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.

**The applicant must be given a reason for the change in the specification.** The Examiner should state that the specification as filed is not allowable because the goods are not named but if the proposal in the report is not acceptable any counter proposals will be considered. This offer can be made because a class heading only serves to indicate in broad terms what a particular class includes and if there is doubt that the proposed specification does not cover all the goods intended to be used in connection with the mark, items may be added which fall in the class of the application. For instance in the above it would be possible to add e.g. "parts and fittings for all the aforesaid goods" since the class heading does not list these goods.

Note that applications filed with specifications such as:

Class 25: Articles of outer clothing and all other goods in this class

will continue to be edited in the normal way, i.e. to "Articles of outer clothing". It will be assumed that the scope of cover is not intended to embrace all goods in the class but the applicant may later wish to broaden the specification to include e.g. "underwear" which is allowed. Any broadening of a specification, subsequent to its editing, but which is still within the ambit of the specification originally filed, may necessitate a re-search.

Some specifications include "all goods" followed by a qualifying statement, e.g.:

Class 1: All goods in Class 1 for use in agriculture, horticulture and forestry

Class 5: All goods in Class 5 for destroying vermin.

These specifications will not be acceptable since although the goods' purposes are stated, the goods are not named. The two examples shown above should be edited to:

Class 1: Chemical products for use in agriculture, horticulture and forestry

Class 5: Preparations for destroying vermin

The applicant should be informed that "All goods" is not an acceptable statement of the goods and the above is proposed as an alternative. The registrar will be prepared to consider the addition of the other goods falling in these classes that can be used in agriculture, horticulture and forestry or for destroying vermin (and which are included in the original description)..

## **2.18 Punctuation, qualifications and use of "all for" as a qualifier**

Precise punctuation is important to ensure clarity in a specification. Providing punctuation is clear it need not be changed and should not be changed merely to fit in with an examiner's particular style (e.g. there is no need to delete a comma before the word "and").

Please note that we also allow capital letters to be used in specifications for the separation of terms and we allow specifications which consist wholly of capital letters.

The following guidelines are intended to help examiners assess whether the punctuation is clear and offers advice on improving punctuation if necessary.

In specifications which list a number of goods or services without uses or other qualifications, either commas or semi-colons may be used between the goods/services e.g.:

"Coffee, tea, rice, bread, salt." or "Coffee; tea; rice; bread; salt."

or combinations of the two e.g.:

"Coffee, tea, rice; bread; salt." or "Coffee; tea; rice, bread and salt".

In the above examples the meaning would not be altered if any or all of the commas were replaced by semi-colons. In many other situations the correct use of commas and semi-colons is of great importance e.g.:

"Ingredients for food; hydrocarbon preparations and resins, all for use in the manufacture of paints; plastics and fertilizers".

Any alteration to the punctuation of the above specification would result in a change in the way the specification could be interpreted. The "all for use in the manufacture of paints" is only intended to apply to "hydrocarbon preparations and resins" and the semi-colons around this item and the comma before "all for use in the manufacture etc." achieve this.

The use of the term "all for" should also be noted in the above example.

"Hydrocarbon preparations and resins for use in the manufacture of paints"

This is not clear since it is uncertain whether the "hydrocarbon preparations" are for use in manufacture or not.

Qualifications which follow a comma only refer to those goods or services which follow the previous semi-colon e.g.:

"Pharmaceutical preparations; plasters and bandages, all for surgical use"

The qualification "all for surgical use", refers only to plasters and bandages;

And in:

"Meat; fish, poultry and game; jams; fruit and vegetables, all being preserved"

The qualification "all being preserved" refers only to "fruit and vegetables" because these are the only goods which follow the previous semi-colon.

Qualifications which follow a semi-colon refer to all the preceding goods or services, e.g. in a specification reading:

"Bleaching preparations, detergents and fabric softeners; all for laundry use".

The qualification “all for laundry use” applies to all the preceding goods.

Where goods or services are to be qualified by a number of items or uses, the qualifications should be separated by commas and the last item worded so as to relate all the items in the qualification to the goods or services being qualified.

When specifications are framed as in the following example:

"Banking, life insurance and consultancy and advisory services relating to the aforesaid services".

There is no need to edit this to:

“Banking, life insurance and consultancy and advisory services, all relating to the aforesaid services”

Since it is obvious that both the consultancy and advisory services relate to banking and life insurance.

Similarly there is no need to edit:

"Telecommunications apparatus and instruments for maritime use"

to

"Telecommunications apparatus and instruments, all for maritime use"

In these examples it is clear that the qualifications are meant to apply to all the services or goods (i.e. the items "read through" to the qualification) and to edit such specifications to conform to the ideal is not sensible.

Full stops are allowed within the body of a specification, e.g.

“Soaps and bleaching preparations. Cleansing preparations and conditioners; all for laundry use.”

In this instance if the full stop is changed to a semi-colon, the limitation would then apply to the whole specification (which is obviously not intended).

## **2.19 All included in Class**

Under previous Trade Marks Acts it was necessary to qualify goods or services which without qualifications could be proper to other classes.

Under the 1994 Act there is no need to add any qualifications since goods or services have to be read in conjunction with the class or classes indicated on the application form. This applies to all specifications including those with parts and fittings in the goods classes and with information, advisory and consultancy services in the service classes. Therefore, the following and similar specifications should be accepted without amendment:

- Class 12      Cars, buses and trucks and parts and fittings for the aforesaid goods.
- Class 45      Legal services; arbitration and conciliation services; information, advisory and consultancy services for the aforesaid services.

In these two examples the class designation which precedes the goods or services serves to qualify the goods and services.

It may be that some applicants will prefer to qualify goods or services using "old" qualifications. This is not wrong and these versions may continue to be accepted, e.g.:

- Class 30      Biscuits, all being in Class 30
- Class 39      Travel agency services included in Class 39.

Although in both these examples the qualifiers are redundant, they should be left in the specification if the applicant wishes to retain them.

## 2.20      Exclusions

Exclusions are the opposite of positive limits in that they define what the goods or services are **not**, starting with the wording “but not including...” Following the judgment of the ECJ in the *Postkantoor* case, C-363/99, there is reduced scope for overcoming section 3(1) objections using exclusions. Previously known as the “penguin practice”, because of its inception as a result of Penguin Book’s trade mark application, it was the registrar’s practice to allow exclusions in respect of marks which are descriptive of goods in the specification having certain characteristics, but acceptable for the same goods without that characteristic.

However, *Postkantoor* makes it clear that the Trade Mark Directive, from which the UK Act is derived, “prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic”. In other words, excluding the particular characteristic that the mark describes is not an option. The reasoning that the Court gave for this ruling is underpinned by the legitimate interest of other traders; an exclusion in relation to particular characteristics might cause other traders to refrain from using that sign in trade, because it would be unclear that the mark’s protection did not actually extend to those goods or services for which it was descriptive. They would not know, as a general rule, about the exclusion and there might be legal uncertainty, which is what the Directive is intended to prevent.

### Characteristics versus sub-categories

However, there is still a place for exclusions provided they are in respect of categories or sub-categories of goods or services and **not** in respect merely of their characteristics. A characteristic is a specific quality, attribute or trait, whilst a category is a group or sub-group of the item. The term “characteristic” includes not only obvious descriptions, such as “pink” for shirts, but also covers when, where, why and how the goods or service may be supplied and their intended purpose. It would not therefore be acceptable to exclude, for the mark “Post Office”, postage stamps provided they are not connected with a post office.

When considering employing exclusions, regard must be had to whether the exclusion will render the mark deceptive or whether it is likely that the applicant intends to use the mark on goods or services for which it is not descriptive (otherwise, it may be open to a bad faith objection (section 3(6)).

The following are examples of acceptable and unacceptable exclusions:

### **Acceptable:**

Mark: **TUTANKHAMUN**

Specification: “Printed matter; but not including educational, archaeological or historical printed matter.

This is acceptable because printed matter can be sub-categorised; books on history etc would be a sub-category rather than a characteristic. An exclusion merely in relation to books about Tutankhamun would be too narrow as the applicant would then have cover for similar goods (such as books about Egyptology).

Mark: **VELVET BUNNY**

Specification: “Toys, games and playthings; but not including soft toys”.

This is acceptable because soft toys can be regarded as a subcategory of toys and the mark would not be descriptive of other types of toys.

Mark: **FISH**

Specification: “Cleaning preparations; cosmetics; preparations for the hair; but not including soaps.”

This overcomes the problem with novelty soaps, novelty soaps being a sub-category in this class. It would be insufficient simply to exclude soaps in the form of fish.

### **Unacceptable:**

Mark: **ROSE**

Specification: “Cosmetics, perfumes, toiletries; but not including any such goods scented to smell like roses.”

This exclusion does not overcome the descriptiveness objection because the exclusion relates simply to goods bearing the characteristic described by the mark.

This objection cannot be overcome for this type of goods.

Mark: **DAFFODIL**

Specification: “Chinaware; glassware; ornaments, statuettes and figurines; but not including any such goods in the form of or decorated with flowers”.

This would not overcome the descriptiveness objection because the mark describes a characteristic of the goods; and it is common in the trade for goods of this type to be decorated florally.

Mark: **FROG**

Specification: “Footwear; but not including footwear in the form of frogs”.

This exclusion does not overcome the descriptiveness objection. The exclusion covers only a specific characteristic of the goods rather than a sub-category. The objection could be overcome by excluding “novelty footwear.”

Mark: **BROADBAND GLOBAL**

Specification: “Telecommunications; provision of telecommunications information; transmission of messages and images; broadcasting services; but not including any such services provided by or about the internet.”

The exclusion does not overcome the descriptiveness objection. “Broadband” is a characteristic of telecommunications services, usually, although not exclusively, associated with internet use. Internet services are not a sub-category of a broadband telecommunications service. The mark describes a specific characteristic of a telecommunications service, i.e. a broadband telecom service providing global access.

The descriptiveness objection cannot be overcome. Broadband services are a subcategory of telecommunications services, but it is implausible that the applicant would apply for a mark like this in respect of non-broadband services. Consequently, a proposal to exclude “broadband telecommunication services” would give rise to further objections under section 3(3) (b) - because other use would be deceptive - and Rule 8(2) because there is no real intention to use other than for broadband services.

Note that the use of exclusions to overcome objections is covered in the Trade Marks Examination Guide.

## **2.21 Territorial and other limitations**

The purpose of a specification is to provide a statement of the goods and services. (Section 32(2) (c)). Under the 1994 Act provision is made under Section 13 for specified territorial or other limitations. Geographical limitations have in the past been incorrectly included in lists of goods and services rather than expressly identified as limitations. Therefore, in instances where there are geographical limitations which appear in the statement of goods/services, applicants will be required to delete these and insert them in Box 9 on the form TM3. Section 13, which governs the practice on limitations reads:

Registration subject to disclaimer or limitation 13(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may-

(a) disclaim any right to the exclusive use of any specified element of the trade mark, or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.

There is a need to distinguish between territorial limitations, which are properly the subject of a voluntary limitation of rights under Section 13 of the Act, and restrictions of the type or kind of products or services included in the statements of goods/services. In the first category are territorial limitations such as:

Pharmaceutical preparations and substances, none being for export, other than to the Republic of Ireland;

Cosmetics and soaps, all for sale in Northern Ireland and Scotland;

Manufactured tobacco, for export from the United Kingdom to Zambia, the Republic of South Africa and Tanzania;

Nightclub services provided in London;

All of the limitations which appear under this category must not be included in statement of goods or services and should be entered in Box 9 of the form TM3 and recorded under the limitations field on the Registry database as, for example:

Registration of this mark is subject to the following limitation: The rights conferred are limited to goods which are not for export, other than to the Republic of Ireland;

Registration of this mark is subject to the following limitation: The rights conferred are limited to goods for sale only in Northern Ireland and Scotland;

Registration of this mark is subject to the following limitation: The rights conferred are limited to services provided only in London.

Registration of this mark is subject to the following limitation: The rights conferred are limited to goods solely for export from the United Kingdom to Zambia, the Republic of South Africa and Tanzania.

Secondly, there are restrictions which particularise the type of goods or services, their purpose, method of sale or geographical origin, or otherwise qualify the goods or services so as to more accurately describe them. For example:

Fertilizers for use in the care of house plants;

Pharmaceutical substances for use in treatment of cardiovascular diseases;

Gardening magazines;

Alcoholic beverages, but in so far as whisky and whisky based liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland;

Transportation of goods by rail;

Pharmaceutical preparations for supply only on prescription of a registered medical practitioner;

Lubricants, for sale in containers of not less than 20 litres;

Milk and cheese, the produce of Northern Ireland;

Cleaning preparations; preparations for the hair; but not including soaps;

Financial services, but not including banking;

Building materials (not of metal).

All of the above types of limitations may continue to be accepted in specifications of goods or services.

For the purposes of examination on relative grounds, the registrar will treat registrations which contain a restriction of the type exemplified above as a voluntary restriction of rights under section 13 of the Act.

The revised practice came into force on 26th July 2004. An application filed on or after this date with a territorial limitation contained in the body of the specification will face objection at the time of issue of the examination report. A pending application filed before this date which includes such a limitation within its specification (or if the Registrar has already agreed to a revised specification including a territorial limitation) will not be amended unless the applicant makes an appropriate request. In respect of registrations and other pending applications filed before the implementation date, the revised practice will also apply to requests (or requirements) to enter territorial limitations made on or after 26th July 2004.

## **2.22 Use of registered trade marks in specifications**

Trade Marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade are not registrable in the *prima facie*. However, the Trade Marks Act recognises that such signs or indications are capable of being registered if they have acquired a distinctive character through use as a trade mark. For instance the word DIGITAL is registered in Class 38 but is also used in trade as a description, as in, for example, “digital television broadcasting”. Moreover, Section 11 of the Act makes it clear that a registered trade mark is not infringed by the use of indications concerning characteristics of goods or services or indications of their intended purpose, provided the use is in accordance with honest practices. Therefore, it is acceptable to include in specifications ordinary dictionary words (or words common to the trade) which in the context of a statement of goods or services function as descriptions but which may at the same time be registered trade marks. It is also acceptable in a specification to use a registered trade mark as a description provided that use is not in the same context as the goods or services for which the mark is registered. For example, POLO is registered in many classes but is also descriptive of a type of shirt in Class 25. Therefore in Class 25 specifications, the term “polo shirts” is acceptable as a description.

This practice **does not** apply to surnames or coined or invented words as registered trade marks. For instance, JACUZZI would not be acceptable in any specification: it is registered for "whirlpool baths". YO-YO is a registered trade mark and applicants are asked to substitute it with "spools incorporating coiled string which rewind and return to the hand when thrown". The word TELECOPIER is registered in Class 9 and must not be used in place of facsimile machines or services (in Class 38). The surname HOOVER is a well known registered brand of vacuum cleaner and as a registered trade mark cannot be used to describe such equipment or the service of vacuuming.

NB: An expanded list of registered trade marks and acceptable alternative terms which may be used in specifications follows:

<b>REGISTERED MARK</b>	<b>CLASS/ES</b>	<b>ACCEPTABLE ALTERNATIVE</b>
<b>ALLEN</b>	<b>08</b>	<b>Hexagonal wrenches; hexagonal spanners</b>
<b>ANDROID</b>	<b>09</b>	<b>Computer hardware and computer software for use with mobile devices</b>
<b>ARTEX</b>	<b>02</b>	<b>Distemper</b>
<b>BABYGRO</b>	<b>25</b>	<b>All-in-one stretch garments for babies</b>
<b>BAND-AID</b>	<b>05</b>	<b>Adhesive dressings/materials</b>
<b>BLUETOOTH</b>	<b>09</b>	<b>Telecommunication equipment</b>
<b>BIRO</b>	<b>16</b>	<b>Ball point pen</b>
<b>BLUE-RAY DISC</b>	<b>09</b>	<b>Optical and magneto-optical discs</b>
<b>BOOGIE</b>	<b>28</b>	<b>Body boards</b>
<b>BOTOX</b>	<b>05</b>	<b>Botulinum toxin</b>
<b>CATSEYE</b>	<b>09</b>	<b>Reflecting road studs</b>
<b>DICTAPHONE</b>	<b>09</b>	<b>Instrument for recording and reproducing dictation</b>
<b>DISCMAN</b>	<b>09</b>	<b>Portable compact disc player</b>
<b>DONGLE</b>	<b>09</b>	<b>Internet access apparatus</b>
<b>ELASTOPLAST</b>	<b>05</b>	<b>Elasticised dressings</b>
<b>FRISBEE</b>	<b>28</b>	<b>Toy flying saucer</b>
<b>GATEWAY</b>	<b>37</b>	<b>Telecommunication access services</b>
<b>HOOVER</b>	<b>07</b>	<b>Vacuum cleaners</b>
<b>HULA HOOP</b>	<b>29</b>	<b>Circular tubed plaything</b>
<b>IPOD</b>	<b>09</b>	<b>Portable digital music device</b>
<b>JACUZZI</b>	<b>11</b>	<b>Whirl pool baths</b>
<b>JEEP</b>	<b>12</b>	<b>All terrain vehicles</b>
<b>MEMORY STICK</b>	<b>09</b>	<b>Data storage media device</b>
<b>ONESIES</b>	<b>25</b>	<b>All in one nightwear</b>
<b>PERSPEX</b>	<b>17</b>	<b>Synthetic resin sold in the form of sheets</b>
<b>PORTAKABIN</b>	<b>06 &amp; 19</b>	<b>Portable buildings</b>
<b>ROLLER BLADE</b>	<b>28</b>	<b>In-line skates</b>
<b>STRIMMER</b>	<b>07</b>	<b>Grass cutting machines</b>
<b>SELLOTAPE</b>	<b>16</b>	<b>Adhesive tape</b>
<b>SLUSH PUPPY</b>	<b>30</b>	<b>Frozen confectionery</b>

<b>TELETEXT</b>	<b>38</b>	<b>Television screen based information broadcasting and retrieval services</b>
<b>THERMOS</b>	<b>21</b>	<b>Insulated flasks</b>
<b>TUPPERWARE</b>	<b>21</b>	<b>Plastic food containers</b>
<b>VASELINE</b>	<b>05</b>	<b>Petroleum jelly</b>
<b>VELCRO</b>	<b>26</b>	<b>Hook and eye fasteners</b>
<b>VELUX</b>	<b>06 &amp; 19</b>	<b>Roof windows</b>
<b>WALKMAN</b>	<b>09</b>	<b>Portable audio equipment</b>
<b>YO YO</b>	<b>28</b>	<b>Spools incorporating coiled string which rewind and return to the hand when thrown</b>

### 2.23 Use of standard specifications

Whilst the use of standard specifications is to be encouraged, their function is for the sole purpose of initial examination only. Individual applications may require further modification to take account of any other objections under the Act or Rules, e.g. under Section 3(3)(b) if the mark is deceptive or Section 3(6) if the goods, when read in conjunction with the mark, seem to be too broad.

### 2.24 Communicating changes in specifications to customers

If a change is made to a specification it must be brought to the applicant's attention by:-

- underlining or typed in bold in the case of lengthy specifications **and**
- in all cases pointing out the specific changes made and reasons for them.

In relation to all specifications:

Changes **must** be underlined or typed in bold **and reasons** given. If only deletions are made the reasons **must** be stated. Where substantial changes are made involving a large degree of re-editing these **must** be explained. Also, deletion of any wording **must** always be explained.

Furthermore, a reason **must always** be given for any substantial amendment which affects the protection sought For example:

"the punctuation has been amended to ensure that the qualification applies to all the goods" or "the goods "potato crisps" have been deleted because they are proper to Class 29".

### **3 CLASSIFICATION WORKING PROCEDURES: REGISTERED MARKS**

#### **3.1 Amendment of a specification of a registration**

Under Rule 33, the specification of a registration may be restricted at any time.

#### **3.2 Partial surrender of a specification for a registered mark**

The relevant part of Rule 33 states:

(1) Subject to paragraph (2), the proprietor may surrender a registered trade mark, by sending notice to the registrar-

(b) on Form TM23, in respect only of those goods or services specified by the proprietor in the notice.

(3) The registrar shall, upon the surrender taking effect, make the appropriate entry in the register and publish the date of surrender on the Office website.

For this a purpose a form TM23 (“Notice of a partial surrender of the specification of goods or services for which the mark is registered”) is used. This form contains a heading "Goods or services to be surrendered" and any goods or services that require to be deleted from a registration should be entered here. If the goods or services relate to a registration covering more than one class they should be listed in class order. Upon the surrender taking effect, an entry will be made in the register and it will be published in the Trade Marks Journal.

It is a responsibility of the Classification Team to scrutinise forms TM23 and any enquiries concerning amendments to a specification of a registration should be directed to them.

However, it is the responsibility of the registered proprietor to state the goods or services that are to be surrendered. It is not acceptable to merely list the goods or services which are intended to remain after surrender but this additional information is helpful (in order to provide a clear statement of what the registration is ultimately intended to cover).

## **INTRODUCTION**

**The purpose of this Addendum is to provide more detailed guidance on how to find the correct class for specific items and notes on classification practice (including words or phrases that should not be used)**

# A

## **Abbreviations**

Abbreviations should be used with caution. While the meaning of many abbreviations might be well known today, it is difficult to know how some of them may be interpreted in the future. However, providing an abbreviation only has one meaning in relation to the class of goods or services applied in, it may be allowed. Therefore, for example CD-ROMs and DVDs - are acceptable in Class 9, but where the abbreviation is a lesser known term it would have to be followed by the word or phrase abbreviated.

## **Accessories, Components, Parts and fittings**

These terms are acceptable but they must relate to specific goods and cannot be accepted without qualification. For example, do not accept:

Parts and fittings. Class 12

but allow:

Parts and fittings for motor vehicles. Class 12

Care should be taken in the use of “accessories”. For example, in Class 25, “suits and accessories therefore” is an acceptable specification as there are accessories (e.g. hats) that are in this class but goods such as “handbags” and “umbrellas”, which are also clothing accessories, are proper to Class 18.

Punctuation is important so that the parts and fittings relate to the goods intended by the applicant. It is also important to ensure that any claim for "parts and fittings" is applied sensibly and logically, i.e. only to goods which would in a practical sense have parts and fittings.

Allow the following and similar:

Computers and parts and fittings therefore. Class 9

Computers and parts and fittings for the aforesaid goods. Class 9

Computers and parts and fittings for all the aforesaid goods. Class 9

Computers and parts and fittings all for the aforesaid goods. Class 9

It is clear in all the above examples that both the "parts" and "fittings" relate to the computers.

Allow the following and similar:

Computers and modems; parts and fittings therefore. Class 9

Computers and modems; parts and fittings for the aforesaid goods. Class 9

Computers and modems; parts and fittings for all the aforesaid goods. Class 9

Computers and modems; parts and fittings all for the aforesaid goods. Class 9

Again there is no ambiguity and the parts and fittings must relate to all the preceding goods.

In the following example there could be difficulty in interpreting what is meant to be covered and the punctuation should be queried:

Computers, modems and parts and fittings therefore. Class 9

The question arises are the "parts and fittings" intended only to cover the "modems"?

In such instances edit to:

Computers and modems; parts and fittings therefore Class 9

## **Advisory services**

See guide at Consultancy, advisory and information services

## **Amusement apparatus and electronic games**

Following changes to the International Classification on 1<sup>st</sup> January 2012, these goods are now classified as:

Class 28                      Electronic games apparatus; electronic games and amusement apparatus adapted for use with television receivers or other external display screens or monitors.

## **Amusement machines, automatic and coin operated**

Class 28 covers coin operated games apparatus and amusement rides as well as fruit machines, one-armed bandits and other arcade games such as pinball machines.

Please note: All computer games programs, software and cartridges for any type of games apparatus are in Class 9 (even if the equipment is in Class 28).

## **And/or and use of oblique strokes**

Oblique strokes may be used in specifications and are normally put in the phrase "and/or". It is acceptable in the following:

"Chemical/biochemical products" or "Chemical and/or biochemical products".

It may also be used in the following ways:

"Chemicals for use in industry/science" or "Chemicals for use in industry and/or science" and "Import/export agency services"

## **And the like, ancillary and related**

These terms are too vague as descriptions as goods or services as in:

Class 25                      Shirts and tee shirts and the like clothing

or:

Class 36                      Banking, insurance and related financial services.

In all cases the goods or services should be specified.

However, where the goods or services are clearly stated, the terms may be accepted as a secondary qualifier, e.g.

Class 25                      Shirts, tee shirts and polo shirts, for use in games and the like  
leisure activities

or:

Class 41                      Training of personnel in data processing and the like office skills.

In both of these examples the goods or services are clearly defined.

## **Apparatus, instruments and equipment**

No objection will be raised against the use of these terms where they are suitably qualified, e.g.

"Mining apparatus" or "Mining equipment".

## **Association services or services provided by an association to its members**

Too vague and broad a description. The type of service being provided needs to be specified, e.g.

Class 35	Business administration
Class 45	Legal services

## **B**

### **Babies nappies, napkins and diapers**

These goods were formally classified under International class 16, but from 1st January 2012 are proper to Class 5.

### **Badges**

Badges are classified differently if for wear or not for wear

Badges for wear, of precious metal	Class 14
Badges for wear, not of precious metal	Class 26

Badges, not for wear, are classified by material

Common metal	Class 6
Leather	Class 18
Plastics	Class 20
Textile materials	Class 24

### **Beverages**

Beverages can be found in a number of classes, the classification being dependent on their content or purpose, for example:

Class 5	Dietetic beverages adapted for medical purposes.
---------	--

This class includes drinks specifically prepared to treat a medical disorder. Also medicinal wines and other medicinal drinks (including medicinal tea) and beers for diabetics fall in this class.

Calorie reduced soft drinks such as lemonade or carbonated cola beverages are generally proper to Class 32, although they could be proper to Class 5, e.g. for diabetics.

Class 29	Milk beverages and milk shakes. Beverages containing milk when the milk predominates. Yoghurt beverages.
Class 30	Coffee, tea, cocoa, and beverages based on these products, including chocolate drinks.
Class 31	Beverages specially made for animals, for example, cat milk.
Class 32	Beers, mineral and aerated waters, non-alcoholic carbonated beverages such as lemonade, fruit drinks and fruit juices.

This class includes all beers (including stout, porter, lager etc) regardless of their alcoholic strength; shandy; drinking water and tonic water; soft drinks such as fruit juices, lemonade or carbonated cola beverages (including low calorie versions of these drinks); isotonic drinks; low alcohol beverages which contain no more than 1.2% alcohol by volume (these include very low alcohol cider and wine or any other very low alcohol drink which would ordinarily be regarded as an alcoholic beverage). Non-alcoholic or de-alcoholised wines, cider or perry also fall in Class 32.

Note that mineral water for medical purposes is proper to Class 5.

Class 33	Wines, spirits, liqueurs, cider and perry.
----------	--

This class includes drinks with a alcohol content which exceeds 1.2% by volume with the exception of beers which are proper to Class 32. Also under Class 33 are drinks which are alcoholic versions of soft drinks (more than 1.2% by volume) e.g. alcoholic lemonade. Very low alcohol wines, cider or perry (1.2% by volume or less) are proper to Class 32.

## **Blinds and curtains**

In classification terms these are viewed as distinct products. Blinds may be used on windows either internally or externally and their classification follows a different path depending on the purpose of the product and its material composition. Curtains are usually only used indoors and are classified according to their material. The classification of these items, based on the following entries in the 10<sup>th</sup> edition of the International Classification, is shown below.

### **Blinds: International Classification:**

<b>Class</b>	<b>Entry</b>	<b>Example of goods</b>
6	Outdoor blinds of metal	An external metal blind as part of a building for security purposes
19	Blinds [outdoor] not of metal and not of textile	A wooden version
20	Blinds (slatted indoor)	Venetian and vertical window blinds
20	Indoor window blinds	Blinds of any material for furnishing a

[shades] [furniture] window

As a consequence of these entries, the following classification applies:

Outdoor window blinds:

- |          |   |
|----------|---|
| Class 6  | Outdoor blinds of metal                         |
| Class 19 | Outdoor blinds, not of metal and not of textile |
| Class 22 | Outdoor blinds of textile                       |

Indoor window blinds:

- |          |  |
|----------|--|
| Class 20 | Indoor blinds (regardless of material) |
|----------|--|

Curtains: International Classification:

- |          |                                 |
|----------|---------------------------------|
| Class 17 | Curtains of asbestos (Safety-)  |
| Class 20 | Curtains (Bamboo)               |
| Class 20 | Curtains (Bead-) for decoration |
| Class 24 | Curtains of textile or plastic  |

The classification is more straightforward here since “curtains” do not normally become parts of building structures (or if they do they are not really part of the fabric of a building). The vast majority of curtains will fall under Class 24 since most domestic curtains are of textiles or plastic (woven to simulate textiles).

## **Book club services**

Normally applied for in Class 41, this is too vague. It could mean either a library type service e.g. lending and loaning of books - Class 41 but is usually intended to cover retail services for the supply of books to club members (and it therefore proper to Class 35).

## **C**

### **Cases**

Cases adapted to the product they are intended to contain, are in principle, classified in the same class as the product. Therefore, “spectacle cases” are in Class 9, “rifle cases” Class 13, “violin cases” Class 15 and “cigarette cases of precious metal” are in Class 34.

## **Charitable services**

Charitable services are classified in the same class as to the service which is being offered under that heading e.g.

Charitable collections	Class 36
Charitable fund raising	Class 36
Charitable services, namely repair, maintenance and installation	Class 37
Charitable services, namely education and training	Class 41
Charitable services, namely providing food and drink catering	Class 43
Charitable services, namely providing temporary accommodation	Class 43
Charitable services, namely providing medical services	Class 44
Charitable services, namely mentoring [personal or spiritual]	Class 45

## **Cheque book holders**

Although these can be of leather, they fall under Class 16 (regardless of material) since they are specially adapted to hold cheque books. Wallets or cases incorporating cheque book holders are proper to Class 18.

## **Cleaning machines, apparatus or installations and polishing machines**

The International Classification classifies these goods in three classes - 7, 9 and 21:

Acetylene cleaning apparatus	Class 7
Air suction machines	Class 7
Cleaning machines	Class 7
Electric carpet shampooing machines and apparatus	Class 7
Polishing machines and apparatus [electric]	Class 7
Dust removing installations for cleaning purposes	Class 7
Vacuum cleaners	Class 7
Cleaning apparatus for sound recording discs or phonograph records	Class 9

Non-electric polishing apparatus and machines for household purposes Class 21

Carpet sweepers Class 21

## **Cloud computing services**

With the development in computer services in the last few years the term Cloud computing is seen as the delivery of computing as a service rather than a product. With this in mind the term is acceptable in class 42

## **Components**

See guide at accessories, components and parts and fittings

## **Computer and video gaming apparatus**

These goods were formally classified under International class 9, but from 1st January 2012 are proper to Class 28.

## **Construction services**

Building construction is proper to Class 37 and is intended to cover building of structures, roads, bridges and similar civil engineering projects. Construction of manufactured products e.g. custom manufacture of cars are proper to Class 40. Shipbuilding, however, is proper to Class 37.

## **Consultancy, advisory and information services**

In general, consultancy services will belong to the same class as the service or field on which they are being consulted e.g. installation of double glazing is in Class 37, therefore consultancy on double glazing installation is proper to Class 37; chemical analysis falls in Class 42, therefore the services of consultant chemist are also proper to that class. The fact that the advice or information obtained through the service may be used for business purposes is not a relevant factor when determining the classification.

All services relating to the business management or administration of a commercial undertaking are in Class 35. "Management" and "administration" refer to the way the business is organised or run. Thus, consultancy services for management are in Class 35 regardless of the nature of the business using the consultancy service, whereas consultancy services for technical matters concerning the nature of a business may fall into a number of classes e.g. a business in the food industry might want to: (a) reorganise its sales and marketing operation and (b) improve its bakery products. Consultancy services on (a) would be in Class 35 and on (b) in Class 42 (consultancy services on food chemistry). It is probable that the consultancy services of a single organisation could fall in more than one class, e.g. a management consultant may advise on business organisation **and** on complementary computer software.

Therefore as a general guide, "consultancy services" may fall in all the service classes and the following examples illustrate the practice:

Consultancy services in the field of business administration	Class 35
Financial consultations	Class 36
Building consultations	Class 37
Consultancy services relating to telecommunications	Class 38
Travel consultants	Class 39
Dress making consultancy	Class 40
Training consultation services	Class 41
Computer programming consultancy	Class 42
Holiday accommodation consultants	Class 43
Beauty and medical consultancy	Class 44
Security consultancy	Class 45

Note that from 1st January 2002, the distinction between “**professional and non-professional consultancy**” which formerly played a role in the classification of these services has been removed and therefore the criterion used to determine the classification is simply on the basis of subject matter (as for advisory and information services). For example:

Consultancy relating to business management	Class 35
Consultancy relating to banking	Class 36
Consultancy relating to construction	Class 37
Consultancy relating to telecommunications	Class 38
Consultancy relating to computer services	Class 42
Consultancy services relating to security	Class 45

Advisory and information services are similarly classified according to the subject content of the advice or information being provided e.g., business advisory services are in Class 35, insurance advice in Class 36, transport information falls in Class 39, weather information in Class 42 etc. This classification practice applies even if the consultancy, advice or information is provided by electronic means, e.g. by way of a computer database or over the telephone. It should also be noted that the compilation of statistical data, market research and opinion polling falls in Class 35.

Given that consultancy, advisory and information services may fall in all of the service classes, it is not necessary to state the subject matter of these services. For example, in Class 45 a specification reading “consultancy services” is acceptable without further qualification since the consultancy is restricted to fields covered by Class 45.

**However, it is advisable to specify the type of consultation, advisory or information service since such a specification is unlikely to be accepted by WIPO (in the event that an application for an International Registration is subsequently made). The WIPO normally requires the type of consultancy, advice or information to be specified.**

## **Curtains and blinds**

See guide at Blinds and curtains

## **Custom manufacture**

The term "Custom manufacture" is acceptable in Class 40 and is interpreted as meaning either the one off manufacture of a prototype, or assembly of items on behalf of others.

## **D**

### **Design services**

Design services are proper to Class 42 apart from landscape design, floral design, turf design and planning [Design] of gardens which are all proper to Class 44.

## **Dietary supplements for humans and animals**

These covers dietary supplements intended to supplement a normal diet or to have health benefits and are proper to class 5.

## **Doors**

Doors are classified as follows:

Doors of metal (other than for furniture)	Class 6
Doors not of metal (other than for furniture)	Class 19
Doors for vehicles	Class 12

## **Drinking straws**

These goods were formally classified under International class 20, but from 1st January 2012 are proper to Class 21.

## **Drinks**

See guide at Beverages

## **E**

## **Electric door openers and closers**

These goods were formally classified under International class 9, but from 1st January 2012 are now proper to Class 7.

## **Electric flat irons**

These goods were formally classified under International class 9, but from 1st January 2012 are now proper to Class 8.

## **Electric welding and soldering apparatus**

These goods were formally classified under International class 9, but from 1st January 2012 are now proper to Class 7.

## **Electronic data storage**

These services were formally classified under International class 35, but from 1st January 2013 are now proper to Class 42.

## **Electronic games**

See guide at Amusement apparatus and electronic games

## **F**

## **Filters and filtering materials**

Filters are normally classified according to use, e.g.:

Filters being parts of engines or machines	Class 7
Filters (photographic)	Class 9
Filters for ultra violet rays for medical purposes	Class 10
Filters being parts of water supply apparatus	Class 11
Filters being parts of electric coffee machines	Class 11
Filters being parts of non-electric coffee machines	Class 21
Filters (coffee) of paper	Class 16
Filters (cigarette)	Class 34

### **Filtering materials are classified by material, for example:**

Chemical preparations, mineral substances, unprocessed plastics	Class 1
of metal	Class 6
of paper	Class 16
of semi-finished plastics	Class 17
of textiles	Class 24

## **Floats for bathing and swimming**

These goods were formally classified under international class 9 but from 1st January 2012 are now proper to Class 28.

## **Franchising services**

Services rendered in the framework of franchising are in the same classes as the particular services being provided by the franchisor e.g;

Business consultancy services relating to franchising	Class 35
Financial services relating to franchising	Class 36
Legal services relating to franchising	Class 45

## **Fuel dispensing pumps for service stations and self regulating fuel pumps**

These goods were formally classified under international class 9 but from 1st January 2012 are now proper to Class 7.

## **G**

### **Goods**

This term will be accepted in specifications when used in conjunction with a description that adequately describes the type of goods, e.g.:

Goods for the care of the nails	Class 3
Metal goods for use in building	Class 6
Optical goods	Class 9
Leather goods	Class 18
Textile goods for bathroom use	Class 24
Fancy goods [embroidery]	Class 26

## **H**

### **Hair curlers (electric)**

These goods were formally classified under International class 9, but from 1st January 2012 are proper to Class 26.

### **Hire**

See guide at Rental

## **I**

## **Including, for example, namely, as well as, in particular, specifically i.e.**

While not desirable in specifications since it encourages tautology, such wording should usually not be changed. Such terms are not allowable in Class 35 (with the exception of “namely” see below) for specifications covering retail services as they do not create the legal certainty that is required. However, in other class the terms may be allowed.

For example we would allow:

Biocides including insecticides and pesticides

Paper articles of stationery in particular envelopes

Dairy products namely cheese and butter

Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

## **Information services**

See guide at Consultancy, advisory and information services

## **Internet services, on-line services and associated goods**

The activities provided by on-line and Internet suppliers are varied and wide ranging and the classification can include all of the service classes. For example, the UK along with the US, OHIM and WIPO classify information services according to their subject matter. Thus, business information falls in Class 35, insurance information in Class 36, travel information in Class 39 and so on. This classification applies regardless of whether the information is provided face-to-face, over the telephone, on-line from a database or from the Internet. The following guidance sets out what is accepted.

Note that the terms “multi-media services, Internet services and on-line services” are too vague and should be clarified.

**Classification: Acceptable identifications of goods and services and explanatory notes:**

**Class 9:**

Computer software downloaded from the internet

Computer software supplied from the internet

Electronic publications [downloadable] provided on-line from computer databases or the internet

Computer software and telecommunications apparatus (including modems) to enable connection to computer databases and the Internet

Computer software to enable searching of data

Digital music [downloadable] provided from the internet

Telephone ring tones [downloadable] provided from the internet

**Explanatory note:**

This class includes the provision of computer software by whatever means (e.g. through retail sale, mail order or downloaded from the Internet to a computer); any apparatus which allows electronic or telecommunication connection to the Internet or computer databases. Also covered by Class 9 are publications in electronic format [downloadable]. Many publications which are sold in printed matter form are also available on the Internet (e.g. The Times). They may be browsed or supplied to the user. If merely viewed then a service under Class 41 is provided but if downloaded from the Internet to a computer, Class 9 is appropriate (by analogy with CD-ROMs).

**Class 35:**

Advertising information and business information; all provided on-line from a computer database or the Internet; compilation of advertisements for use as web pages on the Internet

Compilation of directories for publishing on the Internet

Provision of space on web sites for advertising goods and services

Auctioneering provided on the Internet

Business administration services for the processing of sales made on the Internet

The bringing together, for the benefit of others, of a variety of [indicate goods or types of goods], enabling customers to conveniently view and purchase those goods.

Electronic shopping retail services connected with [indicate goods or types of goods]

**Explanatory note:**

Although Class 35 includes the advertising and promotion of goods and services, when products are sold on the Internet or through other electronic means, unless a “bringing together service” is provided, the classification is determined by the nature of products which are purchased. **The means by which they are sold are irrelevant.** For instance, selling ones

own branded clothing from a web site may involve the advertising of these products but in order to ensure that proper protection is given to the mark, an applicant will need to include Class 25 to cover the goods. Similarly, selling an airline ticket on the web could involve promotional activities under Class 35 but these services are peripheral to travel arranging under Class 39.

Applications in this class sometimes include claims to e-commerce, home shopping, TV shopping, on-line shopping, Internet shopping malls, e-tailing, digital commerce etc, but none of these vague terms are acceptable as service descriptions in their own right (but may be allowed when further qualified by a specific service, e.g. “advertising to promote e-commerce”). Such descriptions are essentially variants of retail services which are carried out by electronic means.

**Class 36:**

Financial and insurance information, provided on-line from a computer database or the Internet

Home banking

Internet banking

**Class 37:**

Repair, maintenance and installation information, provided on-line from a computer database or the internet

Installation and repair of telecommunication apparatus

Installation and repair of computer hardware

**Explanatory note:**

The service of “installation and maintenance of computer software” is proper to class 42.

**Class 38:**

Telecommunication of information (including web pages), computer programs and any other data;

Electronic mail services

Providing access to computer databases

Providing user access to the internet [service providers]

Providing telecommunications connections to the internet or databases

Providing access to digital music web sites on the internet

Delivery of digital music by telecommunications

Rental (or leasing\*) of access time to computer databases

\* note that WIPO recommends that the term “leasing” should not be used on applications for International Registrations other than when used in relation to financial leasing services in Class 36.

**Explanatory note:**

Class 38 covers the telecommunication infrastructure for transmitting and receiving information but not the information itself (unless that information is about telecommunications). Additionally, the core activities of Internet Service Providers (ISPs) are included in this class. Note that if a specification is filed as "Internet services" it will be edited to:

Providing access to the internet; providing telecommunications connections to the internet or databases.

The practice in force until 30<sup>th</sup> June 1999 was to classify “providing access to the Internet” under Classes 38 and 42, the determining factor being whether the applicant is primarily a telecommunications business. Given that many Internet Service Providers (ISPs) may also provide telecommunications services directly to customers (or at least form part of a telecommunications link) the distinction that was originally drawn had become somewhat blurred and artificial. Therefore, the following identifications are included in the International Classification:

Class 38: Providing telecommunications connections to a global computer network

Class 38: Providing user access to a global computer network [service providers]

This in effect puts under class 38 all access services provided by ISPs, whether they are able to provide telecommunications directly or merely provide a link in the access chain. Although the term “Internet” is not used in the above (because it is not accepted in specifications by some national trade mark offices) its use in specifications in the UK will continue to be allowed.

**Class 39:**

Airline booking services provided on the Internet

Arranging travel and information therefore, all provided on-line from a computer database or the internet

**Class 40:**

Material treatment information, provided on-line from a computer database or the internet.

Photographic printing services provided on the Internet

**Class 41:**

Entertainment information and education information, all provided on-line from a computer database or the internet

Electronic games services provided by means of the internet

Providing on-line electronic publications [not downloadable]

Publication of electronic books and journals on-line

Providing digital music [not downloadable] from the internet

**Explanatory note:**

This class includes providing publications on the Internet which may be browsed (by analogy with "Library services").

**Class 42:**

Computer rental; design, drawing and commissioned writing, all for the compilation of web pages on the internet

Creating and maintaining web sites for others

Hosting the web sites of others

Installation and maintenance of computer software

Operating search engines

Providing search engines for the Internet

**Class 43:**

Holiday accommodation information provided on-line from a computer database or the internet

**Class 44:**

Medical information provided on-line from a computer database or the internet

**Class 45:**

Security information provided on-line from a computer database or the internet

Legal information provided on-line from a computer database or the internal compilation, creation and maintenance of a register of domain names

## K

### **Kits, sets and outfits**

It is unlikely that all items included in a kit would fall in one class but it is recognised that it is too onerous to expect an applicant to enumerate the contents of a particular kit, set or outfit. “Kits” and “Outfits” appear in the International Classification, for example, as in the following:

Cosmetic kits Class 3

Inner tube repair outfits Class 12

The criteria used for this classification is unclear and inconsistent. Whereas “cosmetic kits” would appear to be proper to Class 3 on the basis that their predominant contents are proper to the class, “inner tube repair outfits” seem to be classified under Class 12 because of their end function.

Therefore, in order to avoid uncertainty in the classification of kits and outfits, the following practice is applied in the UK. When classifying an application for a kit it is first necessary to know what the kit is for, or alternatively, what it is going to be used to make or construct. If the end purpose does not fall neatly into one category, the classification may be determined by the class in which the principal products contained in the kit or outfit fall. For example “diagnostic kits” that are for medical purposes could fall in either Classes 5 or 10 since both classes contain goods used for these purposes. The following examples demonstrate the above:

Cholesterol test kits Class 5 or 10  
(medical goods fall in two classes and therefore contents could be proper to either class)

Filled first aid kits Class 5

Hands free kits for phones Class 9

Brake cylinder repair kits Class 12  
(for repairing a vehicle part that is in Class 12)

Furniture repair kit Class 20

Rug making kit Class 27

Snooker cue repair kits Class 28

Kits [sold complete] for the construction of scale models Class 28

Toy construction kits	Class 28
Toy model kits	Class 28
Beer making kits	Class 32
Wine making kits	Class 33
Manicure and pedicure sets	Class 8

## **L**

### **Leasing**

See guide at Rental

### **Lottery tickets and scratch cards**

Lottery services, i.e. the organising and conducting of a lottery, fall under Class 41. Lottery tickets (as printed matter) are proper to Class 16 whereas printed lottery scratch cards, which involve playing a game, are in Class 28.

## **M**

### **Mail order**

See guide at Retail Services

### **Manuals**

Sometimes applicants wish to reflect that the goods come with a manual, e.g.:

Computers and user manuals sold as a unit	Class 9
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This is an acceptable specification if the manuals are, e.g. a CD or downloadable from the internet. However, if the manuals are in the form of printed matter, no benefit is gained by specifying them in a Class 9 statement of goods.

## **Media**

The “International Classification of Goods and Services” includes this term in certain instances, e.g. "Media for bacteriological culture", "magnetic data media", and "optical data media". Therefore the term "media" may be used if qualified as being of a particular type, or as being for specific purpose, e.g. "magnetic recording media" or "media for the recordal of computer programs".

**N B: The term "media" alone is not to be accepted and must be further qualified.**

## **Mobile phone cases, fascias and holders**

Mobile phone cases are commonly incorrectly classified under Class 18. In the general remarks in the International Classification it states:

"cases adapted to the product they are intended to contain are in principle classified in the same class as the product"

Therefore cases for mobile phones are classified under Class 9 along with mobile phones.

Similarly mobile phone fascias and holders are also in Class 9.

## **N**

### **Networks**

This term is generally used in class 9, particularly in the field of computing and is acceptable when qualified, as in the following examples:

Computer networks

Communications networks

Telecommunications networks

Computer networking installations

The term may be used for other descriptions and examiners should exercise caution before using the term in a specification.

## **O**

## **On-line services and associated goods**

See guide at Internet services, on-line services and associated goods

## **Outfits**

See guide at Kits, sets and outfits

## **P**

## **Parts and fittings**

See guide at Accessories, Components, parts and fittings

## **Peripherals**

This is too vague a description to be accepted without further qualification. It may be accepted in Class 9 as "Computer peripherals".

## **Personal and social services rendered by others to meet the needs of individuals**

This is part of the class heading of class 45 and attracts an objection under Rule 8(2) because it is too vague and/or broad in scope.

It only covers those personal and social services which are not included in any of the other service classes so cannot include, e.g.:

Class 36	Personal insurance such as life assurance
Class 41	Entertainment and education including personal tuition.
Class 43	Food and drink catering
Class 44	Medical and beauty services

## **Playing cards**

These goods were formally classified under class 16 but from 1st January 2002 are proper to Class 28.

## **Polishing machines**

See guide at Cleaning machines, apparatus or installations

## **Precious metal goods**

Caution needs to be applied when classifying goods made from precious metals. With effect from 1<sup>st</sup> January 2007, not all goods made from precious metals are proper to class 14. Although the latter includes jewellery, precious stones, horological and chronometric instruments, the following goods, which are classified according to their function or purpose, fall into other classes:

Cutlery of precious metals	Class 8
Pen nibs of gold	Class 16
Teapots of precious metal	Class 21
Candlesticks of precious metal	Class 21
Containers of precious metal	Class 21
Gold and silver embroidery	Class 26
Cigarette and cigar boxes made of precious metals	Class 34

## **Principally - in relation to goods classified by material**

When goods, which are normally classified by material, consist of more than one material, it is for the applicant to determine the principal material of which the goods are made.

The words "all made wholly or principally of" (e.g. common metal) are usually used for such qualifications.

Now that goods and services are limited by the class designated on the application form there is no need to qualify items using this type of wording. For instance, "Anchors" can only be in class 6 if they are wholly or principally of common metal. However, there is no need to amend an application made for:

Class 6                      Anchors

since the only cover provided will be those anchors wholly or principally of common metal. However, if applicants wish to clarify their specifications by using such limitations this should be allowed. In the judgement given in the VAC-U-FLEX case (reported in Fleet Street Reports No.5 1965) it was decided that any decision on the principal constituent material of

any item cannot be decided on one factor alone. A mark registered for "flexible tubing wholly or principally of metal" had been used only for plastic tubing reinforced with metal wire. The metal comprised 56% of the total weight of the tubing. The mark was expunged for non-use, the Assistant Registrar saying that the area and volume of the plastic as well as its weight must be considered in answering the question of whether the tubing was "principally of metal".

## **Protective clothing and padding**

Clothing for normal wear is proper to class 25 and would include items often referred to as "protective" such as "rain suits/hats", "overalls" and "leathers for wear by motorcyclists".

Certain specialised clothing including footwear and headgear can be proper to class 9. These items serve to protect the wearer from injury due to impact in accidents, or where there is some known potential for injury such as contact with chemicals, radiation, fire, environmental or atmospheric hazards. Thus, protective headgear such as hard-hats worn by workmen are proper to class 9. Helmets such as those worn by security guards, horse riders, motorcyclists, American football and cricket etc. are very similar, being protection against accident or injury and are also proper to class 9.

Pads to protect the wearer from injury will in most instances be proper to class 9 although can be proper to other classes. Padding specifically for wear whilst participating in sports such as "cricket pads" or "shin guards", or pads that are a part of clothing worn whilst participating in sports will be proper to class 28. "Knee pads" and "elbow pads" that can be worn by workmen, and also in a range of other activities such as "skateboarding", "climbing" or "cycling" will be proper to class 9 as they are not adapted for any particular purpose. Supports worn on limb joints etc are often used in sporting activities. The same, or very similar items are also used for medical purposes. As these "supports" are not suitable (adapted) only for use in sporting activities they are considered to be proper to class 10. Note that "jock straps" (men's athletic supporters) are proper to class 28.

## **R**

### **Rental services**

Rental or hire services are classified, in principle, in the same class as the services provided, e.g. rental of cars falls in Class 39, rental of telephones in Class 38, rental of vending machines in Class 35, and so on. Note that financial leasing falls in Class 36 i.e. where the customer does not own the goods until the final payment (as this is essentially a financial service).

**NB: WIPO will only accept the term "leasing" in Class 36.**

Further examples of correct classification of rental services are:

Office machine rental	Class 35
Rental of safes	Class 36

Rental of drills	Class 37
Rental of ironing machines	Class 37
Rental of lifting apparatus	Class 37
Rental of diving suits	Class 39
Rental of garages	Class 39
Rental of generators	Class 40
Rental of boilers	Class 40
Rental of audio equipment	Class 41
Rental of computer software	Class 42
Rental of furniture	Class 43
Rental of linen	Class 43
Rental of plants	Class 44
Rental of clothing	Class 45

## **Retail, wholesale and shopping centre services**

For full guidance on this practice, see 3.12 in the classification practice manual

### **Acceptable terms**

The bringing together, for the benefit of others, of a variety of [indicate goods or types of goods], enabling customers to conveniently view and purchase those goods;

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase [indicate goods or types of goods];

Retail services connected with [indicate goods or types of goods];

Retail services connected with the sale of [indicate goods or types of goods];

Retail store services in the field of [indicate goods or types of goods];

Department store retail services connected with [indicate goods or types of goods]

Shop retail services connected with [indicate goods or types of goods];

Mail order retail services connected with [indicate goods or types of goods];

Electronic shopping retail services connected with [indicate goods or types of goods];

Retail clothing shop services;

Wholesale services connected with the sale of [indicate goods or types of goods]

The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and [other clearly defined *related* services], enabling customers to conveniently view and purchase goods and make use of and purchase such services in a shopping centre or mall.

The bringing together for the benefit of others, via the internet, of a variety of retailers and [other clearly defined *related* services] through a virtual shopping mall, enabling customers to conveniently view and purchase goods and make use of and purchase such services by means of telecommunications.

## **S**

### **Scratch cards**

See guide at Lottery tickets and scratch cards

### **Services relating to.....**

Specifications such as “services relating to air transportation” are too vague. The “services” should be specified since it is unclear which services are to be protected. In this case the specification should be edited to “air transportation”. Also note that although descriptions such as “information services relating to.....” are acceptable they are not as clear in specifications where the subject matter immediately precedes “information”. For example, in Class 42, “information services relating to engineering” could be interpreted as “technical information services relating to engineering” whereas “engineering information” is without ambiguity.

### **Sets**

See guide at Kits, sets and outfits

### **Smoothies**

These are seen as non-alcoholic beverages and are proper to class 32.

## **Social networking services**

Social networking services are acceptable in class 45, as it would be seen as a personal service and refers to the locating and introduction of friends, family etc.

Care should be taken as it would only cover the services in this class. With most social networking websites offering other services these must be covered in the relevant classes e.g.

Chatroom services	Class 38
Online forums	Class 38
Entertainment services	Class 41
Gaming services	Class 41

## **Software as a service**

With the development in computer services in the last few years the term Software as a service is a term used in trade that is associated with the provision of software from a hosted platform. With this in mind the term is acceptable in class 42

## **Solar panels**

These can fall into two classes:

Solar panels for electricity generation	Class 9
Solar panels for use in heating	Class 11

## **Stationery**

The term "stationery" should be regarded as covering goods traditionally sold by a stationer and not merely writing paper, envelopes and similar writing materials. This wider interpretation is supported by the definition given by major dictionaries and by the comments made by Mr Justice Pennycuik in the OFREX case, reported in [1963] RPC 169-171 where it was held that staples were covered by the term "stationery".

## **Substitutes**

The word "substitutes" should not be used in specifications without further qualification. For instance, "coffee substitutes", "cream substitutes", "ivory substitutes" are acceptable.

NB: The term "substitutes" by itself is unacceptable.

## **Supply of.....**

Care should be taken in the use of this term when qualifying services. Although acceptable in some circumstances, for example, "supply of electricity" in Class 39, in situations where its use is unclear, it should be objected to under Rule 8. For instance, in Class 42, the term "supply of computer software" is too vague because whilst this class includes design, rental, updating and maintaining computer software, it does not include the sale of software. Supply of software may also be interpreted as the goods themselves which would be proper to Class 9.

## **Systems**

This term is normally considered to be too vague as a description unless applied to goods which are clearly understood as being a system, e.g. allow:

Filing systems

Alarm systems (fire, burglar etc.)

Exhaust systems

Computer systems

Telecommunications systems

This list is not exhaustive. Alternative wording includes "equipment", "installations", "apparatus" or "instruments".

## **T**

## **Tableware**

This is an area in which care must be exercised since some items are classified as hand tools or cutlery in Class 8 and as domestic utensils in Class 21.

For example:

Class 8	Knives, forks, spoons, ladles and tongs. (including those made of precious metals)
Class 21	Tableware (except those goods in class 8) (including those made of precious metals)

## **Takeaways and takeaway services**

A takeaway is a shop or catering establishment that prepares and sells food or meals for consumption off the premises but the term can also describe the foods or meals sold by such businesses. Therefore an application containing the term "takeaways" is not an acceptable description in a class 43 specification since it can refer both to the sale of foodstuffs or prepared meals and to the business of preparing foods or meals. The specification should be edited to "Takeaway food and/or drink services" or "Takeaway services".

Note that it will not be possible to transfer the application to a goods class or extend the application to cover the sale of foodstuffs or prepared meals.

Some applications refer to "takeaway restaurants" in order to reflect that the restaurant service provided also has facilities to sell takeaway foods. This description is acceptable.

## **Tautology**

Tautology or repetition of items within a specification was once firmly edited out of specifications. This is no longer the practice and Examiners should not normally amend a specification for this reason alone. Applicants should have the opportunity of using both general and specific terms to make clear what goods or services they wish the registration to cover. The only exceptions to this guidance are for very long specifications which clearly contain a great deal of tautology. Where the removal of tautology would result in such a specification being very much reduced in length, it should be edited. Editing long and repetitive specifications also will lead to savings in terms of entering data onto OPTICS and reduce the number of potential errors.

## **Tea Cosies**

These goods were formally classified under International class 26, but from 1st January 2012 are now proper to Class 21.

## **Telecommunication services**

These services are proper to Class 38 but it should be noted that this class only covers the means of communication (e.g. land lines, satellite transmission facilities, rental of communications systems) and not information or advice provided by telecommunications such as, entertainment information (Class 41), financial information (Class 36), traffic news (Class 39) and so on. Class 38 does, however, include information or advice about telecommunications.

## **Tinder**

These goods were formally classified under international class 13 but from 1st January 2012 are now proper to Class 4.

## V

### **Vacuum cleaners**

See guide at Cleaning machines, apparatus or installations

### **Valves**

Valves fall in various classes. For example:

Class 6	if of common metal
Class 7	if parts of machines
Class 9	if thermionic
Class 10	if for feeding bottles or medical purposes
Class 11	if level controlling valves in tanks or if air valves being parts of steam heating installations
Class 12	if for vehicle tyres
Class 15	if parts of musical instruments
Class 17	if of rubber or vulcanised fibre
Class 18	if of leather
Class 19	water pipe valves not of metal or plastics
Class 20	if of plastics or materials in this class (including water pipes)
Class 21	if of glass or ceramic materials

### **Vending machines**

These goods were formally classified under International class 9 but from 1st January 2012 are now proper to Class 7.

# W

## **Workstations**

Although "workstations" are defined in most dictionaries as being computer equipment it is clear that in the trade that the term is used to describe goods such as furniture for housing computers. Hence the following classification:

Class 9                      Workstations [apparatus and installations]

Class 20                     Workstations [furniture]

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WORDING AND JUSTIFICATION OF OBJECTIONS

# INTRODUCTION

## 1. Foreword

This Guide is compiled from judgements and decisions from a variety of sources including, in particular, the Court of Justice of the European Union (CJEU), the General Court (GC), UK Courts and the Appointed Persons. Registry practice reflects and interprets current law, but just as the law evolves, so practice must change to take new factors into account.

Occasionally an application referred to as an example to illustrate a point suggests that the decision regarding acceptability was not in line with current practice. Given the constantly changing significance of certain words, phrases or signs in general use, it may be decided in retrospect that a given mark should not have been accepted for registration. An expression of opinion relating to such marks is not intended to determine or affect the registrability of any mark or any rights arising under the Trade Marks Act.

It should be remembered that the practice stated in this Guide should not be applied rigidly and without regard to the particular circumstances of the application. Each case must be considered on its own merits. An examiner should not disregard practice but the particular circumstances of a case may suggest that a departure from practice would be justified. See for example the comments made by the Appointed Person (Simon Thorley QC) in the appeal by *Henkel KGaA* ([BL 0/152/01](#)), against the refusal of the Registrar to grant protection in respect of an International Registration. In that decision, at paragraph 12, it says -

*"It must always be remembered that the Registry Practice is a guideline and nothing more. It is helpful both to the Registry and to practitioners, but it cannot absolve the registrar's hearing officers, or me on appeal, from approaching each case on its own facts".*

Where there are good reasons to depart from usual practice officers may do so. The reasons for departing from practice should be recorded on the application file either on the internal minute sheet or (if appropriate) in the Hearing Record.

### 1.1 Purpose of this Guide

The purpose of this Guide is to indicate to examiners the procedures to follow when examining a mark, and to give guidelines on registrability. Practice is determined by applying the judgements and decisions referred to above. The Guide will set down how particular categories of mark should be examined by applying this guidance. It will indicate when objections should or should not be raised and give guidance, where possible, on ways of overcoming the objections, including the filing of evidence.

### 1.2 Practice, as determined by judgements and decisions of courts

The examination of marks for acceptability under the Trade Marks Act 1994 must be by reference to the provisions of that Act, taking account where appropriate of existing practice as laid down or endorsed by judgements and decisions in the Courts or tribunals referred to below.

COURT OF JUSTICE OF THE EUROPEAN UNION (CJEU). These decisions are binding on the Office. They are usually cases referred to the Court by EU member states for a 'preliminary ruling' on a point of law. The case is then referred back to the national court for a final decision in accordance with the terms of the ECJ's judgement. Alternatively, they are cases being appealed from the CFI. (See below)

ADVOCATE GENERAL'S OPINION. Before the CJEU gives its judgement, the Advocate General may deliver his/her opinion which may assist the Court in reaching its decision. The Opinion does not have binding effect but may give fuller reasoning on the issues being considered than the main Court needs to give in its final decision.

GENERAL COURT (GC). These decisions are binding where the facts remain the same and are of persuasive value on cases where similar considerations apply. The GC is used for appeals involving Community institutions such as the UK IPO. There is the right of appeal from the GC decision to the CJEU. Either the GC or CJEU will give a final ruling.

UK COURTS. These decisions are binding on the Office.

APPOINTED PERSON. These decisions are not binding on the Office on points of law other than in the case being dealt with. However they are of persuasive value in considering similar cases. These decisions are published on the Office website under '[HEARINGS \(Results of past decisions\)](#)'. Appointed Persons are experienced Intellectual Property Law practitioners who are appointed by the Lord Chancellor. They are an appeals tribunal to the Office's decisions. There is no right of appeal to their decisions.

PRACTICE AMENDMENT NOTICES (PANs). These are internal guidelines and notices changing or clarifying practice. The contents of a PAN are published on the Office website to notify practitioners and the public under '[Practice Amendment Notices](#)'

DECISIONS OF TRIBUNALS/COURTS IN OTHER MEMBER STATES - decisions of other national tribunals/courts within the EU may be of persuasive value in determining the registrability of a particular trade mark. This has been affirmed by the CJEU in [Henkel KGaA v Deutsches Patent und Markenamt \(C-218/01\)](#) where it was stated that:

*"The fact that an identical trade mark has been registered in one Member State for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.*

*On the other hand, the fact that a trade mark has been registered in a Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark application for registration of a similar mark for goods or services similar to those for which the first mark was registered."*

The same must, in principle, be true of the position of the registrar with regard to decisions of law made in other EU tribunals & courts. The Decisions of the CJEU on points of law are, of course, binding in the UK.

## EXAMINATION PROCESS

### Examination of a mark prior to acceptance for publication in the Trade Marks Journal for possible opposition purposes

The main focus of examination is consideration of the 'Absolute Grounds' for acceptance under **section 3(1)** of the Act. (See below.) However, other sections of the Act also need to be considered where they cover specific categories of marks. These topics are listed alphabetically under PRACTICE and include:

**Section 3(2) - 'Shape' marks**

**Section 3(3) - 'Offensive' or 'Deceptive' marks**

**Section 3(4) - Marks whose use is prohibited in the UK by enactment or rule of law by any provision of Community law**

**Section 3(5) - Marks specified or referred to in Section 4 below (Specially Protected)**

**Section 3(6) - Applications made in 'bad faith'**

**Section 4 - 'Specially protected emblems' such as Royal arms, Royal crowns, representations of the Royal family, UK and other flags, Coats of Arms, Olympic words and symbols**

**Section 5** - We also examine marks under 'Relative Grounds'. That is to say, we identify earlier marks which are considered to be confusingly similar. **This is not a barrier to acceptance** but we are required to 'notify' earlier right holders of any acceptance of a later mark which is considered to be confusingly similar to their mark under the terms of sections 5 and 6 of the Trade Marks Act. (See NOTIFICATION)

As indicated above, the main consideration at examination stage is section 3(1). The majority of categories considered during examination are concerned with this section of the Act. These categories are listed alphabetically under PRACTICE, in common with the topics covered by the other sections of the Act listed above. What follows is a general introduction to the approach to examination under section 3(1).

### Section 3(1) – an explanation

#### 1 Section 1(1) of the 1994 Act states:

*"In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."*

The words "capable of distinguishing" must be construed by reference to the essential function of a trade mark, which the CJEU has described as being:

*“...to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality...”* [Philips v Remington judgment, C-299/99](#), paragraph 30.

## **2 Section 3(1) of the 1994 Act states:**

*“The following shall not be registered-*

- (a) signs which do not satisfy the requirements of section 1(1),*
- (b) trade marks which are devoid of any distinctive character,*
- (c) trade marks which consist 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,*
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”*

## **3 Section 3(1)(a)**

### ‘Sign’

Court of Justice of the European Union (‘CJEU’) case law, (see [Heidelberger Bauchemie, Case C-49/02](#) and [Dyson, Case C-321/03](#) ) has developed the requirement that to be registrable, a mark must be a ‘sign’.

To be a ‘sign’ is an independent and fundamental requirement which, if not considered met, will result in an objection under section 3(1)(a) being raised prior to any full examination .

The CJEU has said that the underlying purpose of the requirement to be a ‘sign’ is to prevent the abuse of trade mark law by obtaining an unfair competitive advantage.

In the *Dyson* case, the CJEU felt that an unfair competitive advantage was being sought by the applicant who, in the description on his initial form and by admission during proceedings, stated that the application covered all conceivable shapes (and colours) of transparent bins, being parts of vacuum cleaners. The application and resulting rights were not therefore confined to the shape/appearance of a specific bin(s) presented with the form.

The registrar may raise a section 3(1)(a) objection against the following illustrative types of mark:

- wherever the subject of the application appears to be a mere 'property' of a product such as the material from which something may be made or a functional feature which is not limited to any specific shape;
- applications to protect an 'idea' rather than a fixed expression of the idea; an example may be marks which purport to secure rights in relation to a 'theme';
- applications to register extended moving imagery, such as an advertisement, which cannot be regarded as forming a single sign.

The following types of description (non exhaustive) would give rise to such an objection:

1. "The mark consists of a drinking vessel made of leather"
2. "The mark comprises a transparent collecting chamber of a vacuum cleaner, as shown in the representation"
3. "The mark comprises a rugby themed restaurant, several photographs of which are shown"
4. "The mark comprises an advertisement showing a man walking into a bar (frames 1-5), engaging in conversation (frames 6-11), eating a packet of crisps (frames 11-20)"

In the first example above, even assuming that a representation had been filed, there is no clear 'linkage' or 'fixing' to any accompanying representation. Moreover, the 'subject' of protection appears to be a property of the vessel (the fact that it is made of leather). In the second example, the 'subject' of protection appears to be the transparent nature of the bin and any representations are merely illustrative of that concept. In the *Dyson* case, the use of the words "as shown in the representation" were found to be an ineffective means of fixing the mark to collecting bins of the particular shapes shown in the application. Consequently, if the intention is to fix the mark to the particular shape shown in a pictorial representation of the mark, applicants should use unequivocal wording such as "of the shape (and/or in the position/location) shown in the representation". In the third example, use of the word 'themed' is uncertain and, again, any accompanying photographs would be assumed to be illustrative only. In the fourth example, the subject of protection appears to be a sequence of unrelated movement(s) which cannot be said to be a single 'sign'.

'capable of being represented graphically'

A 'sign' objection and a 'graphic representation' objection may well overlap but this will not necessarily be the case. The specific requirement for graphical representation is covered more fully in the section on unconventional trade marks.

'which is capable of distinguishing goods or services of one undertaking from those of other undertakings'

If a 'mark' has no capacity to serve this primary distinguishing function then it would attract objection under section 3(1)(a). The often quoted example of this would be the word 'soap' sought to be registered for 'soap'. The 'mark' applied for is nothing more than the common name for the goods; such a 'mark' has no capacity to serve the essential function of a trade mark, no matter how much 'use' has been made of it (see, for example, *Re Registered Trade Mark "Jeryl Lynn"* [1999] FSR 491, [2000] ETMR 75 sub nom Merck and Company's Trade Mark: SmithKline Beecham PLC's Application for a Declaration of Invalidity (Laddie J)).

#### **4 Section 3(1)(b)**

Section 3(1)(b) prohibits (*prima facie*) the registration of trade marks which are devoid of any distinctive character. Unlike sections 3(1)(c) and (d), it does not give any clear definition as to the nature of the objection. Its purpose is to prohibit registration of marks which do not fall foul of the clear parameters set by sections 3(1)(c) and (d), but nevertheless still do not fulfil the function of a trade mark; that is, they do not identify goods and services from one undertaking from those of other undertakings. Section 3(1)(b) has separate and independent scope from section 3(1)(c).

(See "Wording of Objections" under PRACTICE, below, for examples of marks which may be objectionable under section 3(1)(b)).

#### **5 Section 3(1)(c)**

Following the CJEU's judgement in case [C-191/01 P Doublemint](#), Article 7(1)(c) of Community Trade Mark Regulation 40/94 applies to trade marks which consist exclusively of signs or indications which may serve, in trade, to designate a characteristic of the goods or services for which registration is sought. In order to determine whether a trade mark is excluded from registration under Article 7(1)(c) it is necessary to ascertain whether the sign at issue is capable of being used by other economic operators to describe a characteristic of their goods and services.

The court indicated that the test is NOT whether the mark is exclusively descriptive; it is sufficient if one of the meanings of the mark designates a characteristic of the goods/services.

The same court confirmed its earlier judgement in *Windsurfing Chiemsee* ([C-108/97](#) and [C-109/07](#)) to the effect that it is not necessary for a sign to be in current use as a description before it is susceptible to an objection under Article 7(1)(c). It is sufficient that the sign is capable of being used as a designation of the goods/services. Article 7(1)(c) of the Community Trade Mark Regulation corresponds to Section 3(1)(c) of the Trade Marks Act 1994 and the court's findings must therefore be taken to apply equally to the national law.

When examining marks consisting of unusually juxtaposed words and marks which consist of only part of a natural description for the goods/services, the court's judgement in [Baby-Dry \(C-383/99 P\)](#) provides guidance. *Baby-Dry* also assists in an assessment of whether a trade mark consisting of two or more words consists *exclusively* of a descriptive term, when the

words in question are juxtaposed in a manner which renders the mark resistant to natural descriptive uses. Although the court stated in *Doublemint* that it is sufficient if the sign in question is "capable" of being used as a description of the goods/services, this must be taken as applying only where there is a reasonable likelihood that the sign in question will serve a descriptive purpose in the ordinary course of trade. What must be considered is whether third parties are likely to use signs corresponding to the trade mark applied for in order to describe characteristics of the goods/services covered by the application.

This assessment will consider the position as at the date of the application, but it will also take account of new uses that were reasonably foreseeable as at that date.

It is important to take account of distinctions between a trade mark and a description of the goods/services arising from the *omission* from the trade mark of words or other components that would be essential in order for the sign to work as a description for example, compare "Keeps Your Baby Dry." with "Baby-Dry". It must be borne in mind that shorthand for, or an abbreviation of, a longer descriptive term may itself be a term which "may serve, in trade, to designate the goods/services or their characteristics". Shortening a longer descriptive phrase will not therefore *automatically* result in a trade mark which is free from objection under section 3(1)(c). [See, for example, the decision of the Appointed Person in "[Where all your favourites come together](#)" (BL 0/573/01) ]

In determining whether a trade mark consists *exclusively* of a designation of the goods/services, differences of a kind which may go unnoticed by an average consumer, will be discounted entirely. The presentation of a descriptive trade mark in a graphical form which corresponds to common forms of presenting descriptions in trade, such as the use of a colour or a simple border, is unlikely of itself to be sufficient to resist an objection under section 3(1)(c).

It is well established that each of the sub-sections of section 3(1) of the Act operate independently of one another. However, a mark which consists exclusively of a sign which may serve, in trade, to designate the goods/services or their essential characteristics is liable to be devoid of any distinctive character. Consequently, the grounds which give rise to an objection under section 3(1)(c) are also likely to support a further objection under section 3(1)(b). However, the *absence* of a section 3(1)(c) objection does not preclude the possibility of a section 3(1)(b) objection being raised on grounds other than that the mark is descriptive of the goods/services covered by the application.

## **6 Section 3(1)(d)**

This section of the Act applies where the mark consists of a sign which has become customary in the current language or in the bona fide and established practices of the trade. The relevant trade is that concerned with the goods or services covered by the application. The relevant question is whether the sign is used in the sense described above to designate goods or services of the relevant kind. Use of the sign by consumers **in the course of trading in the goods or services** is just as relevant as use by traders in the goods/services. The use does not have to be for the purpose of designating characteristics of the goods/services in order to fall within the prohibition.

See “Bravo” case: [Merz & Krell GMBH & Co \(C-517/99\)](#), European Court of Justice and [STASH Trade Mark, BL 0-281-04](#), The Appointed Person (at paragraph 30).

Marks falling in this category include, for example, simple devices of grapes for wines, star devices for brandy, as well as common names such as ‘The Red Lion’ for public house services.

This notice is issued in conjunction with [TPN 1/2011](#) and replaces PAN 14/06. It takes into account the latest guidance from the courts in respect of the issue of partial refusals, and in particular, the guidance of Mann J in [Giorgio Armani SpA v Sunrich Clothing Ltd \[2010\] EWHC 2939 \(ch\)](#).

## **7 Onus on the Registrar to assess registrability in context of the goods/services claimed.**

It is settled law that the registrability of a sign must be assessed in context *‘first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the relevant public’s perception of the mark’*.

In the [Sensornet](#) decision [BL O/136/06] Mr Richard Arnold QC, sitting as the Appointed Person stated at paragraphs 50 to 59:

*“...if an objection to registrability only applies to some goods or services in the specification applied for, then the application should only be refused in so far as it covers those goods or services and should be allowed to proceed in respect of the remainder... all that is needed is to identify which part of the specification is acceptable and which is not, and the Registrar’s decision can and should do this... in the event that it is decided that grounds for refusal exist in respect of certain of the goods or services specified but not others, deleting the objectionable goods and services from the specification i.e. applying a blue pencil approach”.*

This was supported in [Giorgio Armani SpA v Sunrich Clothing Ltd \[2010\] EWHC 2939 \(ch\)](#) where Mann J stated at para 53 (ii)

*“...In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling that which is not admissible, or it might be obvious that a plain express qualification (“save for [the goods in respect of which opposition succeeded]”) will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities.*

The guidance provided by the above decision has been supported in more recent decisions such as [Fresh Direct](#) [BL O/367/10] and [O2 Holdings Limited Application](#) [BL O/078/11] where it has been confirmed that the Registrar has the responsibility to indicate the extent of the refusal and to accept the application in respect of all non objectionable terms.

## Practice

In practical terms this will mean that examiners will indicate at the examination stage the range of goods/services for which the mark is objectionable. Where the objection does not extend to all goods/services claimed in the application they will raise a partial refusal and will indicate the list of acceptable terms.

As suggested in *Sensornet*, the examiner will apply a blue pencil approach to what he regards as obviously descriptive terms. The “blue pencil” will also be applied to broad terms which may cover objectionable items.

In relation to the latter, there may well be goods and services also covered by the broad terms which may not face objection. It will be up to the applicant, following receipt of the examination report, to identify what these are and submit a restricted specification for consideration, should they wish to do so.

Example:

Mark: **Four by Four** - Vehicles; land vehicles; motor vehicles; motor cars and bicycles.

The mark is descriptive of motor vehicles incorporating a four wheel drive capability and objection would be raised in respect of motor vehicles and those terms which contain motor vehicles within their ambit.

The examination report would indicate that the mark is refused in respect of “Vehicles; land vehicles; motor vehicles; motor cars”, but is acceptable in respect of “Bicycles”.

The broad terms “vehicles and land vehicles” are excluded from acceptance because they can include ‘motor vehicles’ within their scope. However if the applicant were to suggest limiting the broad terms to e.g. “Space vehicles, aircraft, ships, locomotives; trailers; 6 wheeled tractor units; bicycles” then the objection would be overcome.

Alternatively, an exclusion of the objectionable goods may be acceptable providing it excludes a category of goods and not merely a characteristic of those goods (as per guidance provided in the [PostKantoor](#) (C-363/99)). “Four wheel drive” is a property of the goods claimed and to merely exclude four wheel drive vehicles would not be acceptable. Whereas ‘motor vehicles’ is a category of goods which would include vehicles incorporating a 4 wheel drive capability and an acceptable exclusion would read: ‘Vehicles; land vehicles; but not including motor land vehicles; bicycles.

If the applicant did not reply to the examination report, the application would be published for the acceptable goods ‘bicycles’. This is because the Registrar does not have the power to change or add to the wording of specifications without authority from the applicant, but may delete objectionable terms and publish the acceptable parts of the specification.

If an appeal is lodged against the refused goods/services, the whole application will be suspended until the outcome is finally determined. If the applicant wished the acceptable

part of the specification to proceed whilst the appeal is ongoing, a form TM12 to divide the application should be filed. The acceptable part of the specification may proceed to publication, whilst the remainder will be suspended until finally determined.

## **PRACTICE (In alphabetical order)**

### **AMENDMENTS TO AN APPLICATION**

Section 39(1) states:

*"The applicant may at any time withdraw his application or restrict the goods or services covered by the application.*

*If the application has been published, the withdrawal or restriction shall also be published.*

*(2) In other respects, an application may be amended, at the request of the applicant only by correcting –*

*(a) the name and address of the applicant,*

*(b) errors of wording or of copying, or*

*(c) obvious mistakes,*

*and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.*

*(3) Provision shall be made by the rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it."*

It is, of course, very difficult to determine what an "error of wording" or "obvious mistake" is, but the most important part of this section of the Act is the final few lines, which permit very few amendments to the mark itself. It would not be an obvious mistake if e.g. a mark written as SELECTA should have been filed as SELECTOR, trade marks often consist of misspellings of well known words. Even if it was an error such a change would substantially affect the identity of the trade mark.

If an amendment to the trade mark or the list of goods and services is requested after advertisement, and the amendment is permitted, the amendment to the mark must be advertised (section 39(3), rule 18).

In the registrar's view, "the application" for the purposes of section 39(1) consists of the items listed in section 32(2) of the Act. The Class number(s) entered on the application form are considered to be part of the statement of goods or services.

Other matters covered on the application form, such as the agent's details and

limitations or disclaimers are not covered by the restrictions set out in section 39(1) and can be amended, deleted or inserted subject to the provisions of the appropriate rules.

## **ANIMALS (DEVICES OF)**

Certain animals are inherently non distinctive for certain goods e g cows or goats for dairy products, sheep for wool products. Such marks should be objected to, as appropriate, unless presented in a fanciful way e g a laughing or dancing cow.

Animal devices are often distinctive trade marks. However, care needs to be taken in relation to goods aimed at children such as children's clothing, children's bedding etc, where they are frequently used as decoration. As a rule of thumb, the more "warm and cuddly" the representation, the more likely it is to appeal to children and be seen as mere decoration and the less likely it is to be seen as a trade mark. Object under section 3(1)(b) where appropriate.

(See also CARTOON CHARACTERS)

## **APPEAL PROCESS**

There is an appeal process whereby the registrar's decisions can be challenged. Under the 1994 Act any decision of the registrar (except classification) can be appealed.

The person taking the decision may be called upon to provide a reasoned statement of grounds for their decision. Appeals may be made to the Courts or to the Appointed Persons.

## **ARMORIAL BEARINGS, HERALDIC DEVICES AND COATS OF ARMS**

Arms and Insignia are dealt with under rule 10 of the Trade Marks Rules 2008 and section 4(4) of the Trade Marks Act 1994 as amended.

### **Background**

In England, Wales and Northern Island the right to grant arms lies with the present-day Officers of the College of Arms (under the Garter King) and can be granted to individuals and corporate and public bodies amongst others. The right to bear arms is granted in perpetuity. In the case of an individual it extends to the descendants and in the case of a corporate body etc. it endures for as long as the corporation or organisation itself.

The legal regime in Scotland differs from that of the rest of the UK. In Scotland the Lord Lyon advises that arms, as protected by Scots law, are regarded as incorporeal heritage or property and are rights *in rem* maintainable against anyone within Scotland. Therefore, it appears that the use of arms in Scotland by a person whose right is not on record in the

statutory Public Register of All Arms and Bearings in Scotland constitutes a statutory offence, and offenders may be prosecuted at the instance of the Procurator Fiscal of Lyon Court.

In relation to trade mark law, in both jurisdictions, companies and other commercial organisations which have been granted Arms and wish to use them in the course of trade are free to register the whole or any part of the full achievement as a trade mark.

At present, where applications for Trade Marks have been considered to contain either Arms or Insignia, as part of the *ex officio* examination process, it is the Registry's policy to request a search of the records of grants of arms held by either The Garter King of Arms for England, Wales and Northern Ireland or The Lord Lyon King of Arms for applicants based in Scotland. Where the mark was considered to contain such recorded Arms then an objection is raised under s. 4(4).

With effect from 17<sup>th</sup> August 2009, no further search requests will be issued either to Garter King of Arms or Lord Lyon King of Arms. In future, the protection of such right will be left to the proprietors, and interested parties, to exploit, where they wish, the existing legal processes as provided by opposition (s. 5(4); s. 38), observation (s. 38(3)) and invalidation (s. 47(2)(b)). The proposed legal basis for opposition and invalidation would rest with s. 5(4)(a) and/or (b) (and s. 4(4) read with r. 10 of The Trade Marks Rules 2008).

There are a number of reasons for the proposed change. Other earlier rights (s. 5(2)(b)) no longer form a basis for refusal at the examination stage and arms are effectively an earlier right. In this sense they differ from the special protection granted to the Royal Family and its emblems listed in s. 4 of the Act, and to other specially protected symbols there listed, where protection is based on explicit public policy in relation to the Royal Family and national flags or on the requirements of international law. It follows that the holders of Arms should protect their rights using the power granted by s. 4(4) on the basis of a personal decision in relation to the protection of that right, the regime that currently applies to other earlier rights holders, and has been operating successfully in relation to earlier marks since October 2007.

Nevertheless, where applications consist of or contain heraldic devices, the IPO will advise that applicants contact Lord Lyon in Scotland or Garter King in the England given that their application may be affected by the law of Arms in either or both. Such advice would be provided in all cases as the criminal sanctions in Scotland may well affect Welsh, English and Northern Irish based businesses where they use their marks in Scotland.

Where the mark is found to consist of or contain what appears to be arms or insignia nearly so resembling arms then the following paragraph will be included in the examination report:

“Whilst your mark, which appears to [consist of] [contain] arms, has not been objected to, the right to bear arms falls under the jurisdiction of the Kings of Arms for England, Wales and Northern Ireland or Lord Lyon in Scotland, who you may wish to contact for guidance. Further, it is the advice of the Lord Lyon that the use of armorial insignia in Scotland by a person whose right is not recorded in the statutory Public Register of All Arms and Bearings in Scotland constitutes a statutory offence and may lead to prosecution at the instance of the Procurator Fiscal of Lyon Court.

For further information on these matters you should either contact:

Garter King of Arms  
The College of Arms  
Queen Victoria Street  
London  
EC4V 4BT  
England

Or

The Court of the Lord Lyon  
HM New Register House  
Edinburgh  
EH1 3YT

## **CARTOON CHARACTERS**

A cartoon character can often function as a distinctive trade mark e.g. when used in relation to shoe polish or accountancy software. With other goods or services, such as clothing or soft toys, acceptability of a mark consisting of a cartoon character may be less clear. The following points should be considered and objections raised as appropriate under section 3(1)(b):

- The representation at issue, whether two-dimensional or three-dimensional, should be treated the same way.
- If the cartoon character is well known to the examiner, (s)he can take judicial notice of that fact. The examiner must then consider whether the representation is likely to come from a single source (e.g. 'Mickey Mouse' being a Disney character) as opposed to a representation that could come from many sources e.g. a representation of TARZAN could come from a variety of sources because numerous undertakings have produced TARZAN films in the past.
- Are the marks sufficiently individual as to differentiate them from standard variations for the goods where animals/cartoons are commonly used as decoration e.g. children's clothes?
- There is usually a wide range of product variations for toy shapes including plush toys (which often have cartoon-like features). Therefore variation from the norm for these goods would rarely be sufficient for the mark to act as a badge of trade origin, especially for definable animal types e.g. rabbits, cats, birds, bears.

[See also ANIMALS (DEVICES OF)]

## COMPANY NAMES

A company name may be accepted for registration provided that it meets with the normal requirements of section 3 of the Act. The addition of 'Ltd' or 'PLC' to descriptive words is unlikely to confer distinctive character by suggesting that the sign is used by a single undertaking. For example 'SOAP LTD' (for soap) would not be acceptable *prima facie*. This is not, however, an inviolable rule. There may be situations where the addition of company name descriptors can be material. For example, 'The Blackheath Locksmiths Co Ltd' is likely to be acceptable for locksmiths' services, whereas 'Blackheath Locksmiths' would not. It is not the addition of 'The' which confers distinctive character. Rather it is the fact that there are likely to be a limited number of blacksmiths in Blackheath and so the **combination** is thought to convey a single trade source. However, 'The Organic Food Company' would **not** be acceptable for organic foodstuffs as there would be a large number of organic food producers, 'organic food' describing the name of a **category** of goods.

Conversely, the addition of a company name descriptor to words describing characteristics of the goods or services other than the name of the goods/services will sometimes bestow distinctive character. For example, 'Soft and Gentle' would not be acceptable for soap, whereas 'Soft and Gentle Ltd' would be seen as fanciful and therefore acceptable. Each case must be considered on its own facts.

A company name may be accepted for registration provided that it meets with the normal requirements of section 3 of the Act. Unless the company name is **wholly descriptive** there will rarely be a basis of objection under section 3(1) because the addition of 'Limited' or 'Plc' will often provide moderately descriptive words with some capacity to indicate origin. The addition of Limited or Plc will avoid any objection under section 3(1)(c) or (d).

[(See also ORGANISATIONS (NAMES OF)]

## CONFIDENTIALITY

Unless confidentiality has been agreed all documents and correspondence on 1994 Act applications will be open to public inspection after the mark has been published. 1938 Act applications will not be open to public inspection (except for statutory forms) until registered and then only in respect of correspondence and documents filed after registration.

### 1 References

Section 67 provides that anyone may inspect the contents of any file once the mark in question has been published.

Section 67(2) provides that certain documents may also be seen before publication.

These are specified by rule 57 and are:

the application form

any forms which have been filed to amend it, including particulars filed under rule 35 which covers registrable transactions, e.g. assignments.

## **2 Handling of requests for confidentiality**

The presumption is that, once an application has been published, the file is open to public inspection. Section 67 of the Trade Marks Act 1994 provides for there to be restrictions to this general presumption. There is no general exception which covers sales and/or advertising figures as such. There is provision in rule 45 for an applicant to request confidentiality for a particular document (or part of a document). To do so he must give his reasons.

If it had been the intention for all sales and advertising figures submitted in *ex parte* evidence to be kept confidential the rules might have been expected to reflect this. There will be occasions where it can be shown that, for specific reasons, public inspection of particular sales or advertising figures will be damaging to the applicant and in such a case favourable consideration will be given to a request for confidentiality. Depending on the weight of the case for confidentiality and the significance of the figures to the monopoly being sought, the Registrar may agree that the figures for particular periods be kept confidential either absolutely, or on condition that a supplementary summary, showing the figures in a less specific way, be submitted for the public record. For example sales for a particular period could be expressed as being not less than £XXX, or between £XXX and £YYY. In such a case the summary may be made available for public inspection but the actual figures kept in the confidential section of the file.

It is always open to the applicant or his representative to submit evidence in a form that avoids the need to refer to specific figures. For example, one applicant submitted evidence which provided details of the length of user, the number of outlets through which the goods had been sold and their location, and a "not less than" figure for sales through each outlet. The point being that it is not always necessary to provide precise sales figures in order to establish factual distinctiveness.

The registrar has agreed to confidentiality in cases where either sales figures were not central to the decision to accept the application, or specific reasons for keeping them confidential were provided. Most requests for confidentiality so far received have not included reasons to justify the request beyond generalities such as the exhibit "contains sensitive commercial information". These have not been accepted. However, if specific reasons are provided for such requests the registrar must consider them and, if justified, agree to confidentiality.

The issue of confidentiality of documents submitted to the Patent Office (as it then was) was considered in the *Diamond Shamrock Technologies SA* case (1987 RPC page 91). This was a patent case, but the rules are similar. The issue was whether royalty payments and prices under a licensing agreement should be kept confidential.

At page 93, line 22, Mr Justice Whitford said:-

*"It is commonplace in connection with a variety of proceedings, and patent proceedings are no exception, that the parties to the proceedings want material to be kept confidential. There are matters which they do not want to be disclosed to the public at large. What is said in these letters is that this, that or the other information contained in the declarations or exhibits should be kept confidential because "it contains sensitive commercial information."*

*I think it is desirable that a more exact indication should be given as to the reasons why in truth the document ought not to be disclosed because it is easy enough to talk about the material being of commercial interest and to talk of it being sensitive. That fact in itself does not necessarily mean that the material, which would otherwise become public property because it was included in the documents which are going to be open to public inspection, is to be excluded from public inspection."*

### **3 Guidelines on the practice to apply when a request for confidentiality is received**

Where full reasons for the request are given, the applicant's desire for commercially sensitive information to be kept secret should be balanced against its significance in the context of the application. If the application is only proceeding because of evidence of use there would have to be very strong commercial reasons why the sales figures should not be open to inspection.

The request for confidentiality must be made at the time the information is filed (or within 14 days of filing it).

## **DATE OF ACCEPTANCE**

This is the date when an application is accepted by the registrar. The date of acceptance is either the date of the examination report, the subsequent letter from the registrar accepting the application or, if the application is accepted at a hearing, the date of the hearing. An offer to accept an application, subject to conditions, does not amount to acceptance under section 37 of the Act. However, acceptance will normally follow compliance with the stated conditions of acceptance.

## **DECEPTIVE MARKS (geographic)**

**Geographical Indications and section 3(3)(b) (See also the main section on section 3(3)(b) Deceptive Marks)**

### **1 When to raise an objection under section 3(3)(b)**

Section 3(3)(b) objections should only be taken at the first examination stage to place names or figurative marks indicating **geographical origin** where the place has a reputation for the goods or services, for example:

PIAZZA D' ITALIA for "clothing", because the public would be deceived if the goods or the cloth were not made in Italy, which has a strong reputation for quality cloth and clothing;

SOMERSET GOLD for "cider", because Somerset is well-known for its cider;

SWISSTEX for "watches", because Switzerland is famous for high quality watches.

Geographical names appearing in trade marks for wines and spirits, such as brandy, also require consideration in relation to deceptiveness: **see also the section on “Reserved Words” for Protected Geographical Indications and Designations.**

## 2 Overcoming section 3(3)(b) objections

Section 3(3)(b) **may be overcome** by a restriction to the specification.

Objections raised under this section of the Act generally result in the narrowing of the rights in the mark by means of imposing a limitation to the specification of goods/services.

Where a specification is being restricted to overcome a deceptiveness objection based upon the origin of the goods/services the specification should be restricted to goods *manufactured in* the appropriate place for manufactured goods or *produced in* for other goods, for example:

SWISSTEX: “Watches and horological instruments; all manufactured in Switzerland”;

LOCH DOUGLAS: “Salmon and salmon products; all the produce of Scotland”.

## 2 Whisky

[The Scotch Whisky Regulations 2009](#) (SI 2009 No. 2890) is concerned about the treatment of marks containing the words Scotch and Scotch Whisky (**see also the section on Scotch Whisky**) which are sought to be registered in respect of whisky and whisky based liqueurs.

Use of the following terms in specifications will avoid/overcome a section 3(3)(b) objection to marks which are merely evocative of Scotland and applied for in respect of a specification which consists of, **or includes** whisky or liqueurs:

“Scotch whisky”

“Scotch whisky based liqueurs produced in Scotland”

“Alcoholic beverages, but in so far as whisky and whisky based liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland.

It is, of course, open to any applicant to challenge the general practice, or to argue that a proposed specification is sufficient to overcome an objection under section 3(3)(b) of the Act. Any alternative wording suggested by an applicant should be considered on its merits.

# DECEPTIVE MARKS (other than geographical indications)

Section 3(3)(b) of the Act states:

*(3) A trade mark shall not be registered if it is -  
b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origins of the goods or service)."*

In [Elizabeth Emanuel v Continental Shelf 128 Ltd, Case C-259/04](#), the CJEU stated in paragraph 47 of its judgment that the application of this provision "presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived". An objection under section 3(3)(b) should therefore only be raised if in the examiner's view there is a real (as opposed to a purely theoretical) potential for deception of the public.

## 1 Nature

Upon initial examination of an application, it is **unnecessary** to raise an objection to the mark where there is no realistic possibility of deception. For example, there would be no objection against HARTLEY'S STRAWBERRY JAM for "jam". It will be assumed that the applicant will either only use the mark on strawberry jam, or he will vary the mark in use (or else will fall foul of the Trading Standards legislation and also rapidly lose customers). If the mark was used deceptively it would be open to revocation under section 46(1)(d) of the Act.

However, if, in response to an objection under section 3(1) of the Act, an applicant seeks to exclude goods or services from the specification, the examiner should reconsider whether the mark has now become of such a nature as to deceive the public. For example no objection under section 3(3)(b) may have been raised at the examination stage to the mark FINANCIAL WORLD for "magazines". It appears to be against any trader's own interests to use such a mark on anything other than magazines about finance. However, if the applicant seeks to exclude such goods simply to overcome the objection under section 3(1) of the Act to get his mark on the register, a section 3(3)(b) objection should be raised.

## 2 When to raise an objection under section 3(3)(b):

In the main, therefore, section 3(3)(b) objections at the first examination stage should only be taken to marks which indicate a particular (desirable) **quality** of the goods. (But see also **DECEPTIVE MARKS (Geographic)** above).

### 2.1 Quality

STAINLESS SUREFIT for "exhausts", because stainless steel exhausts are better quality, being more durable;

ARTIC LEATHER for "clothing", because imitation leather is sometimes passed off as leather;

BRASSRITE for "plumbing fittings", because brass fittings are perceived as being of better quality than plastic ones;

MOONSILK for "underwear", because silk is more desirable than other fabrics.

In each of the examples listed above, the list of goods should be restricted to reflect the composition of the goods, or the application should be refused.

### **3 Overcoming section 3(3)(b) objections**

Section 3(3)(b) **may be overcome** by a restriction of the specification. Objections raised under this section of the Act generally result in the narrowing of the rights in the mark by means of imposing a limitation to the specification of goods/services.

For example:

Mark applied for: Woolpoint

Specification: *Suits*

Limitation required: *"...; all made wholly or principally from wool."*

It is, of course, open to any applicant to challenge the general practice, or to argue that a proposed specification is sufficient to overcome an objection under section 3(3)(b) of the Act. Any alternative wording suggested by an applicant should be considered on its merits.

## **DESCRIPTION OF GOODS (Descriptions of the subject matter of the goods or of what the goods represent)**

Section 3(1)(c) of the Act excludes trade marks which consist exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods. In *Zapf Creation AG v OHIM*, (Case C-498/01 see below), the General Court found that a mark which is descriptive of what the goods represent (in that case, toy dolls), cannot be considered to be descriptive of the toy itself, other than insofar as consumers conflate the toy with what it represents. The GC held that the trade mark NEW BORN BABY was not therefore excluded from registration by Article 7(1)(c) of the Community Trade Mark Regulation (which is equivalent to section 3(1)(c) of the national law).

OHIM filed an appeal against that decision. The application was withdrawn after the [Opinion of Advocate General Jacobs \(C-498/01 P\)](#) was issued; until the ECJ re-considers the matter in another case, the Registrar will continue to apply his existing practice in this area, which corresponds with the opinion of the AG. In the AG's opinion, "where an essential characteristic of a product is to represent something else, a term consisting exclusively of elements which represent that something else may not be registered as a trade mark."

### **1 Practice**

Where a trade mark consists exclusively of a word or words which designate the subject matter of a product, or what it represents, the application for registration will face an objection under section 3(1)(c) if the word will serve only a descriptive purpose in trade.

Accordingly, in the case of printed matter and electronic media, the registrar would not accept:

## **TUTANKHAMUN**

- because the mark describes the subject matter, i.e. printed matter and electronic media about Tutankhamun.

Similarly, for goods such as soaps, books, films and toys, an objection under section 3(1)(c) would be raised in respect of:

## **FISH**

- because the mark describes the shape of the soap, the subject of the books and films, and the shape of the goods in relation to toys.

The following would also not be acceptable for chinaware:

## **DAFFODIL**

- because the mark describes the decoration on the goods or the shape of the goods, that is, chinaware decorated with daffodils or in the form of daffodils.

See also the section entitled SPECIFICATION RESTRICTIONS for guidance about the circumstances in which such objections can be overcome.

## **DEVICES: REPRESENTATIONS INDICATIVE OF THE GOODS/SERVICES**

Conventional representations of devices indicative of the goods concerned are devoid of any distinctive character and consequently not acceptable under section 3(1)(b) and (c). For example, devices of animals in respect of leather, skin or hides; devices of cows in respect of milk, butter, cheese and other dairy products; devices of trees in respect of timber. The same principles apply to service marks. For example, ordinary representations of motor cars would not be acceptable for car repair, car leasing or taxi services; a head for hairdressing; clothed figures for hire of clothing and a house for estate agencies.

While an ordinary representation of a cow would be objected to as being devoid of any distinctive character in respect of milk products the mark may be considered acceptable if the cow was shown in some fanciful manner such as dancing or laughing.

When considering services, devices of human figures performing or connected with a given service, especially if dressed in uniforms, are not acceptable unless shown in a stylised, cartoon or fanciful way. Consider objecting to, for example, the device of a plumber, or typist

for relevant services if the marks concerned do not incorporate other distinctive matter.  
Object under section 3(1)(b) and (c).

## **DISCLAIMERS AND LIMITATIONS (Wording of)**

It is clear from the wording of section 13 of the Act that the entry of a disclaimer or limitation is voluntary and may be made prior to, or post, registration. However, there are two conditions which must be met.

Firstly, the volunteered disclaimer or limitation must either disclaim any right to the exclusive use of a specified element of the trade mark, or it must limit the rights conferred by registration. The use of a limitation to add in elements of the trade mark that were absent at the outset is not a limitation of the rights conferred by registration, and is not therefore permissible. See [Nestle SA Trade Mark Application \[2004\]EWCA Civ 1008](#).

Secondly, the disclaimer or limitation should be worded in such a way as to make it tolerably clear to third parties what its effect is. Accordingly, whilst the registrar cannot and will not insist on standard wording for disclaimers and limitations, he has an inherent power to require clarification of the wording of a proposed disclaimer or limitation which leaves room for serious doubt as to the effect of the voluntary disclaimer or limitation of rights.

It is suggested that limitations take the form "The rights conferred by the registration of this mark are limited [description of limitation]."

And that disclaimers take the form "Registration of this mark shall give no right to the exclusive use of [description of element(s) of trade mark to be disclaimed]."

[\[SEE CLASSIFICATION CHAPTER, Paragraph 5.1.22, for further guidance\]](#)

## **DOMAIN NAMES (registrability of)**

A domain name is a written representation of an Internet electronic address, e.g. [www.ipo.gov.uk](http://www.ipo.gov.uk), which is the Office's web site address. It is common-place for goods and services to be sold in the UK under such a name, i.e. the domain name is being used as a trade name or trade mark, and the Registrar will, subject to the usual criteria of the Act, permit domain names to be registered as trade marks. Elements of the domain name such as ".com" or ".co.uk" are considered to be totally non-distinctive. As a general rule, one should consider whether the remainder of the mark is descriptive or non-distinctive; if so, there is likely to be an objection under section 3(1)(b) and or (c) of the Act.

There may be exceptions. For example TWIST AND SEAL would be liable to an objection for storage jars on the basis that it describes a characteristic of the goods, whereas the addition of ".COM" gives the sign as a whole a trade mark character.

For further guidance on domain names see BL O-008-07 In The Matter Of Application no. 2398973 By FSTC Ltd Foundation for Science Technology and Civilisation, for the mark [MuslimHeritage.com](http://MuslimHeritage.com)

Also the Decision of the Second Board of Appeal of 18 July 2006 Case R 338/2006-2, DNI Holdings, Ltd. for the mark [SPORTSBETTING.COM](http://SPORTSBETTING.COM)

## EVIDENCE OF DISTINCTIVENESS ACQUIRED THROUGH USE

The proviso to section 3(1) makes it clear that a trade mark which offends section 3(1)(b), (c) or (d) of the Act may still be registered if it can be shown that, by the date of application, the mark has in fact acquired a distinctive character as a result of the use made of it.

### 1 The Test

[In Windsurfing Chiemsee \(C108 & 109/97\)](#), the ECJ provided guidance as to the conditions which should result in a finding that a trade mark has acquired a distinctive character through use. The court found that:

*“If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.”*

### 2 Mark must have been used distinctively – as a trade mark

In the [Philips v Remington judgment, C-299/99](#), the ECJ found that the fact that an undertaking is the only known supplier of a kind of goods/services does not preclude a finding that a mark has acquired a distinctive character for the goods/services. However, the court pointed out that such a finding was only possible where reliable evidence shows that recognition of the mark as indicating the goods/services of one undertaking is as a result of its use as a trade mark.

According to the ECJ in [Societe des produits Nestle SA v Mars UK Ltd, Case C-353/03](#), this means “use of the mark for the purposes of the identification, by the relevant class of persons, of the product or services as originating from a given undertaking.” (See paragraph 29 of the judgment).

In principle, this applies whether or not the applicant is the only supplier of a kind of goods/services to the market. The significance of the monopoly in the product or service is that its effect may make it difficult to gauge whether the public has come to recognise the sign as a trade mark or whether they merely recognise the sign as characteristic of a particular kind of goods or services, and associate that kind of goods/services with the applicant because it is the only known (or the best known) supplier of goods/services of that kind.

Acquired distinctiveness cannot therefore be shown to exist *solely* by reference to general, abstract data such as pre-determined percentages of recognition by the relevant class of persons: *Windsurfing* and *Philips*. Instead the views of an average consumer must also be taken into account. Such a consumer is reasonably well informed, observant and circumspect. Such a consumer is unlikely to have come to recognise a sign as being one that identifies the trade source of the goods/services, unless the proprietor has educated the consumer to that perception.

The less plausible it appears on the face of things that consumers would take the mark in question as serving a trade mark function the more important it is to consider what, if anything, the proprietor has done to nurture the mark into a trade mark. Or to put it another way, the more descriptive or non-distinctive the mark appears, the more work the proprietor will have to put in to educate consumers that it is a trade mark. Where the mark has been used on a substantial scale as the sole or principal means of identifying the trade source of the goods it will often be quite easy to conclude from the context of the use that the public have been educated to see the mark as a trade mark.

### 3 Secondary trade marks

In [Societe des produits Nestle SA v Mars UK Ltd, Case C-353/03](#), the ECJ determined that a mark may acquire a distinctive character as a result of it being used as part of, or in conjunction with, another mark. There is therefore no requirement for a non-distinctive mark to have been used alone before it can be registered on the basis of acquired distinctiveness, but where such a mark is used alongside another distinctive sign the burden on the applicant to show that the non-distinctive mark has come to be seen as a secondary trade mark will be greater, as in the *British Sugar v Robertson case*, [1997] E.T.M.R. 118.

Where the evidence shows that the trade mark is used together with another distinctive trade mark it may still be possible to accept the application provided the evidence indicates that the sign applied for has been used as a secondary trade mark. Here is an example which does not show that the applied for mark has been used as a trade mark.

Mark Applied For:

**YORKSHIRE**

Mark Shown in Use in Evidence:

**HARDCASTLE'S YORKSHIRE  
BITTER**

**In this case the word “Yorkshire” is merely used as a description of the geographical origin of the goods (beer).**

Here is an example which does show the secondary mark in use as a trade mark:

Mark Applied For:

**LOVELY**

Mark Shown in Use in Evidence:

**SAUVAGE  
“Lovely”**

In this example the word “lovely” has been dressed up to have the appearance of a secondary brand. It is not just a question of relative size. The degree of descriptiveness is also important. Simply increasing the size of the word “perfume” would never turn it into a trade mark for those goods. In this case, the presentation presents the mark as a brand name for the product.

Non-traditional marks, particularly colours and the appearance of the goods or their packaging, often pose particular problems. Such marks are seldom used as the principal means of distinguishing the trade source of the goods or services.

Nevertheless, they are capable of being used as secondary trade marks. The key issue will usually be whether the proprietor has used the mark distinctively to educate the public that it is a trade mark. The most obvious way of educating the public that such a mark is a trade mark is for the proprietor to indicate this in its advertising by the use of statements such as “look for the one with the [blue] wrapper” or “you can rely on the [description of appearance of goods or packaging] to tell you it’s a [brand name]”.

In this connection, it should be noted that the use of small letters “tm” in relation to a mark with no trade mark character is more likely to make an impression on a lawyer than on an average consumer.

If there is evidence that the applicant applies the same styling feature to the shapes of a range of goods of the same kind, this may assist in educating the public that the feature has some trade mark significance. On the other hand, evidence that the undertaking produces a large number of similar kinds of products, all with different shapes, tends to point in the other direction.

One means of signifying the trade mark significance of colours is to use them as a livery, i.e. as a consistent colour scheme applied to a range of products of the same general kind so as to designate the trade source. The use of such liveries for buses, trains and vehicle service stations are good examples of such use in relation to services. On the other hand, evidence that an applicant uses a wide range of colour schemes in relation to goods or services of the same kind tends to point away from the trade mark significance of any one such colour scheme.

Where there is doubt as to whether the proprietor has done enough to educate the relevant public that at least one of the functions of the sign in question is to identify the product or services as those of a single undertaking, evidence that the relevant public has come to rely upon the sign in question for the purpose of distinguishing between goods/services of different undertakings may be sufficient to show that the sign is recognised as serving a trade mark function. The best evidence of reliance is that which shows that (and in what way) those making selection decisions between competing products or services have come to rely upon the sign in the course of the selection process. Evidence of mere abstract recognition of the sign is unlikely to assist if the doubt is not about the extent of the use of the sign, but rather whether it is used for the purpose of identifying the goods or services of one particular undertaking.

#### **4 Evidence - Pure colour marks**

Evidence filed to support a claim of factual distinctiveness for a mark consisting of colour as such will need to be very persuasive. It will clearly need to demonstrate that the mark alone (whether or not it has actually been used alone) would serve to designate the goods or services of one particular undertaking to the relevant consumer. There is more likelihood of establishing factual distinctiveness where the goods or services are very restricted and the relevant market very specific. Deciding whether a single colour is distinctive raises complex issues and examiners should consult with an evidence specialist before finally accepting or refusing applications for single colour marks.

## 5 Use of the Mark as Part of another Trade Mark

In the light of the CJEU's judgment in [Societe des produits Nestle SA v Mars UK Ltd Case C-353/03](#), it is clear that, as a matter of law, there is no bar on a mark acquiring a distinctive character as a result of its use as part of another trade mark. Word marks are often used with device marks but that does not mean that the consumer could not regard the word (or device) element as having an independent distinctive role within the composite mark. The question is whether the mark applied for, if used alone, would distinguish the goods/services listed in the application in the perception of a relevant average consumer. Where the use relied upon by the applicant is likely to be perceived by relevant consumers as use of the mark only as part of another mark, establishing a claim of acquired distinctiveness for the part alone is likely to be much more difficult.

For example, use of the mark on the right below could not be perceived as simply use of the trade mark "Quality". Therefore use of the mark on the right ought not to result in the inference being drawn that the word "Quality" as such has become distinctive of the applicant. It will be for the applicant to establish through evidence that the result of the use of the mark on the right is that the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for (on the left), as originating from a given undertaking.

QUALITY



Small differences between the mark applied for and the mark which has been used, which do not alter the distinctive character of the mark, may be ignored. For example, the use of the mark below should be considered as use of the word PREMIER as such.



## 6 Examination of Evidence - Gauging the extent and effect of trade mark use

Having established that the mark has been used as a trade mark (including use as a secondary trade mark or playing an independently distinctive role in a composite mark) the next thing is to assess the *extent* and *effect* of the use. The ECJ provided guidance on the relevant factors in the *Windsurfing* case (see above).

The court stated that:

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account:

- a) the market share held by the mark;
- b) how intensive, geographically widespread and long-standing use of the mark has been;
- c) the amount invested by the undertaking in promoting the mark;
- d) the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking;
- e) statements from chambers of commerce and industry or other trade and professional associations”.

## 7 Market share

It is necessary to have some idea of the market share held by the applicant under the mark applied for. For example, several hundreds of thousands of pounds per annum in the dairy produce sector will be a tiny proportion of the market and it is unlikely that such turnover will have educated a significant proportion of the relevant public to perceive the mark as a trade mark. On the other hand, this level of use on an established specialist publication may well have reached a significant proportion of the relevant public for the product.

## 8 Turnover and Period of Use

Evidence normally includes the date use first commenced and **must** relate to use before the date of filing. Any use after that date should not be taken into account. If there have been gaps in the use, it will be necessary to consider how this affects the reputation of the mark applied for. For example, a strawberry grower may not be able to demonstrate sales throughout the year, but if he sells his strawberries for two months of the year every year for ten years, that is likely to be sufficient to illustrate continuous use, given the seasonal nature of his product. Another trader might sell goods under a certain mark for twelve years, but there may be a two year gap leading up to the date of the application in which few or no sales took place. Before a judgement can be made about accepting or refusing the mark, it would be necessary to look at all the surrounding facts to see what effect that gap had. If sales weren't particularly strong beforehand, the reputation of the mark may have been

severely diminished. If, on the other hand, sales were very good both before and after any gap, it may be that the gap would have no negative effects on the reputation at all.

Turnover figures should normally be given for the sales of goods/services under the mark over a period of about five years before the date of application. If the period of use is shorter, figures for the period in question should be given.

The greater the turnover, the more likely it is for the mark to be accepted. Turnover, advertising and period of use are considered together - massive turnover and/or advertising could compensate for a short period of use.

Ideally, the turnover figures should be broken down to give the turnover relating to each class of goods/services. However, industry does not group its products according to the WIPO system of classification, so this may not be a practical proposition. There should however be sufficient breakdown of the goods/services to support a finding that the relevant public has been repeatedly exposed to the mark in use as a trade mark for all the goods/services for which acceptance is proposed.

In the case of financial services, turnover figures may not always be the appropriate means to gauge the extent of use of the trade mark. For example, turnover figures which are merely the total amount loaned or insured by the applicant will give an inflated picture in relation to how well-known the mark is in terms of exposure to the relevant public. However, a clear indication of the extent of use is required if the applicant is relying on this to demonstrate that the mark has acquired a distinctive character. In the case of financial services the number of account holders or investors and, if appropriate, the number and geographical spread of branches, could be used to demonstrate the extent of the use.

## **9 Area of use**

Within the UK: a list of the areas of sale is normally included within the declaration. Sometimes no specific areas are given and phrases like "throughout the UK" or "in England and Wales" are used instead.

In [\*Bovemij Verzekeringen NV v Benelux Merkenbureau, Case C-108/05\*](#), the ECJ held that in order for a trade mark to be registered on the basis of acquired distinctiveness, "only if it is proven that that trade mark has acquired distinctive character through use throughout the territory of a member state." Accordingly, it is not possible to register a trade mark on the basis of distinctiveness acquired on a local or regional basis. The ECJ's judgments are binding and conclusively determine the meaning of those provisions of national law that give effect to the Trade Marks Directive. Consequently, national procedural provisions, such as the entry of geographical limitations under section 13 of the Act, do not allow the Examining Authority in the UK to interpret the proviso to section 3(1) in a way that permits registration in circumstances that are incompatible with the *Bovemij* judgment. Accordingly, other than in the circumstance described below, it will not be possible to register a trade mark on the basis of acquired distinctiveness within an area of the UK, even with an associated geographical limitation of rights. So, for example, it will not be sufficient to prove that a mark consisting of English words which describe a characteristic of the goods or services has acquired a distinctive character in Scotland alone.

The *Bovemij* judgment also considered the position where the trade mark is a word in a language which is only spoken and understood in a part of the member state. In these circumstances the ECJ decided that it is sufficient to prove that the mark has acquired a distinctive character in the relevant linguistic area. For example, a Welsh word which describes the goods applied for may be registered if it is shown that it has acquired a distinctive character to a substantial proportion of the Welsh speaking population in Wales.

It should be borne in mind that the requirement for use throughout the territory of the member state includes use in advertising. Accordingly, it is not necessary to show that sales have occurred throughout the member state if the mark has acquired a distinctive character on a UK wide basis through national advertising.

Furthermore, the court's judgment cannot have been intended to have the effect of preventing the registration of a trade mark which has become factually distinctive to a significant proportion of the relevant UK public simply because there is a small discrete areas of the UK in which the mark has not become distinctive. Accordingly, failure to show that a trade mark has become distinctive in (say) the Isle of Man will not prevent a national registration on the basis of acquired distinctiveness.

**For export:** occasionally, turnover figures also include goods for export. These figures may also be taken into account when considering the strength of the evidence. If turnover relates to goods manufactured in this country which are **only** for export, the evidence will not be sufficient to demonstrate that the mark has acquired a distinctive character amongst a significant proportion of the relevant UK public.

**Outside the UK:** if the only use of the mark is outside the UK, the mark cannot be accepted. Section 3(1) requires the mark in question to be factually distinctive in the relevant markets in the UK.

## 10 Advertising expenditure

Advertising figures are normally provided for three or more years prior to filing. The nature of the advertising should be given where possible e.g. television, radio, newspapers, trade magazines, etc. This usually shows whether the advertising was nationwide or restricted to local areas. The figures should be broken down to show costs in relation to each class of goods/services *where this is feasible*.

The importance to be attached to advertising figures will very much depend on the goods/services at issue. An aircraft manufacturer, for example, will spend vast amounts of money assessing the market for a new aircraft, developing this market and advertising their intended product. Such costs may run to hundreds of thousands of pounds, or even millions, and may indicate that the company has established the mark before even one aircraft is sold. In such a case, the advertising expenditure might be sufficient for the mark to proceed without any sales being made. On the other hand, there may be little or no advertising expenditure for a highly specialised product with a small market. A company producing technical valves may inform existing clients of their updated product through a catalogue which is already sent out regularly. It may then be impossible for that company to attribute

specific costs to the marketing of one particular product among hundreds in their catalogue. It is therefore important to assess the circumstances of each case when considering the importance of the advertising expenditure in gauging the reputation under the mark.

## **11 Exhibits**

These are required to show how the mark has been used and in relation to which goods / services. They may be, for example, brochures, catalogues, price lists, advertisements, etc. Exhibits should be dated prior to the date of application.

## **12 Evaluating the effect of the use of the trade mark**

### **12.1 Through the eyes and ears of the average consumer**

If the goods are consumer goods/services then it will be the general public who are relevant. This will not be the case for specialist goods/services where the average consumer may be in a trade and is likely to have a higher level of attention when discerning between suppliers.

### **12.2 Nature of goods/services & market**

The cost of the items should be considered in the context of the turnover figures. Are they expensive, specialised goods or cheap everyday items? The wider the market the more traders will be in it. Consequently, it will be harder for a trade mark to acquire a distinctive character for common inexpensive goods/services than would be the case with an equivalent scale of use on expensive, specialised goods/services sold in a small market.

### **12.3 Goods/services claimed**

The specification of goods/services should normally reflect the goods/services shown in the exhibits to the applicant's declaration, *affidavit* or witness statement, and not the more general claims often used in the latter.

However, a wider specification of goods/services may be allowed where:

1. the *prima facie* objections do not apply to the goods/services not shown in the evidence;

or

2. the exhibits show use on a range of goods or services (e.g. "Pencils, pens, rulers, wallcharts, staples, ink, deskpads") within the general term applied for (e.g. "Stationery").

Where use is shown on a specific item only (e.g. "magazines") the specification should reflect that item rather than the general term ("printed matter", which includes books). It is possible for wholly descriptive terms to become trade marks for magazines because magazine titles also double as trade marks, but it is more difficult for such terms to become trade marks for books on the subject described by the mark.

### 13 Retail Services, examination of evidence

One of the reasons the registrar changed his practice in this area is because he was persuaded that there was real doubt about whether retailers without "own brand" goods could properly register their marks for any goods and/or services. As a consequence of that decision, the question has arisen whether use of a mark as a retail name can be regarded as use in relation to goods.

Section 10(4)(b) of the 1994 Act states:

*"(4) For the purposes of this section a person uses a sign if, in particular, he –*

*(b) offers or exposes his goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;"*

It can be argued from this that use by another trader that counts as infringement must, if undertaken by the proprietor of the trade mark, similarly be regarded as use of the mark in relation to the goods.

However, in the *Crate & Barrel* case, *Euromarket Designs Inc v Peters and Crate & Barrel Ltd* [2001] FSR, Mr Justice Jacob [as he then was] said, that the definition of "use" under the Act may be different for different purposes. In particular he said,

*"If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but I doubt whether the reader would regard the use of the shop name as really being "in relation" to the goods. I think that this is an issue worthy of trial itself."*

*"In this connection it should be borne in mind that the Directive does not include an all-bracing definition of "use", still less of "use in relation to goods". There is a list of what inter alia may be specified as infringement (Article 5(3) corresponding to Section 10(4)) and a different list of what may, inter alia, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2) equivalent to Section 46(2)). It may well be that the concept of "use in relation to the goods" is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled "Boots", only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too."*

It appears that use of a shop name can be use in relation to the goods, if it distinguishes the goods of one undertaking from those of another. However, if goods are sold under the mark of another party, and are also available at other retailers, it is difficult to see how the use of the shop name serves a trade mark function for the goods. On the other hand if the goods do not carry another party's trade mark, the use of a shop name may be perceived as use of the retail name in relation to the goods, for example the name of a "fruit and vegetable" shop.

As a rule of thumb therefore, the answer to the question "can use of a mark as a retail name be regarded as use in relation to the goods", will usually be "no" where the goods carry a trade mark of another party. However, every case must be considered on its own facts.

The position of specialist retailers may be difficult to assess, particularly where the producer's mark is not prominently applied to the goods. In such cases the average consumer may well perceive the specialist retailer as having more than just the usual retail relationship with the goods.

This does not mean that only manufacturers can register marks for goods. The party whose name is used in relation to the goods may be a manufacturer or a producer, who has the goods made for him, or a retailer selling his own goods. The registrar will not seek to look behind applications from retailers seeking registration of their marks for goods. However, retailers will not be able to register their marks for goods on the basis of distinctiveness acquired through use, if all they can show is use in relation to a service in Class 35.

#### **14 Domain Names - Examination of evidence of distinctiveness**

If the sign is not distinctive the applicant may submit evidence of factual distinctiveness. If such evidence shows goods or services being offered for sale under the sign it is likely to constitute trade mark use, and may (subject to the usual considerations) be sufficient to show that the sign has acquired a distinctive character as a trade mark.

Use of a domain name will not assist unless the evidence shows that the relevant goods/services have been offered for sale under the domain name. Prominent use of the domain name (or at least the distinctive element(s) of it) on web pages offering goods or services for sale may constitute trade mark use, but each case should be considered on its own merits taking account of the way that the domain name has been used.

#### **15 Examination of Evidence of Use - Conclusion**

An accurate analysis of the nature of the use of the mark followed by a careful evaluation of the extent of the use prior to the date of the application will, in virtually all cases, allow the registrar to reach a reliable finding on whether, and for which goods / services, the mark has acquired a distinctive character because of the use made of it. However, in a few cases doubt may remain either about the nature of the use (whether the mark has been used and perceived as a trade mark) or about the extent and effect of the use (the extent of the reputation acquired under the trade mark).

## **EVIDENCE FROM THE TRADE OR FROM A SURVEY**

Applicants sometimes submit evidence from others in the same trade attesting to the distinctive character of the trade mark. These statements may come from chambers of commerce or other trade and professional associations, but often they come from other individual traders in the same field. Such evidence may assist where there is doubt about the

whether the trade mark has been used to a sufficient extent in the market place so as to have acquired a distinctive character in the eyes of a significant proportion of the relevant class of consumers.

Trade evidence may also assist where the goods or services are highly specialised and the trade comprises some or all of the customers for the goods/services concerned.

Trade evidence of this type is less likely to assist where the doubt is not about the extent of the use of the mark, but whether the nature of the use is such as to have educated an average consumer to regard the mark as an indication of the trade source of the goods / services. Where trade evidence is intended to fulfil this function, it will probably only be of assistance where it comes from traders with direct contact with ordinary consumers of the goods/services, who can give evidence of consumers reaction to, and reliance upon, the mark in question **in the course of trade**.

In nearly all cases the answers to the questions “how non-distinctive is the mark?”, “Do the exhibits overall show use that the average consumer is likely to perceive as use of the sign to indicate the trade source of the goods/services?” and “Is the use shown indicative of a substantial business under the mark?” will determine whether the case for acquired distinctiveness succeeds or fails. A public survey will usually be superfluous, seldom adding anything of materiality.

Very rarely, survey evidence may show that (contrary to what might be expected from the primary facts) a significant proportion of the relevant consumers do in fact look upon the applicant’s mark as serving a trade mark function. A survey is only likely to be of assistance if it is conducted in accordance with the guidance set out below, and is directed to a matter in respect of which there is room for doubt.

## **1 Requesting trade or survey evidence**

Examiners and hearing officers should avoid giving the impression that they are *requiring or requesting* evidence in support of trade mark applications.

In letters, the registrar will instead aim to say what needs to be proved. He will leave the applicant or his representative to decide what kind of evidence might prove it. The usual formula is to put it like this "In the absence of evidence that [e g the relevant public perceive the mark as designating trade source] the objection is maintained". This is not to say that the registrar will not give an opinion as to the kind of evidence which might assist an application. We will give an opinion if we are asked for it. But we will make it clear that all evidence is considered on its merits.

**We cannot commit ourselves before the evidence has even been considered.**

## **2 Sworn Statements and Others – Weight**

More weight should be attached to sworn statements than to unsworn statements. The more apparently objectionable the application is, the more important it will be for at least some of the survey or trade statements to be sworn. However, evidence in the form of a witness

statement is acceptable and the registrar will also take account of unsworn exhibits, e.g. letters, which have been submitted alongside, and in support of more formal evidence.

### **3 Statements from the Trade**

Where the person making the statement is a representative of a trade association or the editor of a trade journal this evidence may be considered at face value. In other cases it should be disclosed how the parties were selected. Such evidence normally includes:

- the status of the person within the trade or service industry (this will assist in estimating the weight to be given to the trade evidence);
- that the person concerned either has no relationship with the applicant, or details of what the relationship is;
- the specific goods/services that the witness knows are traded in under the mark;
- how long the witness has known of the mark (this must be prior to the application date otherwise it is of no assistance);
- whether the person concerned regards the mark as indicating goods/services originating from a single source, i.e. the applicant;

This evidence may also include:

- a statement that the person concerned would regard use of the sign by other traders as likely to cause confusion, and why;
- any first hand experience the witness has about consumers' reaction to, and reliance upon, the mark in question **in the course of trade**.

Evidence from any party under the control of the applicant, or in respect of whom the applicant is likely to be able to apply commercial pressure to for supporting statements, should be given little weight. Examples of this may be those who manufacture, distribute or provide the goods or services on the applicant's behalf (other than independent retailers), or those with a vested interest in securing registration, such as a licensee.

### **4 Trade Experts seeking to speak for the public**

Where the goods or services are not specialised, the fact that trade experts (who by definition, are likely to be much more familiar than the general public with the signs used in the trade) regard the applicant's sign as a trade mark may not be representative of the public at large. However, such evidence may still assist an application to the extent that it establishes that the applicant's mark is unique in the trade. Further, if the applicant has provided evidence from traders with direct contact with relevant consumers, appropriate weight should be attached to any direct experience they can provide of consumers reacting to the mark as a trade mark and relying upon that mark **in the course of trade**.

## 5 Survey evidence

Where the applicant submits responses to questionnaires filed as a result of a survey (whether of the general public or of the trade), the following guidelines should be considered:

- it should be stated how the interviewees have been selected (the survey will carry more weight if they have been selected so as to represent a cross section of the relevant public or trade);
- the 'relevant public' is comprised of actual or potential customers of the **kind** of goods / services in respect of which registration is sought - it is not appropriate to restrict the survey only to the class of persons who might purchase the applicant's goods/services;
- the number of persons issued with questionnaires or otherwise invited to take part in the survey should be disclosed;
- the total of those responding should be disclosed and should equal those responses submitted to the Registrar;
- the name of the applicant should not be disclosed in the questionnaire or in the covering letter;
- a representation of the sign(s) (if any) shown to interviewees should be included;
- the exact answers should be disclosed by providing copies of the actual response sheets;
- where the survey is conducted by professional interviewers, the place where the survey was conducted should be disclosed, together with the exact instructions given to interviewers, including any coding instructions if the results were recorded on a computer.

## 6 The Questions

Questions must not be leading. For example, if the question to be answered is "is the sign regarded as the applicant's trade mark" the questionnaire should not indicate that the sign is a trade mark but use more open questions such as "What, if anything, does the sign on this picture signify to you?" It is legitimate to probe those that directly or indirectly mention the applicant in order to test the nature of any association using questions like "what would your reaction be if I told you that this is not a product of [the applicant]?"

Questions must not lead the participant into a field of artificial speculation that he or she would not have entered into in a normal shopping experience. Accordingly, the answers to questions such as "can you think of a company who might make this?" are unlikely to be helpful. Nor are questions which invite the participants to say who they 'associate' the sign with. Evidence of superficial "association" with an undertaking may simply reflect that it is the best known user of that type of sign, which may still not be sufficiently concrete to constitute a trade mark connection (*DUALIT* [1999] RPC 890).

## 7 Control Sample

It will often be helpful to include one or more other marks (fictitious or third party) in the survey to act as a control sample. This can assist in isolating recognition resulting simply from guesswork from more concrete identification.

## **8 Verbatim Answers**

Particular care is required where the applicant has been the only or best known (perhaps first) supplier of a category of goods/services to the market and the association is the result of the applicant's monopoly in the goods/services rather than because of use of the sign in question as a trade mark. In this sort of case the views of the average consumer who is reasonably well informed etc must be established. The "headline" results from a survey will not do this, although the verbatim answers to the questions may assist.

## **9 Timing of Survey**

Care is needed because a survey will most likely be conducted after the date of application. If the mark has had a long period of use before the date of application, and the survey is conducted reasonably soon after the material date, the perception of the average consumer will probably not differ greatly during that time. However, if the mark has not had much use before application and/or there is much more use and publicity etc after the material date, this could negate the value of a public survey: the public's perception of the mark will be as a result of education post-application date.

## **10 Surveys which do not meet the requirements**

Failure to comply with these requirements does not necessarily mean that the evidence should be given no weight, (although it may do if the defects suggest that the survey has not been conducted fairly). However, it will mean that reduced weight should be given to the outcome of the survey.

In cases where there is big doubt about whether a sign is a distinctive trade mark, it will be particularly important that any survey evidence is valid before it can form the basis for accepting the application. Where the case for acceptance is otherwise more debateable, a technically defective survey may still carry enough weight to justify acceptance, provided that it has been conducted honestly and the defects do not appear to seriously undermine the result.

## **EVIDENCE AND EXHIBITS (when used in connection with statements of grounds)**

Hearing officers, when researching and writing statements of grounds, may sometimes come across information and/or exhibits which they wish to use in relation to their decision. Care needs to be exercised in the use of such material, in the light of comments in the DUNKERS trade mark case (unreported).

Any such material used in support of a statement of grounds must be placed before the applicant and the applicant must be given the opportunity to comment on it (including the right to be heard) before such material may be relied upon in a statement of grounds.

The alternative is for the registrar to seek leave to introduce additional evidence on appeal (which is only likely to be allowed - if at all - in compelling circumstances).

## FAMOUS NAMES

Where a famous name is concerned (and where the reputation does not stem from a trade in the goods/services applied for) it is possible that, when used in relation to certain goods / services, the name may appear to the average consumer as an indication that the goods / services are *about* the person whose name it is rather than as an indication that the goods / services are supplied by, or under the control of, one undertaking.

The Court of Appeal decided that '*Elvis Presley*' was not registrable under the 1938 Act for memorabilia products in Class 3: see [1997] RPC 543.

In the case of [Arsenal v Reed \[2002\]EWHC2695\(Ch\)](#), Laddie J. held that the trade mark ARSENAL was validly registered under the 1994 Act, even though it could and had been used by others in a non-trade mark sense. He concluded that this did not automatically make the trade mark ARSENAL non-distinctive for scarves etc. Although Arsenal is the name of a famous football club rather than the name of an individual or group, a similar point arises; namely, whether the name of a person or organisation which others wish to use in order to demonstrate their support/allegiance should be registrable as a trade mark for relevant goods. The decision in the ARSENAL case indicates that such protection should not be automatically refused or invalidated in these circumstances.

Accordingly, the correct approach appears to be to consider whether the famous name put forward for registration is so descriptive in relation to the goods/services for which registration is sought that it could not be perceived by consumers as anything more than a description of the subject matter of the goods/services. The following paragraphs are directed at the main areas of uncertainty.

### 1 Media

The names of famous persons or groups may serve as trade marks for printed publications, recorded sounds, films, videos, TV programs, musical or live performances etc as use of the mark on such goods or services would be likely to imply some form of control of, or guarantee from, the holder. Consequently, there will not usually be an objection to the registration of a famous name for these goods.

### 2 Mere Image Carriers

The name of a famous person or group is likely to be perceived as merely descriptive of the subject matter of posters, photographs, transfers and figurines. Names of famous persons or

groups are therefore unlikely to be accepted by consumers as trade marks for these goods because they will usually be seen as mere descriptions of the subject matter of the product. Objections will arise under section 3(1)(b) & (c) of the Act.

### **3 Badges of Allegiance**

The name of a famous person or group may serve to identify the trade source of badges of allegiance (including T-shirts, mugs, scarves etc) even if the possibility of other traders producing unofficial merchandise cannot be ruled out. Consequently, such marks will normally be accepted for such goods unless there is a particular reason to believe that the mark in question cannot fulfil the function of a trade mark, for example, the names of some members of the Royal Family may be incapable of performing a trade mark function for such goods because of the widespread historical trade in Royal souvenirs.

### **4 Names of Deceased Famous Individuals or Defunct Groups**

In these circumstances the name is more likely to be seen by consumers as merely an historical reference to the subject matter of the goods or services, rather than to the trade source of the goods. However, each such case must be judged on its own facts taking account of the length of time that has passed since the person concerned died, or the group became defunct, and the relationship (if any) between the goods/services in the application and those associated with the dead person or defunct group. A PEO will be involved in each case.

### **5 Pictures of Famous Persons (living and deceased) and Groups**

Pictures of famous persons/groups present similar issues to famous names. However, depending upon the goods, they may be more likely (compared to a name) to be taken as mere decoration and therefore to lack a trade mark character. Each case will be judged on its own merits and a Hearing Officer will be involved in each case.

### **6 Section 3(6) – Bad Faith**

Where third parties apply to register the name of a famous individual or a recently deceased famous individual an objection under section 3(6) of the Act may be appropriate. However, this will depend upon whether the application covers goods and/or services with which the famous individual is associated. For example, an application to register the name of a famous fashion model for “clothing” or “cosmetics” would be liable to an objection because it is an obvious attempt to take unfair advantage of the person’s reputation. Conversely, an application to register a name [which corresponded to that] of a famous fashion model for “agricultural machinery” would not, *prima facie*, be liable to a bad faith objection. However, the application may still be successfully opposed, under section 5(4)(a) of the Act, if it can be proven that use of the mark could be restrained under the law of passing off. Care should however be taken where the reputation of a famous individual is not commercial. For example Tony Blair, whose fame stems from politics, should not be accepted for any goods/services without his consent.

Applications to register the names of famous musical groups will not normally at the examination stage face an objection. This is because to firmly establish who are the rightful owners of the names of musical groups often requires evidence and is therefore best left to be determined in opposition proceedings.

Bad faith objections can be overcome if permission to the registration of the mark is obtained from the individual or his/her legal representative.

## **FAMOUS BUILDINGS (Pictorial representations or names of well known buildings)**

We have previously had doubts about the distinctiveness of such marks for films, videos, printed matter and photographs falling within classes 9 and 16 and also for tourist services within classes 39 and 43.

It is felt that this practice does not go far enough as traders in the area of a famous building, which is likely to be a tourist attraction, should be free to produce mementos and ornaments bearing the name or representation of the building without infringing the rights of another.

In future an objection should be taken under Section 3(1)(b) for the goods mentioned above and also goods which could be seen as mementos. This applies to goods such as ornaments, ashtrays, confectionery, biscuits, key rings, t-shirts. This list is not exhaustive and consultation with a PEO is recommended.

Consideration has to be given to the type of building. If the building is a tourist attraction then the objection should be raised, but those buildings which are famous but are unlikely to be the subject of mementos and ornaments should not be objected to e.g. Pentonville prison is a famous building but it is unlikely that anyone would want to produce memorabilia with the name Pentonville on it.

It will not be necessary to raise a 3(6) objection.

## **FAMOUS FICTIONAL CHARACTERS/STORIES (Names or representations of well known fictional stories/characters)**

### **1 Names of well known fictional stories or characters**

The names of fictional characters/stories may be accepted *prima facie* for any goods / services *provided that they are likely to be taken as a sign indicating the goods/services of one trader*. See the *Tarzan* case 1970 RPC 450 for useful guidance.

If the name in question is **both long established and well known** it may have passed into the language. In that case its primary signification is likely to be viewed as the name of the story/character concerned. In such instances, the name should be regarded as a sign which

may serve in trade to designate a characteristic of goods/services featuring the story / character concerned and objection should be raised under sections 3(1)(b) & (c) of the Act.

If it appears that other traders had become accustomed to using the name in trade without the applicant's consent (e.g. in relation to printed matter or films) prior to the date of application, the examiner should also raise an objection under section 3(1)(d) of the Act on the ground that the mark has become customary in the bona fide and established language of the trade.

For example, SHERLOCK HOLMES is a name that has been used by many traders over the years in order to describe a story and a character that appears therein. No one these days would expect all material bearing this name to originate from Conan Doyle or his estate. In these circumstances the name of the character is devoid of any distinctive character and descriptive of books, films etc featuring that character. In other cases, such as SPIDERMAN, where the name appears to have been used by one party as a trade mark for magazines, the name may be capable of identifying the goods of one trader notwithstanding that it is also the name of a well known fictional character. The question of who coined the name is not decisive if it has subsequently come to be seen *purely* as the name of a character/story. Similarly, the question of whether the applicant has copyright or some other exclusive right to publish the printed material commonly associated with the title/character concerned is not of itself decisive. The question is whether the sign is likely to be taken as a badge of origin.

Where it appears that the fictional name applied for is unable to distinguish the goods / services of one trader the application is likely to face objections under section 3(1)(b) & (c) of the Act. Depending upon the nature of the mark in question, this objection may be taken in respect of printed matter; posters; photographs; figurines; films; videos; TV programs; organisation of plays and shows; toys, badges and fancy dress costumes (this is not an exhaustive list).

Further, the use of well known and long established (particularly children's) fictional characters, such as CINDERELLA, on goods such as personal cleaning products (soap, bubble bath), clothing, mugs, tooth brushes, jewellery, etc, may be seen as *purely* for the purpose of attracting potential customers, rather than trade mark use. Accordingly, marks such as CINDERELLA are open to objection under section 3(1)(b)& (c) of the Act in respect of these goods also.

In deciding whether a fictional character is 'well known and long established' to the extent that it has entered the language, care should be taken to avoid taking into account the applicant's own efforts to promote the name after the date of application. On the other hand, if the name in question had entered the language prior to the date of application, subsequent concerted promotional activity by the applicant should not benefit the applicant even if it has brought about a temporary high level of association with the applicant.

## **2 Representations of well known fictional characters**

Similar considerations apply to representations of well known fictional characters. However, it should be borne in mind that (unlike with a name) there are many ways of depicting the

same character and a representation of even a widely used fictional character may be acceptable if it has distinctive stylisation.

## FAMOUS PAINTINGS (Representations of)

If a sign contains a representation of a famous painting it is **not** necessary to object under section 3(3). Objections based on copyright should normally be left to opposition.

## FLAGS (UK National Flags)

Section 4(2) of the Act states:

*"A trade mark which consists of or contains a representation of -  
(a) the national flag of the United Kingdom (commonly known as the Union Jack), or  
(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,  
shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive. Provision may be made by rules identifying the flags to which paragraph (b) applies."*

There are no specific provisions in the rules to which the latter paragraph refers. The inclusion of this clause is an enabling provision for future use, if required. Marks incorporating such flags **may** be objected to if the flag element can be regarded as a "representation" of the flag in question.

There are no automatic grounds for refusing marks which contain a UK national flag. Section 4(2) of the 1994 Act states that marks which consist of or contain a representation of the U.K. national flag shall not be registered **if it appears that the use of the mark would be misleading or grossly offensive.**

Marks which consist only of a representation of a UK national flag will attract objection under section 3(1) (b) of the Act, on the grounds that such marks are non distinctive. Furthermore, objections under section 3(3) and 4(2) of the Act may be appropriate if the mark is judged to be misleading or deceptive.

Marks consisting of a UK national flag with other features have to be considered in their totality, and may meet the requirements of section 3(1). Objections under sections 3(3) and 4(2) of the Act may be appropriate if the mark is misleading or grossly offensive.

A mark incorporating a UK national flag could be misleading if it:-

- a) Suggests goods are made in the U.K. when they are not; or
- b) Suggests that the applicants have official endorsement when they do not.

The mark should be considered in relation to the goods applied for. Many people will be influenced to purchase goods or services simply because they appear to be British in origin.

Objection under section 3(3)(b) should therefore be taken unless the specification of goods or services is specific on this point. Similarly, unless the goods or services are of such a nature that there is unlikely to be any prospect of official endorsement e.g. matches, cigarettes, motor cars, an objection under section 4(2) is appropriate.

### **Stylised representations of UK national flags**

Stylised representations of UK national flags are considered acceptable, *prima facie*, and are not open to objection under section 3(1)(b) and (c).

for example:



Stylised representations forming part of an overall distinctive mark may be accepted *prima facie* under section 3(1)(b) and (c), but they may be open to objection under section 3(3)(b) and 4(2) if their use would be deceptive as to the origin of the goods/services.

## **FOREIGN CHARACTERS (e.g. Chinese or Japanese )**

Characters in a foreign script such as Chinese, Japanese, Arabic, will usually be acceptable and give distinctiveness to a sign. Even if the words translate as something descriptive for the goods/services, this will not be recognised by the average UK consumer. Conversely, if the goods/services are, by their very nature, aimed at the relevant ethnic group, such descriptive marks will not be acceptable as they will be recognised by that consumer. In this connection, it is important to bear in mind that such terms are often included in general terms used in specifications. For example the Arabic characters for 'yashmak' would clearly be descriptive for 'yashmaks', goods which would be covered by a general term such as 'outer clothing' in Class 25. In these circumstances it will be necessary for the general term appearing in the specification to be amended or restricted so as to make it clear that the registration does not cover goods or services for which the mark will be perceived as descriptive by the relevant consumer

## **FORESEEABILITY**

The wording of section 3(1)(c) of the Act states:

*“(1) The following shall not be registered –  
(c) trade marks which consist 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 services, or other characteristics of goods, or services.” (emphasis added)*

In [Doublemint, C-191/01 P](#), the European Court of Justice said that it is not necessary that a sign is actually in descriptive use at the time of application but that it is sufficient that the sign **could** be used descriptively (paragraph 32).

The presence of the word “may” indicates that an assessment of descriptiveness is not confined to what is already in common usage at the relevant date: this is the focus of section 3(1)(d). The word “may” should be construed as meaning “reasonably likely to” come into descriptive use in the foreseeable future.

## **1 New products**

The issue of foreseeability will be particularly relevant when examination of an application suggests that the mark applied for may become the accepted description of a new type of product or service. The applicant may, for example, be the first to use or invent a product and have coined a term as a brand which may, or may not, be something by which the product will become known. Similarly, in relation to shapes of new products, account should be taken not only of shapes which are already the “norm” for the relevant sector, but also of which shapes are likely to become the normal shape of the product: “the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character.” ([Proctor and Gamble, ECJ Joined Cases C-468/01 P to 472/01 P](#)). For example, frozen potato chips which were cooked in domestic ovens instead of deep fat fryers were, at one time, a new product. The manufacturer branded them “Oven Chips”, but although they were the first to coin the term, the term was an apt description and it was reasonable to assume that it would become the natural description in trade for that category of goods. Conversely, the inventor of a revolutionary new type of temporary plastic mesh fencing also invented a trade mark to brand the new product. The mark was inspired by the names of the inventor’s children, Catherine and Nicholas, *Catnic*. It would be unreasonable to assume that this mark would be the natural description of the goods because it is an invented word and is distinctive. Unless allowed by the proprietor to pass into generic usage, it would be unreasonable to assume that it would be used by others, as a description, in the natural course of trade. Thorough research will be prudent particularly in fast-changing fields such as technology and scientific research, where the consultation of patent examiners and/or trade bodies may yield results which the Internet may not.

## **2 Relevant dates**

The “relevant date” is the date of application but

- a) with regard to section 3(1)(c), it is appropriate to consider what was reasonably foreseeable at that date and
- b) the fact that the mark has not been used by third parties by the relevant date does not automatically mean that it has distinctive character.

## **3 Foreign descriptive use: interpretation of the Internet**

During examination of an application, Internet referencing may reveal that the mark applied for appears to be used as a term of art in the relevant category of goods or services outside

of the UK. Whether an objection under section 3(1)(c) is appropriate will depend on a number of considerations; some are listed below, but not exhaustively.

Does the mark consist of a word which is recognised either by the relevant trade, or by relevant consumers, as being one used outside the UK to describe the product or its characteristics?

If the mark is known to those who trade in the product as being a word which is used as a description of the product elsewhere, it may not be registrable in the UK. English words used in the USA in the technological field are usually known to those who trade in the products in the UK, even if the product has not yet reached the UK market.

Is the product in a category of goods and services that might be regarded as the “latest craze”?

Similarly, knowledge of a new craze sweeping the US may travel to the UK with its US description, even if the applicant for the UK trade mark is the first to use it in the UK. For example, hooded sweatshirts and fleeces are not new clothing items in the UK, but when they became popular as the “hoody” in the US, they quickly became known on both sides of the Atlantic by that name. The names of new sports and newly popular foreign plants, foods and drinks frequently reach the UK (particularly the UK trade) before the goods or services themselves become widely available.

If we already have the product, do we have a different descriptive name for it?

If we have a name for a product or service, commercial tradition indicates that the name already in existence in the UK will endure as the accepted descriptive term. In this scenario, the overseas term will be more likely to operate as a trade mark in the UK. For example, Internet referencing on the mark “MARBLECRETE” uncovered generic use as the US version of ‘pebbledash’; however, because the UK generic description “pebbledash” has existed for so long, it is unlikely that UK traders in these goods, or UK consumers, will switch to using the US term descriptively. The mark was therefore accepted as differing from the usual way of designating the goods in the UK, both at the date of application and in the reasonably foreseeable future.

## **GEOGRAPHICAL NAMES (Registrability of Geographical Indications as Trade Marks)**

### **1 Background**

The law regarding the registrability of geographical indications as trade marks is set out in the judgement of the European Court of Justice (ECJ) in [Windsurfing Chiemsee v Boots and Attenberger \(C-108/97 & 109/97\)](#).

It is clear from this judgement that article 3(1)(c) of the Directive (section 3(1)(c) of the Trade Marks Act 1994) applies where:

- the name designates a place which, in the minds of the relevant public, is already associated with the goods/services listed in the application;
- there is no current association, but the name is liable to be used in the future by undertakings as an indication of the geographical origin of the goods/services concerned;

and that:

- in assessing whether the name is liable to be used as a designation of the geographical origin of the goods/services, the registrar must consider the degree of familiarity amongst the relevant class of persons with the geographical name in question, the characteristics of the place designated by that name, and the nature of the goods/services concerned;
- it is not necessary for goods to be manufactured in a place before the name is liable to be excluded from registration as a trade mark for those goods.

The nature of the association could be the place of manufacture, production or design of goods, or the place to which, or from which, services are provided or any other association that establishes the geographical location as the commercial origin of the goods/services. For example, "Blackpool" would be unacceptable for T-shirts or rock because the name characterises the goods as mementoes from Blackpool (whether or not they are made or even designed there). It is doubtful whether the name of the place where goods are simply offered for sale can be regarded as indicating the geographical origin of the goods. However, where the place concerned has a reputation for the retailing of particular goods, the name of a retail area may become associated with the goods in question, e.g. "Saville Row" for clothing.

The ECJ indicated that the defences set out in article 6(1)(b) of the Directive (section 11(2)(b) of the Act) should not have a decisive bearing on the names excluded from registration under article 3(1)(c). The ECJ's more recent judgement in [Libertel \(C-104/01\)](#) also suggests that the existence of defences should not play a part in the assessment of registrability.

## **2 Practice**

All relevant factors will be considered in order to assess the potential for other traders to use the sign as a geographical designation. The most usual factors will be:

- a) Whether the geographical location has a reputation for the goods/services listed in the application;
- b) If not, whether the characteristics of the geographical location concerned indicate that the place is, or in the future is liable to become, a geographical source for the goods/services listed in the application;

c) The extent to which the location is known to the relevant class of persons in the UK - and what it is known for.

On the basis of these factors, examiners will assess whether the name is *liable* to be used as a designation of geographical origin. This will be determined on the balance of probability. The test is not whether it is impossible for the goods/services to originate from the place concerned. Examiners will pay particularly close attention to the following types of applications.

**i) Geographical indications with a reputation (or in an area with a reputation) for the goods/services listed in the application or for *closely* related goods/services**

Such applications are likely to be refused unless the applicant can show why the name applied for is nevertheless unlikely to be used by other undertakings in relation to the goods or services concerned. For example, the name of a particular spring may be registrable for water even though it is in an area with a reputation for that product, if

1) the applicant can show that he is the sole owner of the rights to exploit the spring water and no other water in that area is entitled to be sold under the name of the spring, and 2) the name is not so well known as being *merely* the name of a spring as to be incapable of also designating the trade source of the product.

**ii) The Goods are Natural Produce**

The names of places which are likely to be the source of natural produce are unlikely to be registrable as trade marks for such goods even if the place identified by the mark has no specific reputation. However, the names of very small locations (small in this sense means area as well as population) are unlikely to be used in trade as designations of geographical origin because - without reputation - the place is unlikely to mean anything to the relevant public. A place will have to be obscure before its name could be registered as a trade mark for *unprocessed* products of the kind frequently sold from roadsides and farm shops, such as fruit and vegetables, flowers, potatoes, water, eggs and milk. A slightly more relaxed view may be taken where the product is *processed* natural produce. Again, without a specific reputation, the goods are more likely to be identified with the (generally larger) place of processing, or the name of the wider area, rather than the small villages where the raw materials were grown.

**iii) Local Services**

A cautious approach will be taken to the registration of geographical names for local services such as hairdressing, window cleaning & retail type services such as the organisation of car boot sales. However, each case will be judged on its merits and the names of very small places (population of less than 5000) may still be registrable.

**3 The Names of Other Places with No Reputation for the Goods/Services in the Application (and where the application does not include natural produce or local services)**

The registrability of the names of other geographical places will be assessed against the following criteria:

- a) how well known the name is as a geographical location

Names that are well known as being a geographical location are less likely to be registrable compared to the names of obscure or remote places. However, a name which is well known but which is fanciful or exotic in relation to the type of goods or services listed in the application will not be refused simply because it is well known. For example, "Marrakech" may be seen as simply a fancy and exotic name for motor cars (but may be a plausible indication of the geographical source of other goods, such as carpets, and therefore not registrable for those goods).

- b) the goods and services with which the place is associated (if any)

Examiners will also take account of the types of goods or services with which the place is already associated. For example, if the mark consists of the name of a town with significant manufacturing industry it will be reasonable to assume that the town is, or will become, a source of other manufactured products. On the other hand a rural location is less likely to be the source of a product which requires heavy industry, such as vehicles or their parts and fittings.

- c) other characteristics of the place, including its size

For most goods, the larger the location the more likely it will appear as a source of goods. Consequently, there are likely to be difficulties in registering the names of well known towns and cities in the UK as trade marks for many types of products.

However, it may be possible to register such names where, because of the type of place it is, the name appears to be an unlikely description of the geographical origin of the goods or services e.g. Henley for steel.

#### **4 Names of Overseas Locations**

Overseas place names will be subject to the criteria set out above. The practice will, however, vary in a few respects. The names of geographical locations outside the UK are normally acceptable for services, unless the services are those which are likely to be provided in the UK from overseas e.g. financial services, entertainment or travel and accommodation.

Although the same criteria will apply, it should be borne in mind that the towns, cities and regions of other countries are unlikely to be as well known in the UK as names of our own geographical locations. In practice, therefore, it may be easier to register the name of a small or medium size location in (say) Poland than it would be to register the name of a comparable size location in the UK for the same product.

#### **5 Names of Lakes, Seas and Mountains**

The names of seas will face objection if they characterise the location of services, e.g. "Mediterranean" for transport services, or the goods concerned e.g. "Atlantic" for prawns. Where the name concerned is that of a sea, lake or mountain, the key question is whether the location has a relevant reputation. If Lake Chiemsee has a reputation for sporting activities (such as windsurfing) it should be borne in mind in assessing the registrability of the name Chiemsee for sports clothing because it is likely to be sold in the vicinity of the lake.

## **6 Names of Districts other than Districts of London**

Because of their limited local repute, district names are not usually used to identify the geographical origin of goods or services, other than possibly services of a local nature. Accordingly, the names of districts are normally acceptable as trade marks.

## **7 Names of Districts in London**

London is such a large city that it is more likely that goods and services will be designated as originating from some of its districts, which tend to be well known. However, the well known central districts, such as Mayfair and Westminster, have little or no manufacturing industry and their names would probably not be taken as the geographical origin of goods - unless the area has a specific reputation. The same applies to services, although a more cautious approach would be justified with local services.

A more cautious approach is also justified in the case of applications to register the names of suburbs or outlying districts of London, particularly if they are well known. Many, such as Wimbledon, are as large as many towns and should be treated the same as a town of a comparable size.

## **8 Use of Geographical Limitations to overcome objections**

As goods travel, the actual geographical origin of the goods is not always apparent. An objection under section 3(1)(c) cannot therefore be overcome by a limitation to exclude goods originating from the place whose name they carry.

In the past the Registrar has permitted a territorial exclusion to be entered under section 13 of the Act in respect of services relating to little known locations (unless the place has a relevant reputation). This can no longer be allowed in view of the comments in [Bovemij Verzekeringen NV v Benelux Merkenbureau, case C-108/05 \[EUROPOLIS\]](#), which makes clear that the mark must be distinctive in the whole of the territory of the member state.

## **9 Certification and Collective marks**

Schedules 1 & 2 to the Trade Marks Act 1994 contain provisions which give the Registrar a discretion to register geographical names as collective and certification trade marks notwithstanding the terms of section 3(1)(c) of the Act.

The registrar's practice is that geographical names will be accepted as certification trade marks provided that the name is capable of distinguishing goods or services which are certified from those which are not.

Similarly, collective marks consisting of geographical names may be accepted for registration provided that they are capable of distinguishing the goods or services of the members of an association from those of other traders. This may, in practice, be a more difficult test to satisfy compared to the position with certification trade marks.

If, for example, the members of an applicant's trade association comprise only a minority of the persons entitled to use a geographical indication, it may not be possible to conclude that the geographical name distinguishes the goods or services of the members of the association

## **GET UP ('surplus')**

### **Trade marks including prominent descriptive or non-distinctive signs with get-up and/or combined with other distinctive signs ('surplus')**

When considering whether a trade mark has any distinctive character, the question is whether the sign as a whole will identify the trade source of the goods or services to the average consumer of those types of goods or services.

Whether the presentation or configuration of a description will convey distinctive character may depend not just upon the impact of the configuration or presentation, but also upon the extent of the descriptiveness of the word(s) at the centre of the mark. The more word(s) look like a generic description of the product the less likely it is that the average consumer's perception of the sign will be changed by minor elements of get-up. Each case turns on its own facts.

Where the get-up simply adds to the description or is too commonplace, it may not imbue the mark with a trade mark character.

Where the application is for a shape and the distinctive element of the mark is not the shape i.e. is a word or figurative element, such marks will generally be acceptable. This is because the mark cannot be said to consist exclusively of a sign which may serve in trade to designate the kind of goods etc, and cannot be said to be devoid of any distinctive character. However, applications of this type will be open to objection if the distinctive element is proportionately too small (*de minimis*) within the mark as a whole. The distinctive element must be visible and legible **as a matter of first impression**.

The following examples show marks which all contain an objectionable word element, but are all acceptable because of the surplus elements contained in the mark.



For building services

The words "Period Property Preservation" are wholly descriptive for these services and representations of "bricks" are non-distinctive. However, the impact of the totality is sufficient to signify to the average consumer that the services are provided by a single undertaking.



For ticketing information services

The word "Tickets" for these services is totally descriptive. The words "Ticket.com" is a combination of a purely descriptive word with a non-distinctive suffix. In these circumstances, the device element, although relatively banal, is enough to imbue the mark as a whole with trade mark character for the services at issue.



For foodstuffs.

"Devon" obviously has a reputation for dairy produce, which extends to milk based desserts. The presentation of the words would be likely to be perceived differently to the words alone by the average consumer, and would most likely be regarded as having trade mark character.

The following marks all have an "additional" element, but are open to objection on the basis that either the additional element is imperceptible in normal use, or that it reinforces the descriptive message of the words, or is too commonplace.

For example:



This mark would be open to objection under section 3(1)(b) as the border surrounding the laudatory words is commonplace and does not add any distinctive character to the mark as a whole.



For stationery in Class 16

Whilst the "P" is somewhat stylised (and may be registrable on its own as a device), when considered as a whole the difference between the mark and the highly descriptive word "Premier" would make no impact on the average consumer. The mark is therefore open to objection under section 3(1)(b) & (c).

**CONTROL** 

Pesticides in Class 5 and Extermination of pests in Class 37.

The addition of the "ant" to the non distinctive word "control" for these goods and services does no more than reinforce the descriptive message of the mark as a whole. It is therefore open to objection under section 3(1)(b) & (c).

## **INTERNET (use during examination)**

### **1 When are Internet searches justified?**

Web-wide searches need not be carried out for every case. Searches should be conducted either where the examiner has identified a descriptive meaning from the usual references (i.e. technical dictionaries or subject-specific websites identified by the Registry as suitable reference sources), or because the examiner has suspicions that an apparently non-descriptive word(s) has come to be used in trade as a description. The latter might arise in fast moving fields, such as information technology where it is often difficult to keep up with

the current language of the trade. However, the same point could apply wherever the goods/services appear to be of a new type or are highly specialised.

## 2 Procedural Requirements

The registrar must observe principles of natural justice. This means that applicants, or their representatives, are entitled to know the case against them, and be given an opportunity to respond to any material that has influenced the examiner or hearing officer in coming to a view of the application which is adverse to the applicant. Accordingly, where an Internet search has been conducted any *relevant* results should be sent to the agent or applicant with the examination report. If a search is conducted later any relevant results should be disclosed to the attorney/applicant. If a hearing is scheduled within seven days of the later search, the attorney/applicant should be given an opportunity to postpone the hearing.

When a file leaves the examination team for a hearing, no search results should be on the file which have not been disclosed to the attorney/applicant. If a search reveals no relevant hits a file note to that effect is required.

## 3 Relevancy

### 3.1 Section 3(1)(d)

Before an objection is taken under section 3(1)(d) it is necessary to pinpoint sufficient use of the sign by third parties prior to the date of the application to show that it was in use in the 'customary language' or 'established practices of the trade' at the relevant date. It is not possible to lay down a minimum number of uses required to show this as much depends upon the nature of the hits (e.g. use in an advert for the goods/services in a popular daily newspaper would carry much more weight than an instance of journalistic use of the sign in an article on a web site). In order to be relevant the use *should* be in the UK (e.g. UK website or extract from publications circulating in the UK). The references must show use that occurred *before* the relevant date. Extracts showing use on overseas websites (unless they include relevant extracts from UK publications) should *not* be used to support a section 3(1)(d) objection.

### 3.2 Section 3(1)(c)

*If needed* a limited number of examples of use of the sign in the course of trade in the UK as a designation of characteristics of the goods or services **may** support a section 3(1)(c) objection (and a consequential section 3(1)(b) objection) where a descriptive meaning can be adduced from the ordinary meaning of the sign and the purpose of citing examples of use is therefore to illustrate the capacity of the sign to function as a description in trade. This is to be contrasted with the facts in the [STASH Trade Mark case \[BL-O/281/04\]](#) where the word lacked any *prima facie* descriptive significance (for clothing).

Examples of use of words in other jurisdictions are *not* usually conclusive without more. This is because the same word can be descriptive in one country and distinctive in another. However, overseas use *may* be relevant where:-

a) the *ordinary meaning* of the word(s) identified in the usual reference sources suggests that the sign may serve in trade in the UK as a description and the use made of the sign in other English speaking countries is merely confirmation that the sign is apt for such use here, or

b) the hits suggest that the sign in question had, *at the date of the application*, been adopted in other English speaking countries as the name of (or an abbreviation for) a new sort of product or service.

### **3.3 Use in trade**

It should be borne in mind that objections under section 3(1)(c) can only be based upon the existence or likelihood of the sign being used for descriptive purposes *in trade in the goods / services*. One or two isolated examples of journalists using a word as a description will not, without more, serve to show that an apparently meaningless or inapt word is apt for use in trade as a description. On the other hand, a persistent pattern of descriptive use by journalists (particularly in trade papers) is sufficient to establish that the sign is liable to be used in trade as a description.

### **3.4 Dates**

Use after the date of the application is *usually* irrelevant. However, if an objection is raised under section 3(1)(c) which is based primarily upon the descriptive meaning of the word(s) identified in the usual reference works, then examples of descriptive use in trade after the date of application may be relevant. This is because such examples confirm that the word(s) had descriptive potential at the date of application. In the absence of any other indication, we should take the date that the web-page was last updated as the date of the article for examination purposes.

### **3.5 Applicant's own web site**

Use of the sign *as a trade mark* on the applicant's own web site is irrelevant and care should be taken not to include such material in examination reports. However, evidence of the applicant using the sign in an *obviously* descriptive manner *may* be relevant.

## **LETTERS AND NUMERALS**

Section 1(1) of the Act states that trade marks may consist of letters or numerals. Such signs are not therefore excluded from registration per se. Whether a letter or numeral mark can be registered *prima facie* will depend upon whether the average consumer of the goods / services at issue would expect all such goods/services offered for sale under the sign to originate from a single undertaking. If the sign does not possess the character necessary to perform this essential function of a trade mark it is "devoid of any distinctive character."

### **1 Descriptive letters or numerals and those customary in the trade**

Letters or numerals which designate characteristics of the goods/services, and/or which are customary in the trade, are excluded from registration by section 3(1)(c) and/or (d).

Numbers/letters which may be used in trade to designate:

- \* the **date** of production of goods/provision of services (e.g. 1996, 2000)
- \* **size**, e.g. XL for clothes, 1600 for cars, 34R for clothing, 185/65 for tyres
- \* **quantity**, 200 for cigarettes
- \* **dates** e.g. 1066 for history books, 1996 for wines
- \* **telephone codes** e.g. 0800 or 0500
- \* the **time** of provision of services, e.g. 8 – 10, 24/7
- \* the **power** of goods, e.g. 115 (BHP) for engines or cars or
- \* **speed**, e.g. 486, 586, 686 & 266, 333, 500, 550 for computers
- \* **strength**. e.g. "8.5%" for lager

Such signs will be subject to objection under section 3(1)(b)(c) and/or (d) of the Act.

## **2 Devoid of distinctive character**

### **2.1 Random letters/numerals more distinctive**

The more random and atypical the letters or numerals are the more likely it is that the sign will have the necessary distinctive character. Accordingly, the more a letter or numeral mark resembles signs commonly used in the relevant trade for non-trade mark purposes, the less likely it is to be distinctive.

### **2.2 Well known practices of trade to be considered**

In all cases the distinctive character of the sign must be assessed in relation to the goods / services specified in the application. Account may be taken of facts that are considered to be well known. For example, some letters, such as "L" and "S" are members of a "family" of letters commonly used in the motor trade to designate trim or performance characteristics of motor vehicles. The average consumer will probably take the letters "LS" as a mere trim level designation for motor cars whereas other similar combinations, such as "Z7", may function as a trade mark.

However, unless research or general knowledge shows that there is a history of non trade mark use of similar combinations of letters/numbers in a particular trade, the application will be examined on the assumption that the letters/numbers are sufficiently random. The matter may be re-considered in the event of observations or opposition.

### **2.3 Two and Three letter marks**

Marks consisting of two and three letters will be accepted unless there is a specific reason to believe that the particular letters will not be taken, by the average consumer, as a trade mark.

### **2.4 Two, Three (or more) letters presented as a descriptive abbreviation**

Prior to 22 April 2013, examiners in their assessment of trade marks containing non-distinctive and/or descriptive words coupled with abbreviations, acronyms or initialisms, routinely considered the nature of the goods and services claimed. In particular, the extent to which abbreviations are likely to be used within the relevant sector largely influenced decision making. To illustrate this the mark 'M.G.S. Missile Guidance System' was presented as an example of one which is objectionable when intended for use in respect of military hardware, and was contrasted with the mark 'BBFB Best Bank For Business', being one which would be acceptable when applied for in respect of financial services. However, due to an update in practice following the CJEU judgment in joined cases C-90/11 and C-91/11 both 'M.G.S. Missile Guidance System' and 'BBFB Best Bank For Business' would now face an objection under sections 3(1)(b) and (c).

In its judgment the CJEU considered a reference from the German Patent and Trade Mark Office relating to the trade marks 'Multi Market Funds MMF' and 'NAI-Der Nature-Aktien-Index'. In the case of the first mark, the German Court, having already determined that the term 'multi market funds' is descriptive for the services claimed, then also found that the three-letter combination 'MMF' would be understood as an abbreviation for the accompanying word elements. In reaching this conclusion, the referring Court was unconcerned with determining whether or not the three-letter combination 'MMF' is already established as an abbreviation for the term 'multi market fund', or with the extent to which it might have other meanings.

In that context, the CJEU was asked whether Articles 3(1)(b) and (c) of the Directive (equivalent to sections 3(1)(b) and (c) of the UK Trade Marks Act) should apply to any trade mark consisting of a 'descriptive word combination and a non-descriptive letter sequence' where the relevant public perceives that latter sequence as being an abbreviation of the descriptive words on account of it reproducing their initial letters. The Court answered in the affirmative, stating that:

"Article 3(1)(b) and (c) of the Directive... must be interpreted as meaning that it is applicable to a word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and that the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character."

The CJEU's judgment impacted on UK examination practice, most notably because it made no distinction between those products which are more likely to be denoted in trade via abbreviations and acronyms, and those which are not. The Court's judgment indicates that, where a word combination is deemed to be descriptive pursuant to section 3(1)(c), and where the accompanying 'letter sequence' represents the initial letters of the words to which it is attached, then the relevant consumer is unlikely to perceive the sign in totality as being an indicator of trade origin. Factors such as the nature of the product intended for protection and the extent to which that product is likely to be abbreviated in trade are not presented as having any relevance to the assessment of *prima facie* distinctiveness. Nor is the fact that the initial letters may spell out another word.

As a result, the Registrar's practice towards such marks was updated to reflect the judgment of the Court. When dealing with signs such as e.g. 'M.G.S. Missile Guidance System' and 'BBFB Best Bank For Business', the examiner will first seek to determine whether the word combination designates a characteristic of the goods and/or services intended for protection, pursuant to section 3(1)(c). Where that is the case, and where the corresponding letter sequence clearly and unambiguously represents the initial letter of each word in that combination, the examiner will raise an objection under section 3(1)(c). As a result both 'M.G.S. Missile Guidance System' and 'BBFB Best Bank For Business' would now face objection under sections 3(1)(b) and (c).

Throughout its judgment on C-90/11 and C-91/11, the Court made specific reference to word combinations which fall foul of section 3(1)(c). It does not address those word combinations which fall foul of section 3(1)(b) alone. As a result, it should be emphasized that this guidance only applies to those marks where the word combination is found to be descriptive. It does not apply to marks containing a word element which is deemed to be devoid of any distinctive character pursuant to section 3(1)(b) *solus*. For this type of mark, the Registrar will continue to consider factors such as the nature of the goods, and their propensity to be signified in trade via the use of abbreviations, acronyms and/or initialisms, in order to determine and assess *prima facie* distinctiveness. Each case will be considered on its own merits.

Nor does the judgment make any reference to marks containing acronyms (i.e. a series of initial letters which combine to form a pronounceable word). In most cases, the distinction between an abbreviation and an acronym will be negligible, and will not influence an examiner's decision to raise an objection. In some cases however, the use of an acronym may add an element of word-play, humour, or other inventiveness into the mark. In these instances, the use of an acronym (as opposed to an abbreviation) may provide the mark with inherent distinctiveness, and may render it acceptable. Again each case will be considered on its own merits.

## **2.5 Single letter marks**

There is no bar to the acceptance of single letters as trade marks. Each case must be considered individually. A single letter mark may be distinctive for a wide range of services. A single letter may be descriptive or non-distinctive for many goods, but may be acceptable for many other goods. Research is required in each case so as to avoid registering a descriptive indication as a trade mark. For example, the letter "K" appears to be a distinctive trade mark for footwear, but the letter "H" is a customary indication of a width fitting for shoes, and so would not be distinctive. However, the letter "H" would appear to be a distinctive trade mark for drinks. Particular care is required where the goods are technical items such as computers, machines, motors and tools, where particular letters often have a descriptive meaning or have become customary in the language or in the *bona fide* and established practices of the trade.

Where a letter is not distinctive, a plain rectangular or oval border is unlikely to make the mark distinctive. However, a fancy or unusual border may be enough. Colour may also

assist in providing the mark as a whole with the necessary power to individualise the goods/services of one undertaking.

## **2.6 Numerals & Letter/number combinations**

Numerals and letter/number combinations will be accepted as trade marks provided that they appear sufficiently random to individualise the goods/services of one undertaking. The distinctiveness of the mark must be assessed in respect of the goods/services at issue.

## **2.7 Five digit numbers & letter/number combinations**

Five digit numbers and combinations of numbers and letters will be regarded as having the necessary distinctive character unless the examiner is able to identify a specific reason why a particular combination would not be taken as a trade mark.

## **2.8 Four digit numbers & letter/number combinations**

Four digit numbers will also normally be regarded as having some distinctive character, provided that they are random numbers, e.g. 1560, 8787 and not round numbers e.g. 1000, 2400 - which are commonly used in trade as mere model or product numbers for goods. Even round numbers may be distinctive for services and goods not usually sold under a model or product number such as food & drink. Numbers which are current or shortly forthcoming dates should be regarded as devoid of any distinctive character.

Combinations of 4 numbers and letters, in any order, (e.g. F120) may be regarded as having the necessary distinctive character.

## **2.9 Three digit numbers & letter/number combinations**

Random three digit numbers, such as 159 or 343 may be regarded as having the necessary distinctive character. Round numbers (e.g. 100 or 120) will normally be regarded as devoid of any distinctive character as trade marks for goods. Even round numbers may be distinctive for many services and goods not usually sold under a model or product number.

Combinations of two letters and one number (e.g. EK5) may be accepted. One letter and two numerals (e.g. W70) may also have some distinctive character.

## **2.10 Combinations of one letter and one numeral**

Combinations of one letter and one numeral may have the necessary distinctive character. So combinations, such as "Z7" for motor cars may be accepted and other straightforward combinations, such as "C6", may be distinctive for goods (like soft drinks) which are not frequently sold under a model code. Combinations of one letter and one number may also be acceptable for many services.

## **2.11 Two digit numbers**

Two digit numerals may be devoid of any distinctive character because they are commonly used in trade as descriptions or else have become customary in the language or in the bona fide and established practices of the trade. However, they may be distinctive for certain goods and services (e.g. 77 for estate agents services or soft drinks).

## **2.12 Single digit numbers**

Single numbers which involve little or no stylisation will often face an objection because many such numbers are used in trade to designate a characteristic of many goods (e.g. 6 = cylinders in an engine, 2 = litres of milk). However, each case must be considered individually. There may be occasions when a single number in relation to some services may possess the necessary degree of distinctiveness e.g. '9' appears to be distinctive for recruitment services.

## **LIMITATIONS (See DISCLAIMERS AND LIMITATIONS)**

### **MULTI COMPONENT MARKS (Trade marks made up of a number of components, each of which is descriptive)**

In [\*Campina Melkunie BV v Benelux-Merkenbureau Case C-265/00\*](#), the ECJ determined that a trade mark which is composed of a number of elements, each of which is descriptive of the goods/services in the application, is excluded from registration under section 3(1)(c) of the Act unless the trade mark is perceptibly more than the sum of the meanings of its descriptive parts.

The judgement indicates that this may apply even where the combination of descriptive parts creates a word or phrase which has not been seen before.

Nevertheless, if the combination of descriptive elements is unusual and creates an impression that is sufficiently far removed from being simply a composite description of the goods/services, the trade mark may be registrable.

The mark EUROLAMB has been found to be unregistrable (for lamb) under section 3(1)(c) on the grounds that the element EURO is commonly used to indicate "European" and conjoining EURO and LAMB therefore results in nothing more than a composite description of the kind and geographical origin of the goods, which is no more registrable than the term "European Lamb".

Similarly, it is suggested that the mark MULTIBLADE would not be registrable for razors. However, it is suggested that the mark MULTICLOSE is registrable (for razors). Although razors commonly have multiple blades (and 'Multi' is therefore descriptive) which are designed to provide the user with a close shave (and 'close' is therefore descriptive of the intended purpose of the product), the terms 'Multi' and 'Close' would be an unusual

combination and not a natural one to use as a description of these characteristics of the product.

The words HIGH SPEC HOME COMPUTING SYSTEM would not be registrable for computer hardware and software, because the composite phrase is simply a description of high specification computing systems tailored for the home (as opposed to a business) environment.

In contrast, the term AUTOMOTIVE NETWORK EXCHANGE was found to be registrable (for business information for the automotive industry provided by means of a private network) on the grounds that although each of the words was individually unregistrable, the amount of effort and analysis required to interpret the composite phrase as a description of the services was more than an average consumer was likely to undertake.

## **NEW PRODUCTS (See ‘Foreseeability’)**

## **NON ENGLISH WORDS (Registrability of)**

These guidelines indicate how the registrar is likely to respond to applications to register non-English words as trade marks where, if words with the same meaning were applied for in English, the application would be subject to an objection on the grounds that the words are descriptive and/or non-distinctive.

The Welsh language has equal status to English in Wales and similarly the Gaelic language has equal status to English in Scotland. For the purposes of section 3(1) of the Act, trade marks consisting of words in the Welsh or Gaelic languages will be treated in the same way as trade marks consisting of the equivalent English words

Following the European Court of Justice’s (ECJ) judgement in case [C-421/04 Matratzen Concord AG v Hukla Germany SA](#), there are no grounds for refusing registration of trade marks on the basis that they are relevantly descriptive or non-distinctive in a language which is unlikely to be understood by the relevant trade in the UK or by the relevant average UK consumer of the goods/services in question.

Consequently, the registrar will only object to the registration of word marks which are likely to be recognised as a description of a characteristic of the goods or services (or otherwise be descriptive of the goods/services) in the application.

The relevant trade in the UK consists of those in the UK who trade in the goods or services in question. A pharmacist may recognise the descriptive meaning of a Latin name even though an average consumer of pharmaceuticals may not. Similarly, a trader in wines is likely to have a better understanding of French wine descriptions than the average end consumer of those goods. Further, traders in computing goods and services are likely to be more aware of the names used elsewhere to designate characteristics of new products, even if the product is not yet available on the UK market.

## **1 The Most Commonly Understood European Languages**

In general, the most widely understood European languages in the UK are French, Spanish, Italian and German. The majority of UK consumers cannot be assumed to be fluent in any of these languages, but most of them will have an appreciation of some of the more common words from these languages, particularly common French words. So it may be assumed that the meaning of 'Biscuit pour Chien' (dog biscuits) will be known to the average UK customer for dog biscuits. Similarly, it may be assumed that traders in and/or average UK consumers of cosmetics (who will be accustomed to seeing French descriptions on the packaging of cosmetics) will know the meaning of 'lait' (milk) and will be able to decipher the meaning of 'Lait hydratant' as being moisturising milk (or similar).

## **2 Non English Descriptions which are most likely to be understood**

The average UK consumer may well be familiar with the non-English name of a product or service, or the local name for its geographical origin. For example, the average English speaking consumer of wine would know that 'Bourgogne' is the French word for the region known in the UK as 'Burgundy' and would also be likely to know that 'vin rouge' means 'red wine.' Similarly, the average consumer of olive oil is likely to know that 'Toscana' is the Italian word for the region known in the UK as Tuscany. Consequently, these names are not registrable for wine and olive oil, respectively.

## **3 Non-English Words which resemble English Descriptive Words**

The more closely a non-English descriptive word resembles its English equivalent, the more likely it is that its descriptive significance will be understood by the consumer. So for example, the Italian word 'caffè' should be rejected as a trade mark for coffee because the average UK consumer of coffee would be likely to see that it simply means 'coffee'.

## **4 Further Considerations which apply to Non-English Descriptive Marks for Services**

Section 3(1)(c) is directed at signs which may serve, in trade, as designations of goods or services. Goods are known to move from one territory to another. Non-English words are therefore inherently more likely to be taken as descriptions used in the UK in relation to imported goods than is the case with most services.

Consequently, with certain exceptions, such as travel, transport and language services, non-English words may be registrable for some services even where the meaning of the words would be apparent to the relevant average UK consumer. For example, the use of 'Pret a Manger' (ready to eat) in relation to a catering service provided in the UK is unlikely to be regarded by the trade as simply descriptive use, even if they know what the French words mean. In contrast 'Pret a Porter' (ready to wear) would not be registrable for clothing as this is a recognised descriptive term in the trade.

## **5 Goods or Services aimed at Minority Groups**

Where the average consumer or end user of the goods in the application is far more likely than the average UK consumer to understand the language of the mark, this should be taken into account in determining whether the mark is caught by section 3(1)(c) of the Act.

For example, the mark  $\text{ع}$  IMAR (an Arabic word – YASHMAK is the English) would not be registrable for yashmaks in Class 25 because this would be a normal way for traders of these goods to market them because they are primarily used by the Arabic speaking community. The same would apply if the application includes more general descriptions of the same goods, such as ‘clothing.’

This sort of point is most likely to arise in relation to marks for foodstuffs and drinks in Classes 29-32 and clothing in Class 25.

## **6 Non-English Words which have become customary in the Current Language or in the bona fide and Established Practices of the Trade**

Non-English words which have become generic in the trade in the goods or services (by customers or traders) are excluded from registration under section 3(1)(d) of the Act. So the German word ‘auto’ is not registrable for motor cars, their parts and fittings, or related services. Nor is the Italian word ‘panini’ for sandwiches.

## **NOTIFICATION (Section 5: Relative Grounds)**

From the 1 October 2007 the registrar will only be able to refuse an application on a ground mentioned in Section 5 of the Trade Marks Act 1994 if opposition on that ground is raised (successfully) by the proprietor of the earlier mark or sign. The practical effect of this is that earlier trade marks will no longer constitute a barrier to the acceptance of an application at examination stage. It will instead be up to the owners of earlier marks to decide if they wish to challenge the acceptance of the application through opposition.

Irrespective of the above, a search for earlier marks will still be conducted at examination stage and the results of it passed to the applicant for registration. This will enable the applicant to make an informed choice as to whether or not to proceed with his application and to assess the risk of doing so. If the applicant continues with his application the owners of any earlier marks identified in the search will be notified (via his address for service) about the existence of the new application when it is subsequently published in the Trade Mark Journal.

Essentially, the same tests will be applied for this notification regime as were applied for the previous “citing” regime (whereby applications would be blocked by an earlier trade mark). The test being whether the similarities between the respective trade marks and their goods and services would lead, in the registrar’s opinion, to a likelihood of confusion.

The following paragraphs set out the guidance which applies in deciding whether or not the earlier trade mark owner should be notified about the existence of the new application. However, it should be noted that a decision to notify (or not) has no bearing whatsoever on any subsequent opposition case which may be received. It should also be noted that

notifications will not be issued in relation to possible grounds under section 5(3) or 5(4) of the Act as the registrar's examiners cannot know whether grounds for these objections exist.

An earlier trade mark is a trade mark (registered or pending) with an earlier date of filing, priority or seniority than the trade mark under examination. Where the earlier mark is still pending, then it is an earlier mark "subject to it so being registered". It also includes International trade marks (UK and EC), Community trade marks and well known marks protected under section 56 of the Act.

## **1 Section 5(1)**

This section of the Act is concerned with conflicts where the marks are identical and the goods or services are also identical. The ECJ, in its judgment in the [LTJ Diffusion SA v. Sadas Vertbaudet SA case, C-291/00](#), said that "a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

This approach was followed by the English Court of Appeal in the [Reed v. Reed case, \[2004\] EWCA \(Civ\) 159](#), Jacob LJ also gave guidance on how identity of specifications should be determined, specifically services in this case. In recognising that "a service provider of one sort is apt to provide a range of particular services some of which will be common to those provided by a service provider of another sort", he said it was important to identify what are the core activities of the provider, rather than giving a wide interpretation of the specification of the registered mark.

When performing a relative grounds search for conflicting marks, an earlier mark will be considered identical if:

a) all the elements are the same, or the differences between the two are so minor that the average consumer is unlikely to notice them;

and

b) the specifications cover identical goods or services. In deciding the meaning of particular terms in the specifications, examiners should not "stretch" the meaning of the terms to cover all eventualities, but should give the terms their ordinary natural meanings.

If only a) or b) is present, the objection will fall under section 5(2) rather than 5(1).

## **2 Section 5(2)(a) and (b)**

Section 5(2) of the Act implements Article 4(1)(b) of the 1988 Directive 89/10/EEC. The European Court of Justice (ECJ) has provided guidance in the form of four judgements on cases which were referred to the Court from differing national jurisdictions. These are:

[Sabel BV v Puma AG \(C-251/95\)](#)

[Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc \(C-39/97\)](#)

[Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. \(C-342/97\)](#)  
[Medion AG v Thomson multimedia Sales Germany & Austria GmbH, Case C-120/04.](#)

### **3 Similarity of goods/services**

In determining the **degree** of similarity between the respective goods/services, the following should be taken into account:

Nature of the goods/services  
The intended purpose of the goods or services  
Method of use  
Whether the goods/services are in competition  
Whether they are complementary

### **4 Similarity of marks**

The visual, aural and conceptual similarities (and differences) between the marks must be assessed and an overall assessment made about the degree of similarity and difference between the marks.

The question is not whether the marks are similar under any one of the above headings (although that might be enough to create a likelihood of confusion in some circumstances) but what is the overall extent of the similarities and differences. In this connection, it should be noted that similarity/difference under one head, e.g. conceptual similarity/difference, can increase or reduce the effect of similarities or differences under other heads, e.g. visual or aural similarity.

In assessing the degree of aural similarity between two marks one is mainly concerned with word marks or word elements, although pictures with an **obvious** aural description may also give rise to a degree of aural similarity.

The respective marks must be compared as wholes because the average consumer normally perceives marks as a whole and does not proceed to analyse their various details.

Nevertheless, it should be borne in mind that although the consumer normally perceives marks as a whole, his or her recollection of them is likely to focus on their dominant and distinctive components.

Non-distinctive similarities should not be ignored altogether if they comprise a significant part of the respective marks, but distinctive similarities should be given more weight.

Non-dominant but distinctive elements may also give rise to a material degree of similarity between the marks where trade mark A is subsumed within trade mark B and yet retains an independent and distinctive role within trade mark B.

### **5 Likelihood of confusion**

Likelihood of confusion means that it is more likely than not that confusion will arise in the mind of the average consumer for the goods/services at issue.

Likelihood of association is not an alternative to likelihood of confusion, “but serves to define its scope”. Mere association, in the sense that the later mark brings the earlier mark to mind is insufficient to find a likelihood of confusion, unless the average consumer, in bringing the earlier mark to mind, is led to expect the goods or services of both marks to be under the control of one single trade source. “The risk that the public might believe that the goods / services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion” (*Canon*).

## 6 Global comparison

The main emphasis in *Sabel* is the idea that no single factor will lead to a conclusion that there is or is not a likelihood of confusion between marks, a theme shared by the judgements which followed. In *Sabel*, the Court decided that:

“The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case.”

The three most relevant factors in examination of trade mark applications by the Office will usually be:

- i) the similarities and differences between the respective trade marks,
- ii) how distinctive the earlier mark is, and
- iii) the degree of similarity between the respective goods or services. Once an initial assessment of the individual factors has been undertaken, all three factors must be considered together in order to assess the overall likelihood of confusion.

These factors are interdependent. “A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa” (*Canon*). And, “...the more distinctive the earlier mark, the greater will be the likelihood of confusion.” (*Sabel*).

The weight given to visual, aural and/or conceptual similarities and differences between the marks will vary depending upon the goods or services at issue. For example, purchase of clothing is likely to be on the basis of visual selection, whilst over-the-counter medication or leisure club classes may be purchased orally, rendering the aural comparison paramount (*Lloyd*). In the case of conceptual comparison,

“It is ....not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier trade mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.” (*Sabel*)

It is clear from an analysis of the case that the ECJ had very highly distinctive marks in mind, such as a representation of a monkey playing a piano, where the very distinctive common idea behind the marks is likely to outweigh any visual differences in the respective representations of the idea in the perception of the average consumer. Other than in exceptional cases such as this, mere conceptual similarity will be insufficient to give rise to a likelihood of confusion.

During *ex officio* examination the examiner can only have regard to the inherent distinctive character of the earlier mark; enhanced distinctiveness can only be assessed through evidence of reputation, and this is more appropriate to *inter-partes* proceedings.

## 7 Where Trade Mark A is subsumed within Trade Mark B

In the case of composite marks comprised of two or more **distinctive** elements, it will often be difficult to determine that any one of those elements is dominant.

The most obvious example is that of a full name such as 'Alexander Morgan', where both elements contribute roughly equally to the origin identification message sent by the composite sign, which therefore depends upon the presence of both elements. Accordingly, the registrar would not normally regard the marks 'Alexander' or 'Morgan' as being in conflict with the mark comprised of the full name, even if the respective goods are the same.

Nevertheless, there may be cases even of this type where one part of the name will be seen as the dominant and distinctive feature. For example, in the full name 'Tony Copland', the surname is rare whereas the forename is common. The surname therefore contributes more to the distinctive character of the mark than the forename. The owners of the 'Tony Copland' mark should therefore be notified of 'Copland' alone and vice versa (subject to the respective goods/services being identical or at least closely similar) on the basis that 'Copland' is the dominant and distinctive feature of 'Tony Copland'. But the owners of the mark 'Tony' would not be notified of the mark 'Tony Copland', or vice versa.

Where trade mark A is incorporated into trade mark B in such a way that it **cannot** be said to be a **dominant** element of trade mark B, there may still be a likelihood of confusion where:

- i) the respective goods or services are identical or virtually so, and
- ii) the element which corresponds to trade mark A retains an independent role within trade mark B, and
- iii) the common element is not *prima facie* lacking or low in distinctive character.

If mark A has limited distinctive character it is less likely that its mere inclusion in mark B will cause relevant consumers to suppose that the users of the respective marks are economically linked. In this connection, it is noted that the ECJ's guidance in its judgement in the *Medion* case assumed that mark A was of "average" distinctiveness.

In the example below, the dominant element of the trade mark is probably the word 'Catania'.



However, the word 'Schachenmayr' retains an independent and distinctive role within the composite mark. Accordingly, if a third party applied to register 'Schachenmayr' (or nomotta) for the same goods, it would be appropriate to notify the owners of the above composite mark (or vice versa). This is because the presence of the independent 'Schachenmayr' element in the composite mark would be likely to result in consumers expecting there to be an economic link between the undertaking responsible for the goods sold under that mark and the same goods sold under the mark 'Schachenmayr' alone .

Where the composite mark appears to comprise of the name or another means of identifying the undertaking responsible for the goods/services combined with a product name, both should be regarded as playing an independent and distinctive role within the composite mark. Accordingly, (again assuming identical goods/services but different proprietors) it is likely that the owners of the mark 'BJ's Matrix' would be notified of the marks 'BJ's' and 'Matrix'.

However, examination of composite marks should not be reduced to a search to find one mark within another. The more the elements of the composite mark 'hang together' the less likely it is that the individual elements will have an independently distinctive role within the composite mark. For example, the element POLO is not an independently distinctive element within the composite trade mark ROYAL BERKSHIRE POLO CLUB because the words 'hang together' as a name. The word POLO does not therefore stand out as having its own independently distinctive role within the composite mark.

Further, it is possible for a word to be subsumed within a multiple word mark even though the words do not combine to form a totality with an obvious meaning. For example, it would be difficult to say that the word 'targets' has an independent and distinctive role in the composite mark 'Fashion Week Targets Friday' (for clothing). Consequently, it is not likely that it would be held to be in conflict with the mark 'Targets' *solus* (again assuming same goods) because it is not the dominant element of that mark, and neither is it an independent and distinctive element of the composite mark.

The most difficult case is where mark A (in the example given below CAREAID) is included in a two word composite mark B, such as SPINESPAN CAREAID (for medical services) where the two elements of mark B would appear to the consumer to be a) normally distinctive, and b) entirely independent of each other. If the respective goods/services are also identical, it is quite likely that the relevant consumer will assume that the inclusion of the CAREAID mark as an element in the composite mark SPINESPAN CAREAID is indicative of

an economic connection between the undertakings using the marks. Notification of the later mark would therefore be justified if the marks are in different ownership.

## **8 The average consumer**

The global appreciation of the likelihood of confusion must be made through the eyes and the ears of the “average consumer”. The average consumer will depend upon the type of goods or services in question, so that this may include members of the trade as well as of the general public. He/she 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*). The consumer’s level of attention is likely to vary according to the category of goods or services, e.g. closer attention will be paid to the purchase of engineering equipment than is likely for everyday items such as foodstuff.

## **9 Notional and fair use**

This refers to use across the range of goods/services claimed in any way that would be considered to be normal use of the trade mark in relation to the goods or services in question. Notifications should not be waived on the basis that the goods/services will only be sold in a certain environment, or in a specific price range, or that the mark will only appear in a certain way in connection with the goods/services. Trade Mark proprietors are free to change the way they market goods/services and they can assign marks which may then be used however the new proprietor sees fit.

## **10 Disclaimers**

Where the only component of the earlier trade mark which could be regarded as creating a similarity with a later trade mark is the subject of a disclaimer to any exclusive right, the examiner will not consider the marks to be similar enough to create a likelihood of confusion.

The registrar will treat a disclaimer as an admission that the disclaimed component of the earlier mark is not, by itself, distinctive of the proprietor’s goods and/or services. In that case, its presence in another party’s trade mark cannot give rise to a likelihood of confusion. The disclaimed component(s) of the earlier trade mark may still contribute towards confusion between the marks and therefore a requirement for the registrar to notify the owners of the earlier mark where there are other similarities between the respective trade marks.

An applicant’s offer to disclaim exclusive rights to a component of his (later) trade mark will not assist in overcoming a requirement to notify because an admission made by the applicant cannot, of itself, be deemed to affect the scope of protection of the earlier trade mark. Of course, if the applicant can show that the feature shared by the marks is in fact non-distinctive, the notification requirement will be reviewed.

## **11 Section 5(3)**

This may prevent registration of a mark which is identical with or similar to an earlier mark which has a reputation. This will not be dealt with at the examination stage. It will be up to the proprietor of the earlier mark to prove reputation in opposition proceedings.

## **12 Section 5(4)**

This prevents registration of a mark the use of which at the date of application [or priority] would have been prevented by any rule of law e.g. passing off, and also because of any other earlier right, such as copyright, design right or registered design. Section 5(4) can only be determined on the basis of evidence filed in opposition or invalidation proceedings.

## **13 Families of Marks**

Simon Thorley QC, acting as the Appointed Person, gave consideration to this point in the ["Ener-Cap" appeal \(BL O-295-98\)](#), believing the question of "families of marks" to be irrelevant to section 5(2)(b) but that it could be relevant to an argument under section 5(4) of the Act.

If a search reveals a number of marks in the same ownership with common identical elements, they should not be regarded as confusingly similar to the mark being examined on this count alone; to do so, would be to assume a degree of reputation in the common feature of the earlier marks. Reputation cannot be considered at the *ex parte* stage because this is only appropriate as a matter for consideration under opposition. It cannot be assumed in the *prima facie* that any or all of the marks are even in use at the date of application. Consequently, where similar marks in the name of the same party are identified in a search, they should be compared with the later mark sequentially, not collectively.

Of course, there may be a case for the registrar notifying the owners of all or some of the earlier marks on other grounds. For example, company A has registered marks including "Portakabin", "Portaloo", "Portahouse", "Portatank" and "Portasafe", and company B has applied for "Portahome". The registrar would not notify the owners of all the registered marks but only those, if any, that are individually confusing, i.e. Portahouse, on the grounds of visual and conceptual similarity.

There may also be cases where the common feature of the earlier marks is so inherently distinctive that its inclusion in the later mark is sufficient to give rise to a likelihood of confusion, notwithstanding the differences in the marks. For example, ZIGGOOSUR v ZIGGOOTAN; in this case the existence of other similar earlier marks in the name of the same party, e.g. ZIGGOONOR, will not add to the case for notifying the owners of ZIGGOOSUR.

## **14 Retail Services: search of the Register**

In [case C-418/02](#), (Praktiker) Advocate General Phillipe Leger opined [agreeing with communication No. 3/01 from the President of OHIM] that "the risk of confusion between [retail] services and the products, if it cannot be excluded, is nevertheless improbable except in particular circumstances, for example when the respective marks are identical or almost identical and well established on the market."

The ECJ did not feel the need to answer the referring court's question about the scope of protection of retailers' marks and so there is no definitive statement of law. Nevertheless, the Advocate General's Opinion is of persuasive value. In the light of it we will consider notifying the earlier right holders in the course of official examination where:

- a mark is registered (or proposed to be registered) for retail services (or similar descriptions of this service) connected with the sale of specific goods or types of goods;
- another mark is registered (or proposed to be registered) by a different undertaking for goods of the type expressly mentioned in the specification of the retail services trade mark;
- the earlier trade mark has at least a normal degree of distinctive character, i.e. marks with low distinctive character, such as, for example, common surnames, need not be cited;
- the later trade mark is not just similar to the earlier mark but is identical or virtually identical to it, or contains a dominant and/or independently distinctive feature of it.

The reputation of the earlier trade mark and (unless it is obvious) the practices of the trade will only be taken into account on the basis of evidence in opposition or invalidation proceedings.

In view of these factors, we will conduct a search for earlier trade marks as detailed in the guide to cross searching . ([See Cross Search List on this website.](#))

#### **15 Where there are potential earlier rights to be notified but the applicant has an identical 'earlier trade mark'**

In the past, applicants have been allowed to proceed to publication in the face of an earlier mark where the applicant is also the proprietor of a trade mark which predates that earlier right ('leapfrogging'), providing that certain criteria were met. In future, the owners of all earlier marks identified in a search will be notified of the later application. It will be for the parties to decide how they wish to proceed.

#### **16 Where the owner of an application has previously consented to the registration of an earlier right or have an earlier mark with a later date but which has lived together with an earlier right for some time**

It sometimes occurs that the proprietor of an application facing a requirement for an earlier right holder to be notified, has previously given consent to the registration of that earlier mark, as owner of a still earlier trade mark. This will not be taken into account and it will be left for the two parties to decide whether the new application disturbs the earlier position e.g. if the specification goes wider than the earlier one.

Where the applicant has an existing registered trade mark with a later date than a potential earlier trade mark, but which has lived together with that earlier mark for a period of time, we should still notify the owner of the earlier trade mark about the latest application for the same reasons as given above.

#### **17 Where the earlier trade mark is a Community mark or an International trade mark (UK or EC)**

A Community trade mark or an International trade mark (UK or EC) with an earlier date constitutes an earlier trade mark within the meaning of section 6 of the Act. Accordingly, a similar approach to that set out above may be followed where a UK applicant is faced with an earlier Community trade mark or an International trade mark, but has an earlier identical or similar trade mark. As a Community trade mark may be converted into a national application under Article 108 of Council Regulation 40/94 whilst maintaining its original filing date and priority, and similar provision exists for transforming an International trade mark (UK and EC) into a national application, it does not matter whether the applicant's earlier trade mark is a national application/registration or an International trade mark or a Community trade mark application/registration.

#### **18 Expired earlier rights**

A mark expires when renewal does not take place by the due date (which is the anniversary of the date of application). This fact is published in the TMJ. When 6 months passes the mark is removed from the register - effective from the renewal date. Where a potential earlier right has a status of "expired", it is considered to be no longer on the register and so the owner of that expired mark will **not** be notified of the new application. (Section 6(3) of the Act states that marks '*whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry....*') However, as a recently expired mark is no longer a barrier to acceptance, the procedures previously applied e.g. suspending the later mark until the one year period has passed, are no longer necessary.

We will, however, advise the applicant of any such cases as some may be reinstated within the one year after expiry. If the earlier right is reinstated prior to the notification letter being prepared the owner of that right will, of course, be notified.

#### **19 'Technical notifications' between companies in the same common ownership**

It is likely that large companies will be filing applications for similar marks in the names of their various subsidiary companies, and may wish to overcome the resulting 'technical notification' by consent. However, the registrar will list technical notifications in relation to **all** earlier right holders during examination and it will be for the applicant to decide whether they wish to pursue consent or simply allow the related company to be notified.

#### **20 Overcoming a requirement to notify - a summary**

It remains open to applicants or their representatives to respond to an examination report which has raised relative grounds by arguing against the need for some or all of the earlier

right holders to be notified of their application. Applicants may also wish to avoid notifications being sent by the registrar as the result of earlier rights identified under section 5 by:

- removing the conflict of goods/services;
- obtaining consent from the proprietor of the cited mark(s);
- dividing the application.

## **20.1 Removing the conflict of goods/services**

This can be done by:

- (1) Positively limiting the goods/services of the application
- (2) Excluding the goods/services which are in conflict.

### **20.1.1 Positively limiting**

Many applications are filed with very wide specifications, and/or include terms which cover a wide range of goods/services. The applicant may not actually intend to trade in/offer all the goods/service which could be covered by such wide terms and therefore may be able to be more specific about his intended activities. It may then be possible to identify whether a clash remains when more detail is available. If so, the applicant could propose a limited specification to overcome the conflict and therefore the notification requirement. Such a limitation could take the form of a shorter list of the goods/services for which protection is required, or it could consist of a more precise description of the kinds of goods/services named in the original list.

#### **For example:**

- (a) Class 7 application: Spraying machines
- (b) Class 7 earlier right: Agricultural machines and parts and fittings therefor

Limitation required of (a): "...; all for use on vehicle construction lines."

#### **For example:**

- (a) Class 9 application: Electric cables
- (b) Class 9 earlier right: Speakers and parts and fittings therefor.

Limitation required of (a): "...all for use in providing an electricity supply to properties".

A positive limitation is more likely to overcome a notification requirement where the applicant has used wide or vague terms in the original specification of the application.

### **20.1.2 Exclusions**

When using an exclusion as a means of overcoming a notification requirement it is normally necessary for the applicant to ensure that all the goods and/or services considered to be both identical and similar to the earlier mark are excluded from the amended specification

submitted in respect of the application. Previously, where the respective goods or services fell in the same class, it was acceptable to word an exclusion in the following way: "...; but not including x or any goods/services similar to x". However, as it is now established that the similarity of goods/services is a somewhat elastic concept and but one factor in the global appreciation of all the relevant factors [**see the Section on similarity of goods/services for further details**], in the interests of legal certainty and proper administration, it will no longer be appropriate to deal with conflicts involving similar goods/services simply by excluding the identical conflicting good/service (X) from the specification of the later application and further excluding "...any goods/services **similar** to X".

Instead, the application will need to be amended to explicitly exclude not only all those goods/services that are considered to be identical, but also any descriptions of goods / services that are considered to be sufficiently similar that the mark applied for would give rise to a likelihood of confusion if it were used in respect of those goods/services in order to overcome a requirement to notify the earlier right holder.

Exclusions must be added to the specification of the relevant class of the application. If an exclusion is applied to resolve a conflict which arises because the applicant's description of goods/services (whilst relatively specific) still encompasses a product in the specification of an earlier conflicting mark, the exclusion applied to the applicant's specification of goods /services will have to exclude not only identical goods/services, but also similar goods /services (insofar as the similarities give rise to a likelihood of confusion on the part of the public). For example:

- (a) Class 9 application: Electrical machines for use in the Office
- (b) Class 9 earlier right: Modems

Exclusion required of (a): "...but not including modems or telecommunications or computing apparatus."

Where the clash is only in respect of similar goods/services, the applicant will need to identify the conflict and submit an amended specification where those (named) similar goods/services are excluded in order to overcome the notification requirement.

- (a) Class 12 application: Cycles
- (b) Class 12 earlier right: Motor land vehicles

Exclusion required of (a): "...; but not including motor cycles."

## **20.2 Obtaining consent from the proprietor of the earlier mark(s)**

This is specifically mentioned in the Act and covers any earlier mark raised as a notification in relation to the application under consideration. It is covered by section 5(5) which states:

*"Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or earlier right consents to the registration."*

The wording of this sub-section makes it clear that the registrar has no discretion to refuse to accept consent, even where the marks are identical and cover identical goods/services. If the proprietor of the earlier mark doesn't mind someone else using an identical mark then the Registrar will allow the later mark to proceed to publication without the requirement to notify the earlier right holder.

### **20.2.1 Letters of consent**

The basic principles to bear in mind are that the consent must be given by the owners of the earlier mark, that the application being consented to is clearly identified and that it is clear that consent to registration (and not just use) of the mark is being given.

The **minimum** requirements for a letter of consent are set out below:

- (i) The consent should always include the details of the person giving the consent i.e. name, position, the name of the company (if appropriate) and the letter should be signed by the person named.
- (ii) The application in respect of which consent is being given should be identified. The application number(s) is sufficient. It is not essential to include the trade mark - nor is it necessary to identify the earlier trade marks owned by the person giving consent.
- (iii) If the specification is not referred to it will be assumed that the specification applied for is acceptable to the party giving the consent. However, if a specification is referred to, and is narrower than the one filed, the application will only be accepted without a requirement to notify the earlier right holder in respect of the goods and services in conflict to which the consent applies.
- (iv) Letters of consent should be in English or, if in a foreign language, be accompanied by a certified translation.

### **20.2.2 Consent between Companies in the Same Ownership**

The registrar accepts the following simplified procedure in such cases, should the parties wish to pursue this option:

- (i) A general letter of consent may be provided between the two companies setting out the relationship between the two companies and confirming that they are prepared to consent to any trade mark applications made by the other party.
- (ii) On each occasion that a copy of the general letter of consent is filed, the applicant, or his agent, must supply a covering letter certifying that the general consent is still valid.

### **20.2.3 Payment for Consent**

If there is a conflict, the actions of the proprietor of the earlier mark in requesting payment for consent is not a factor which the registrar can take account of.

## **21 Honest concurrent use**

An order was passed in 2007 which means that Honest Concurrent Use can no longer be filed in support of an application where there is a requirement to notify the owners of earlier marks thought to be confusable with the applicant's mark.

Applicants may wish to place on file evidence of their earlier use of the mark applied for. If so, the application will not be held up in order for them to do so. It is anticipated that any evidence is more likely to be filed in response to any opposition the applicant may face after publication.

## **22 Dividing the mark (TM 12) as a method of overcoming a requirement to notify:**

This does not, strictly speaking, overcome the requirement for the registrar to notify the holders of the earlier mark, but where the goods/services which conflict can be pinpointed, these can be the subject of a division. This places them in a separate application to that of the remaining non-conflicting goods/services and allows the latter application to proceed without a notification requirement if the registrar is satisfied that the restricted goods/services included in that part of the division has overcome the conflict. The part which includes the goods/services which conflict must then be dealt with by one of the other means suggested here.

## **23 Unacceptable methods of overcoming notification requirements**

The following are NOT acceptable methods of overcoming notification requirements which are open to the applicant. Furthermore, they should not be suggested by the registrar as he is unaware of the commercial circumstances surrounding the use (or otherwise) of the earlier mark:

- Seeking revocation of the earlier mark : TM26(N) (non-use) or TM26(O)
- Other grounds
- seeking invalidation of the earlier mark: TM26(I)
- seeking assignment of the earlier mark or assigning the application to the proprietor of the earlier mark: (TM16),
- seeking full or partial surrender of the registered earlier mark: (TM22 or TM23)

If the applicant decides to try one of these methods, any request to suspend the application pending the outcome of the action should be refused and the case allowed to proceed to publication with Notification being sent to the earlier right holder. If exceptional circumstances are made known to the examiner, such as that **both** parties have requested the application be suspended, the request should be referred to the Team Leader for consideration. If acceptable, the application may be suspended to allow the action to be completed within a reasonable timescale. Notification would no longer be necessary in such a case.

In practice, it is expected that such actions are more likely to be pursued in response to an opposition being filed against the later application after publication. Allowing the later mark to proceed to publication would place both parties on an equal footing.

## **“NOTIONAL AND FAIR USE” and section 3(1)**

The concept “Notional and fair use” refers to how a trade mark may be used in the market-place and, consequently, will have a bearing on how distinctive the mark will be in its various modes of use. This will include use on business papers, on packaging and in advertising i.e. not just on more conventional means for carrying brands, such as swing tags and sew-in labels etc. A mark may lose trade mark significance when encountered in a promotional context rather than physically used on the goods. Care must be taken when examining a mark which “reads” into the goods or services.

“Notional and fair use” of a mark registered in block capitals will also include use in differing typefaces and in upper and lower case letters.

## **OBSERVATIONS (Post advertisement)**

Section 38(3) of the Act provides that, once an application has been published, any person may at any time before registration, make observations as to whether a trade mark should be registered.

Section 40(1) of the Act (as recently amended by The Trade Marks (Proof of Use) Regulations 2004) states that, where no notice of opposition is filed or opposition is withdrawn or decided in favour of the applicant, the registrar shall register the trade mark:

“...unless it appears to him having regard to matters coming to his notice since the application was accepted that the registration requirements (other than those mentioned in section 5(1),(2) or (3)) were not met at that time”.

Consequently, for applications published after 5 May 2004, objections based upon the existence of earlier conflicting trade marks can only be raised after publication in opposition or invalidation proceedings. Further references to “new matters” should be taken to exclude matters arising under sections 5(1)-(3) of the Act.

The registrar will consider any new matter which comes to his notice after publication which shows that the requirements for registration (other than those mentioned in section 5(1), (2) or (3)) were not met at the date of acceptance.

Where the circumstances suggest that the decision to accept the trade mark was the result of facts being misconstrued (such as evidence of use only showing use of a mark on a small proportion of the goods listed in the specification published), the registrar will consider the matter afresh.

Where an observer informs the registrar that a trade mark is descriptive or a sign commonly used in the trade, the observation will be regarded as a new matter. However, observations to the effect that the mark is generic will normally only be acted upon if the observer provides examples of customary use in the relevant trade (preferably by at least two other traders) or other supporting information (such as extracts from trade publications or reference works).

### **1 When a post advertisement observation is received**

The registrar will give an initial opinion on any new matter which comes to his attention as soon as possible after publication. The registrar will write to the applicant indicating whether (or not), taking account of the observations (which will be attached) he now believes that the registration requirements were not met when the application was accepted.

If the registrar takes the view that the registration requirements were not met at the date of acceptance, the applicant will be asked to comment upon the observation; but he need not reply before the opposition period is over.

A copy of the letter to the applicant, setting out the registrar's position in the light of the matter raised, will be copied to the party filing observations. It will be stressed that this is the registrar's provisional view and that it may change after considering the applicant's submissions or in the light of further observations.

### **2 Where the Application does not appear to have met the requirements for registration at the time of acceptance**

In addition to the applicant's usual right to make submissions to the registrar on the late objection, the applicant will also be entitled to amend the specification so as to overcome the objection or to submit (further) evidence in support of the application. If the specification of an application is restricted the amendment will be open to a further one month opposition period under rule 18. Unless the registrar's provisional assessment (that the application did not meet the requirements for registration at the time of acceptance) can be reversed or the objection otherwise overcome, the registrar will refuse to register the trade mark. However, notice of refusal will not be issued before the opposition period expires.

### **3 Applications allowed to proceed to registration**

If after considering the observations and any submissions from the applicant, the Registrar decides that the mark should be registered, he will proceed accordingly. The only further action open to the party filing observations will be invalidity proceedings under section 47 of the 1994 Act.

### **4 Applications also subject to other opposition proceedings**

Given that the registrar is not permitted to re-assess the acceptability of an application in the light of earlier trade marks (other than through opposition proceedings), it will often be the case that where the same application is subject to a late objection and opposition, the two will be based on *different* grounds. In these circumstances the registrar will seek to deal with the observations in parallel with any opposition proceedings. The registrar has no power to

extend the period for filing opposition and can only extend the time for filing a counterstatement in the circumstances set out in rule 13. Subject to these constraints, the registrar will consider an application from either party to stay the opposition proceedings to await the outcome of the late objection.

If the registrar decides to refuse the application, a notice of refusal will be issued. The outstanding opposition proceedings will then only have to be dealt with if the registrar's decision to refuse registration is reversed on appeal. If opposition is filed on the *same* grounds as observations, the registrar will, in general, suspend any further action on the observations until the opposition proceedings are concluded. The registrar cannot act in a quasi-judicial capacity, as a tribunal determining an opposition between two parties whilst pursuing (or rejecting) the same grounds of objection in *ex parte* proceedings with the applicant. However, where the parties jointly request it, the registrar may agree to stay the opposition proceedings in order to deal with the observation first.

## OFFENSIVE MARKS

Section 3(3)(a) of the 1994 Act states:

*“(3) A trade mark shall not be registered if it is -  
a) contrary to public policy or to accepted principles of morality”*

### 1 Types of marks

Marks which offend this section of the Act fall broadly into three types: those with criminal connotations, those with religious connotations and explicit/taboo signs. Marks offending public policy are likely to offend accepted principles of morality e.g. illegal drug terminology, although the question of public policy may not arise against marks offending accepted principles of morality, e.g. taboo swear words.

The term “public policy” in section 3(3)(a) is intended to deny protection to marks which could induce public disorder, or increase the likelihood of criminal or other offensive behaviour. Caution will always be required where marks appear to have criminal connotations, e.g. are associated with counterfeiting, illegal drugs or violence, or which exhibit racial, religious or discriminatory characteristics; or appear to be trivialising criminal activity, such as the word “stolen”. Examiners must decide whether such marks should benefit from or be denied the advantages of protection by intellectual property law, and they should refrain from erring on the side of caution if in doubt: “the right to freedom of expression must always be taken into account without discrimination under section 3(3)(a) and any real doubt as to the applicability of the objection must be resolved by upholding the right to freedom of expression, hence acceptability for registration”, [Jesus Trade Mark, \(BL/O/021/05\)](#) Geoffrey Hobbs Q.C., sitting as the Appointed Person, paragraph 6. The applicability of the objection must be decided objectively and non-discriminately, “Otherwise there would be a risk that the vociferousness of those with an axe to grind might illegitimately diminish the free speech rights of those whose views they oppose”, paragraph 8.

## **2 Objective assessment**

The term “accepted principles of morality” is somewhat harder to define than that of public policy and examiners should assess the degree of censure involved on the following basis (see [Ghazilian’s Trade Mark \(BL O/538/01\)](#)).

***Is the mark likely to cause offence which amounts only to distaste or is it likely to cause offence which would justifiably cause outrage?***

If a mark is merely distasteful, an objection under section 3(3)(a) is unlikely to be justified, whereas if it would cause outrage or would be likely significantly to undermine religious, family or social values, then an objection will be appropriate.

***How much outrage is enough to raise an objection?***

The outrage must be amongst an identifiable section of the public. A higher degree of outrage amongst a small section of the public will be sufficient to raise an objection, just as a lesser degree of outrage amongst a larger section of the public will also suffice.

***Is it enough that the examiner finds the mark offensive?***

No, but the fact that the examiner is offended will alert him or her to the need for caution. They may find it helpful to seek the views of others; for example, women may find some marks offensive, whilst men may find them distasteful, at the most. Similarly, the examiner may not be offended, but must have regard to the likelihood of an identifiable section of the public being offended.

***How should the assessment be made?***

In order to make this assessment, the examiner must be objective, not subjective. Objectivity means being neither out of date nor a trend setter; not setting some kind of moral standard but also not being insensitive to public opinion.

***Does it make a difference what the goods or services are?***

Examiners are entitled to rely upon their own knowledge of words and their own perception of how they may be used; for example, some goods are traditionally used as message carriers, e.g. T-shirts, caps, banners, badges, mugs, stationery items and bags.

The nature of the goods or services can influence the degree of likely offence. For example, a vulgar mark may be acceptable on some goods or services whereas a racially offensive mark will face a blanket objection, regardless of the goods and services. Where an obscene or crude mark is concerned, an objection will be certain where the goods or services are primarily or equally aimed at children, such as toys, games, confectionery, soft drinks etc. For goods intended for adults, such as alcohol and contraception, there may be less cause for concern.

## **3 Offence caused by misuse of religious symbolism**

There are a large number of different religious beliefs held and practised in the United Kingdom. Care should be taken when examining marks consisting of or containing elements which have a religious significance and which may provoke greater offence than mere distaste, or even outrage, if used to parody a religion or its values. Where a sign has a very sacred status to members of a religion, mere use as a commercial trade mark may be enough to cause outrage, e.g. “The power of the word **JESUS** to give rise to the relevant concern is not diminished by the nature of the goods in the different categories specified”, *Jesus Trade Mark*, paragraph 26. A mark which is likely to cause serious offence to a minority in the UK is susceptible to an objection under section 3(3)(a) of the Act.

#### **Examples of marks considered to be objectionable under section 3(3)(a).**

This is not a change of practice, but some of the examples have been changed to clarify current practice. Paragraph 39.4 has been replaced by the following:

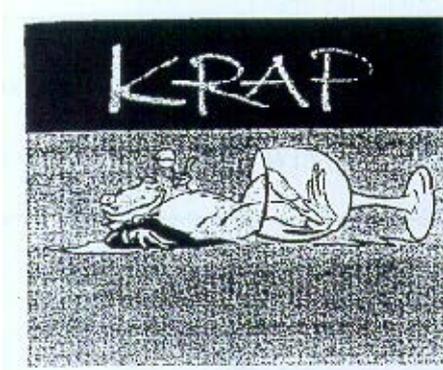
#### **4 Offensive Designs**

Objection should be taken under section 3(3)(a) to any mark which is likely to be offensive to religious susceptibilities or to public decency. Objections should be raised against explicit full frontal nudes and offensive (scandalous) back views. No objection should be raised to outline drawings or photographs of nude figures which are not explicit.

#### **5 Examples of marks considered to be objectionable under section 3(3)(a)**

<b>JESUS</b>	Contrary to public policy; offence is caused by the fact that an accepted religious value is likely to be undermined to a significant extent if this word is used as a trade mark.
<b>WHITE DOVE</b> <b>YOU DON'T NEED WINGS TO FLY</b>	Contrary to public policy as it would be seen as promoting drugs (White Dove is a nickname for a type of drug)
<b>SNUFF MOVIES</b>	Contrary to public policy as it would be seen as promoting pornography and murder.
	Contrary to accepted principles of morality in view of bad language.
<b>FOOK</b>	Contrary to accepted principles of morality as it is phonetically identical to, and visually similar to the taboo word FU*K in some regional dialects in the UK

#### **6 Examples of marks which have been *accepted* under 3(3)(a)**

<b>Ratz Piz</b>	This mark was for beer. Fairly mild bad language. Also the words are somewhat hidden as presented.
	Fairly mild bad language
<b>BREWERS DROOP</b>	Fairly inoffensive
	Fairly mild slang word
<b>EROTICA</b>	Not offensive
<b>OLD FARTS</b>	Relatively inoffensive
<b>BAD ASS BOYS FLY BAD ASS TOYS</b>	Relatively inoffensive

## ONUS (during examination)

Geoffrey Hobbs Q.C., acting as The Appointed Person, heard arguments in the *EUROLAMB* trade mark case (1997) RPC 279 about whether there is an onus on the registrar to justify objections to applications.

He decided that:

- a) *section 37 is neutral and there is no presumption in favour of or against registration;*
- b) *the combined effect of sections 37(4) and (5) is to eliminate the discretion that the Registrar previously had and to put him in a position of having to make a judgment, yes or no, upon the materials before him as to the registrability of a mark;*
- c) *there is nothing in the nature of a burden for the Registrar to discharge in order to justify his decision to refuse an application.*

## ORGANISATIONS (names of)

Words which describe the nature of an organisation are not excluded from registration under section 3(1)(c) of the Act, unless the words may also serve in trade to describe characteristics of the goods/services.

For example, “National Institute for the Disabled” describes an organisation not the services provided by it. Consequently, there is no objection under section 3(1)(c).

In contrast “National Breakdown” (for vehicle recovery and repair) is (or was) both the name of an organisation and describes characteristics of the services, i.e. breakdown services with national coverage. Consequently, these words are excluded from registration *prima facie* by section 3(1)(c).

As a rule of thumb, the inclusion of words such as “Institute”, “Foundation”, “Association” and “Society” will generally mean that the name describes the organisation rather than goods or services. However, care should be exercised not to mis-categorise words such as “National” and “Campaign” which can refer both to the organisation and the nature of certain goods and services.

Names of organisations that are free from objection under section 3(1)(c) are unlikely to be excluded under section 3(1)(b). However care should be taken in relation to the names of those organisations which are unlikely to be able to signify a singularity of trade origin.

For example, THE TAE KWON DO FEDERATION WALES, is a sign which is able to signify the services of a single undertaking. This is because the word FEDERATION is not the normal way traders would wish to describe the nature of their organisation. It is much more likely that they would describe their services as being provided by a SCHOOL or an ACADEMY. Therefore, given the practice of the trade coupled with the size of Wales, it is highly unlikely that relevant consumers would expect that there would be more than a single Tae Kwon Do Federation within Wales.

In contrast to this, THE HIGHER EDUCATION SCHOOL, is not a sign which will be able to signify the services of a single undertaking. Although the term is not a generic description for a type or class of educational establishment, the words HIGHER EDUCATION and SCHOOL are, separately, in common use within education. The words are therefore open to a section 3(1)(b)&(c) objection as the combination is descriptive of higher education services provided by a school. The average consumer would be unlikely to expect there to be only one higher education school in the UK.

In some cases, such as “Tourist Information Office”, it will be obvious that the name is not distinctive because there is one in most large towns. However, “National Association of Tourist Information Offices” is registrable. Unless the name describes the goods/services or is self-evidently commonplace, names which are descriptive of the nature of the organisation should be accepted on a “first come-first served” basis.

This is because the names of organisations are normally recognisable as signs which identify the source of the goods/services provided by those organisations. There is nothing in the Act which requires the registrar, on public policy grounds, to keep names such as “National Guild of Carpenters” free to use in future.

### **Printed and electronic publications**

Where the organisation concerned is well known there is sometimes a question about whether its name is distinctive for publications provided by it (as opposed to publications produced by others about it).

Where the organisation concerned is recognisable as being of a type that the public would expect to produce its own publications, there should be a presumption in favour of registration. The possibility that someone else may one day wish to write a book about the organisation is not sufficient to refuse registration. On the other hand, if there is evidence that there are already numerous publications about the organisation produced by other parties, the name should not be accepted as a trade mark for publications. In these circumstances objections should be raised under section 3(1)(b), (c) & (d) of the Act.

Similarly, if because of the nature or history of the organisation concerned, its name is wholly or primarily indicative of subject matter rather than trade origin (e.g. Special Air Service or Great Western Railway), objection under section 3(1)(b) & (c) will arise if the application covers publications.

[See also COMPANY NAMES]

## **PHONETIC EQUIVALENTS of objectionable words (misspellings)**

When considering applications which are in respect of words which are the phonetic equivalent of a descriptive or non-distinctive word(s), the appearance of the mark should be given weight. If the mark applied for is distinctive to the eye **as a matter of first impression**, then it cannot be said to be devoid of any distinctive character, at least where the goods or services are customarily selected by eye.

The registrar is aware that in case [C-363/99 Postkantoor](#), the ECJ stated at paragraph 99 of its decision that word only marks should be distinctive to the ear as well as the eye. However, the Court was not asked to rule on this point and this observation is therefore not binding upon us. Until the matter has been properly argued before the ECJ, the registrar does not propose to change his practice in order to conform to this observation, remaining consistent with the judgment delivered by the English Court of Appeal in the [Reed v. Reed case, \[2004\] EWCA \(Civ\) 159](#). The Court said that distinctive character must be assessed by reference to the visual and aural impact of the mark, basing its judgment upon the ECJ judgment in the [LTJ Diffusion SA v Sadas Vertbaudet SA case, C-291/00](#). So, a mark which is a gross misspelling of a descriptive mark, and therefore has visual distinctiveness, should

not necessarily be denied the benefit of trade mark protection, even though, aurally, it may appear to be identical to the descriptive word.

## **1 Common misspellings**

Whilst obvious misspellings of words may be acceptable because the average consumer would perceive the difference between the trade mark and the descriptive word, this may not be true when considering applications to register words which are commonly misspelt, or where the public are not used to seeing the word written down.

For example,

KOMMUNIKATION is clearly misspelt and the average consumer would immediately recognise the difference between this mark and the descriptive word COMMUNICATION.

When confronted with words which are often misspelt, the difference may not be perceptible as a matter of first impression. For example,

MILLENNIUM is often misspelt with either one "l" or one "n". The average consumer is therefore less likely to see any perceptible difference between the word and the mark MILENNIUM.

This may often be true where "double" letters appear in the middle of the word.

Informal words may be more often heard than written down e.g., CUPPA for tea. The average consumer may therefore be unsure of the correct spelling of the word because they will be unused to seeing it written down. Arguments that the word is misspelt will not assist in these circumstances.

Similarly, use of the "American" spelling of a word is less likely to be perceived as different to a normal presentation of the word. Even if the difference is noticeable, the average consumer is unlikely to suppose that the difference is on account of the fact that the American spelt version of the word is a trade mark. The average consumer is more likely to assume that the goods are originally from America or the person marketing them has used the American spelling of a description.

For example,

COLOR

Where there is a perceptible difference between the trade mark and those descriptive or non-distinctive terms, the trade mark will be generally acceptable. For example, the following examples of obviously misspelt or unusually presented descriptions are all acceptable:

DIETETIX for dietician services

NOWAX for ear drops (In this rather unusual case the conjoining of the two words NO and WAX, the individual words are submerged within the apparent invented word NOWAX)

KA for cars

SERIAL for breakfast cereals

## **2 Misspellings used in trade**

Care should be taken however where misspellings are commonly used, for example "XTRA" instead of EXTRA and 'N' instead of AND. Such variations will not confer distinctiveness.

Where misspellings or abbreviations are commonly used in the trade, the marks would still be open to objection. For example:

CUT 'N BLOW DRY for hairdressing.

DRIVE THRU for restaurant services.

STARTER PAK for beginner packages.

FRESHLY PREPARED 2 GO for takeaway pizzas.

BEST 4 YOU

## **3 Text messaging abbreviations**

With the advent of sending text messages via mobile phones, a virtually completely new language has evolved, centred on using abbreviations rather than the full word. Indeed there are dictionaries available which detail the meanings of such abbreviations. Further, goods and services are now commonly promoted through advertisements in the form of text messages delivered to mobile phones.

The average consumer will, or it is reasonably foreseeable that they will in the future, see direct descriptions in the form of text messages as being a usual way of designating goods or services provided to the general public. Consequently applications consisting of this abbreviated language are open to objection where the equivalent full word(s) would be objectionable. For example:

LRN 2 TXT for telecommunications or education services would be objectionable as it directs the consumer to the subject matter, namely, Learn to Text.

## **4 Goods and Services customarily ordered by word of mouth**

Most goods and services are these days usually selected by eye. However, in some cases goods and services are still ordered by word of mouth e.g. food and drink, takeaway services, and taxi services. Misspelt descriptions may not work as trade marks for goods and services of this type. Consequently, applications to register trade marks consisting of

misspelt words for these types of goods/services will be examined critically if there is no perceptible difference to the ear between a description and the mark.

## **PRECEDENTS**

The individual circumstances surrounding each application are paramount. 'Precedents' cannot be decisive.

The comments made in the MADAME case (1966) RPC page 545 were re-stated by Mr Justice Jacob in the TREAT trade mark case (1996) RPC page 25:

*"In particular the state of the Register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. Madame TM and the same must be true under the 1994 Act."*

## **PRIORITY CLAIMS - International Convention (I.C.) priority claims**

Under section 35, a person who has filed an application for protection of a trade mark in a country party to the Paris Convention has a right of priority during a period of six months from the date of filing of the foreign application. The effect is that if, within that period, that person files an application to register the same trade mark under the 1994 Act, that application takes precedence over another application which has an earlier filing date, but a later priority date. Similarly, section 36 refers to countries which are not a party to the Paris Convention, but with whom the UK has an agreement for reciprocal protection of trade marks. A priority claim may relate to all the goods/services covered by an application or just some of them - perhaps a whole class, or maybe just one item within a 45-class application. There may also be several different partial priority claims included within an application covering *different* goods or services (there can only ever be one priority claim for particular goods/services).

### **1 Claiming priority and priority documents**

All priority claims should be included on the TM3 at the time the application is made (rule 6(1)). Each claim has to be listed and must give details of the number accorded to the overseas application, the country from which priority is claimed and the date of filing.

There is no longer a need for the applicant to submit priority documents to support the claim unless requested to do so.

### **2 Multiple priority dates**

The earliest valid I.C. claimed on the TM3 will be recorded for search purposes. The claim will only be examined in greater detail if the date claimed makes any difference when considering earlier marks for notification purposes.

### **3 Earlier rights by virtue of a priority claim**

Where a later filed application is identified in the search with a priority date which is earlier than the filing date of the application being examined and is considered to be confusingly similar, then it should be raised as an earlier right in the examination report.

If following examination, it is proven that the priority claim is for only part of the specification and later filed application's rights do not exist in the conflicting goods, then the notification can be waived.

### **4 Marks with the same priority/filing date**

The Act is very specific about *earlier* marks, but does not mention marks that may have the same filing (or priority) date. If, as part of the search for notification purposes, the examiner identifies a similar mark with the same filing (or priority) date, the parties will not be cross-notified. Both marks will be advertised in the Journal and the two parties will have to determine any conflict by way of opposition proceedings. If there is no opposition to either application they will both proceed to registration. Similar considerations will apply where two parties have the same priority date by virtue of an International Convention (I.C.) date.

## **PRIOR RIGHTS**

### **1 General Principles**

In the case of a mark which has been accepted on the basis of factual distinctiveness in the UK, the registrar will not routinely require applicants to prove that the mark is distinctive for the purposes of a subsequent application to register a later mark, incorporating the earlier mark, for the **same** goods/services.

Where the earlier mark is an OHIM mark or an international registration designating the EU, which has proceeded on the basis of factual distinctiveness, the registrar is not bound by OHIM's decision and will, in any event, require sight of the evidence of distinctiveness in order to assess what, if any, weight should be attached to the decision of OHIM.

In all other cases, such as where the applicant applies to register a mark which consists of, or contains, a mark which is **similar** to an existing registered trade mark in its name for the same goods/services, or where the applicant applies to register an existing registered mark for goods/services which are **similar** to those for which it is already registered, the earlier registration will have whatever value it provides as a precedent.

### **2 Reasons**

The proviso to section 3(1) of the Act makes it clear that a trade mark which is excluded from *prima facie* registration by section 3(1)(b) - (d), may nevertheless be registered if:-

*"...before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it"*

The final words of the proviso make it clear that the question of factual distinctiveness must be determined by reference to the *use made* of the trade mark. In the TREAT case (1996 RPC 281) Jacob J [as he then was] criticised the registration of the TREAT mark for 'dessert sauces and syrups' when the evidence of use filed only showed use of the mark on 'ice cream toppings'.

The words "*acquired a distinctive character as a result of the use made of it*" therefore mean the use made of the mark in relation to the goods/services for which it is proposed to be registered. In this connection it should be noted that the infringement rights extend to the use of the same or similar marks in respect of similar goods/services, provided that there exists a likelihood of confusion.

### **3 Detailed Practice**

#### **3.1 New trade mark includes existing registered mark - same goods/services**

A later trade mark which is *prima facie* objectionable under section 3 of the Act will not normally face an official objection where the trade mark proposed for registration *includes*:

- an earlier trade mark which is already registered in the UK or an international registration (UK) which is protected in the UK in the applicant's name **and which proceeded on the basis of distinctiveness acquired through use;**

AND

- which is registered in respect of ALL the goods/services covered by the later application;

PROVIDED THAT the earlier trade mark is *not*:

- (i) *de minimis* in the later mark; OR
- (ii) included in the later mark in such a way as to take away any distinctive character the earlier mark had when viewed alone.

For example, if an applicant already has a registration of EXETER (for ties) it would be appropriate to accept a subsequent application to register EXETER TIES or EXETER'S TIES (for ties). However, it would not follow that CHOICE COMPUTERS has acquired a distinctive character (for computers) because an applicant had established that PC CHOICE had acquired a distinctive character (also for computers) through use. Where all the elements in a trade mark are non distinctive, the distinctive character is to be found in the specific combination of the elements. CHOICE COMPUTERS is not therefore a minor variation on PC CHOICE. Nor would it be appropriate to accept an application to register KEEPS YOUR BABY DRY on the basis that the applicant had a existing registration of

BABY-DRY because any distinctive character that BABY-DRY has is lost when incorporated into the longer phrase.

### **3.2 Same mark for goods/services which are similar to those listed in the new application**

In all cases the applicant must file evidence showing use of the mark applied for, before the date of the application, **in relation to the goods/services listed in the application.**

However, it is recognised that marks that are factually distinctive for one range of goods / services can more quickly become distinctive for similar goods/services.

Accordingly, in assessing whether the evidence the applicant has filed on the application under examination is sufficient to show that the mark has acquired a distinctive character for the goods/services listed in the application, account may also be taken of any evidence filed on earlier applications for the same or closely similar trade mark for the same or similar goods/services.

It does *not* follow that a trade mark will *automatically* be accepted for additional goods / services simply because they are similar to the goods/services for which the mark is already registered. Every case should be decided on its own merits taking particular account of the strength of the *prima facie* objection to the latest application.

Where the mark is *even less* distinctive for the goods or services in the latest application compared to those goods/services for which it is already registered, evidence of factual distinctiveness filed in respect of the earlier registration will not assist the latest application. For example, an application to register TAX ADVISOR as a trade mark for 'financial advisory services' will not be assisted by evidence from an earlier case showing that the mark had become distinctive as a trade mark for 'periodical publications relating to finance' - even if these goods are similar to 'financial advisory services.'

## **4 Journal Entries**

Where the later mark **incorporates, or differs only in ways which do not alter the distinctive character of**, the earlier mark and the goods/services are **the same as, or more restricted than**, those of the earlier mark, the registrar will publish entries in the Journal advertising acceptance because of "prior rights". The registrar will no longer use this clause in other circumstances.

Where evidence from an earlier registration is taken into account, the Journal clause used will be the usual:

"Proceeding because of distinctiveness acquired through use".

## **5 All relevant evidence to be made available for public inspection**

Where the registrar agrees to take account of evidence from earlier applications/registrations in the applicant's name, the applicant will be asked to agree (in writing) that the evidence

filed on the earlier case be copied and regarded as having been filed on the latest application. This means that the evidence will be made available for public inspection.

## PROTECTED WORDS and other Signs (Reserved and Prohibited Words)

A range of protected signs which present prima facie grounds for the refusal of trade mark applications on the so-called absolute grounds specified in section 3 of the Trade Marks Act 1994. There are 4 separate types of protected signs on the Registry's database:-

Protected under	Coverage	Objection relevant in
Article 6 <sup>ter</sup> of the Paris Convention. Specified in the Trade Marks Act 1994 in s.57 and 58	Names, emblems, titles, symbols etc of other signatories to the Paris Convention Names of International organisations	All classes
Article 3 of the procedure for the selection of International Non-Proprietary Names	Veterinary substances, Pesticides, Pharmaceutical preparations and substances	Class 5
Regulations 510/2006 and 1234/2007	Protected Geographical Indications (PGI) Protected Designations of Origin (PDO) Geographical Designations of Origin for Wines and Spirits	Classes 29, 30, 31, 32 & 33
Geneva Conventions Act 1957. <i>Geneva Conventions Amendment Act 1995</i> Olympic Symbol, etc (Protection) Act 1995. <i>London Olympic Games and Paralympic Games Act 2006</i> Anzac (Restriction on Trade Use of Word) Act 1916	Signs protected under National Legislation	All classes

### 1 Objections based on Protected Signs

For a protected sign in any category to be the basis of an objection, the mark applied for should generally consist of, or contain, an identical sign or a sign which is plainly an imitation of the protected sign. However, the fact that the mark contains certain types of protected sign may not require an objection to be raised if certain conditions are met (see below).

## 2 Marks Protected under Article 6ter of the Paris Convention or WTO Agreement

The practice in relation to National symbols has been reassessed in light of the comments made in the recent judgement by the ECJ in the *American Clothing Associates NV* case [C-202/08P](#) (RW and maple leaf device). This case provides guidance on the different functions of National emblems and trademarks and the way they are treated in law.

### 2.1 National Symbols

National symbols will be taken to mean armorial bearings, flags, other State emblems, official signs and hallmarks which have been notified to the World Intellectual Property Office (WIPO) and included in the [Art 6ter](#) database of marks. Flags of States are protected under Article 6ter without any need to be incorporated in the Art 6ter database of marks.

National Symbols are covered by s. 57 of the Trade Marks Act 1994 (as amended):

Specifically s.57 (1), (2) and (4):

(1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention or the WTO agreement shall not be registered without the authorisation of the competent authorities of that country.

...

(4) the provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

### Purpose of a National Symbol

The *American Clothing Associates NV* case considered the difference in function between a National sign and a trade mark. A National symbol will indicate a State and is a presentation of its sovereignty and unity, whereas a trade mark should guarantee the identity of origin of the marked product to the consumer, without any possibility of confusion.

This difference in function has an effect on the way the law treats trade marks and National symbols. These differences, as they apply in the UK, are summarised in the following table:

Trade Mark	National Symbol
Obtained by registration	States communicate emblems to be protected to WIPO (Flags are protected without notification to WIPO)
Protection is limited in respect of certain determined classes of goods and services	Are entitled to general protection independent of specific goods and services
Can be declared invalid and their proprietor can be deprived of his rights	Cannot be declared invalid and their proprietor cannot be deprived of his rights
Duration of their protection can be limited	Duration of their protection is not limited
A likelihood of confusion test exists in the case of similarity between marks and between goods or services	Paris Convention makes no reference to such a test and protection is irrespective of goods and services
Protection of an earlier registration requires action by the proprietor of the trade mark	Absolute grounds for refusal operate <i>ex officio</i>

Consequently, the scope of protection is very different as between a trade mark and a national symbol under the Paris Convention. The protection afforded to the latter is very broad in that it prohibits the use of a National symbol as a trade mark and also as an element of a trade mark, in respect of any goods or services.

Though the judgment also makes clear that the reproduction of the symbol need not be an exact (as is pointed out, this is the purview of s. 57(1) and (2)), it is also clear that not all such will be caught by Article 6ter. The imitation must be perceived as being so by the *relevant public from a heraldic point of view*.

### **Practice in relation to National Symbols**

The guidance provided in the ‘*American Clothing*’ judgement is not wholly clear on what is regarded as ‘from a heraldic point of view’ as this infers a certain amount of specialist knowledge to understand the heraldic expression of the symbol. At para 48 it states:

*“...the prohibition of the imitation of an emblem applies only to imitations of it from a heraldic perspective, that is to say, those which contain heraldic connotations which distinguish the emblem from other signs. Thus, the protection against any imitation from a heraldic point of view refers not to the image as such, but to its heraldic expression. It is therefore necessary, in order to determine whether the trade mark contains an imitation from a heraldic point of view, to consider the heraldic description of the emblem at issue”.*

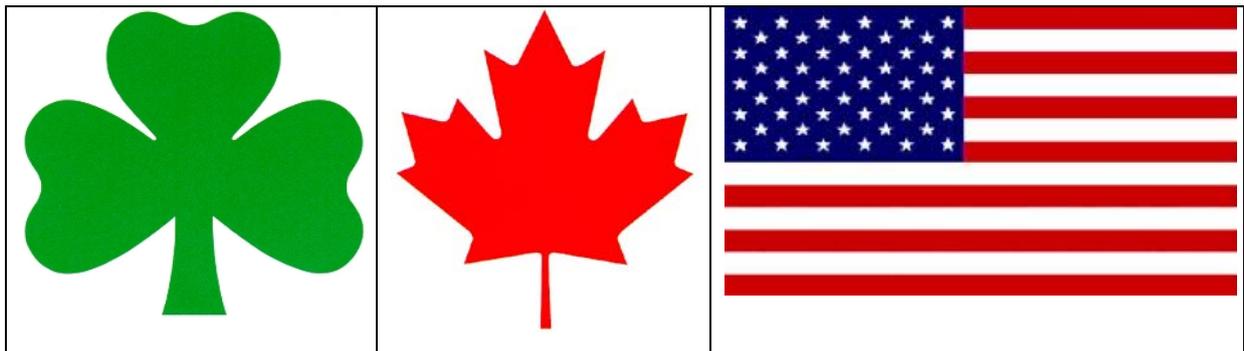
But this specialist heraldic knowledge is qualified by its perception by the average consumer. Para 51 states:

*“So far as the expression ‘imitation from a heraldic point of view’ in that provision is concerned, a difference detected by a specialist in heraldic art between the trade mark applied for and the State emblem will not necessarily be perceived by the average consumer who, in spite of differences at the level of certain heraldic details, can see in the trade mark an imitation of the emblem in question”.*

This is taken to mean that the actual comparison is made against how the symbol would normally be reproduced from its heraldic description as this is the representation with which the average consumer would be most familiar. In other words, if a sign substantively departs from its traditional depiction, it will be probably be acceptable.

However, the overall impression of the mark or the prominence of the protected sign within the mark is not a determining factor; an objection under Section 3(5) and 4(3) will be raised in all cases where an application contains a protected National symbol.

In an effort to illustrate this in context the following examples are offered as a guide to the practice. Here are three well known protected national symbols:



In the examples, below, : Examples 1 and 2 contain a normal representation of the national symbol and therefore an objection would be raised. Examples 3 and 4 contain sufficient stylisation that the average consumer would not take it to be an imitation of the protected symbol and objection under s. 3(5) and s.4(3) would not be appropriate.

Example 1 - Not Acceptable

My Lucky Star 

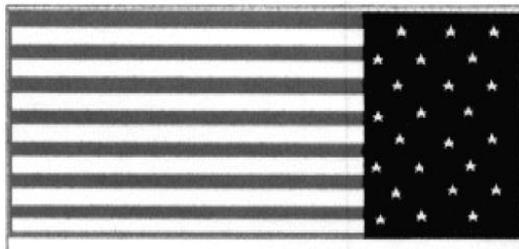
Example 2 - Not Acceptable



The words 'My Lucky Star' are prominent in the mark, but the presence of the protected national symbol, though small, is sufficient to warrant an objection under s.3(5) and s4(3).

The device element is not an exact representation of the national symbol, but it is an imitation from a heraldic point of view, and would be taken by the average consumer to be the National emblem. Again, the mark would face an objection s3 (5) and s4 (3). The presence of the letters RW makes no difference to this assessment.

Example 3 - Acceptable



This is a stylised version of the American Flag but it contains sufficient differences that the average consumer would not take it to be an imitation of the protected national symbol.

Example 4 - Acceptable



This is an acceptable trade mark; although a maple leaf, it is clearly not an imitation of the Canadian emblem as it is too naturalistic. It is not how the average consumer would view a traditional expression of the maple leaf emblem.

## National Flags

Flags of convention countries are protected irrespective of whether they are included in the Article 6ter database at WIPO. Where a mark consists of or contains a representation of a national flag an objection under s 3(5) and s 4(3) would be appropriate. However where the mark contains a stylised representation of the colours of the national flag, as in examples 5, 7 and 8 then an objection under s.3(5) and s.4(3) would not be raised.

Example 5 - Acceptable



Example 6 - Not Acceptable



<p>Although the background contains the colours of the German flag, this is clearly not an imitation from a heraldic point of view as its heraldic content – and the normal expression thereof - is very different.</p>	<p>Though the flag is “furled” the effect of this is not enough to mitigate what amounts to a representation of the French flag from a heraldic point of view and an objection under s.3(5) and s(4 ) would be taken.</p>
<p>Example 7 - Acceptable</p>  <p>Contains the colours of the Italian flag but only alludes to the same.</p>	<p>Example 8 – Acceptable</p>  <p>This is not an imitation from a heraldic point of view of the American flag – the image is too distorted and incomplete. No objection should be taken.</p>

## Overcoming Objections

Objections taken under s. 3(5) and s. 4(3) maybe overcome by obtaining the consent of the relevant authority to the use and registration of the symbol.

## 2.2 Symbols of International Intergovernmental Organisations

Pursuant to s. 58 of the Trade Marks Act, symbols of International intergovernmental organisations will be taken to mean armorial bearings, flags, other emblems which have been notified to the World Intellectual Property Office (WIPO) and included in the [Art 6 ter](#) database of marks. The section also applies to imitations of the same from a heraldic point of view. However in contrast to the provisions of s.57 where protection is independent of goods and services, s.58 allows for registration of a trade mark where the use is not as to suggest to the public that a connection exists between the organisation and the trade mark.

For example: WIPO (World Intellectual Property Office) is a protected emblem whose core activities centre on the field of Intellectual Property Rights. If an application for the mark ‘WIPO’ was made in respect of ‘Cleaning services’ in Class 37’, it is unlikely that the two organisations would be connected in the minds of the average consumer. However if the application for the mark ‘WIPO’ covered ‘legal services’ in Class 45 then it is very likely that the average consumer would assume that an association would exist and an objection should be raised.

The test in relation to protected symbols of international intergovernmental organisations is the same as that for national symbols and the Court of First Instance found in [Case T-127/02](#), (ECA and device) when considering a mark containing a representation with the appearance of a circle of 12 stars that it was not decisive that the stars and background were not identical, but that the relevant public may have the impression that it is an imitation, from a heraldic point of view, of that circle. The application in that case is reproduced as the first example in the table below, which provides an indication of what the Office is likely to find acceptable.

Protected Symbol in this case is the flag of the Council of Europe:



Example 1 – Not Acceptable



The mark is presented in black and white with the stars shown in a circle on a dark background. This is regarded as an imitation of the protected symbol and an objection under s. 3(5) and s.4(3) is appropriate

Example 2 - Acceptable



The stars are presented in a circle but are of differing colours and are presented on a white background. The image does not give the impression that it is a heraldic imitation of the protected emblem.

Example 3 – Not Acceptable



The mark contains 12 yellow 5 pointed stars in a circle on a blue background. This is a imitation of the protected emblem and an objection would be raised

Example 4 - Acceptable



Here the mark contains a partial representation of the Union flag and part of the EU flag. Here the heraldic description of the mark would not be the

	<p>same as that of the protected symbol and therefore it cannot be regarded as an imitation from a heraldic point of view. The Union flag being a national flag of the UK is not covered by Article 6ter and is acceptable.</p>
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In relation to Protected Words, the following examples may be helpful:

CCF – This is the abbreviation for the Commission for the Control of Interpol’s Files

ERA – This is the abbreviation for the European Railway Agency

The examples shown below consist of the same letters as the protected words and consideration of the goods and services is required to assess whether there is likely to be a connection with the international intergovernmental organisation concerned.

<p>Example 6 - Acceptable</p>  <p>Class 6: Locks and metal hardware:</p> <p>Given the area of trade of the applicant there is unlikely to be an assumption of a connection between the protected emblem and the applicant.</p>	<p>Example 8 - Not Acceptable</p>  <p>Vehicles in Class 12; repair of vehicles in Class 37.</p> <p>In this case it is likely that the average consumer would assume there is a connection between the applicant and the European Railway Agency because they are operating in the same field. The stylisation of the letters is not sufficient to avoid the likelihood of a connection between the two marks.</p>
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**Wording of objections – Marks protected under Article 6ter or WTO Agreement**

*The application is not acceptable: there is an objection under section 3(5) and section 4(3) of the Act because the mark consists of, [or contains,] a specially protected emblem under the provisions of Article 6ter of the Paris Convention (See attached printout).*

**Overcoming Objections**

The objection may be overcome by obtaining the written consent of the competent authority of the country/organisation concerned to the proposed registration of the mark.

### **3 International Non-Proprietary Names**

These are received from the British Standards Institute (BSI) or World Health Organisation (WHO) as a proposed name. The name is searched against the Office's database of trade marks and the Registrar has the opportunity to raise objections (if appropriate), before the name is protected. Non-proprietary names are generic names for specific substances in the fields of (a) veterinary substances (b) pesticides and (c) pharmaceuticals.

#### **Objections in Class 5**

Applications in Class 5 which consist of a mark identical to (or a trivial variation on) a protected sign in this category are open to objection under section 3 (1)(b), (c) and (d) where the specification contains: pharmaceutical substances, veterinary substances or pesticides.

Where the trade mark merely contains a reserved word there is unlikely to be an objection. In other words where the protected sign is used in combination with a house mark or another distinctive element e.g. Tesco or Boots, the application would be considered *prima facie* acceptable.

#### **Wording objections**

*The application is not acceptable: there is an objection under section 3(1)(b) (c) and (d) of the Act because the mark consists exclusively of the word "paracetamol", being a generic term for a pharmaceutical product.*

Where the application consists exclusively of a protected sign in this category the objection cannot be overcome

### **4 Protected Geographical Indications - Section 3(4) (also 3(1)(c) and 3(3)(b))**

Section 3(4) of the Act states:

*"A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community Law."*

There are three EC Regulations which impact upon the examination of geographical indications under section 3(4) of the Act. These are:

Regulation 510/2006 protects geographical indications and designations of origin in relation to agricultural products and foodstuffs;

Regulation 1493/99 protects those used in relation to wines and Regulation 1576/89 protects those used in relation to spirits.

Protected Geographical Indications are terms used in the course of trade to establish an association between a place and certain goods in order to evoke a quality standard and to

benefit from the region's good reputation; for example, Roquefort for cheese and Champagne for sparkling wine.

A Protected Geographical Indication constitutes a collective right, subject to certain conditions, to all those trading in the goods of the geographical area concerned. In order to avoid misappropriation, counterfeiting and misuse, international treaties and national law protect such indications.

## **5 Goods covered by Regulation 510/2006**

The Regulation covers:

“Beer; beverages made from plant extracts; bread, pastry, cakes, confectionery, biscuits and other baker's wares; cheeses; essential oils; oils and fats; fresh fish, molluscs and crustaceans and products derived from them; fresh meat and offal; fruit, vegetables and cereals; meat based products; natural gums and resins; other agricultural products; other products of animal origin, for example eggs, honey.”

A full list of the current goods for which protection has been granted is available at [http://ec.europa.eu/agriculture/foodqual/protec/types/index\\_en.htm](http://ec.europa.eu/agriculture/foodqual/protec/types/index_en.htm)

## **6 Object in Classes 29, 30, 31, 32 and 33**

Marks consisting of or containing a Protected Geographical Indication (PGI) or a Protected Designations of Origin (PDO) cannot be registered in respect of products which are not entitled to use the PGI/PDO but which are of the same category of goods. For example, a PGI/PDO for milk cannot be registered as a trade mark for cheese.

If an application for a trade mark (other than a certification or collective trade mark) consists of a protected sign and covers the same product for which the Geographical Indication is protected, objection should be taken under section 3(1)(b) and (c), section 3(3)(b) and section 3(4) of the Trade Marks Act. If the mark contains a PGI/PDO, e.g. a label mark including a trade mark and a PGI or PDO e.g. the words “Dorset Blue” (which is a protected geographical indication for cheese), and the application covers the same product [in this case cheese], then objections under section 3(3)(b) and 3(4) would be appropriate.

## **7 Wording Objections**

Section 3(1)

*The application is not acceptable: there is an objection under section 3(1)(b) and (c) of the Act because the mark consists exclusively of the word “Dorset blue” being a protected designation of origin for e.g. Dorset blue cheese, being a blue cheese originating in Dorset.*

Section 3(3)(b)

*The application is not acceptable: there is an objection under section 3(3)(b) of the Act because the mark contains or consists of the geographical indication Dorset Blue, which is liable to deceive the public in the U.K. if used in respect of cheese products other than cheese products entitled to the geographical indication Dorset Blue.*

## Section 3(4)

*The application is not acceptable: there is an objection under section 3(4) of the Act because the mark contains or consists of the protected geographical indication Champagne and its use in relation to wines (or products of the same type), other than wines entitled to use the protected geographical indication, would be contrary to law.*

## 8 Overcoming Section 3 Objections

Where the mark consists of a Geographical Indication, the section 3 (1) objection cannot be overcome.

Where the mark contains a protected Geographical Indication in combination with a distinctive sign, the objections under section 3 (4) and section 3 (3) (b) can be overcome by limiting the specification to cover only those goods entitled to use the geographical indication in question.

*e.g. Wines entitled to the geographical indication Champagne.*

If an objection is justified under section 3(4) of the Act (the mark contains a protected geographical indication for relevant goods, or a statement of the geographical origin of a wine or spirit) an objection should be raised under section 3(4) and maintained until the specification is limited accordingly. This is required even where the applicant already has a similar mark registered for the goods or similar goods without a geographical restriction.

## 9 Signs Protected under National Legislation

These include: The Red Cross; *The Civil Defence Sign*; the Olympic word, the Olympic symbol; the *Paralympic word, the Paralympic symbol*; Anzac.

### 10.1 Red Cross

The red cross symbol, words "Red Cross", the red crescent symbol, the words "red crescent" and the red lion and sun symbol, the words "red lion and sun" and the Swiss heraldic emblem are all protected under section 6 (1) of the Geneva Conventions Act 1957.

Given the special significance of these symbols use of the above within the UK must be authorised by the Ministry of Defence.

Trade mark applications consisting of or including the following are open to objection under sections 3(4) and 3(5) of the Trade Marks Act 1994 for all goods and services:

(a) the words Red Cross, Geneva Cross, Red Crescent or Red Lion and Sun;

(b) phonetic equivalents of the words Red Cross, Geneva Cross, Red Crescent or Red Lion and Sun, for example applications such as 'Redd Kross' or 'Red Kresent' or 'red lyon and son', or a visual combination of a word and a symbol

e.g. Red + or Red X.

(c) the emblem of a red cross with vertical and horizontal arms of the same length on, and completely surrounded by a white ground;



(d) the emblem of a red crescent moon on, and completely surrounded by, a white background;



(e) the lion and sun emblem in red on, and completely surrounded by, a white back ground, that is to say, a lion passing from right to left of, and with its face turned towards the observer, holding erect in its raised right forepaw a scimitar, with, appearing above the lion's back, the upper half of the sun shooting forth rays;



(f) any design consisting of a white or silver cross with vertical and horizontal arms of the same length on and completely surrounded by, a red back ground, being the heraldic emblem of the Swiss Confederation, or any other design so nearly resembling that design as to be capable of being mistaken for that heraldic emblem;



g) any design so nearly resembling any of the emblems specified above as to be capable of being mistaken for, or, as the case may be, understood as referring to, one of those emblems.

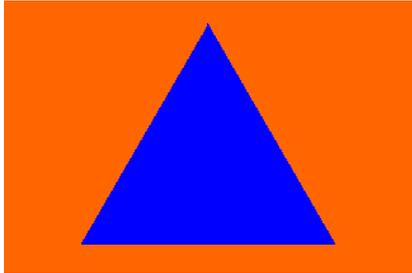
## 10.2 Cross devices not in Red and White

Applications made in black and white, which contain the device of a cross, or a crescent moon or lion and sun, will not attract objection. However when such applications are received, examiners must ensure that a relevant paragraph explaining the protection of such symbols (found on the TM practice Sharepoint resource) is included as part of the examination report.

Green crosses on a white background are generic for pharmacy and medical goods and services. White crosses on green backgrounds are generic for first aid goods and services, and are based on European Union legislation.

### 10.3 International Civil Defence sign

The International civil defence sign consists of an equilateral blue triangle completely surrounded by an orange background, as illustrated below;



Use of the above sign within the UK requires the consent of the Secretary of State for Defence under the provisions of section 6(1) of the Geneva Conventions Amendment Act 1995.

Use of any sign capable of being mistaken for the above sign within the UK requires the consent of the Secretary of State for Trade, under the provisions of section 6(2) of the *Geneva Conventions Amendment Act 1995*. (Responsibility for such approval has been devolved to The Office). However it is unlikely that approval will be given.

Trade mark applications consisting of the above or containing any sign so nearly resembling the sign as to be capable of being mistaken for the sign are open to objection under sections 3(4) and 3(5) of the Trade Marks Act 1994 for all goods and services:

### 10.4 Olympic and Paralympic Symbol or Word

The Olympic and *Paralympic* symbols:



Olympic motto (*Citius, Altius, Fortius* which means Faster-Higher-Stronger) and Paralympic motto (Spirit in Motion) and the words Olympic(s), Paralympic(s), Olympian(s), Paralympian(s), Olympiad(s) and Paralympiad(s) are protected under the Olympic Symbol, etc (Protection) Act 1995 as amended by the *London Olympic Games and Paralympic Games Act 2006*, which came into force on 30 March 2006. Protection extends to signs which are sufficiently similar to the Olympic/Paralympic Symbol the Olympic/Paralympic motto or the words Olympic(s), Paralympic(s), Olympian(s), Paralympian(s), Olympiad (s)

and Paralympiad(s) as to be likely to create in the public mind an association with those signs. Where an application is made consisting of or containing the Olympic/Paralympic symbol or words, examiners should object under section 3 (4) and section 3(5) of the Trade Marks Act.

### **10.5 London Olympics Association**

The following group of words are listed under the London Olympic Games and Paralympic Games Act 2006, in the context of a provision prohibiting the unauthorised association with the London Olympics

#### *Group 1*

*Games*  
*Two Thousand and Twelve*  
*2012*  
*twenty twelve*

#### *Group 2*

*Gold*  
*Silver*  
*Bronze*  
*London*  
*Medals*  
*sponsor,*  
*Summer*

The use of any combination of words listed in Group 1 with those listed in Group 2 used in connection with any trade, business or profession, without the permission of the London Olympics Association, may lead to an unlawful association, but the words are not protected as such, and there are various defences available which protect justified association with the games, consequently it is not appropriate to object to a trade mark application simply because it includes a combination of these words of special interest.

### **10.6 Anzac (Australian and New Zealand Army Corps)**

Anzac is protected under the Anzac (Restriction on Trade Use of Word) Act 1916. An offence is committed if the word ANZAC is used in connection with any trade, business or profession, without the authority of The Secretary of State for Trade and Industry. Where an application is made consisting of, or containing, the word Anzac, examiners should object under section 3 (4) and section 3(5) of the Trade Marks Act.

### **10.7 Wording of objections in respect of signs protected under National Legislation**

*The application is not acceptable: there is an objection under section 3(4) and section 3(5) of the Act because the mark consists of, or contains, a controlled representation, whose use is prohibited in the United Kingdom by rule of law. (The relevant law must be identified e.g. the*

Olympic Symbol etc (Protection) Act 1995 *as amended by the London Olympic Games and Paralympic Games Act 2006*)

## **10.8 Overcoming objections in respect of signs protected under National Legislation**

**Red Cross** - Objections raised for marks in this category cannot be overcome if they are shown in the colours red and white.

**Olympic/Paralympic symbol, etc.** - An objection may be overcome by obtaining the written consent of the British Olympic Association which is the proprietor of the Olympics Association Right.

**ANZAC** - An objection may be overcome by obtaining the written consent of the Secretary of State for Trade & Industry.

## **11 Prohibited words**

### **11.1 Tobacco Descriptions in Trade Marks**

The Tobacco Products (Manufacture, Presentation and Sale)(Safety) Regulations 2002 state:

*11.-(1) No person shall supply a tobacco product the packaging of which carries any name, brand name, text, trade mark or pictorial or any other representation or sign which suggests that the tobacco product is less harmful to health than other tobacco products.*

This implements Directive 2001/37/EC of the European Parliament which states at paragraph 27:

*“The use on tobacco product packaging of certain texts, such as ‘low-tar’, ‘light’, ‘ultra-light’, ‘mild’, names, pictures and figurative or other signs may mislead the consumer into the belief that such products are less harmful and give rise to changes in consumption.”*

### **11.2 Wording objections in respect of words prohibited under tobacco regulations**

*This application is not acceptable: there is an objection under section 3(4) of the Act because the mark contains words prohibited by The Tobacco Products (Manufacture, Presentation and Sale)(Safety) Regulations 2002. This implements Directive 2001/37/EC of the European Parliament which states at paragraph 27:*

*“The use on tobacco product packaging of certain texts, such as ‘low-tar’, ‘light’, ‘ultra-light’, ‘mild’, names, pictures and figurative or other signs may mislead the consumer into the belief that such products are less harmful and give rise to changes in consumption.”*

## 12 Registration and Use of the Same or Similar Trade Marks for Tobacco and Non-Tobacco Products

### 12.1 The Brandsharing Regulation

The Tobacco Advertising and Promotion (Brandsharing) Regulations 2004 (the Brandsharing Regulation) came into effect on 31 July 2005. Paragraph 3(1) of the Regulation prohibits the use in the course of a business in the UK in relation to a non tobacco product or service, of any feature which is the same as, or similar to, a feature connected with a tobacco product - if the purpose *or* effect of that use is to promote a tobacco product.

A feature of branding which is likely to be mistaken for one used for a tobacco product is a “similar” feature for this purpose.

Paragraph 3(2) of the Regulation similarly prohibits the use of a feature for tobacco products where that feature is connected with a non-tobacco product and the purpose *or* effect of the use is to promote a tobacco product through an association with a non tobacco product or service.

It is not necessary for a trade mark for tobacco products and other products or services to be owned by one party before its concurrent use on the respective products and services is capable of being prohibited under the Brandsharing Regulation.

#### Exceptions

The prohibitions in the Regulation are subject to a number of exceptions. The exceptions in paragraph 5 of the Regulation cover lawful advertising of tobacco products on goods such as display units and gantries at places where tobacco products are sold, and on vending machines for tobacco products.

The exceptions in paragraph 4 of the Regulation cover situations where the *effect* of the use is to promote a tobacco product, but the use:

- a) could not reasonably have been foreseen to have the effect of promoting a tobacco product through an association with a non-tobacco product or service (paragraphs 4(1) and 4(5));
- b) is not by a person who has a direct or indirect economic connection with a tobacco producer or promoter (see paragraphs 4(2) and 4(6) of the Regulation for full details);
- c) commenced in the EEA before 1 September 2002 *and* the presentation of the feature in question does not make it appear that the non-tobacco product or service belongs to the same brand as any tobacco product (paragraphs 4(3) and 4(7));

All the exceptions described above are subject to the further condition that the person using the feature in question does not do so for the *purpose* of promoting a tobacco product.

Paragraphs 4(4) and 4(8) of the Brandsharing Regulation contain further exceptions covering the situation where the person using the feature does not *know* that the purpose or effect of using the feature is, or is likely to be, to promote a tobacco product, *and* the use does not make it appear that the same person, firm or company is responsible for the branding of both the tobacco product and the non-tobacco product or service, whether that is in fact so or not (paragraphs 4(4) and 4(8)).

## **The Registrar's Practice**

### **Applications by the same party to register the same or similar trade marks for tobacco and non-tobacco products and services**

The registrar's examiners will not normally be able to determine, without evidence, whether the effect of the proposed use of the same/similar mark on tobacco and non tobacco products/services is to promote tobacco products. Further, the use the applicant proposes may be covered by one of the exceptions listed above.

Furthermore, the registrar's examiners will rarely be in a position to determine whether the applicant's purpose in proposing to use a mark for both types of products/services is to promote tobacco products through an association with a non-tobacco product or service.

Accordingly, the registrar will not normally object to the registration of a trade mark on the grounds that the proposed use of the mark would be an offence under the Brandsharing Regulation.

There may, however, be a few cases in which it is obvious that the purpose or effect of the proposed use of the mark will be to promote tobacco products, e.g. an application to register a well known tobacco brand for motor racing services. If the examiner believes that the facts are so self evident as to remove any reasonable doubt as to the purpose or effect of the proposed use, he or she will object to the registration of the trade mark for the second class of products. The objection will be based on 3(4) of the Trade Marks Act, which prohibits the registration of a trade mark where its use would be contrary to law.

Trade marks which are accepted and published may still, of course, be opposed by third parties on these grounds, who may file evidence in support of their case. Whether the use of a trade mark offends the Brandsharing Regulation must be determined as at the date of the application for registration. The registrar's provisional view is that the registration of a trade mark from a date earlier than the date of commencement of the Brandsharing Regulation cannot be subject to an application for invalidation on the ground that use of the mark would *now* be contrary to the Brandsharing Regulation.

However, the absence of grounds to *invalidate* a trade mark registration (because the application for registration pre-dates the date of commencement of the Brandsharing Regulation) does not mean that the provisions of the Brandsharing Regulation are inapplicable to the subsequent *use* made of that trade mark.

Article 106(2) of the Community Trade Mark Regulation 40/94 would appear to have a similar effect in that *registration* of a Community trade mark will not prevent the prohibition of the *use* of that mark in the UK in ways that are contrary to the Brandsharing Regulation.

### **Search for other relevant trade marks**

Applications filed on or after 31 July 2005 for tobacco products in Class 34 will be subject to an additional search for the goods and services in all other classes.

Applications filed on or after 31 July 2005, which do *not* include tobacco products will also be subject to an additional search to establish whether the same or a similar trade mark has been registered for tobacco products.

The object of the search will be to identify any other trade mark which is the same as, or so similar to, the trade mark in the application and is registered (or applied for) in respect of tobacco/non-tobacco products (as the case may be).

Any relevant trade marks will be drawn to the attention of the applicant in the examination report and his attention will be drawn to the Brandsharing Regulation. The purpose of doing this is to inform trade mark owners of the new restrictions on brandsharing so that they can take these into account when making decisions about the future uses they make of the trade mark applied for.

The registrar will not (other than in the circumstances described above) offer an opinion as to whether any particular use is or is not contrary to the Brandsharing Regulation.

## **RELATIVE GROUNDS (See NOTIFICATION)**

### **RETAIL, WHOLESALE AND SHOPPING CENTRE SERVICES**

In [Case C-418/02 \(Praktiker\)](#), reference for a preliminary ruling under Article 234 EC from the Bundespatentgericht (Germany), was made to the European Court of Justice in relation to an application from *Praktiker Bau- und Heimwerkermärkte AG*, concerning the registration of a trade mark in respect of services provided in connection with retail trade.

In reply to the questions asked of it, the Court ruled in its judgment issued on 7 July 2005 that:

*"1. The concept of 'services' referred to by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, in particular in Article 2, covers services provided in connection with retail trade in goods.*

2. For the purpose of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details must be provided in connection with regard to the goods or types of goods to which those services relate."

## 1 Scope and effect of the Praktiker decision

The services provided by retailers are recognised by the Court as being "all activity carried out by the trader for the purpose of encouraging the conclusion of a transaction. That activity consists, *inter alia*, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the above mentioned transaction with the trader in question rather than with a competitor".

Accordingly, these are the services covered by a "retail services" type registration. The Court stated that it is not necessary to specify in detail the retail services for which registration is sought. Rather general wording may be used. In that connection the Court cited with approval the wording in the explanatory note to Class 35 of the International Classification, namely, "the bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods."

Having recognised that there is no barrier to the registration of services connected with the retail trade in goods, the Court did not draw any distinction between the various forms of retail services (for example, supermarkets, department stores, specialist retail outlets, mail order, electronic shopping etc). Whereas in the past it was a requirement in the UK to specify the precise nature of the retail services being provided, the Court makes it clear that this is not required and that the emphasis is to be placed on the nature of the goods supplied in connection with the services.

Consequently, it is necessary to specify the goods or types of goods in **all** cases.

The mark *Praktiker* was filed for registration in relation to, *inter alia*, retail services in connection with the "building, home improvement and gardening goods for the do-it-yourself sector". The Court approved this as being sufficient to identify the types of goods connected with the services applied for.

Consequently, an indication of the types of goods concerned with the services will be sufficient, although applicants may list the associated goods in more detail if they so wish. Note that a registration for retail services does not cover the sale of goods themselves and therefore if applicants require protection for their marks to include the transaction that occurs between the customer and the retailer at the point of sale, it will be advisable to file in the appropriate goods classes in respect of those items that are being sold under the trade mark.

## 2 What is acceptable

The following paragraphs provide guidance on what is (and what is not) acceptable and the effect of the revised practice on pending applications and existing registrations.

### Acceptable

The bringing together, for the benefit of others, of a variety of [indicate goods or types of goods], enabling customers to conveniently view and purchase those goods; The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase [indicate goods or types of goods];

Retail services connected with [indicate goods or types of goods];

Retail services connected with the sale of [indicate goods or types of goods];

Retail store services in the field of [indicate goods or types of goods];

Department store retail services connected with [indicate goods or types of goods] as in, for example:

Department store services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery, publications, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products;

Shop retail services connected with [indicate goods or types of goods];

Mail order retail services connected with [indicate goods or types of goods];

Electronic shopping retail services connected with [indicate goods or types of goods];

Retail clothing shop services;

Stationery shop retail services connected with the sale of stationery, printed matter, computer equipment and peripherals and home entertainment products;

The bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods from a clothing and clothing accessories catalogue by mail order or by means of telecommunications.

### **Not acceptable**

Sale of electrical and electronic goods for industrial use [the sale of goods is not a service];

Trade in building products [trading in goods is not a service];

Retailing [retailing goods is not a service per se];

Retailing of cars [retailing of goods is not a service];

Retail services for the sale of foods [sale of goods is not a service];

Retail off licences specialising in the sale of alcoholic beverages [sales are not a service];

Shops [not a service per se];

Factory shops [not a service per se];

Shopkeeping [not a service per se];

Merchandising [not a service per se];

Distributorship [not a service per se];

Sales services [not a service per se];

Direct selling [not a service per se];

Mail order [not a service per se];

Television shopping [not a service per se];

Electronic shopping [not a service per se];

Computer shopping [not a service per se];

E-commerce [not a service per se] ;

Retail services [unqualified] ;

Retail store services [unqualified];

Department store services [unqualified];

Mail order catalogue services [unqualified];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those [unqualified] goods;

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store [“department store” does not identify the types of goods];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise internet web site [“general merchandise” does not identify the types of goods];

Retail services connected with the sale of electrical and electronic goods [the terms “Electrical” and/or “Electronic” are too vague without further indication to define types of goods];

Retail services connected with stationery products and the like goods [“and the like goods” fails to identify the goods or types of goods];

### **3 Wholesale services**

The Court’s judgment did not include any observations concerning the acceptability of services provided by wholesalers. However, the same practice will apply as for retail services and it will be necessary to specify the goods or types of goods, as in, for example:

Wholesale services connected with the sale of [indicate goods or types of goods]

### **4 Where the specification is deficient**

For descriptions which identify retail services but which do not clearly indicate the goods or types of goods connected with the services, an objection will be raised under section 1(1) and/or rule 8(2)(b) (because such claims do not clearly identify “services” within the meaning of section 1(1) of the Act). Similarly, specifications which include descriptions that adequately identify the goods, but fail to define the retail services, (for example, “sale of clothing”) will face similar objections.

### **5 Effect on registrations**

Owners of registered marks may request a restriction of their specifications (in order to comply with the revised practice). For example, a registration in Class 35 for: *“The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store”* could be amended by requesting partial surrender of the specification (using Form TM23) as in, for example:

*“Surrendered in respect of all services except the bringing together, for the benefit of others, of a variety of [ state goods or types of goods ] , enabling customers to conveniently view and purchase those goods in a department store”;*

### **6 Absolute Grounds for refusal**

Retail stores are commonly named after their geographical location. Retail services will therefore be classified as a local service and applications to register geographical place names as trade marks for such services will normally be objected to.

### **7 Shopping Centre Services**

In the judgement of the High Court in *Land Securities plc (and others) (CH2008 APP 0278/0279/0281)* it was recognised that the services provided by the operator of a shopping centre are those which "make the shopping centre as a whole an attractive place for the consumer to come and spend money. In that manner the operator generates a goodwill

associated with the name or mark under which the shopping centre trades. To that extent, the shopping centre operator is providing services".

In reaching its decision, the Court focused on the following terms which made up the opening section of the specification in question:

"The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and other services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall;"

Having decided that the operator of a shopping centre or mall does provide a service within the meaning of the Trade Marks Act 1994, the Court then went on to consider whether the terms applied for are sufficiently clear for the purposes of satisfying rule 8(2)(b) of the Trade Marks Rules. Ultimately, the Court found that the majority of those terms did satisfy the relevant criteria, although objections were upheld against the references to "and other services" and "such facilities" on the basis that they are broad, non-specific and unclear (paragraphs 50-51 of the decision refer).

Based on guidance set out in this decision, the Registrar **will accept** the following specifications:

"The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and [other clearly defined *related* services], enabling customers to conveniently view and purchase goods and make use of and purchase such services in a shopping centre or mall.

The bringing together for the benefit of others, via the internet, of a variety of retailers and [other clearly defined *related* services] through a virtual shopping mall, enabling customers to conveniently view and purchase goods and make use of and purchase such services by means of telecommunications."

In the above examples, the reference to "other clearly defined *related* services" refers to those services which are conventionally offered within a shopping centre to complement the primary activity of providing retail outlets. To illustrate this point, the Court acknowledged facilities as child care, language assistance, car cleaning, restaurants and cinemas as being services typically provided within a retail environment (paragraphs 13 and 28 of CH2008 APP 0278/0279/0281 refer). It is important to emphasise that any reference to such services included as part of a wider shopping centre-type specification will not equate to a claim to the provision of those services *per se*. To illustrate this point, the Registrar will not consider a class 35 claim to "the provision of restaurant facilities" (where it is made as part of a wider claim covering the services of a shopping centre operator) to be the same as a claim to "restaurant services" which are proper to class 43.

It should also be noted that the specifications presented above **do not** exhaustively list the specific goods which are likely to be provided by outlets situated within the shopping centre or mall. Notwithstanding the fact that the listing of goods remains a requirement of more

conventional retail claims, the Registrar does not consider it to be a necessary requirement in relation to claims for the operation of shopping centres and malls.

By contrast, applicants should note that the following example specification **would not be accepted**:

The bringing together for the benefit of others, of a variety of retail outlets and other services enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall.

It is important to stress that the judgement in Land Securities did not focus on "the bringing together of services" *per se*, but only "the bringing together of services within a shopping centre or mall" (including the virtual type). As a consequence, specifications which involve the bringing together of services in some other manner will be judged on a case by case basis and referred to classification section where necessary.

## **ROYAL MARKS (Marks incorporating elements referring to Royalty)**

Section 4(1) of the Act states:

*"A trade mark which consists of or contains –*

*(a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,*

*(b) a representation of the Royal crown or any of the Royal flags,*

*(c) a representation of Her Majesty or any member of the Royal Family, or any colourable imitation thereof, or*

*(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation, shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal Family."*

The registration of certain words and figurative marks is therefore prohibited under this Section of the Act unless, as stated in the final paragraph of this subsection, *consent* is obtained. This may be obtained from the Lord Chamberlain. The address is Buckingham Palace, London, SW1A 1AA.

### **1 Royal arms and similar emblems (Section 4 of the Act)**

Section 4 of the 1994 Act prevents registration of marks containing the ROYAL ARMS or ARMS which are likely to be mistaken for them. If appropriate, object under section 3(5).

Conventional representations of the ROYAL ARMS are shown below:



## 2 Representations of the Royal crown

If a mark includes a device of the Royal crown or a closely resembling device, it is necessary to consult with the Lord Chamberlains Office (Buckingham Palace, London, SW1A 1AA) to ascertain whether the degree of similarity justifies objecting under section 3(5).

Conventional representations of the ROYAL CROWN are shown below:



The Royal Warrant Holders Association has already advised the registrar that crowns similar to those shown below may be used for business purposes without infringement of the Royal Crown.

## ILLUSTRATIONS OF CROWNS

Which may be used for business purposes without infringement of the design of the ROYAL CROWN.

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2



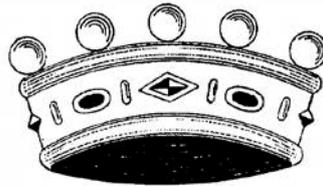
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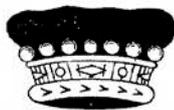
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11



10



12

*Issued by :*

THE ROYAL WARRANT HOLDERS ASSOCIATION

### **3 Portraits of the Royal Family**

Marks containing representations of Her Majesty, or any member of the Royal Family, are open to objection under section 3(5) of the Act unless the consent of the Queen or the relevant member of the Royal Family is provided.

### **4 Names of the Royal Family**

Names of the Royal Family may not be registered in, or as, trade marks without the consent of the Queen or the relevant member of the Royal Family. To avoid the need to rely on general knowledge the Registry has been supplied with a list of those regarded by the Queen as members of The Royal Family for the purposes of the Trade Marks Act 1994. This is shown below.

#### **The Royal Family – for the purpose of Trade Marks Legislation**

Her Majesty The Queen

His Royal Highness The Duke of Edinburgh

Their Royal Highnesses The Prince of Wales and The Duchess of Cornwall

Their Royal Highnesses The Duke and Duchess of Cambridge

His Royal Highness The Prince Henry of Wales

His Royal Highness The Duke of York

Her Royal Highness Princess Beatrice of York

Her Royal Highness Princess Eugenie of York

Their Royal Highnesses The Earl and Countess of Wessex

Viscount Severn

The Lady Louise Mountbatten-Windsor

Her Royal Highness The Princess Royal and Vice Admiral Timothy Laurence

Mr. and Mrs. Peter Phillips

Miss Savannah Philips

Mr. and Mrs. Michael Tindall

The Viscount and Viscountess Linley

The Honourable Charles Armstrong-Jones

The Honourable Margarita Armstrong-Jones

The Lady Sarah Chatto and Mr. Daniel Chatto

Mr. Samuel Chatto

Mr Arthur Chatto

Their Royal Highnesses The Duke and Duchess of Gloucester

Their Royal Highnesses The Duke and Duchess of Kent

Their Royal Highnesses Prince and Princess Michael of Kent

Her Royal Highness Princess Alexandra, the Honourable Lady Ogilvy

Sarah, Duchess of York

In addition to the possibility of an objection under Section 3(5), Examiners will also consider whether the application has been made in bad faith (Section 3(6) and whether the mark is distinctive for the goods/services (Section 3(1) [*See also Famous Names*]).

## **5 Royal places of residence**

The names and pictorial representations of Royal places of residence are objectionable under section 3(5) if they would be, in the words of section 4(1)(d) of the Act, “likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation”. Such a trade mark may not be registered unless consent is given by or on behalf of Her Majesty or the relevant member of the Royal family.

## **6 Royal Warrant**

When Royal Patronage **is** granted, for instance by Royal Warrant, an application can only proceed with evidence of the granting of the Warrant.

## **7 Marks incorporating the word ROYAL**

Section 4 relates to the use of any words, in such a manner as to be likely to lead persons to think that the applicant either has, or recently has had, Royal patronage or authorization. Examples of goods or services for which ROYAL **may** indicate Royal patronage are high quality porcelain or glassware, luxury foods, organic food, confectionery, alcoholic beverages, clothing, organisation of sporting events, exhibitions, flower shows, tourism, medical and charitable services. This is not an exhaustive list. ROYAL may indicate royal patronage or authorisation for other high value products, or prestige or 'public interest' type services.

ROYAL is unlikely to indicate Royal patronage or authorisation for everyday items e.g. insurance or financial services, double glazing services, provision of electricity, or for goods which are far enough removed from any association with the Royal family such as skateboards, computers, computer games or T-shirts.

## 7.1 Practice

ROYAL alone and closely similar words, e.g. ROYALE, for goods or services which can imply Royal patronage should be objected to under section 3(5).

ROYAL in combination with a descriptive word is also likely to suggest Royal patronage or authorisation and may face objection prima facie for goods/services that Royalty may be prepared to use or approve, e.g. ROYAL VENISON for meat.

ROYAL in combination with a word which also implies royal patronage should be objected to under section 3(5) and section 3(3), e.g. ROYAL BALMORAL for any goods or services.

ROYAL in combination with words which points away from the mark implying Royal Patronage, e.g. ROYAL FLUSH, can be accepted prima facie for any goods/services unless the combination is descriptive.

ROYAL in combination with another registrable word or device, e.g. RAYBURN

ROYAL or ROYAL HARTEX can be accepted.

The words ROYAL SOVEREIGN suggest Royal Patronage. Objections should be raised under section 3(5).

## SAVING PROVISIONS (relevance)

The following statement was made by Geoffrey Hobbs QC in his capacity as the Appointed Person in relation to an appeal against the refusal of an application for the mark 'AD 2000' (1997) RPC 168.

*“Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse the registration of signs which are excluded from registration by the provisions of Section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacobs Esq. QC in his decision on behalf of the Secretary of State in Colorcoat TM (1990) RPC 511 at 517 in the following terms: ‘That possible defences (and in particular that the use is merely as a bona fide description) should not be taken into account when considering registration is well settled, see e.g. Yorkshire TM (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. ‘Essentially the reason for this is that the privilege of a monopoly should not be conferred where it might require honest men to look for a defence.’”*

The ECJ in Libertel Groep BV and Benelux- Merkenbureau confirmed that:

*“...examination carried out at the time of application must not be a minimal one. It must be a stringent and full examination, in order to prevent trade marks from being improperly registered. As the Court has already held, for reasons of legal certainty and good administration, it is necessary to ensure that trade marks whose use could successfully be challenged before the courts are not registered.”* (Case C-104/01).

## **SERIES (Applications to register a series of trade marks)**

### **1 Section 41(2) of the Act - Principles**

When considering an application for a series of marks it is important to consider the wording of section 41(2) which states:

*"A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non distinctive character not substantially affecting the identity of the trade mark."*

In [Logica's Trade Marks \[BL O/068/03\]](#) Professor Ruth Annand as the Appointed Person stated that Section 41(2) of the Act contains three conditions. She said that:

*"First, the marks in the series must resemble each other in their material particulars. Second and third, the differences between the trade marks must not comprise matter, which when considered:*

*a) as a separate element of the trade mark would be regarded as having distinctive character;*

*and*

*b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark."*

The over-riding requirement is that the differences between the marks does not substantially affect their identity. The test is NOT simply whether the marks in the series would be regarded as confusingly **similar** to each other if used by unrelated undertakings. Any variation in the non-distinctive features in the marks must leave the visual, aural and conceptual identity of each of the trade marks substantially the **same**. Further, it is not enough for marks to share the same conceptual identity if there are substantial differences in the visual or aural identities of the marks. The matter must be assessed by reference to the likely reaction to the marks of an average consumer of the goods/services in question.

### **2 Application of principles to different types of marks**

The following are examples of what are thought to be acceptable and unacceptable series under new practice:

## **2.1 Numeral marks:**

**Acceptable:**

**FENTON 1**

**FENTON 2**

**FENTON 3**

**FENTON 4**

**FENTON 5**

**FENTON 6**

**FENTON 7**

**FENTON 8**

(For 'Television, video and radio apparatus' in class 9)

Such is their presentation, the differing numerals can clearly be seen as merely model numbers following the dominant and distinctive word feature. The overall identity of each of the marks is substantially the same. These marks are therefore thought to constitute a series.

**Unacceptable:**

**CH101**

**CH102**

**CH103**

**CH104**

**CH105**

(For 'Guided missiles and projectiles, all being weapons' in class 13)

Here however, the numerals are not seen as a separate element but as an integral part of the five digit marks. The identity of each of the marks resides in the specific combination of five digits. The alteration of the last numeral therefore substantially affects the overall identities of the marks.

## **2.2 Common misspellings:**

**Acceptable:**

**MERKINS LODGEMENT CENTRE**

**MERKINS LODGMENT CENTRE**

(For 'Provision of temporary accommodation' in class 42)

Although spelt differently in the second version, the second word is still clearly the word 'lodgement'. Therefore it is felt that, as both marks share substantially the same identities, they do form a series.

**Unacceptable:**

**PAINT WEB**

**PAYNT WEB**

(For 'Production, distribution and presentation of television programmes' in class 41)

Although the second mark is phonetically identical to the first, it is visually quite different, and if viewed in isolation, is unlikely to be seen as the word 'paint'. Therefore this is not a series because the material particulars of the marks differ substantially and, in consequence, so do the visual and conceptual identities.

### **2.3 House marks:**

**Acceptable:**

**Xerox Copier**

**Xerox Laser**

**Xerox Multipurpose**

**Xerox Colour Laser**

(For 'Facsimile telegraphy transceiver apparatus, and parts and fittings therefore' in class 9)

Although their additional wording differs greatly (and consist of well-known types of paper), the presence of the highly-distinctive invented house mark at the start of each of the marks means that the differences are immaterial. The varying elements contribute nothing to the identities of each mark. These marks are a series.

**Unacceptable:**

**POWER LAWN MOWERS**

**POWER GARDEN KIT**

(For 'Machines and machinery all for use in gardens' in class 7)

Here the common element in the marks is a well-known (and descriptive or semi-descriptive) dictionary word. The material particulars and distinctive character of the marks (particularly the second mark) depends partly on the combination of words.

Where marks with a low distinctive character are concerned, virtually any perceptible difference between the marks is likely to prevent them from qualifying as a series. In this example, changing some of the words does alter their identities. These marks are not a series.

## 2.4 Minimal stylization:

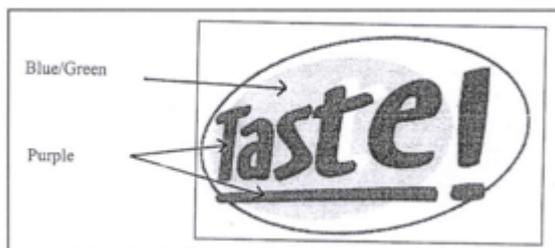
### Acceptable:



(For 'Books; printed matter; periodicals; post cards' in class 16)

Although marks three and four contain additional matter, the material particulars of each mark are substantially the same, the differences are non-distinctive and the visual, aural and conceptual identities of the marks are substantially unaffected by the differences. These marks are a series.

### Unacceptable:



**Taste !**

(For 'Prepared meals' in class 30)

The word 'Taste' is obviously a descriptive word for the goods claimed (being likely to be perceived as an exhortation to taste products bearing the marks). The version of the mark limited to colour was felt to possess sufficient distinctive character to qualify for registration.

The second mark, being merely the word 'TASTE !' was, by implication, not thought to share the slender distinctive character of the first mark. The one mark has a trade mark identity, the other not. These marks are not a series.

## 2.5 Dominant features:

Acceptable:

**M&S MEAL DEAL**

**M&S**

**MEAL**

**DEAL**

(For 'Meat, fish, poultry and game; seafood and seafood products; prepared meals' in class 29)

Despite differences in their respective layout, the marks clearly share the same material particulars. The differences are non-distinctive and not such as to affect the identities of the marks. They are therefore acceptable as a series.

Unacceptable:

**asda**

**making sound sense.**

**asda making sound sense.**

asda

**making sound sense.**

(For 'Pies; meat pies; tortillas; snack foods; condiments, sauces, spices and seasonings; rolls, biscuits, bread, cakes; confectionery; honey; yeast; baking powder' in class 30)

The element which varies from mark to mark is non-distinctive, but the distinctive feature of the mark is considerably overshadowed in the third version and can no longer be seen as the dominant element of the trade mark. Arguably the second mark is in the same position. The differences plainly have a substantial effect on the visual identities of the marks. They are not therefore a series.

## 2.6 Stylization:

**Acceptable:**

***chessman***

**CHESSMAN**

(For 'Clothing' in class 25)

Despite some stylistic differences, the two marks have the same material particulars, the distinctive word CHESSMAN. The variations in presentation are non-distinctive and have no substantial effect on the identities of the marks. They are therefore thought to be a series.

**Unacceptable:**

**SUSAN JEFFIELDS**

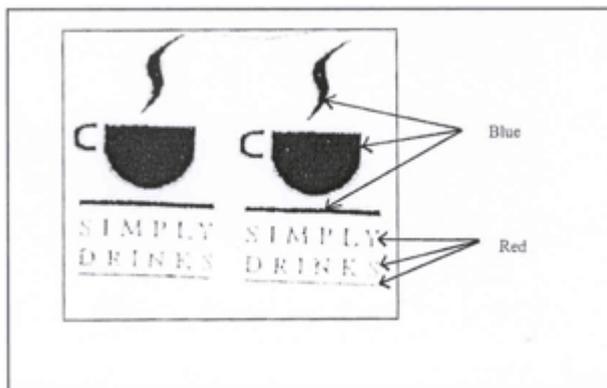


(For 'Books; printed matter; magazines' in class 16)

Such is the heavy stylization in the second mark that its material particulars are no longer just the words 'Susan Jeffields'. The differences affect the identities and distinctive character of the marks. They cannot therefore be considered a series.

## 2.7 Colour marks:

**Acceptable:**

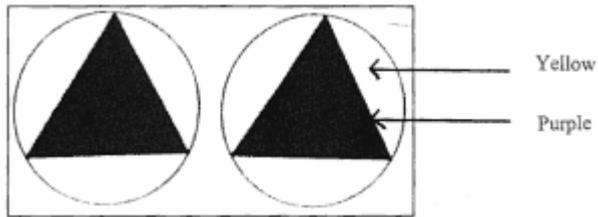


(For 'Coffee, tea, cocoa, sugar; rice; tapioca; sago; artificial coffee' in class 30)

Although the second mark is limited to the colours blue and red, the colours add little to the material particulars of the second mark. The colours are non-distinctive *per se* and their

presence or absence does not substantially affect the visual identity of the second mark. These marks are a series.

**Unacceptable:**



(For 'Chemical preparations and substances' in class 1)

Although the essential shape of the marks is the same, the first mark is merely a black and white representation of a triangle set within a circle, whereas the material particulars of the second mark includes colour, which in this case accounts for a significant part of the distinctive character of the second mark. The identity of the second mark is therefore substantially different to the first and the marks are not a series. The addition of colour combinations to simple geometric shapes will often have a substantial effect on the identity of the marks. The same applies when different colour combinations are applied to the same simple geometric shape.

**2.8 Domain names:**

**Acceptable:**

**SHADWELL.COM**

**SHADWELL.CO.UK**

(For 'Compilation, provision, storage and retrieval of business and commercial information, all provided on-line from a computer database or the internet' in class 35)

Both suffixes are well-known and easily recognised domain name/address details identifying the same type of commercial organisation, therefore their addition to the distinctive element does not substantially affect the identities of the marks.

**Unacceptable:**

**MAPLIN**

**MAPLIN.CO.UK**

**MAPLIN.NET.UK**

**MAPLIN.BI**

(For 'Computers; computer peripherals; computer software' in class 9)

Because the first mark is not recognisable as being based upon an internet address, its conceptual identity differs from that of the other marks in the series. The identity of the fourth mark is ambiguous because 'BI' is not a well known component of a domain name and an average consumer would therefore be unsure as to the conceptual identity of the mark. The third mark is recognisable as being comprised of a distinctive word in combination with a well known Top Level Domain (TLD) component. However, the average consumer would be aware that when used as part of a domain name, '.NET.UK' indicates that the user is an internet service provider. The message conveyed by the mark MAPLIN.CO.UK is therefore different to the message conveyed by the mark MAPLIN.NET. The conceptual identities of the marks therefore differ and they are not a series with each other or with either of the other two marks.

## **2.9 Geographical marks:**

**Acceptable:**

**VLAD'S NEW YORK**

**VLAD'S PARIS**

**VLAD'S LONDON**

(For 'clothing' in class 25)

Geographical names are not to be regarded as necessarily immaterial and non-distinctive. The geographical names added to the distinctive word "VLAD'S" in this case are clearly non-distinctive for the goods concerned. In this case they may be regarded as making no substantial difference to the identities of the trade marks. These marks are a series.

**Unacceptable:**

**BLINK RIO DE JANEIRO**

**BLINK MARAKESH**

**BLINK COSTA BLANCA**

(For 'Milk' in class 29)

These three marks would not be considered to constitute a series as the geographical element in each of them is not self evidently so non-distinctive that the average consumer would be bound to ignore it as purely informative matter. The identities of these marks therefore depend, in part, upon the inclusion of the geographical names. These marks are not a series.

**Unacceptable:**

**DONCASTER**

## **DONCASTER UNITED**

## **DONCASTER UTD**

(For 'Footwear; boots; half boots; shoes, slippers; galoshes; sandals' in class 25)

This cannot be considered a series, as although versions two and three are clearly the name of a sports team, the first mark viewed in isolation would be seen as the name of a geographical location. Consequently, the conceptual identity of the first mark is substantially different from the other two marks. The first mark does not form a series with the second and third marks.

### **2.10 Position of distinctive element:**

**Acceptable:**

**ear financial**

**ear investment**

**ear insurance**

(For 'Financial services' in class 36)

Because the word 'ear' is placed at the beginning of the marks, it can clearly be seen as the trade mark and the remaining words are unequivocally descriptions of the services. Consequently, the trade mark identities of the marks are the same.

**Unacceptable:**

**financial ear**

**investment ear**

**insurance ear**

(For 'Financial services' in class 36)

In this format the words 'financial', 'investment' and 'insurance' now appear as integral to the identities of the marks. Presented like this, these words form part of the material particulars of the trade marks and varying the first word therefore changes the identities of the marks. This is not a series.

### **2.11 Conjoining words:**

**Acceptable:**

**Roomlock**

## Room Lock

(For 'Safes for use in hotel bedrooms' in class 6)

The marks are composed of two well known dictionary words and in both the conjoined and separated versions the identity of the marks remains the same and would be seen as such by the average consumer. Consequently these marks are acceptable as a series.

**Unacceptable:**

## Growright

### Gro Wright

(For 'Fertilisers and compost' in class 1)

Although the first mark consists of the same letters as the second mark, it could equally be seen as "Grow" and "Right" conjoined. Consequently, the visual and conceptual identities of the trade marks differs and they are not a series.

### 2.12 Character marks:

**Acceptable:**



(For 'Toys, games and playthings' in class 28)

These marks are clearly recognisable as the same character, albeit in slightly different stances, with all the same visual features. The material particulars of the marks are therefore the same and the differences in stance do not substantially affect the identities of the marks. They form a series.

**Unacceptable:**



(For 'Toys, games and playthings' in class 28)

The third mark in this series consists of a version of the character playing a musical instrument. This is part of the material particulars of this mark, which differs from the first two. The difference gives the third mark a higher and different distinctive character (e.g. an earlier mark consisting of a totally different looking chipmunk playing a guitar may be cited against the third mark, but not the first or second). The visual and conceptual identity of the third mark differs from the first two and they cannot constitute a series.

### **3 Examination Procedure**

Each mark in the series must be examined individually and must be compared with each of the other marks in turn to ascertain whether they form a series. If an examiner raises a series objection he or she will, where practical, indicate whether any of the marks in the series applied for could be accepted as a series. Applications which do not constitute a series will only be fully examined if all the marks can be covered by one search. Where a number of marks in a series are included in a composite mark in the same series, the search of the composite mark will usually cover the individual marks included in it. In these circumstances the examiner will fully examine the application. However, if an examiner is faced with the prospect of undertaking a number of separate searches, a preliminary objection will be raised prior to the full examination of the application. The applicant will be required to overcome the series objection before the marks are examined on absolute and relative grounds.

The following is a basic example of the above practice:

#### **GOLDEN IMAGE**

#### **KODAK GOLDEN IMAGE**

Searching the second mark entails searching the first also. The series objection will be raised in the full examination report.

#### **GOLDEN IMAGE**

#### **KODAK GOLDEN IMAGE**

#### **FUJI GOLDEN IMAGE**

These marks would require two separate searches. A preliminary objection will be raised prior to full examination.

Where a series objection is raised as a preliminary objection, or where it is the only (or only remaining) objection following full examination, the registrar will, on request in the form of a Form TM5 and accompanying fee, issue a statement of grounds for his decision to refuse to accept the marks as a series, without refusing the application for registration.

This will allow applicants to appeal the registrar's decision to refuse to accept the marks as a series without giving rise to the consequences that normally flow from a final refusal of the

application. In particular, if the appeal is unsuccessful, this approach will leave applicants with the option of overcoming the series objection by deleting marks from the application.

The registrar reserves the right, in appropriate circumstances, of dealing with a series objection through the process set out in section 37 of the Act, which will result in any appeal against the decision being considered as the reason for the refusal of the application for registration.

#### **4 Series of bilingual marks in English and Welsh or English and Gaelic**

Judgements from the Court of Justice of the European Union make clear that trade marks should be considered in relation to the average consumer of the category of goods (*Windsurfing Chiemsee* (C-108/97 & C-109/97), in the territory in respect of which registration is applied for. This confirms that an application for a national registration must be viewed as if seen by consumers throughout the UK (*Bovemij Verzekeringen NV v Benelux Merkenbureau* EUROPOLIS C-108-05). Any visual and aural differences due to language used in a series of bilingual marks must be given due weight, and where such differences alter the 'identity' of the mark, they should not be accepted as a series. For example the mark 'Welsh Water' and 'Dwr Cymru' would not be accepted as a series because of the visual and oral differences between the marks.

However, it may be possible to accept applications for English and Welsh and/or English and Gaelic series where there is a territorial limitation to the area of Wales or Scotland under section 13 of the Act, and where that limitation is applied only to the Welsh/Gaelic language versions of the marks in the proposed registration.

For example in the case of 'Welsh Water' and 'Dwr Cymru' the limitation under Section 13 may read:

Registration of this mark is subject to the following limitation:  
The rights conferred in respect of the second mark are limited to goods/services provided in Wales.

Alternatively, if English and Welsh versions of marks are to be used together they may be applied for as a single mark.

## **SCOTCH WHISKY**

The Scotch Whisky Regulations 2009 seek to regulate the Scotch Whisky industry by establishing laws governing the production, packaging and marketing of Scotch Whisky and Scotch Whisky-based beverages. Given the Regulations' reference to product labelling, the Registrar now has an obligation to ensure that trade marks containing references to 'Scotch' and certain other terms are registered in full compliancy with the law.

The specific provisions relevant to the registration of trade marks are as follows:

6. (1) A person must not label, package, sell, advertise or promote any drink as Scotch Whisky or Scotch if it is not Scotch Whisky.  
  
(2) A person must not label, package, sell, advertise or promote any drink in any other way that creates a likelihood of confusion on the part of the public as to whether the drink is Scotch Whisky.
10. (1) A whisky or whisky-based drink must not be labelled, packaged, advertised or promoted in a way that includes the name of a protected locality or a protected region unless-  
  
(a) in the case of whisky, the whisky is Scotch Whisky that has been distilled in that locality or region; or  
  
(b) in the case of a whisky-based drink, the only whisky in the drink is Scotch Whisky that has been distilled in that locality or region.

In the case of any labelling or packaging which implies that the product contained therein is Scotch Whisky *per se*, section 6 is clear - that product must be Scotch Whisky. For the purposes of assessing trade marks, the Registrar has interpreted this as meaning that, in the majority of cases, any sign containing the terms 'Scotch' and/or 'Scotch Whisky' - where protection has been applied for in respect of any and all drinks products found in classes 29, 30, 32 and 33 - can **only** be registered for Scotch Whisky.

There will be a small number of exceptions to this rule - most notably where an applicant uses the words 'Scotch' and/or 'Scotch Whisky' as part of composite trade mark denoting Scotch Whisky-based mixed drinks. In such cases, the applicant will be required to limit its specification to reflect the goods intended for coverage - further details and examples are provided below.

With the exception of marks clearly denoting Scotch Whisky-based mixed drinks, any other mark containing the words 'Scotch' and/or 'Scotch Whisky', applied for in respect of any drink product *other* than Scotch Whisky, will be subject to a substantive objection.

By comparison, the provisions set out in section 10 are less restrictive - the conditions relating to use of the five localities (listed at paragraph 1(ii) above) apply only to 'whisky' and 'whisky based drinks'. This means that trade marks containing such designations will not be subject to an objection or any further qualification unless they have been applied for in respect of whisky and/or whisky-based drinks.

### **What objections will be raised?**

To date, the Registrar has raised objections against marks containing references to Scotland (including the use of terms such as 'Scotch' and 'Scotch Whisky') solely under section 3(3)(b) of the Trade Marks Act 1994 - on the basis that such marks would deceive the public as to the nature and quality of the product. This type of objection, which has been applied solely to whisky and whisky based liqueurs, has been avoidable via suitable limitation of the class 33 specification. In all cases, and dependent upon other considerations such as overall

distinctiveness, applicants have therefore been able to obtain protection for marks containing terms such as 'scotch' and 'scotch whisky' for the full range of drinks products.

Following implementation of the Scotch Whisky Regulations, this will no longer be possible. Where a mark containing the words 'Scotch' and/or 'Scotch Whisky' is applied for in respect of any drink other than Scotch Whisky (and where it meets all other requirements), the examiner will now raise objections under both **section 3(3)(b)** and **section 3(4)**. This is because the use of such a mark would not only deceive the public as to the nature of the product, but would also be prohibited by other law, namely the Scotch Whisky Regulation. If the specification contains broader terms which imply protection for *inter alia* whisky, the applicant will be invited to limit its specification down to 'Scotch Whisky'. However, if the specification fails to contain broad terms which imply coverage for Scotch Whisky, or if it simply covers beverages *other* than whisky, the application will be refused outright.

Where a trade mark contains any of the five protected regions and localities listed in sections 10(5) and 10(6) of the Regulations (see paragraph 1(ii) above), and does *not* include any references to 'Scotch' or 'Scotch Whisky', the examiner will only raise an objection in respect of whisky and whisky-based drinks. As with marks containing the words 'Scotch' and 'Scotch Whisky', objections will be based on sections 3(3)(b) and 3(4) of the Trade Marks Act 1994. Further, such objections can be overcome by limiting claims to whisky and whisky-based drinks such that they only denote Scotch Whisky produced in the locality or region referenced in the mark. However, no objection will be taken to any other drinks products listed in the specification.

Where a trade mark does contain elements which are evocative of Scotland, but does not contain any references to 'Scotch', 'Scotch Whisky', nor any of the five localities and regions, the Registrar's practice will remain unchanged. In respect of alcoholic beverages in class 33, the Registrar will raise a section 3(3) objection only, and will invite the applicant to limit the specification in order to ensure that, as far as whisky and whisky-based drinks are concerned, coverage only extends to such products being Scotch and/or Scotch-based, all being produced in Scotland.

### **Examples in Practice**

This section sets out a number of examples, indicating how the Registrar will apply the new approach in practice:

The mark 'LOCH CASTLE SCOTCH WHISKY', applied for in respect of '*carbonated drinks*' in class 32, and '*alcoholic wines; whisky; whisky-based liqueurs; vodka*' in class 33, would be subject to objections under sections 3(3)(b) and 3(4) on the basis that it deceives the consumer as to the nature and quality of the goods, and that it indicates intended use of the term 'Scotch Whisky' on drinks other than Scotch Whisky. In this case, the applicant would be required to delete the claims to '*carbonated drinks*', '*alcoholic wines*', '*whisky-based liqueurs*' and '*vodka*', and invited to amend the term '*whisky*' to read '*Scotch Whisky*' only.

The mark 'LOCH CASTLE SPEYSIDE', applied for in respect of '*carbonated drinks*' in class 32, and '*alcoholic wines; whisky; whisky-based liqueurs; vodka*' in class 33, would be subject to similar objections under sections 3(3)(b) and 3(4), but only insofar as the class 33 claims

to *'whisky'* and *'whisky-based liqueurs'* are concerned. The applicant would be invited to limit the latter terms to ensure they denote Scotch Whisky products produced in Speyside (it being one of the five regions and localities listed in the Regulations), but the other terms could remain unchanged. An acceptable re-worded specification would therefore read as *'Scotch Whisky and Scotch Whisky-based liqueurs produced in Speyside; alcoholic wines; vodka'* in class 33, and *'carbonated drinks'* in class 32.

The mark 'LOCH CASTLE', applied for in respect of *'carbonated drinks'* in class 32, and *'alcoholic wines; whisky; whisky-based liqueurs; vodka'* in class 33, would be subject to an objection under section 3(3)(b) only, and that objection would solely affect the claims to *'whisky'* and *'whisky-based liqueurs'*. The mark does not contain any of the terms listed in the Scotch Whisky Regulations 2009, and deception would only occur in respect of those products associated with Scotland i.e. *'whisky'* and *'whisky-based liqueurs'*. As is the case with current practice, the offending terms i.e. *'whisky'* and *'whisky-based liqueurs'* would need to be amended to *'Scotch Whisky'* and *'Scotch Whisky-based liqueurs'*, whilst all other terms could remain as filed.

### **Wider Application and Exceptions**

It is anticipated that the scenarios outlined above will account for most trade mark applications affected by the Scotch Whisky Regulations 2009. However, it is also inevitable that a small number of *'Scotch Whisky'* marks seeking coverage for drinks products will not correspond to any of the three examples set out above and/or will not be caught by the Regulations. In the case of marks which clearly denote Scotch Whisky-based mixed drinks, for example, the Registrar does not interpret the Regulation as a means of prohibiting the marketing of such drinks even where they contain terms such as *'Scotch'* and *'Scotch Whisky'*.

To illustrate this point, applications to register marks such as *'LOCH CASTLE SCOTCH WHISKY LIQUEUR'* and *'LOCH CASTLE SCOTCH & SODA'* for *'liqueurs and mixed alcoholic beverages'* will **not** be rejected outright pursuant to section 6 of the Regulations. In such cases, the Registrar will raise an objection under section 3(3)(b) of the UK Trade Marks Act 1994, but will agree to waive that objection where the specification is limited to reflect the product signified by the mark itself. For example, in the case of *'LOCH CASTLE SCOTCH WHISKY LIQUEUR'* and *'LOCH CASTLE SCOTCH & SODA'*, the specification would need to be amended to *'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland'* in order to meet the criteria for publication.

Applicants should note that where it is not immediately apparent to the examiner that a trade mark containing terms such as *'Scotch Whisky'* and/or *'Scotch'* is intended to denote mixed drinks rather than whisky *per se*, the Registrar will apply a strict practice i.e. pursuant to section 6 of the Regulation, it will insist that the goods are limited to *'Scotch Whisky'*.

In all such instances, each case will be examined on its own merits.

## **SHAPES (Representations of the Goods)**

There have been several cases before the English and European Courts which have provided guidance in relation to the examination of applications for shape marks. The main points arising from these form the basis for examination practice.

## **1 Graphical Representation**

The representation must disclose the mark in a way which is “clear, precise, self-contained, easily accessible, durable and objective”. This is relatively easy to do when it comes to shape marks. It is straightforward to represent the shape of a product or its packaging by filing one or more pictorial representations of the shape in question. It is not normally necessary to file more than 6 views of a shape in order to represent it graphically. Often fewer views will be sufficient. Where more than one view is filed, it is advisable to include a description of the view, such as “front”, “side”, “top”, “perspective” etc.

It is possible to register a part of the shape of the product or its packaging as a trade mark. Consequently, there may be no need to show all of the shape of the product or its packaging in the representation(s) filed. However, no protection can be gained for any feature of shape which is not clearly and precisely represented in the mark.

Trade marks may protect particular shapes, but not design concepts. It is not therefore possible to represent a shape in words alone. Nor can a written description serve to represent features of shape which are not apparent from the pictorial representation(s) of the mark filed. Further, descriptions which suggest that protection is sought for a class of shapes and that the pictorial representation(s) are merely illustrative, will be rejected. Accordingly, a description that “the mark consists of a six sided computer monitor, as shown in the form of application” is not acceptable, but the following description would be: “the mark consists of the shape of the six sided computer monitor shown in the [above] representation”.

## **2 The law on distinctiveness: 3(1)(b) & (c) - shape of the goods**

There is no distinction in law between different types of marks with regard to the test for distinctiveness. This was confirmed by the ECJ in [Linde, joined cases C-53/01 to 55/01](#) . However, the Court found that the assessment for compliance with 3(1)(c) must take account of the public interests underlying that provision, which is to keep characteristic shapes free from the constraints of a statutory monopoly.

Further, the Court stated that whilst the legal test for distinctiveness is the same for shape marks as for other marks, recognition must be given to the differing perceptions of the average consumer in relation to non-traditional trade marks. In particular, the average consumer may not as readily accept the appearance of the goods themselves as an indication of trade origin. This is because “average consumers are not in the habit of making assumptions about the origin of the products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element”:

[Procter and Gamble v OHIM, Joined Cases C-468/01 P to C-472/01 P](#)

In both the *Procter and Gamble* cases, and in the [Henkel case \(C-218/01\)](#), the ECJ stated that the test for a shape-of-goods mark under section 3(1)(b) was whether the mark enabled an average consumer, “without conducting an analytical or comparative examination or paying particular attention”, to distinguish the goods concerned from those of other traders. The Court observed that only a (shape-of-goods) trade mark which departs **significantly** from the norms or customs of the sector and thereby fulfils its essential function of indicating origin possesses the distinctive character necessary for registration.

In *Procter and Gamble*, the ECJ rejected the appellant’s argument that the marks were distinctive because, inter alia, the type of product was relatively new and there were no similar dishwasher tablets on the market at the time the applications were filed. The Court repeated its conclusions in *Henkel* (above) and pointed out that “the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character”. Consequently, it would appear that in deciding which shapes are the “norm” for the sector, account is also to be taken of shapes which are likely to become the norm.

It may be easier to show that a shape has the necessary distinctive character where there is evidence that, contrary to the normal assumption made about consumers’ habits, consumers in the relevant sector do in fact rely upon the appearance of the shape of the product or its packaging as a means of identifying the origin of the product. An example of this is the use of vehicle radiator grilles, which are used by manufacturers as means to differentiate their products, in a trade mark sense. This formed the basis for the CFI’s judgment in the [DaimlerChrysler “Jeep” grille case \(T-128/01\)](#) where it was found that the appearance of the grille did have the necessary capacity to distinguish the product of that vehicle manufacturer from those of other economic operators in that trade.

### **3 Shape of packaging**

The ECJ ruled, in the [Henkel case \(C-218/01\)](#), that for the purposes of Sections 3(1) and 3(2), the shape of packaging is to be treated as the shape of the goods themselves where the goods are traded in packaged form for reasons associated with the nature of the goods; for example, beverages, cleaning fluids. In other cases an objection to a trade mark consisting of the packaging of the goods may only arise under section 3(1)(d) - if it is already common in the sector - or section 3(1)(b) - if it is non-distinctive for another reason.

### **4 Section 3(2)**

Section 3(2) of the Act states:

*(2) A sign shall not be registered as a trade mark if it consists exclusively of -*

*(a) the shape which results from the nature of the goods themselves,*

*(b) the shape of the goods which is necessary to obtain a technical result,*

*or*

*(c) the shape which gives substantial value to the goods.*

**Section 3(2)(a)** When the *Philips* case was before the English Court of Appeal, [1999] E.T.M.R. 816, Aldous L.J. observed that the purpose of section 3(2)(a) is to keep free basic shapes of goods that should be available for use by the public.

However, it is important to bear in mind that there may be more than one such basic shape, or several usual variations, e.g. door handles may be round or lever style. To this extent, there is some overlap with section 3(2)(b).

**Section 3(2)(b).** The ECJ ruled, in *Philips*, that this subsection “*must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result.*” This does not automatically mean that a shape is unregistrable where all its features serve some functional purpose. If it can be shown that an essential feature (which may include the overall impact arising from the way the individual features are arranged) is not only attributable to a technical result, i.e. the shape is not one which would be adopted for its functional efficiency, it will not be caught by 3(2)(b). In [Ekornes ASA's Trade Mark, \[BL O-017-06\]](#) Mr Hobbs QC as The Appointed Person reversed a decision of the registrar to refuse to register the shape of a chair on the grounds that its essential features were all functional. The Appointed Person found that although all the features of the chair were in one sense functional, there was nevertheless an excess of form over function. The decision to refuse registration of the mark on other grounds was upheld.

Shapes which do consist exclusively of functional features attributable only to the technical result will be caught by section 3(2)(b); marks in this category are deemed to be incapable of acquiring a distinctive character and therefore the filing of evidence will not overcome the objection.

The ECJ has held that the word “necessary” in the equivalent Article of the Trade mark’s Directive does not mean “the only”. Accordingly “the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.” This prevents a limited amount of economic operators in a given trade area permanently monopolising shapes which achieve a particular technical result. It is in the public’s interest that legal protection of purely functional shapes is confined to patent rights, which are subject to demarcation in length of time.

**Section 3(2)(c)** This subsection covers shapes which add substantial value to the goods, disregarding any value attributable to a trade mark (i.e. source identification) function. As above, this provision is intended to prevent the securing of a permanent monopoly in the type of design which should be protected under designs legislation, limited in length of time. However, shapes which are, or have been, the subject of registered designs are not excluded from registration unless the shape adds substantially to the value of the goods. It is therefore appropriate to consider whether a substantial proportion of the value of the product to the consumer is attributable to its shape. In many cases this will require a comparative evaluation of the value of the shape in question as compared to those used by competing products.

However, this approach may not assist where purely ornamental products are concerned, such as figurines, where the shape of the product will inevitably also account for a substantial part of the value of competing products.

## 5 Practice

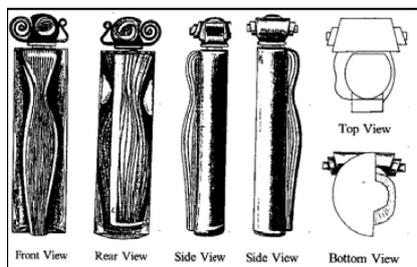
There is no requirement that shapes of goods are only registrable upon evidence of acquired distinctiveness; however, if there is an objection under section 3(2), evidence of use will not assist that objection. Where an application faces objections under sections 3(1) and 3(2), the 3(2) issue must be addressed before, or alongside, any evidence put forward in relation to distinctiveness.

If the essential features of the shape are characteristic of the goods or their intended purpose, the mark will be open to objection under section 3(1)(c). In order to avoid an objection under section 3(1)(b) and/or (c) a shape mark must be sufficiently different from a shape which is:

- i) characteristic of the product;
- ii) the norm or customary in the sector concerned;
- iii) a shape likely to be taken by the product concerned; - so as to permit an average consumer, "without conducting an analytical or comparative examination or paying particular attention, to distinguish the goods concerned from those of other traders".

In other words, the shape must not be descriptive, must stand out from the crowd and, in the case of new product developments, must not be a shape likely to be taken for the product concerned.

The amount of attention that an average consumer pays to the goods and the significance he or she attaches to their shape varies from product to product. Consequently, if there is evidence, or it is well known, that shapes are a customary means of distinguishing the source of a particular category of goods, shapes which stand out to a lesser degree may be acceptable as trade marks. Examples of such goods include perfume bottles, such as:



Where there is no evidence that consumers customarily rely upon the shape of the product itself or its packaging to distinguish the goods of different undertakings, there will be a greater requirement for the shape to stand out from the normal range of product variations

before it can be accepted as liable to distinguish the goods of one undertaking from those of others. For example, this mark was accepted for alcoholic beverages:

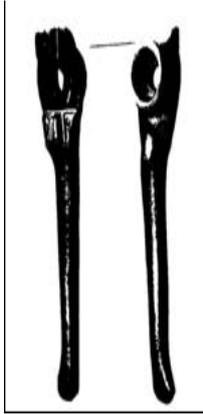


However, the mark below was found *prima facie* to lack the distinctive character necessary to distinguish the goods of one undertaking from those of other undertakings in the market for dairy products, which are relatively low cost products generally bought without a great deal of care and attention to subtle variations in the shape of packaging.



The position in some fields, e.g. soft toys and jewellery, where the shape of the product varies greatly without signifying trade source, will make it more difficult (but not impossible) for a shape to serve a trade mark function for certain categories of goods.

A new shape may still not strike an average consumer as having a trade mark significance if the difference between the shape of the product and other existing products appears to be attributable to a technical advance or is merely attributable to a decorative or ornamental purpose. This shape of an agricultural implement, the [club tine, \(O/005/99\)](#), [2000] R.P.C. 24, was shown to be different to others in that area of trade.



The bulbous end differed from others on the market but was a feature of the tine entirely to achieve the technical result of being more hard-wearing. The other end was designed purely to fit onto the agricultural apparatus used to pull the tines through the ground. Since the entirety of the shape is that which is necessary to obtain a technical result, it was held to be objectionable under section 3(2)(b). It was also held to be devoid of any distinctive character as a trade mark because the average consumer for those goods would not attribute any trade mark significance to a shape whose features were attributable to a purely functional purpose.

In assessing an application against section 3(2)(b), consideration should be given to what the nature of a “technical result” is likely to be for that category of goods. The term should be interpreted broadly and, as well as the more obvious types of technical function, includes shapes which, for example,

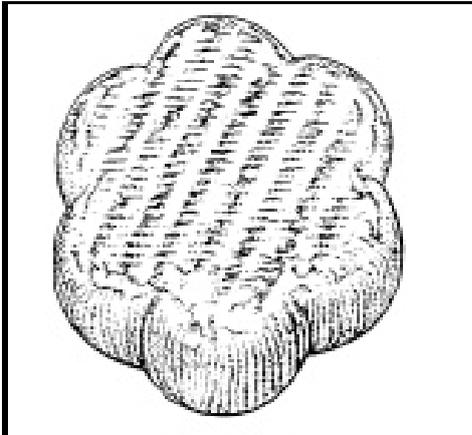
- fit with another article
- give the most strength
- use the least material
- facilitate convenient storage or transportation

Shapes which are, or have been, the subject of a claim in a patent application are not excluded per se by section 3(2)(b) of the Act, but the fact that functional claims have previously been made about the shape will be taken as *prima facie* evidence that those aspects of the shape identified as being functional in the patent claim are necessary to achieve a technical result.

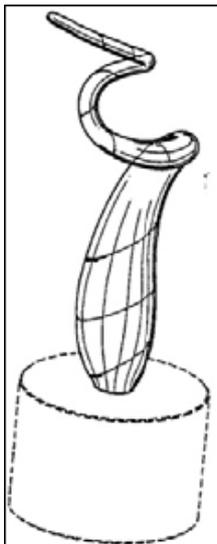
If all *significant* aspects of the shape applied for are attributable only to the achievement of a technical result, the sign will fall foul of section 3(2)(b). The test is whether there are any significant aspects of the shape or its arrangement which are not only attributable to the achievement of a technical result. Trivial embellishments, are unlikely to be sufficient to resist an objection under section 3(2)(b).

The “floral cheese” shape shown below was objected to under section 3(1)(b) because the average consumer would not place any trade mark significance on the “fancy” edging of this basically round cheese. This is because the curves appear decorative and designed to give the individual slices of the cheese an attractive rounded end when the cheese is sliced into

sections for sale. However, no section 3(2)(c) objection was raised because, although attractive, the shape was not considered to give substantial value to the goods.



The shape of the ornamental lamp shown below appears to add substantial value to the goods and was objected to under section 3(2)(c) on this basis:



Although it is an unusual shape for a lamp, the novelty of the shape appears to be attributable to its purpose as an ornamental lamp rather than as an indication of its trade source. Applications of this type are therefore also liable to face objections under section 3(1)(b) and (c) because the shape is characteristic of ornamental lamps.

## **SLOGANS**

Slogans are registrable as trade marks provided that they have the capacity to individualise the goods or services of one undertaking because they are not comprised of signs or indications which directly describe the goods or services or their essential characteristics, and are not devoid of distinctive character for any other reason.

By way of example, the following slogans have been accepted:

OPEN POUR ENJOY LIFE ONCE MORE	(unusual combination)	Foodstuffs and non alcoholic drinks
TIME HAS QUALITY	(impenetrable)	Paints etc
THE DIFFERENCE IS...THE QUALITY OF THE PROMISE	(impenetrable)	Insurance underwriting
Taking care of control	(impenetrable)	Business consultancy
IT'S YOUR TURN TO PLAY	(fanciful)	Electric cooking apparatus
CATCH A WRINKLE IN TIME	(fanciful)	Cosmetic preparations
accelerating your chemistry	(impenetrable)	Metal fences, steel wires
THE SHAPE OF THE MEAL	(fanciful)	Foodstuffs

These were all found to have the capacity to distinguish goods from one undertaking from those of other undertakings, for the goods/services at issue.

In [‘Das Prinzip Der Bequemlichkeit’ \[“The Principle of Comfort”\] C-64/02 P](#), the ECJ stated that slogans serving a promotional function which is not obviously secondary to any trade mark meaning will be objectionable because:

*“...average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans” (paragraph 35).*

Whilst confirming that there is no justification for applying stricter examination criteria to slogan marks, the ECJ confirmed that slogans may fall alongside other non conventional trade marks in being a category of mark that the relevant public is slower to recognise as indicating the product of a single undertaking.

However, that is not to say that a slogan has to contain an additional element of imagination or an additional element of originality to be acceptable; in fact, the ECJ expressly said such criteria should not form part of the assessment of a slogan’s capacity to distinguish the goods of one undertaking from those of another.

Slogans are, by their very nature, adapted for use in advertising and examination should take full account of notional and fair use in that context. It should be borne in mind that the absence of use of the slogan (or similar) by unrelated parties (e.g. during a search of the Internet), does not, in itself, mean that the mark is acceptable (that would be the focus of 3(1)(d)) (see the above decision, paragraph 46).

## 1 Practice

### 1.1 Section 3(1)(c)

Slogans will face an objection under section 3(1)(c) of the Act if they are comprised of a word combination that an average consumer would regard as a normal way of referring to the goods or services or of representing their essential features.

The intended purpose of the goods or services should be regarded as an essential characteristic of the goods or services for the purposes of this assessment.

## **1.2 Plain descriptive language**

The registrar has objected to the registration of: NEVER CLEAN YOUR SHOWER AGAIN (Class 3) – because it describes in plain language the intended purpose of the goods. The fact that the statement may not be literally true is not decisive. Consumers are accustomed to a certain amount of overstatement in advertisements. However, the obviousness of the description need not be fatal to the application if the slogan is an unusual way of conveying a descriptive message, e.g., THE SHOES YOUR FEET HAVE BEEN ACHING FOR. Similarly, although the mark HOW TECHNOLOGY SHAPED THE WORLD would not be acceptable for publications, information or exhibition type goods or services, the registrar has accepted the mark THE BEST WAY TO PREDICT THE FUTURE IS TO CREATE IT (for technology related services in classes 35, 38 & 42) because this was not considered to be a normal way of designating these services, nor to be a commonplace phrase.

## **1.3 Common descriptive phrases**

The mark AN EYE FOR DETAIL (for clothing) was refused because it is a common phrase which, considered in relation to clothing, designates not just a characteristic of the consumer, but also the quality of the goods, i.e. clothing of such quality that it will be appreciated by those consumers with an eye for detail. However, the mere fact that the mark is composed of a well known phrase, will not result in refusal unless the use of that phrase also designates an essential characteristic of the goods or services, e.g., IT'S NOT ROCKET SCIENCE would be acceptable for shoe polish.

## **1.4 Normal use in advertising to be considered**

Some allowance must be made for the fact that, in advertising, it is customary to use short hand when promoting the goods or services. The Appointed Person (Mr S Thorley, QC) upheld the Registrar's refusal to register the trade mark '*WHERE ALL YOUR FAVOURITES COME TOGETHER*' for chocolate confectionery on the grounds that it was a natural abbreviation for the longer expression '*This is where all your favourites come together in one box*', ([Case O/573/01](#)). By contrast the mark FROM THOUGHT TO FINISH has been accepted for goods and services in Classes 9, 16, 35, 41 & 42 because it is not a normal means of designating goods and services in the development field, the mark being a play on the well known phrase "From start to finish".

## **1.5 Ambiguity**

Ambiguity may enhance the prospects of registrability. For example, the registrar has accepted the mark NATURE'S REAL THING for foodstuffs in Classes 29 and 30 because

the reference to natural products is sufficiently allusive, but the mark BEST BUY (on a coloured background resembling a price tag) was refused registration by the Court of First Instance despite the applicant's argument that it had no precise descriptive meaning to consumers. A slogan which has two meanings will not be registrable if one of them is a description of the goods or services. The mark WE SET THE HIRE STANDARD was refused (for car hire services) despite the possible phonetic alternative meaning, and this would have been the case even if the other meaning had not also been a description of the services.

## **1.6 Section 3(1)(b)**

A mark that is free from objection under section 3(1)(c) may still be devoid of any distinctive character because it sends a message that could apply to any undertaking and is not therefore capable of individualising the goods or services of one undertaking. Any objection will identify the alternative message (to a trade mark message) conveyed by the mark.

The following list is not meant as an exhaustive list of the areas where an objection might be relevant, but more as a suggestion of the types of areas covered.

## **1.7 Value statements**

Straightforward value statements that could apply to any undertaking are devoid of any distinctive character, e.g., CARING FOR THE PLANET.

## **1.8 Inspirational or motivational statements**

These types of slogans are considered to be non-distinctive particularly for services, e.g., YOU CAN DO IT WITH US for driving schools, or GO FOR IT for training courses. Where it is an opaque reference and is in respect of goods then it may be acceptable, e.g., JUST DO IT for sports shoes.

## **1.9 Customer service statements**

Similarly, straightforward statements about customer service that could apply to any undertaking are also devoid of any distinctive character e.g. PUTTING CUSTOMERS FIRST; as are natural abbreviations for such statements e.g. PUTTING YOU FIRST.

## **1.10 Purely promotional statements**

The mark SAY IT WITH CHAMPAGNE is composed of a well known advertising strap line "Say it with..." followed by the name of the goods (Champagne). This mark therefore fulfils a purely marketing function, i.e., an invitation to the public to send a message through the gift of champagne. Similarly, the CFI said that "*REAL PEOPLE, REAL SOLUTIONS*", whilst not having a directly descriptive connotation, nevertheless has nothing about it to displace its purely promotional message. These examples are to be contrasted with marks such as THE PRINCIPLE OF COMFORT which (at least in English) is an uncommon term with no clear meaning.

## **1.11 Statements by/about the user of goods/wearer of clothing**

Slogans such as "I ♥ My Boy Friend" or "Here comes Trouble" are often used to decorate goods, particularly clothing – T-shirts, sweatshirts or baseball caps. In this context, consumers are unlikely to perceive this type of slogan as a sign of trade origin. When seen as a personal statement by/about the wearer/user rather than indicating the trade origin of the product. Slogans which are likely to be seen as such will therefore be open to objection under section 3(1)(b) of the Act.

Where it is equally or more plausible that such a slogan is capable of being seen as a fancy trade mark, such as "Lanky Bird", no objection should be raised on this ground. If the mark is not subsequently used as a trade mark it will become liable to revocation for non-use.

## **SPECIFICATION - CLASS HEADINGS**

This guidance takes into account the judgment of the Court of Justice of the European Union ('CJEU') in *Chartered Institute of Patent Attorneys v Registrar of Trade Marks, C-307/10* ('IP Translator'). It also takes into account the decision of the Appointed Person following the CJEU judgment BL O-197-13 (164Kb).

### **Background**

In classifying of goods and services, the United Kingdom follows the practice as set out under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957) (as amended) i.e. the 'NICE' classification. Under this system goods and services are classified under 45 separate classes, using a 'class heading' that indicates, in fairly broad and general terms, the type and range of goods or services it covers. For example, Class 13 is made up of 4 General Indications: Firearms; ammunition and projectiles; explosives; fireworks. Each Class Heading is also complemented by a detailed alphabetical list of items already accepted as proper to each Class (see General Remarks, Nice Classification, 10th Edition).

Over time, Registering Authorities throughout the Community have developed two different approaches to dealing with lists of goods/services made up of full Class Headings. The first approach has been to treat such applications as a claim to all of the goods/services in the class specified. The second approach, historically adopted by the UK, has been to take such claims as covering only those goods/services which were covered by the natural meaning of the individual descriptions of the goods and/or services making up the Class Heading.

This difference in interpretation resulted in a reference to the CJEU seeking guidance in respect of assessing both Class Headings as a whole and the General Indications of which they comprise. The Court confirmed that classification terms used to denote the goods or services covered by a trade mark registration should be identified with sufficient clarity and precision to enable third parties to determine the extent of the protection conferred by registration on the basis of the descriptions alone. In that context, the Court confirmed that General Indications can be used in an application, provided that they are sufficiently clear

and precise. The Court further stated that an applicant who chooses to use all General Indications of a particular class heading (i.e. the Class Heading itself) must say whether such a claim is intended to cover all the goods or services included in the alphabetical list of that class, or only some. The uncertainty cannot be resolved based on the 'interpretation adopted by the competent authority and not on the actual intention of the applicant'.

In paragraph 19 of his decision, the Appointed Person was clear that the Registrar as the competent authority in the United Kingdom has the power under Section 32(2)(c) of the 1994 UK Trade Marks Act 1994 ('The Act') Act, and Rule 8(2)(b) of the Trade Marks Rules 2008 ('The Rules') to ensure that applications for registration comply with the legal requirement for clarity and precision.

### **Clarity and precision: General Indications**

Although the judgment does not preclude the use of the General Indications in lists of goods/services, the Court has confirmed that some of these indications are too vague to meet the requirements for clarity and precision. Through convergence work involving the OHIM, EU National Offices, and participating user organisations, we have now agreed upon a list of 11 General Indications which fall into this category. A list of those terms, and the reasons why they are considered to lack clarity and precision, is reproduced at paragraph 13 of this notice. The use of these descriptions in an application, either alone or in combination with other such indications, will result in an objection being raised during examination under Rule 8(2)(b). This will also apply to designations of the UK under the Madrid Protocol by virtue of paragraph 4(3) of schedule 2 to the Trade Mark (international Registration) Order 2008 (the Order).

In some cases, parts of a General Indication may meet the requirement for clarity and precision, for example, machine tools will not attract an objection if used in a specification whereas the full General Indication machines and machine tools will attract an objection because 'machines' is considered to be too vague. The offending General Indications are highlighted in paragraph 13.

It will be possible for applicants (including those seeking extension of an international registration) to provide replacement descriptions of goods and services where one of the 11 unacceptable General Indications has been used. However, as confirmed by the Appointed Person, any amendment must inevitably take account of the legislative provisions. In particular, this applies to both section 32 of the 1994 Act which sets the requirement for receiving a filing date, and section 33 which limits the scope for amendment of the list of goods or services in an application for registration which has been given a filing date. The Appointed Person also drew attention to section 39 of the Act, which prevents amendments which would have the effect of widening the coverage of the list of goods or services contained in the application for registration as filed. Although referred to in the context of UK applications the prohibition on widening applies equally to international registrations designating the UK by virtue of paragraph 7 of the Order only permitting restrictions. Therefore, in order to be accepted, any replacement terms must clearly fall within the meaning of the offending General Indication(s). In the case of international registrations designating the UK, the replacement must take the form of a restriction to the UK designation and must be filed at WIPO.

## **Use of all the General Indications of a class**

The trade mark application form will be amended so that applicants are required to confirm that the terms used in their list of goods/services should be given their ordinary and natural meanings.

If an applicant wishes to register a mark for all the goods/services set out in the alphabetical list for a particular class or classes of the NICE classification system, they should list all the individual terms in the alphabetical list for the class(es) concerned in the application.

Applicants are, however, reminded that s.32(3) of the Act requires a statement that the mark is being used, or the applicant has a bona fide intention to use the mark, in relation to the goods/services listed in the application.

## **Use of 'All goods in class' (and equivalents)**

The Appointed Person stated that it is for the applicant to specify which of the goods or services in the class are intended to be covered, and that the requirement for clarity and precision cannot be satisfied by means of 'off the register' explanations. Accordingly, wording such as "all goods in Class X", will result in an objection under Rule 8(2) being raised at examination.

## **Implementation**

The list of unacceptable General Indications as agreed by IPO in conjunction with OHIM, other national offices, and user organisations, is presented below. The list also contains brief explanations as to why each of these terms is deemed to be unacceptable and highlights where parts of a General Indication may be used without objection.

### **Class 06 'Goods of common metal not included in other classes'**

This does not describe goods of any specific type, only that the goods are of common metal and do not belong to a class other than Class 6. There are many and varied goods that are made of common metal that are not found in class 6, and without research it would not be clear what these goods are. Therefore, the description 'goods of common metal not included in other classes' cannot, on the basis of the description alone, set out the goods with a clarity and precision that enables others to determine what goods fall within the scope of protection.

### **Class 07 'Machines and machine tools'**

The term 'machines' describes apparatus that 'use mechanical power with the characteristics of having several parts, each with a definite function and together performing a particular task'. Being such a general description, it does not define goods of any particular type or of any particular function, so cannot on its own describe goods with a degree of clarity and precision. This means that the scope of the protection offered by the term cannot be determined. However, it may do so when further defined such as by purpose (e.g. washing machines') or via reference to the industry in which it is used (e.g. 'agricultural machines').

The description 'machine tools' on its own describes a specific type of goods, and will be accepted as having the clarity and precision to set the scope of protection it gives.

**Class 14 'Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes'**

This description does not specify what the goods are, only that they are made or coated with precious metals and are not included in other classes. Many goods such as 'household cutlery made of or coated with precious metal' are proper to classes other than class 14, and without research it would not be clear which goods would be covered by this description. Consequently, the term 'goods of precious metal or coated therewith not included in other classes' cannot, on the basis of the description alone, describe the goods that it covers with enough clarity or precision to enable others to determine the scope of protection.

The descriptions 'Precious metals', 'Precious metal alloys' and 'Precious metals and their alloys' describe specific types of goods, and will be accepted as having the clarity and precision to set the scope of protection they give.

**Class 16 'Paper, cardboard and goods made from these materials, not included in other classes'**

The description 'Paper, cardboard and goods made from these materials, not included in other classes' does not say what the goods are, only that they are made of the materials mentioned and that they are not found in other classes. There are many goods of paper and cardboard are classified in classes other than class 16, and without research it would not be clear what goods would or would not be covered by this description. Consequently, the description 'Paper, cardboard and goods made from these materials, not included in other classes' cannot, on the basis of the description alone, describe the goods that it covers with a clarity and precision that enables others to determine the scope of protection.

The descriptions 'Paper' and 'Cardboard' describe specific types of goods, and will both be accepted as having the clarity and precision to set the scope of protection they give.

**Class 17 'Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes'**

The description 'goods made from these materials and not included in other classes' does not say what the goods are, only that they are made of the materials mentioned and that they are not proper to class 17. There are many goods made of the materials mentioned that are classified in classes other than class 17, and without research it would not be clear what goods would or would not be covered by this description. Consequently, the description 'goods made from these materials and not included in other classes' cannot, on the basis of the description alone, describe the goods that it covers with a clarity and precision that enables others to determine the scope of protection.

The descriptions 'Rubber', 'gutta-percha', 'gum', 'asbestos' and 'mica' describe specific types of goods, and will be accepted as having the clarity and precision to set the scope of protection they give.

### **Class 18 'Leather and imitations of leather, and goods made of these materials and not included in other classes'**

The description 'goods made from these materials and not included in other classes' does not say what the goods are, only that they are made of 'leather and imitations of leather' and that they are proper to class 18. There are many goods made of the materials mentioned which are classified in classes other than class 18, and without research it would not be clear what goods would or would not be covered by this description. Consequently, the description 'goods made from these materials and not included in other classes' cannot, on the basis of the description alone, describe the goods that it covers with a clarity and precision that enables others to determine the scope of protection it gives.

The descriptions 'Leather', 'Imitations of leather' and 'Leather and imitations of leather' describe specific types of goods, and will be accepted as having the clarity and precision to set the scope of protection they give.

### **Class 20 'Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics'**

This description does not say what the goods are, only that they are made of the materials mentioned and that they are proper to class 20. There are many goods made of the materials mentioned that are classified in classes other than class 20, and without research it would not be clear what goods would or would not be covered by this description. Consequently, the description 'goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics' cannot be a description with a clarity and precision that enables others to determine the scope of protection it gives.

### **Class 37 'Repair'**

The service of 'repair' can be provided in respect of any type of goods. Repair service providers generally focus on a defined and related product area, such as household appliances, motor vehicles or construction. These are distinct areas that require very different levels of technical capabilities and knowledge. In some cases the repair can involve a service belonging to a different class, for example, a repair following a computer failure may include reprogramming which is a service in Class 42. Without specifying the product or area to which the repair is to be provided, the description 'repair' on its own lacks the clarity and precision necessary to determine the scope of protection it gives.

### **Class 37 'Installation services'**

'Installation' simply describes the act of installing which can be provided in respect of a wide range of goods. Installation service providers generally focus on a defined and related

product or area, such as 'heating installation', 'motor vehicles' or 'construction'. In some cases, the installation involves an activity that is a service in its own right and belonging to a different class, for example, the installation of computer programme can be a service in Class 42. Without specifying the product or area the description, 'installation' lacks the clarity and precision necessary to determine the scope of protection it gives.

#### **Class 40 'Treatment of materials'**

The description 'Treatment of materials' describes a general activity involving a change to the physical characteristics of a product. Such a service can be provided in many different ways involving a wide range of goods. Service providers generally focus on a defined and related product or area, such as 'chrome plating' or 'the waterproofing of cloth'. In some cases, the 'treatment' does not change the characteristics, and as such is a service belonging to a different class, for example, the application of an anti-rust treatment which is a service in Class 37. Without specifying the nature of the treatment the description 'Treatment of materials' lacks the clarity and precision necessary to determine the scope of protection it gives.

#### **Class 45 'Personal and social services rendered by others to meet the needs of individuals'**

Individuals have many and varied needs, some personal or social, others being medical, therapeutic, educational or for entertainment, etc. As such, this description cannot describe a service with any clarity or precision without the addition of more information about the service being rendered.

## **SPECIFICATION RESTRICTIONS**

Restricting the specification involves amending the description of goods or services applied for in order to limit their scope and thereby overcome an objection that has been raised because of the inclusion in the specification of particular goods or services. Specifications are usually restricted as a result of negotiations at the correspondence stage, or as a result of agreement with the hearing officer if the application has gone to a hearing. However, if the examiner can see a clear way to overcome an objection raised under section 3(1) when he or she is preparing the initial examination report, he or she will suggest (in the examination report) the appropriate amendment (**see also the sections on DECEPTIVE MARKS and NOTIFICATION**).

Although examiners and hearing officers should endeavour to assist the applicant/attorney to overcome the objection by amending the specification, there will be occasions when it will be impossible to do this. The responsibility for overcoming the objection remains with the applicant or his attorney. Accordingly, if an examiner's suggestions are adopted, they become the applicant's proposal.

### **1 Types of specification restriction**

There are three ways to restrict a specification in order to overcome an objection raised under section 3(1):

- a deletion
- a positive limit
- an exclusion

### **1.1 Deletions**

Deleting is a simple removal of the goods or services which are causing the problem. This is an option if the mark faces objections only in relation to specific items in the specification, but is clearly distinctive for the rest of the specification. It is important to ensure that if specific terms have been deleted, the same goods or services are not still included elsewhere in the specification, for example within a broad term. For instance, a deletion of a specific inclusion of “computer software for financial management” would still be covered by the broader term “computer software for business purposes”, elsewhere in the specification. When undertaking deletion of a broad term and substituting individual items, care must be taken not to widen the original scope of the specification. This is especially relevant when the original specification was filed as the class heading. When a class heading is used as a specification, it loses its capacity to function as a class heading and becomes part of an application or registration as a statement of goods or services. So, an application in Class 12 which states “*Vehicles; apparatus for locomotion by land, air or water*” cannot be limited to “*parts and fittings*” at a later stage. (Further information on this topic can be found in the Classification Work Manual).

Once a specification has been limited by deletion, the deleted goods or services cannot be reinstated.

### **1.2 Positive Limitations**

These restrict the scope of the specification by more clearly defining the goods or services. This may be done either by a simple listing of specific items, or by saying specifically, for example, “all relating to...” or “all of the aforesaid goods being for use in...”. Commonly, a limitation of this type will be placed at the end of a specification, but in the case of a lengthy specification, may also be appropriate elsewhere in the text. Wherever it appears, it is very important to ensure that the punctuation is correct. The use of commas or semi-colons can make all the difference to the meaning of a specification. A semi-colon means that the limitation covers all the preceding wording, whilst a comma only covers the wording as far back as the preceding semi-colon.

A restriction in this way is a positive statement by the applicant, affirming exactly what they have cover for. It is therefore a desirable way to amend the specification, making for clarity of the Register, in the interests both of the applicant and of third parties.

### **1.3 Exclusions**

Exclusions are the opposite of positive limits in that they define what the goods or services are **not**, starting with the wording “but not including...”. Following the judgment of the ECJ in

the [Postkantoor case, C-363/99](#), there is reduced scope for overcoming section 3(1) objections using exclusions. Previously known as the “penguin practice”, because of its inception as a result of Penguin Book’s trade mark application, it was the registrar’s practice to allow exclusions in respect of marks which are descriptive of goods in the specification having certain characteristics, but acceptable for the same goods without that characteristic.

However, *Postkantoor* makes it clear that the Trade Mark Directive, from which the UK Act is derived, “prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic”. In other words, excluding the particular characteristic that the mark describes is not an option. The reasoning that the Court gave for this ruling is underpinned by the legitimate interest of other traders; an exclusion in relation to particular characteristics might cause other traders to refrain from using that sign in trade, because it would be unclear that the mark’s protection did not actually extend to those goods or services for which it was descriptive. They would not know, as a general rule, about the exclusion and there might be legal uncertainty, which is what the Directive is intended to prevent.

## 2 Characteristics versus sub-categories

However, there is still a place for exclusions provided they are in respect of categories or sub-categories of goods or services and **not** in respect merely of their characteristics. A characteristic is a specific quality, attribute or trait, whilst a category is a group or sub-group of the item. The term “characteristic” includes not only obvious descriptions, such as “pink” for shirts, but also covers when, where, why and how the goods or service may be supplied and their intended purpose. It would not therefore be acceptable to exclude, for the mark “Post Office”, postage stamps provided they are not connected with a post office.

When considering employing exclusions, regard must be had to whether the exclusion will render the mark deceptive or whether it is likely that the applicant intends to use the mark on goods or services for which it is not descriptive (otherwise, it may be open to a bad faith objection (section 3(6))).

The following are examples of acceptable and unacceptable exclusions:

### Acceptable:

Mark: **TUTANKHAMUN**  
Specification: “Printed matter; but not including educational, archaeological or historical printed matter.

This is acceptable because printed matter can be sub-categorised; books on history etc would be a sub-category rather than a characteristic. An exclusion merely in relation to books about Tutankhamun would be too narrow as the applicant would then have cover for similar goods (such as books about Egyptology).

Mark: **VELVET BUNNY**  
Specification: “Toys, games and playthings; but not including soft toys”.

This is acceptable because soft toys can be regarded as a sub-category of toys and the mark would not be descriptive of other types of toys.

Mark: **FISH**  
Specification: "Cleaning preparations; cosmetics; preparations for the hair; but not including soaps."

This overcomes the problem with novelty soaps, novelty soaps being a sub-category in this class. It would be insufficient simply to exclude soaps in the form of fish.

**Unacceptable:**

Mark: **ROSE**  
Specification: "Cosmetics, perfumes, toiletries; but not including any such goods scented to smell like roses."

This exclusion does not overcome the descriptiveness objection because the exclusion relates simply to goods bearing the characteristic described by the mark. This objection cannot be overcome for this type of goods.

Mark: **DAFFODIL**  
Specification: "Chinaware; glassware; ornaments, statuettes and figurines; but not including any such goods in the form of or decorated with flowers".

This would not overcome the descriptiveness objection because the mark describes a characteristic of the goods; and it is common in the trade for goods of this type to be decorated florally.

Mark: **FROG**  
Specification: "Footwear; but not including footwear in the form of frogs".

This exclusion does not overcome the descriptiveness objection. The exclusion covers only a specific characteristic of the goods rather than a sub-category. The objection could be overcome by excluding "novelty footwear."

Mark: **BROADBAND GLOBAL**  
Specification: "Telecommunications; provision of telecommunications information; transmission of messages and images; broadcasting services; but not including any such services provided by or about the internet."

The exclusion does not overcome the descriptiveness objection. "Broadband" is a characteristic of telecommunications services, usually, although not exclusively, associated with internet use. Internet services are not a sub-category of a broadband telecommunications service. The mark describes a specific characteristic of a telecommunications service i.e. a broadband telecom service providing global access.

The descriptiveness objection cannot be overcome. Broadband services are a subcategory of telecommunications services, but it is implausible that the applicant would apply for a

mark like this in respect of non-broadband services. Consequently, a proposal to exclude “broadband telecommunication services” would give rise to further objections under section 3(3)(b) - because other use would be deceptive - and section 3(6) - because there is no real intention to use other than for broadband services.

**See also the section on Deceptive Marks for exclusions which cause the raising of an objection under section 3(3)(b).**

## **SPECIFICATIONS (Wide or vague)**

Objection will be raised **under rule 8(2)(b) in all classes** where a claim is made to 'All goods' or 'All services' in a Class - these descriptions are too vague and do not constitute a proper list of goods or services.

Subject to conclusions drawn in the judgement of the Court of Justice of the European Union in *Chartered Institute of Patent Attorneys v Registrar of Trade Marks*, C-307/10 ('IP Translator'), applications filed in respect of specifications that are drafted in the form of the headings to the International Classes as listed in the 10th edition of the International Classification will not, in the main, be subject to an objection. The exceptions are classes 6, 7, 14, 16, 17, 18, 20, 37, 40, and 45 - this is because the class headings corresponding to those classes contain individual general indications which were identified by the Court as being imprecise. Those terms are as follows:

### **Class 06 'Goods of common metal not included in other classes'**

This does not describe goods of any specific type, only that the goods are of common metal and do not belong to a class other than Class 6. There are many and varied goods that are made of common metal that are not found in class 6, and without research it would not be clear what these goods are. Therefore, the description 'goods of common metal not included in other classes' cannot, on the basis of the description alone, set out the goods with a clarity and precision that enables others to determine what goods fall within the scope of protection.

### **Class 07 'Machines and machine tools'**

The term 'machines' describes apparatus that 'use mechanical power, and with the characteristics of having several parts, each with a definite function and together performing a particular task'. Being such a general description, it does not define goods of any particular type or of any particular function, so cannot on its own describe goods with a degree of clarity and precision. This means that the scope of the protection offered by the term cannot be determined. However, it may do so when further defined such as by purpose (e.g. 'washing machines') or via reference to the industry in which it is used (e.g. 'agricultural machines').

The description 'machine tools' on its own describes a specific type of goods, and will be accepted as having the clarity and precision to set the scope of protection it gives.

#### **Class 14 'Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes'**

This description does not specify what the goods are, only that they are made or coated with precious metals and are not included in other classes. Many goods such as 'household cutlery made of or coated with precious metal' are proper to classes other than class 14, and without research it would not be clear which goods would be covered by this description. Consequently, the term 'goods of precious metal or coated therewith not included in other classes' cannot, on the basis of the description alone, describe the goods that it covers with enough clarity or precision to enable others to determine the scope of protection.

The descriptions 'Precious metals', 'Precious metal alloys' and 'Precious metals and their alloys' describe specific types of goods, and will be accepted as having the clarity and precision to set the scope of protection they give.

#### **Class 16 'Paper, cardboard and goods made from these materials, not included in other classes'**

The description 'Paper, cardboard and goods made from these materials, not included in other classes' does not say what the goods are, only that they are made of the materials mentioned and that they are not found in other classes. There are many goods of paper and cardboard are classified in classes other than class 16, and without research it would not be clear what goods would or would not be covered by this description. Consequently, the description 'Paper, cardboard and goods made from these materials, not included in other classes' cannot, on the basis of the description alone, describe the goods that it covers with a clarity and precision that enables others to determine the scope of protection.

The descriptions 'Paper' and 'Cardboard' describe specific types of goods, and will both be accepted as having the clarity and precision to set the scope of protection they give.

#### **Class 17 'Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes'**

The description 'goods made from these materials and not included in other classes' does not say what the goods are, only that they are made of the materials mentioned and that they are not proper to class 17. There are many goods made of the materials mentioned that are classified in classes other than class 17, and without research it would not be clear what goods would or would not be covered by this description. Consequently, the description 'goods made from these materials and not included in other classes' cannot, on the basis of the description alone, describe the goods that it covers with a clarity and precision that enables others to determine the scope of protection.

The descriptions 'Rubber', 'gutta-percha', 'gum', 'asbestos' and 'mica' describe specific types of goods, and will be accepted as having the clarity and precision to set the scope of protection they give.

#### **Class 18 'Leather and imitations of leather, and goods made of these materials and not included in other classes'**

The description 'goods made from these materials and not included in other classes' does not say what the goods are, only that they are made of 'leather and imitations of leather' and that they are proper to class 18. There are many goods made of the materials mentioned which are classified in classes other than class 18, and without research it would not be clear what goods would or would not be covered by this description. Consequently, the description 'goods made from these materials and not included in other classes' cannot, on the basis of the description alone, describe the goods that it covers with a clarity and precision that enables others to determine the scope of protection it gives.

The descriptions 'Leather', 'Imitations of leather' and 'Leather and imitations of leather' specific types of goods, and will be accepted as having the clarity and precision to set the scope of protection they give.

**Class 20 'Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics'**

This description does not say what the goods are, only that they are made of the materials mentioned and that they are proper to class 20. There are many goods made of the materials mentioned that are classified in classes other than class 20, and without research it would not be clear what goods would or would not be covered by this description. Consequently, the description 'goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics' cannot be a description with a clarity and precision that enables others to determine the scope of protection it gives.

**Class 37 'Repair'**

The service of 'repair' can be provided in respect of any type of goods. Repair service providers generally focus on a defined and related product area, such as household appliances, motor vehicles or construction. These are distinct areas that require very different levels of technical capabilities and knowledge. In some cases the repair can involve a service belonging to a different class, for example, a repair following a computer failure may include reprogramming which is a service in Class 42. Without specifying the product or area to which the repair is to be provided, the description repair on its own lacks the clarity and precision necessary to determine the scope of protection it gives.

**Class 37 'Installation services'**

'Installation' simply describes the act of installing which can be provided in respect of a wide range of goods. Installation service providers generally focus on a defined and related product or area, such as 'heating installation', 'motor vehicles' or 'construction'. In some cases, the installation involves an activity that is a service in its own right and belonging to a different class, for example, the installation of computer programme can be a service in Class 42. Without specifying the product or area the description, 'installation' lacks the clarity and precision necessary to determine the scope of protection it gives.

## **Class 40 'Treatment of materials'**

The description 'Treatment of materials' describes a general activity involving a change to the physical characteristics of a product. Such a service can be provided in many different ways involving a wide range of goods. Service providers generally focus on a defined and related product or area, such as 'chrome plating' or 'the waterproofing of cloth'. In some cases, the 'treatment' does not change the characteristics, and as such is a service belonging to a different class, for example, the application of an anti-rust treatment which is a service in Class 37. Without specifying the nature of the treatment the description 'Treatment of materials' lacks the clarity and precision necessary to determine the scope of protection it gives.

## **Class 45 'Personal and social services rendered by others to meet the needs of individuals'**

Individuals have many and varied needs, some personal or social, others being medical, therapeutic, educational or for entertainment, etc. As such, this description cannot describe a service with any clarity or precision without the addition of more information about the service being rendered.

## **Individual Terms which do not clearly indicate the nature of the goods or services**

Although it is unlikely to happen very often, individual descriptions of goods or services (other than those taken from the Nice Guide) sometimes fail to clearly describe the nature of the goods or services, even when read in conjunction with the class of the application. In these circumstances an objection will be raised under rule 8(2)(b).

## **Vague Specifications hiding descriptive significance**

The registrar is entitled to require the applicant, in particular cases, to clarify the goods or services in relation to which he/she proposes to register the mark. The applicant is not entitled to hide the descriptive nature of a mark within a broad or vague specification of goods/services - the reasoning behind this is as set out in the *HOLD AND DRAW* case under the 1938 Act (1964) RPC 142. The registrar has power to require such additional information and documents as he deems necessary under rule 62 of the Trade Mark Rules 2008.

## **SURNAMES, FORENAMES AND FULL NAMES**

The ECJ's judgement in [Case C-404/02, \*Nichols plc v Registrar of Trade Marks\*](#) (16 September 2004) addressed the distinctive character of common surnames.

The court confirmed that the assessment of the distinctive character of a surname must be carried out according to the specific circumstances of the case, and that (like all other types of marks) the presence or absence of distinctive character depends upon the perception of relevant consumers, having regard to the essential function of a trade mark identified in Article 2 of the Directive.

It therefore appears that there may be circumstances in which a common surname as such lacks the necessary distinctive character for registration as a trade mark.

The court provided no guidance as to what specific factors may be properly taken into account in assessing the distinctive character of a common surname. However, the court did state (in paragraph 26 of its judgement) that it regarded an assessment of distinctiveness based upon:

- a predetermined number of persons with the same name, above which that name may be regarded as devoid of distinctive character,
- the number of undertakings providing products or services of the type covered by the application for registration, or
- the prevalence or otherwise of the use of surnames in the relevant trade, as applying “stricter general criteria for assessment of distinctiveness” (as compared to the criteria applied to other types of trade marks) which “cannot be applied to [surname] marks.”

Further, the court confirmed (in paragraph 31 of its judgement) that registration of a surname cannot be refused for the purpose of ensuring that no advantage is afforded to the first applicant for its registration as a trade mark.

## **1 Examination of trade marks consisting of surnames**

Given the ECJ’s rejection of the general application of the factors which the court characterised as “general criteria”, the registrar will not raise objections to the registration of marks consisting of common surnames on the basis of these factors alone.

The registrar will not generally have specific information about the extent of the use of a particular surname in a specific sector of the market. Exceptionally, the registrar may take judicial notice of facts which are **generally known**, which could include the extent of the use of a particular surname in a specific field. For example, the registrar may not need evidence in order to notice that there are a large number of doctors in practice in the UK with the name ‘Smith’. He may properly conclude from this finding that consumers or end users of medical services will not regard that name, by itself, as distinguishing the medical services of one undertaking from those of other such undertakings. In these circumstances it will, of course, be open to the applicant to challenge any of the facts upon which the registrar relies to support a resulting objection under section 3(1)(b) of the Act.

Following publication it will be open to third parties to supplement the registrar’s knowledge of the market by placing relevant facts before the registrar through the filing of written observations or an opposition. For example, if an application is made to register the surname ‘James’ as a trade mark for ‘clothing’, it may be relevant that there is evidence that there were other clothing businesses already known to the public to be trading under that name at the date of the application. However, the mere existence of one or two unconnected undertakings with the same name in the same market sector will not automatically justify an objection under section 3(1)(b) on absolute grounds. This is because the existence of earlier

unregistered rights is a matter which, in principle, should support an opposition on relative grounds.

However, if the evidence shows that, at the date of the application, the relevant public's expectation was that there would have been numerous undertakings trading in the relevant sector under the name in question, with the result that the public could have had no expectation that relevant goods or services under that name would originate from any particular undertaking, then it would be legitimate to conclude that the name is devoid of any distinctive character, and therefore subject to objection under section 3(1)(b).

## **2 Surnames with other descriptive meanings**

Where a word which is a surname has another meaning, that meaning may found an objection to registration. For example, the trade mark BROWN would face an objection under section 3(1)(b) & (c) of the Act if applied for in relation to 'sauces' because it is a word which may serve, in trade, to designate a kind of sauce. Similarly, the same word would not be acceptable as a trade mark for 'paints' because it designates a characteristic of those goods (colour).

## **3 Surnames with initials and full personal names**

Full names and surnames with initials will be treated in the same way as surnames alone. The former have, by their nature, a greater capacity to distinguish the goods/services of one undertaking than a surname per se. It is therefore even less likely that the registrar will, in future, object to the registration of such signs as trade marks.

## **4 Single forenames**

Forenames will normally be accepted as having distinctive character. However, an objection may arise under section 3(1)(b) of the Act where the goods are of a kind traditionally adorned with common forenames, such as mugs and bracelets, and where because of this the perception of relevant consumers would be that such a name appearing on those products would be merely decorative.

The registrar has in the past objected to male and female forenames as trade marks for restaurant services, tea shops, hairdressers and beauty salons etc. because such signs are generally used concurrently by unrelated undertakings as the names of such shops. In the light of the ECJ's judgement in *Nichols*, an objection of that kind (under section 3(1)(b)) is only likely to be justified where it can be inferred from specific evidence that consumers would not perceive the name as distinguishing the goods and services in question as being those of one undertaking.

In practice, this is only likely to arise where evidence of the position in the relevant market at the relevant date is available.

## **5 Forenames on clothing**

Applications made in Class 25 for marks consisting of male or female forenames will be accepted, even when the specification covers T-shirts, baseball caps etc. Although the possibility of the mark being taken as a reference to the wearer cannot be ruled out, it is considered at least equally plausible that it could be taken as a brand.

## UNCONVENTIONAL TRADE MARKS

### 1 Colour trade marks - Colour(s) alone - in the abstract or applied to the goods or their packaging

#### 1.1 Graphical representation

In [Libertel \(C-104/01\)](#), the ECJ decided that to be represented graphically, colour marks must be presented in a way that is “clear, precise, self-contained, easily accessible, durable and objective” (the [Sieckmann criteria](#))(C273/00). The court determined that providing a sample of the colour(s) proposed for registration on paper is not sufficient by itself to satisfy the requirement for graphical representation of the sign. However, the court stated that the *Sieckmann* criteria may be satisfied by designating the colour using an internationally recognised colour identification code.

#### Single Colours

With that in mind, marks consisting of colour alone will be considered to be graphically represented if they are filed in the form of a written description of the colour(s) (e.g. dark blue) and are accompanied by the relevant code(s) from an internationally recognised colour identification system. There are a number of colour identification systems in existence e.g. Pantone®, RAL and Focoltone®. Applications filed electronically may also use an RGB profile to define the colour when filed in association with an electronic image of the colour. This is not an exhaustive list and the choice of which system to use is one for the applicant. Where a sample of the colour and a description in words are used to represent a colour mark, the two must be integrated so as to disclose the mark applied for in an unambiguous manner. For example, the colour shown and any colour code should not contradict each other.

A degree of interpretation of the graphical representation is permissible. For example, it is permissible to require third parties to look up the colour which corresponds with a particular colour code. However, there are limits to what can reasonably be expected of third parties. It must be reasonably practicable for persons inspecting the register, or reading the Trade Mark Journal, to be able to gain an understanding from the graphical representation of what the trade mark is.

Representations which are precise but impossible to interpret without costly specialist equipment or services, place too high a burden on third parties and are likely to be rejected because they are not “easily accessible.” Accordingly, a mark defined as “a blue bottle of optical characteristics such that if the wall thickness is 3mm the bottle has, in air, a dominant wavelength of 472 to 474 nanometres, a purity of 44 to 48%, an optical brightness of 28 to

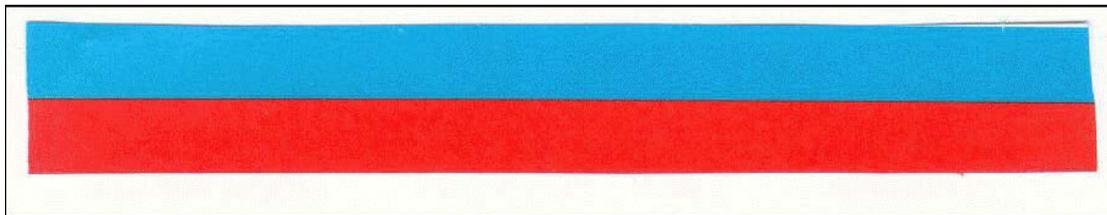
32%” was rejected by The Appointed Person in [Ty Nant Spring Water Ltd’s Application](#) (BL O/241/99) because it would require third parties to use a spectrophotometer to ascertain whether a particular colour was or was not covered by the description, and in fact served to veil the identity of the sign (cobalt blue).

### **Combinations of Colours**

In [Heidelberger Bauchemie GmbH, Case C-49/02](#), the ECJ introduced an additional requirement for marks consisting of a combination of colours in the abstract, without contours. In this case the representation must also include “a systematic arrangement associating the colours in a predetermined and uniform way.”

Unfortunately, it is not very clear what this means in practice. The ECJ offered no examples of the ways in which the requirement might be satisfied. However, the following representation of CTM number 2177566 appears to plainly fall within the guidance.

E2177566



Goods/services: Cl 6, 11, 19 and 20

Description: The distribution and ratio of the colours to each other is 50 - 50, whereby the colour blue runs horizontally above the colour red, forming a striped whole.

Indication of colour: Blue: Ral 5015, red: Ral 2002.

Alternative ways of representing colour marks graphically may be accepted as long as they satisfy the criteria set out above.

### **Representing Colour(s) in the Abstract as Opposed to Colour(s) Applied to the Goods or to their Packaging**

The ECJ has made it clear that there is no reason why, in principle, colour(s) cannot be registered in the abstract, as opposed to specific applications of colour such as being applied to the exterior of the goods themselves, or to their packaging.

Descriptions such as “as shown on the form of application” have been found to be an inadequate means of limiting the mark to the precise form shown in the pictorial representation of the mark on the application form. (See the [Advocate General’s Opinion in Case C-321/03, Dyson Ltd v Registrar of Trade Marks](#) (subsequently endorsed in the [ECJ Judgment of 25<sup>th</sup> January 2007](#)). Consequently, this wording will no longer be accepted as limiting the mark to the form shown. Instead more express wording, such as in the case of

colour marks “in the [arrangement/position] depicted in the pictorial representation of the mark” should be used instead.

Applicants should consider whether the way colour is used forms an essential part of the subject matter of their trade mark. For example, if evidence of acquired distinctiveness is likely to show that a specific colour has come to be recognised as a trade mark when it is used in a particular manner, for example on the sides of the overhead canopy of a fuel service station, it may be advisable to define the mark in this way from the outset. It is not possible to amend the trade mark application after it has been made in ways which substantially affect the identity of the mark.

### **Failure to Meet the Requirements for Graphical Representation of the Trade Mark**

An application which does not meet the requirements will face an objection under section 32(2)(d) of the Act because it does not contain a graphical representation of the trade mark. The applicant or his representative will be notified in writing about this and given two months to remedy this deficiency, under rule 11. Failure to remedy the deficiency within this two month non-extendable period will result in the application being deemed never to have been made.

If the requirements are subsequently met, the filing date of the application will be the date upon which everything required by section 32(2) is received at the registry.

## **2 Assessing distinctive character**

### **Single colours**

In [Libertel \(C-104/01\)](#) the court decided that colour, per se, may have a distinctive character and may be capable of distinguishing the goods and services of one undertaking from those of other undertakings. However, as colour per se is not normally used by traders as a means of brand identification, unlike words or pictures, consumers are not in the habit of making assumptions about the origin of goods and services based solely on their colour or the colour of their packaging. It follows therefore that single colours will only in exceptional circumstances be capable of denoting the origin of a product or service. Marks consisting of a single colour will usually be liable to objection under section 3(1)(b) of the Act because they lack the capacity to distinguish. In some cases single colours may also attract additional objections under section 3(1)(c) and (d) of the Act if the colour sends a descriptive message or the colour is customary in the trade i.e. the colour RED for fire fighting services, or the colour GREEN for ecological goods/services. There may be occasions where colour applied to the goods themselves may be inherently more distinctive than when the colour is applied to the packaging; for example, GREEN beer may be quite distinctive, yet the colour GREEN applied to a beer bottle or a can would be non-distinctive.

The examination of single colour marks requires careful analysis, not least because there is a public interest in not unduly limiting the availability of colours for other traders. Each case must be assessed individually.

### **Two or more colours**

A combination of colours may be registrable, but this will depend on how the colours are presented and what they are applied to. If the colours are presented as a figurative mark, such as a square or circle, then as few as two colours could be accepted; but if they are simply the colours of the packaging of the product they are less likely, *prima facie*, to indicate trade source. When applications consist merely of colours applied to the goods or their packaging it will be necessary to consider how unusual the colour combination is in relation to the goods and whether, *prima facie*, the combination is likely to strike the relevant consumer as an indication of trade source. It is, for example, unlikely that the average consumer of washing tablets would, without extensive and exclusive use, view colour combinations such as green and white or yellow and white as an indication of trade source; it is more likely that they would be taken to indicate the presence of two active ingredients and therefore be given no trade mark consideration.

In addition to considering whether colour combination marks are liable to objection under section 3(1)(b) of the Act, as with single colours, consideration under section 3(1)(c) and (d) must also be given.

### **3 Smell trade marks**

#### **3.1 Graphical representation**

In [Sieckman \(C-104/01\)](#) the ECJ ruled that an olfactory (smell) mark does not satisfy the requirements of graphical representation if it is presented in the form of a chemical formula, by a description in written words, or by the deposit of the odour sample or by a combination of those elements. Although the ECJ Court found that an olfactory mark was, in principle, capable of registration, in practice it is going to be difficult to represent such marks graphically.

#### **3.2 Assessing distinctive character**

Many products have scents, the purpose of which is to make the use of the products more pleasant or attractive. These goods could include cleaning preparations, cosmetics and fabric softeners. Even less obvious goods are now manufactured with particular scents to add to the product's appeal, for example, pens, paper and erasers. Consumers of such fragranced goods are unlikely to attribute the origin of the products to a single trader based on the fragrance. A smell may be distinctive as a trade mark if it is not an inherent or natural characteristic of the goods/services but is added by the applicant to identify their goods and is recognised by the public as indicating trade origin.

### **4 Sound marks**

#### **4.1 Graphical representation**

In [Shield, C-283/01](#), the European Court of Justice confirmed that sounds "must be capable of being regarded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically." Sound marks, like smell marks, are not in themselves capable of



Consequently applications to register whole or large sections of classical pieces are likely to face objection on the grounds that they are not likely to be taken as a trade mark.

Where the mark consists of a non-distinctive sound but includes other distinctive elements, such as words, it will be considered as a whole.

Copyright issues normally require evidence to resolve and so should usually be left to opposition.

## **5 Movement marks and Holograms**

There is nothing, in principle, to prohibit movement marks or holograms from operating as trade marks, provided they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.

### **5.1 Graphical representation - movement marks**

Movement marks require the same degree of clarity of representation as any other application; i.e. the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (*Sieckmann* criteria). Sophisticated computer graphics technology has led to the popular use of moving logos on internet websites and, of course, animation has been around for a long time in the form of film and cartoons. Movement marks can be graphically represented by a series of still images. Each case will carry its own individual requirements, but the representation of the mark should include certain information:

- that the mark is a moving image
- what the image depicts, i.e. what the change in appearance is
- how many images are involved in the complete sequence of movement
- what the sequential order is of the images
- that there is a single sequence of movement (not variable)

### **5.2 Graphical representation – holograms**

For multiple feature hologram marks to meet the graphical representation requirements it will be necessary for the application form to contain representations of each of the various views depicted in the hologram. This will ensure that third parties can clearly see all the material features of the mark. For a very simple image, where the essential features do not change according to the angle at which it is viewed, multiple views may not be necessary and a single representation may be acceptable.

### **5.3 Assessing distinctive character**

The acceptability of a movement marks and holograms, like words or other types of trade marks, must depend upon whether it is, or has become, a distinctive sign; that is, whether the average consumer will perceive the moving image(s) as meaning that the goods or services are exclusively associated with one undertaking. Consideration should also be given to whether other economic operators are likely, without improper motive, to wish to use

the same or similar image(s) in the ordinary course of their business. For example, a moving image/hologram of a teapot pouring tea into a cup will not be distinctive for e.g. café services or for tea, but a spinning gyroscope would be distinctive for these goods and services.

## **WORDING AND JUSTIFICATION OF OBJECTIONS (under section 3(1)(b) (c) and (d))**

Applicants and their representatives are entitled to expect the basis of any objections to be clearly explained. Consequently, examiners will provide the factual and legal basis so that applicants can understand the objection(s) being taken against them and, if they wish, challenge the examiner's findings. There cannot be any hard and fast rules about the wording to use when objecting to a mark under section 3 of the Act. Each case will need to be adapted to meet specific requirements.

### **1 Section 3(1)(b)**

The fact that a mark strongly *alludes* to characteristics of the goods/services is NOT a proper basis for a section 3(1)(b) objection. Applicants can therefore expect an objection that the mark will be seen as a description of the goods/services listed in the application to be raised under section 3(1)(c) or not at all. A section 3(1)(b) objection may arise when the mark consists of, for example:

- a) a description of the goods/services combined with some other noticeable but non-distinctive figurative feature;
- b) a sign which appears to serve a merely decorative purpose in relation to the goods / services concerned;
- c) the shape of goods which does not stand out sufficiently from the norm to be distinctive, or does so in a way which fails to imbue the mark with a trade mark character e.g. because the unusual features of the shape serve an aesthetic or functional purpose;
- d) a sign which is simply too banal to constitute a trade mark for the goods / services concerned e.g. colours, very simple geometrical shapes, such as a circle;
- e) a description of an undertaking or its policies which could equally apply to any undertaking in the field e.g. "The ones you want to do business with";
- f) a description of goods/services *not* included in the application but which are so similar to the goods/services covered by the application as to deprive the trade mark of any distinctive character for those goods/services.

The above is not intended to be an exhaustive list.

Raising an objection under section 3(1)(c) does not preclude the possibility of a separate objection being taken under section 3(1)(b). When an objection is taken under section

3(1)(b) *alone OR* for reasons which *differ* from those given to justify an objection under another sub-section of section 3(1), the examiner will provide the factual basis for his or her finding under section 3(1)(b) e.g. “the trade mark [The ones you want to do business with] is devoid of any distinctive character because it consists of a sign which is merely a description of the customer friendly and high quality nature of a commercial undertaking”.

## **2 Section 3(1)(c)**

An objection raised under section 3(1)(c) of the Act, will identify the characteristic(s) of the goods/services designated by the trade mark. The examiner will also provide an example illustrating how the trade mark could be used, in trade, as a description of the characteristic of the goods/services identified in the objection. For example, “the trade mark [TOP VALUE] is excluded from registration by section 3(1)(c) of the Act because it consists exclusively of a sign which may serve, in trade, to designate the value for money nature of [THE GOODS] e.g. “This is a top value product.”

## **3 Section 3(1)(d)**

Section 3(1)(d) is somewhat different because (unlike sub-sections (a),(b) & (c)) it deals with signs which are actually believed to be *in use* in trade. Where a mark consists exclusively of descriptive matter which *may be* used in trade, the objection will be under section 3(1)(c). Where a sign is devoid of any distinctive character the objection will be under section 3(1)(b).

A section 3(1)(d) objection therefore need only be raised where the examiner is in doubt as to whether the sign is inherently capable of designating a characteristic of the goods or services, or is devoid of any distinctive character, but there is evidence that the sign has nevertheless become customary in the current language or in the established and bona fide practices of the relevant trade. In those circumstances the applicant is entitled to know the basis of the examiner's view. The applicant should be shown or referred to named publications or provided with other examples of use which show the sign being used to designate relevant goods/services.

In [STASH Trade Mark \[BL 0-281-04\]](#), Professor Ruth Annand, as the Appointed Person, found that evidence of two uses of the sign in question by third parties prior to the date of the application for registration, did not amount to ‘customary’ use. In order to show that the use of a sign has become ‘customary’ or ‘established’ it will be necessary for the registrar to provide evidence which is consistent with those descriptions. In this connection it should be noted that;

a) use of the sign in widely read publications offering the goods/services to the relevant public may carry more weight than limited uses on obscure web sites;

b) journalistic use, whilst not irrelevant (because it leads to use by the public), is less relevant than use in the course of trade;

c) private use (in ‘chat rooms’ and the like) is of little relevance;

d) the size and nature of the market for the goods/services is a relevant factor: the amount of use required to show that a sign has become 'customary' or 'established' in a specialised market is liable to be less than that which is required to show the same things in relation to a much bigger market for general products or services;

e) evidence must normally pre-date the application;

f) evidence which post dates the application, but which shows what was happening prior to the date of the application is also relevant.

# ADDENDUM TO TRADE MARKS REGISTRY EXAMINATION AND PRACTICE GUIDE

## INTRODUCTION

The purpose of this Addendum is to provide more detailed guidance to trade mark examiners and practitioners on the registrability of specific marks or types of marks than is provided in The Guide to Examination and Practice. It is essential that each mark is considered by applying the general guidance provided in the main Guide. However, certain specific marks have already been considered in the past. Therefore, this Addendum will indicate which marks can be accepted or rejected in light of these earlier decisions or will provide guidelines which can be applied to specific marks .

It is essential to remember that the practice stated in this Addendum should not be applied rigidly. Full consideration must be given to all relevant factors in any given application as each case must be considered on its own facts during the Examination process. See for example the comments made by the Appointed Person (Simon Thorley QC) in the appeal by Henkel KGaA (BL O/152/01) against the refusal of the registrar to grant protection in respect of an International Registration. In that decision, at paragraph 12, it says:

"It must always be remembered that the Registry Practice is a guideline and nothing more. It is helpful both to the Registry and to practitioners, but it cannot absolve the Registrar's hearing officers, or me on appeal, from approaching each case on its own facts".

It should also be remembered that the significance of certain words, phrases or signs in general use can change over time. Therefore any opinion relating to specific marks is not intended to determine or affect the registrability of any mark or any rights arising under the Trade Marks Act As already stated, this is only a guide and it is open to examiners to be persuaded to depart from that guidance if the facts of the case warrant it

# A

## • ACUMEN

Means keen insight or discernment and is acceptable for most goods. This word is commonly used in the phrase "business acumen" and has laudatory connotations for business or financial services. Not acceptable prima facie, object under sections 3(1)(b) and (c).

## • ADVANTAGE

Generally acceptable unless the goods or services could give the purchaser a specific advantage. For example, ADVANTAGE would not be acceptable for sporting goods, financial services relating to investments or loans, or for marketing services (object under sections 3(1)(b) and (c) where necessary).

## • AIRPORT

Names of airports such as BIRMINGHAM AIRPORT will normally be acceptable for services without the need for evidence of distinctiveness to be filed. Objection should only be taken under section 3(1)(b) and (c) where specifications include 'transport services' such as shuttle buses, taxis etc as it is likely that consumers would expect there to be more than one undertaking providing transport services to and from an airport and would therefore be descriptive of the destination/intended purpose of the services.

## • ALCOPOPS (Notification Guidance)

Alcopops are defined in the New Oxford Dictionary of English as "ready mixed soft drinks containing alcohol". This has caused particular difficulty for examiners when deciding whether to notify earlier right holders of marks between classes 32 and 33 under section 5 of the Act. The following guidance is offered –

Specifications rarely include the term "alcopops" but the goods would be included in terms such as "alcoholic beverages", "alcoholic lemonade/orange/cola", "pre-mixed alcoholic drinks", "spirit mixers", "alcoholic carbonates/soda", "alcoholic ready to drink (RTDs)", "wine coolers", "dairy coolers".

Assuming the specification covers such goods, notification guidance is as follows: Notify in relation to:

General terms, e.g. "non alcoholic beverages" against "alcoholic beverages" "lemonade" etc against "alcoholic beverages"

Specific terms, e.g. “lemonade” against “alcoholic lemonade” or “alcoholic carbonated drinks”  
“fruit juice” against “alcoholic fruit juice”, “pre-mixed alcoholic drinks” or “spirit mixers”

In other cases the degree of similarity between the goods should be taken into account e.g.  
do not notify in relation to “fruit juice” against “alcoholic cola”.

**NB.** Only notify where the later mark is identical, or nearly identical, to the earlier mark or dominant feature of it. Therefore, where the earlier mark is only similar (as opposed to identical/near identical) to the later mark, or the dominant or distinctive feature of it, the examiner may not notify in relation to an earlier mark for alcopops (however described) in Class 33 against a mark applied for in respect of non-alcoholic beverages in Class 32 and vice versa.

- **ALWAYS**

This word may be acceptable, solus, but if combined with other matter, may become non distinctive. For example, ALWAYS may be an acceptable mark in respect of 'retail services' but ALWAYS OPEN in respect of the same services or ALWAYS RELIABLE (for cars) would not be acceptable. Each case should be carefully considered on its own facts.

- **ANGLIA**

Acceptable despite forming part of the geographical term 'East Anglia'.

- **ANIMAL SKINS**

Devices of animal skins are devoid of any distinctive character for e.g. goods made of leather and prima facie objections should be raised under sections 3(1)(b) and (c).

- **ANNIVERSARY**

This is non distinctive for cards, cakes, jewellery and other goods that may be marketed as specifically for the celebration of an anniversary. Otherwise acceptable, object under sections 3(1)(b) and (c) where appropriate.

- **ANSWER/ANSWERS**

It is possible that applications to register the word ANSWER, on its own, may be acceptable. However, combining this word with other matter may in fact render the mark as a whole non distinctive. The following have been accepted:

ANSWER - pregnancy testing kits  
ANSWERS - underclothing

The mark THE ANSWER TO ALL YOUR PROBLEMS, however, is unlikely to be registrable in respect of any goods or services.

- **ANZAC (See Guide at PROTECTED WORDS)**

- **AQUA**

A combining form relating to water; either alone or combined will normally be regarded as distinctive even for goods or services relating to water except where it is common trade practice to use the word descriptively as an alternative for water. In such cases objection should be taken if the mark, in totality, is descriptive e.g.:

AQUA PARK - for water parks - object section 3(1)(b) and (c).

BROWN'S AQUA PARK - for water parks - accept

AQUA AEROBICS - for Aerobics - object section 3(1)(b) and (c)

AQUA - for bathroom apparatus - accept

AQUA PRESTIGE - for hose pipes - accept

This is obviously not an exhaustive list and each case must turn on its own facts.

- **ARMAGNAC**

No trade marks bearing the words ARMAGNAC, COGNAC or CALVADOS can be accepted for registration in respect of goods other than those so designated. This restriction will equally apply even if these words are used with an indication of the true origin, for example JAPANESE ARMAGNAC, or with the addition of an expression such as "kind", "type" or "style". Objection will arise under section 3(4) and 3(3)(b) of the Act. (See Guide at PROTECTED WORDS)

## **B**

### **• BEEFEATER**

The Lord Chamberlain's Office has confirmed that it has no objection to the word BEEFEATER, or pictorial representations of Beefeaters, being used as trade marks.

### **• BETA**

BETA marks may be accepted prima facie. The word need not be treated as too close to BETTER.

### **• BIO**

BIO is now commonly known as an abbreviation for BIOLOGICAL. Examples of dictionary words are BIOCHEMISTRY, BIOCOLLOID, BIODEGRADABILITY, BIOMASS but listings of BIO words are not exhaustive. BIO is commonly added to other words to indicate a biological factor. Whether presented alone or with a descriptive prefix or suffix, treat BIO as if it were the word 'biological' and only object under section 3(1)(b) and (c) where the totality is considered descriptive.

### **• BIRTHDAY (see ANNIVERSARY)**

### **• BLUSH**

This is now a recognised term for rosé wines. It was originally coined in the USA and has become a well established and commonly used term in English speaking countries. The word should be regarded as having a generic signification in relation to wines and is not acceptable prima facie as a trade mark. Object under sections 3(1)(b)(c) and (d).

### **• BOX: Word used in combination with a colour**

Clearly, a mark consisting of the words e.g. BLUE BOX would be devoid of any distinctive character when used in respect of boxes coloured blue. In this context, the mark would be open to objection under section 3(1)(b) and (c) of the Act. (Care should also be taken where an application covers a wide range of goods which includes boxes, while not specifying them separately.)

However, it is unlikely that traders would wish to use words such as BLUE BOX to describe or advertise e.g. goods sold in blue boxes. The words BLUE BOX or WHITE BOX would in consequence be recognised as a trade mark for most goods or services.

It is emphasised that this practice relates only to word marks; objection should still be taken to coloured devices of boxes or other items of packaging unless the overall getup is distinctive.

- **BRANDSHARING (TOBACCO ADVERTISING) [See Guide at PROTECTED WORDS]**

- **BREAKTHROUGH**

Not distinctive for goods or services that could be characterised as a 'breakthrough' in a particular field.

- **BRITANNIA**

This means Great Britain personified and is usually represented as a female figure forming an emblem of Great Britain. BRITANNIA suggests that goods are British made, but even so, it may be accepted prima facie (on the same basis as CALEDONIA).

- **BRITANNIC**

Unlike BRITANNIA, this word is still in use, for example "on her Britannic Majesty's Service" and means of or relating to Britain. However we can accept prima facie.

- **BUS SERVICES (See TRANSPORT SERVICES)**

## **C**

- **CAD**

Standard abbreviation for "Computer Aided Design."

- **CALEDONIA**

Acceptable prima facie (ancient name for Scotland).

- **CALVADOS**

No trade marks bearing the words CALVADOS, COGNAC or ARMAGNAC can be accepted for registration in respect of goods other than those so designated. This restriction will equally apply even if these words are used with an indication of the true origin, for example JAPANESE CALVADOS, or even with the addition of an expression such as "kind", "type" or "style." Objection will arise under section 3(4) and 3(3)(b) of the Act. (See also Guide at PROTECTED WORDS)

- **CAM**

Standard abbreviation for "Computer Aided Manufacture".

- **CARE**

Devoid of any distinctive character for goods in Classes 3 and 5. May also be open to objection for other goods e.g. certain goods in Classes 10 or 20 which are adapted for medical purposes. For services, object prima facie when combined with another descriptive element, for example NURSING CARE for nursing home services, but accept when the totality simply alludes to the services, for example LEGALCARE for legal services. Object under section 3(1)(b) and (c) when appropriate.

- **CE MARK**

This comprises the letters CE in the form illustrated below:



It is used to signify that a product conforms with the requirements of certain EC Directives. It follows that marks which contain the letters CE as illustrated above should not be accepted as trade marks or parts of trade marks. If in doubt staff should consult a senior officer.

- **CELEBRATION (see also ANNIVERSARY)**

This is non distinctive for the sorts of goods that would be marketed as being for the purpose of a celebration. Also not acceptable for entertainment or restaurant services. Object under sections 3(1)(b) and (c) where appropriate.

- **CENTENARY**

This is non distinctive for commemorative articles. Object under section 3(1)(b) prima facie. Evidence that the mark has acquired factual distinctiveness in the market place will be required.

- **CENTRAL**

Can be accepted prima facie for goods unless descriptive e.g. heating. CENTRAL is considered objectionable under section 3(1)(c) for some services e.g. hotels with a central location.

- **CHEF**

The word CHEF and CHEF devices are considered to be devoid of any distinctive character for food, drinks, kitchen equipment and food catering services and should be objected to under section 3(1)(b) and (d) in the prima facie unless they are stylised. The examples shown below include CHEF elements but have sufficient surplus to permit registration.



- **CLASSIC**

Means "of the highest class esp. in art or literature" (Collins English Dictionary). The word is applied most often to works of literature and the fine arts but can be used to describe any object which displays artistic taste and style, for example cars. Given the purely laudatory meaning of CLASSIC and its widespread use, it must be regarded as a word which may be unregistrable for some goods. CLASSIC would not be acceptable for furniture or cars but may be acceptable for some highly technical apparatus such as medical scanners. However like all marks under the 1994 Act, if the applicant can prove that the mark is factually distinctive it can be registered. Trade evidence may also assist for some goods/services.

- **CLOVERLEAF (see SHAMROCK)**

- **CLUB**

CLUB is devoid of any distinctive character for goods bearing a club's motif or sold through a club. It is also unregistrable prima facie for any services capable of being provided by a club. Object under section 3(1)(b) for goods and 3(1)(c) for services.

- **COCKTAIL NAMES**

Marks in Class 32 consisting of the names of alcoholic cocktails should be objected to in the prima facie as not capable of distinguishing if the specification includes non alcoholic beverages, on the grounds of confusability with the alcoholic version in Class 33. A deceptiveness objection (section 3(3)(b) ) may also be appropriate. The references used for raising such objections should be carefully checked.

- **COGNAC**

No trade marks bearing the words COGNAC, CALVADOS or ARMAGNAC can be accepted for registration in respect of goods other than those so designated. This restriction will equally apply even if these words are used with an indication of the true origin, for example JAPANESE COGNAC, or with the addition of an expression such as "kind", "type" or "style". Objection will arise under section 3(4) and 3(3)(b) of the Act. (See also Guide at PROTECTED WORDS)

- **COLOUR TRADE MARKS (See Guide at UNCONVENTIONAL TRADE MARKS)**

- **COLOUR: NAME OF COLOUR IN A WORD MARK**

Where a mark consists of the name of a colour object prima facie under section 3(1)(b) and (c) because the mark is "descriptive of [goods] coloured [red, green] or sold in packaging of that colour."

Note: This applies mainly to colours pure and simple, like RED, GREEN, GOLD etc. Where colour is a feature of the goods, such as clothing and motor cars, the same applies to other words such as EMERALD, PEACH, APRICOT, MINK and CHOCOLATE which, although having alternative meanings, are recognised as having a strong connotation with definite colours. Certain other words such as SAPPHIRE or FLAMINGO do not have a sufficiently strong colour connotation to overwhelm the other non colour meaning.

#### • **COLOUR: WORD APPEARING IN A MARK**

If a mark consists exclusively of the words COLOUR, COLOURS or names of hair shades, for example BLONDE, and is applied for in respect of goods which impart colour such as cosmetics, toiletries and hair preparations, section 3(1)(b) and (c) objections should be raised.

#### • **COLOUR: WORD USED IN A MARK FOR PAINT**

Colours may describe the actual colour of the paint. The following guidelines should be applied:

Object under sections 3(1)(b) and (c) to colour names such as CRANBERRY, DAMSON, GARNET, AMETHYST, AQUAMARINE;

Accept QUARTZ (no colour or various colours depending upon the impurities present), AGATE (variegated appearance, but no single colour indicated), PAPAYA (green fruit, yellow flesh, purple flowers - not known by one colour);

Colours in combination with other words can be accepted if the mark as a whole is distinctive: ICE COFFEE, VANILLA ICE and MISTY BLUE. Descriptive combinations such as DEEP BLUE should not be accepted (Object under section 3(1)(b) and (c) ).

Dictionary words which are descriptive but obscure and unlikely to be used by others can be accepted: LUNA (alchemists name for silver) and CARNELIAN (an alternative name for CORNELIAN, a red gem stone which is less well known).

#### • **COM or COMM**

This abbreviation for "communication" is entered in Websters Dictionary but does not seem to appear in English dictionaries. Nevertheless it is recognised as being the abbreviation and does not add distinctiveness to a mark where goods or services relate to communication (Classes 9 and 38 in particular). COM is commonly used on the Internet.

#### • **COMBI**

This is generic for a type of fuel efficient boiler and is sometimes used as a shortened form of 'combination.'

- **CONCEPT**

The word CONCEPT is defined as “an idea, especially an abstract idea”. Although there are goods and services where the mark, on its own, or with other matter, may be regarded as being distinctive, a cautious approach is required. Objections under section 3(1)(b) & (c) should be raised in circumstances where the word is considered to be descriptive e.g.

CONCEPT OF BIOLOGY in Class 16.

CONCEPT in relation to modern construction, design, cars, music, fashion and art etc.

The word CONCEPT is also used in advertising to denote innovative and modern ideas such as DESIGN CONCEPT & FINANCIAL CONCEPT.

- **CONGRATULATIONS**

This is non distinctive for cards, flowers etc. Object under section 3(1)(b) prima facie.

- **CONNECTION/CONNECTIONS**

This is devoid of any distinctive character for services that provide a link between individuals or places. Object prima facie to applications in respect of telecommunications and transport related services.

- **COOKS**

The word COOK is considered to be devoid of any distinctive character for kitchen equipment and food catering services and should be objected to under section 3(1)(b)(c) and (d) in the prima facie. For examples of cook devices considered acceptable, see CHEF.

- **COPYRIGHT**

If the mark consists only of the word, examiners should consider whether it is likely to be seen as a trade mark or as a statement of rights when considered in relation to the goods or services applied for. If the latter, a section 3(1)(b) objection is appropriate.

- **COUNTERFEIT**

Marks consisting of or containing this word are open to objection under section 3(3)(a) of the Act on the basis that use of such a mark will encourage counterfeiting.

- **COUNTRY**

When used in relation to clothing COUNTRY is open to objection under section 3(1)(c) prima facie for goods which can be used for country pursuits e g country coats. An example is the mark COUNTRY CLASSICS which was considered unregistrable because it is generic for classic clothing in a country style. Such marks may be registrable if supported by evidence of distinctiveness.

COUNTRY is also widely used in relation to all types of foodstuffs, particularly basic foods such as pork, chicken and eggs. That being the case no one company should be granted a monopoly in such a term for goods in Classes 29, 30 and 31. Although COUNTRY may have been accepted for registration in the past, marks consisting of COUNTRY plus the name of the goods will in future be subject, prima facie, to objections under section 3(1)(b) and (c) e g COUNTRY PORK for pork, COUNTRY CHICKEN for chicken and COUNTRY EGGS for eggs.

- **COUNTRY SCENES (see LANDSCAPES)**

- **CRÈME**

Devoid of any distinctive character for food and drinks; object under section 3(1)(b) and (c).

- **CREATIVE**

The Registrar has become aware of the generic use of the term "creative software". Therefore we should not accept, prima facie, CREATIVE alone or with the name of such goods. We may continue to accept the word in combination with other elements where the totality is fanciful or where the applicant has previous combinations registered.

- **CRESCENT MOON (See Guide at PROTECTED WORDS)**

- **CROSSES/RED CROSS/GREEN CROSS (See Guide at PROTECTED WORDS)**

- **CROWNS (See Guide at ROYAL MARKS)**

- **CRYO**

This means "low temperature" but in itself is a vague term. In the past deceptiveness objections have been raised in respect of goods or services which could be for use in (or with) low temperatures but in future this will not be necessary.

- **CUVE/CUVEE**

A French word meaning "blend" or "vat" found commonly in marks in Class 33 for wines etc. It is devoid of any distinctive character and an objection under section 3(1)(b) and (c) is appropriate. It must be combined with a distinctive element to make it an acceptable trade mark.

- **CYBER**

Words incorporating the word CYBER should be examined with particular care. Collins English Dictionary defines CYBER as "combining form indicating computers" and this term is frequently used in the context of the Internet/World Wide Web. Marks incorporating the word CYBER and an apparently meaningful or descriptive word for specifications which may cover goods or services connected with the INTERNET/WORLD WIDE WEB should usually be objected to under section 3(1). Use of Internet search may be particularly helpful to establish whether the word is generic e.g. CYBERCAFE (application no 1581071 for this mark was refused) and should be objected to under sections 3(1)(b)(c) and/or (d). Where the mark conveys a similar idea e.g. CYBERPUB/BAR/LIBRARY i.e. a venue providing these facilities, object under sections 3(1)(b) and (c) e.g. CYBERPUB Statement of Grounds for application no 2031220. CYBERSPACE is another example of apparently generic use.

Use of CYBER with non-distinctive or fanciful words may be accepted e.g. CYBERSMITH (an apparently meaningless combination of non distinctive elements) or CYBERAMA. Each case must be considered on its own merits.

## D

- **DEPOT**

Acceptable for most goods but care is required where services are concerned e.g. DEPOT would be devoid of any distinctive character for transport and delivery services.

- **DEVICES OF GOODS OR THEIR PACKAGING (See Guide at SHAPES)**

- **DIAMOND**

Some examiners have raised objections, in the past, that this word is laudatory. This is not considered to be the case - objections should not be raised on these grounds. However, care should be taken in cases where DIAMOND may be descriptive e.g. for jewellery (obviously) or for machine tools (diamond-tipped).

- **DIRECT**

Direct is descriptive for services sold directly to the public (instead of through a broker or other traditional middleman) or for goods sold by mail order or similar direct selling methods. It will be usual to object under sections 3(1)(b) and (c) when used alone or in combination with the name of the goods/services provided e.g. DIRECT CLOTHING.

- **DOCTOR**

This is commonly applied for in Class 37 combined with the goods being treated e.g. RUG DOCTOR for rug repair, CAR DOCTOR for vehicle repair. Such marks can be accepted.

- **DOMAIN NAMES (See Guide)**

- **DREAM**

This word has a laudatory meaning i.e. "a person or thing that is pleasant or seemingly unreal as a dream" (Collins English Dictionary). DREAM is devoid of any distinctive character for services such as kitchens, kitchen design and holiday services. In such cases prima facie objections under sections 3(1)(b) and (c) may be relevant. However it is usually acceptable prima facie where the word is not customarily used to indicate the desirability of a product/service e.g. pesticides, or for utility products e.g. DREAM knives.

# E

## • E or e

"e" as a prefix denotes "electronic" in the context of conducting business through an electronic medium and there are a number of acronyms and terms which use "e" in this sense, for example e-commerce, e-mail, e-learning and e-software. This is supported by the following definition for "e" in the New Oxford Dictionary of English:

“e’ - denoting use of electronic data transfer in cyberspace for information exchange and financial transactions, especially through the Internet.”

An application for a word which describes the goods or services applied for and is prefixed with 'e' may be objectionable under sections 3(1)(b) and (c) of the Act and in some cases 3(1)(d) may be appropriate. When considering an application, the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or services. The Internet will be searched where necessary, but it should be remembered that the fact that a term is not already in descriptive use does not preclude an objection under section 3(1)(c) if the likelihood of normal descriptive use of the term is foreseeable at the date of application.

In general it is more likely that an objection will arise when the letter "e" (upper and lower case to be treated the same) is combined with a description of a service or goods used in e-commerce, particularly goods classes 9 and 16 (including the subject matter in Class 16) and the services in Class 38. However, each case must be treated on its own merits. So, for example, there would be no objection to e-doors or e-soap because 1) these goods are not normally associated with e-trading and 2) doors and soap sold over the Internet are the same as doors and soap sold in any way. Both considerations are relevant. However e-software, e-book and e-learning are open to objection.

## • EC

Abbreviation for European Community. Not acceptable for goods or services which comply with EC standards. See also entries under 'CE', 'EEC' and EU.

## • ECO

A combining form which is defined in Collins English Dictionary as denoting "ecology" or "ecological". It is now widely used and understood by the average consumer in relation to the environment or environmentally "friendly" products. When considering marks of this type, substitute the word 'ecological' for eco and if the totality is objectionable, consider objecting under section 3(1)(c). Care should be taken to ensure this guidance is not applied too strictly. For example, ECO TIMBER for timber and wood, should be objected to because it describes materials produced in an ecological way (from sustainable resources). Equally, a

mark such as ECO WINDOW should be objected to as the goods in use can be considered as helping the environment e.g. windows that reduce heat loss. Examiners should bear in mind the advice given C-363/99, (POSTKANTOOR) Koninklijke KPN Nederland NV and Benelux-Merkenbureau:

“...a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

Where the words cannot be seen as directly descriptive for the goods/services, e.g. for ECOSLIDE for windows and window furniture, etc., no objection should be taken. However, for a children's slide the words would be seen as descriptive. In effect, the test is this: Does the use of ECO in mark, when considered as a whole, amount to nothing more than a designation of some characteristic of the goods at issue? Or does the mark retain an unusual variation in meaning or syntax? This will be more or less obvious on a case by case basis.

#### • ECO-LABEL

On 23 March 1992 the Council of the European Communities adopted a Regulation in a European Community ECO LABEL award scheme. The ECO LABEL (which incorporates the ECO LABEL logo shown below) will be awarded to products which provide a high level of environmental protection.



The provisions of the Regulation protecting the ECO LABEL logo came into force on 1 May 1992 and became binding in their entirety on, and directly applicable in, the United Kingdom. Any false or misleading advertising or the use of any label or logo which leads to confusion with the ECO LABEL is prohibited by the Regulation. Accordingly, any mark which contains the ECO LABEL logo or anything which could lead to confusion with it will be refused; object under section 3(4). **Note:** This type of protection has nothing to do with the type of protection afforded by Article 6ter of the Paris Convention, it is a matter of Community law. Consent cannot be obtained for this mark.

- **EEC**

Abbreviation for European Economic Community, although no longer officially in use it remains objectionable under sections 3(1)(b) and (c) of the Act. Not acceptable for any goods or services which are likely to be sold or provided between members of the EC. It may also imply that the goods may comply with EC standards. See also entries under 'EC' and 'EU.'

- **ENVIRO**

The mark ENVIROSAFE was considered open to objection in the past. However the term ENVIRO has not found its way into dictionaries and it is not safe to assume that it is an accepted shortening of ENVIRONMENT. Accordingly (unlike ECO-) words with this prefix should no longer be objected to on the grounds described above.

- **EU**

Abbreviation for European Union. Not acceptable for any goods or services which originate in the European Union. It may also imply that the goods comply with EC standards. See also entries under 'EEC' and 'EC'.

- **EURO**

The Lord Chancellor's Appointed Person issued a decision in an appeal before him against the Registrars refusal to register the trade mark EUROLAMB (for lamb - [1997] RPC 27/90). The registrar's decision to refuse the application was upheld. In the course of his decision, Geoffrey Hobbs QC expressed the view that:

"The words 'Euro' and 'European' are now interchangeable and if the word 'European lamb' was open to objection, so too was the word 'Eurolamb.'"

Some previous acceptances by the registrar of marks containing the word 'Euro' may have been too lenient. In the light of this decision marks containing the word EURO should be treated in the same way as if the word EUROPEAN was present. Accordingly e.g. EUROTOURS (for holiday services) is no more registrable than "European Tours" or EURODEBATES is no more registrable than "European Debates" (for conference services) and will be open to objection under section 3(1)(b) and (c) of the Act.

Where the combination of 'Euro' with other words describing the goods or services does not produce a term that is likely to be used in trade the mark may be accepted e.g. EUROMEDICAL for drugs.

- **EXPORT**

Found mostly on beer labels in Class 32. No deceptiveness objection is appropriate as the fact that the goods are exported as well as offered for sale on the home market should not affect purchasing decisions. An application for this word as a mark would not of course be acceptable in the prima facie, object under section 3(1)(b) and (c).

- **EXTRA**

This means something "more than what is usual or expected, something that is better than usual in quality." (Collins English Dictionary). EXTRA (or phonetic equivalents - see Guide at PHONETIC EQUIVALENTS) may therefore be regarded as laudatory and objectionable under section 3(1)(b) and (c). When examining marks including the word EXTRA, examiners should consider whether the totality may be acceptable. For example, the combination could be meaningless, e g RUGBY EXTRA for building materials or only indirectly descriptive e g EXTRA VISION for tracking systems. However EXTRA MILES for car hire services or EXTRA FUN for toys would not be acceptable.

## **F**

- **FAMOUS BUILDINGS - See Guide - FAMOUS BUILDINGS (Pictorial representations of or names of well known buildings)**

- **FAST TRACK**

Examination practice on the acceptability of the term FAST TRACK has been mixed in the past. There are, in fact, numerous acceptances of the word for many services and these precedents may persuade some examiners to accept further marks. However, its use as a means of indicating services where a speeded up service can be offered suggests that its usage is now common to many services and should no longer be accepted prima facie in many classes. The Internet, in particular, shows wide descriptive usage of the word in connection with many services. Therefore, objection should usually be taken under section 3(1)(b) and(c) in cases covering a specification where a faster than standard service can be offered . If Internet references show the word in generic use, for the services at issue, an objection under section 3(1)(d) may also be appropriate .

- **FINESSE**

This means "elegant skill in style or performance" (Collins English Dictionary) and, as the word usually refers to people, it may be accepted in the prima facie for services that are generally provided to organisations or performed on goods, for example repair of vehicles.

The word lacks distinctive character for wine and possibly other types of alcoholic drinks, and is laudatory in relation to personal services such as finishing school services. In such instances it is open to objection under section 3(1)(b) and (c).

- **FIRST**

`First' can be descriptive, e g FIRST SHOES, in respect of footwear for children. In this context objections should be raised under sections 3(1)(b) and (c) of the Act. The word FIRST may be acceptable in combination with other descriptive or non distinctive words e g FIRST NATIONAL BANK

- **FLAGSHIP**

Open to objection under section 3(1)(b) and (c) prima facie because of the common use of the word as a laudatory term (meaning "the leading item in a range, or the leading establishment", Collins English Dictionary). Widespread use in relation to motor vehicles.

- **FLEXI and FLEX**

When examining marks consisting of or incorporating FLEX/FLEXI, it is important to consider the message conveyed by the mark as a whole. Where flexibility is a desirable characteristic of the goods with which the mark is used, it is less likely that the mark as a whole will give a distinctive trademark message. So for example, FLEXI PIPE (for pipes) would not be acceptable.

Where flexibility is not a usual or desirable characteristic of the goods, it is more likely that the mark as a whole will be distinctive e.g. FLEXIHERB for food supplements or FLEXIBUILD for racking units. Equally where the message conveyed is not directly descriptive, it is possible that a mark may have distinctive character, even if the goods with which it is used are flexible by nature. So FLEXIGUARD has been accepted in respect of floor coverings. Each case must be examined on its own facts.

- **FLOAT**

This is the generic name for goods consisting of carbonated soft drinks served together with ice cream (see Collins English Dictionary). It is consequently open to objection under section 3(1)(c) as being descriptive of such goods.

- **FLOWERS**

Representations of flowers are commonly used in the perfumery trade in labels and advertisements and for this reason are not regarded as distinctive in respect of perfumes or perfumed goods in Class 3 or in respect of similar medicated goods in Class 5; object under section 3(1)(b). They are however considered to be acceptable prima facie for beauty salons because research has demonstrated that they are not generally used in respect of these services. Flower devices are considered devoid of any distinctive character for services such as gardening or landscaping, again object under section 3(1)(b).

- **FOOTWEAR: GEOMETRICAL DEVICE MARKS FOR FOOTWEAR**

Device marks which are represented as part of a shoe (the applicant may do this by representing the shoe with dotted lines, or by an explanatory text or simply by depicting stitching and/or eyelet holes with the geometrical device) may require evidence of distinctiveness in support of the application unless the shape of the geometric device applied to the shoe is sufficiently noticeable so that, even as part of the shoe, it retains the capacity to signify the trade origin of the goods. In this connection it should be borne in mind that the consumer is now accustomed to seeing geometrical devices on sports shoes as trade marks. (Geometric devices, in the abstract, for footwear, are acceptable as long as they are not so banal as to lack inherent distinctiveness.)

- **FOREX**

This is unregistrable for foreign exchange or financial related services, object under section 3(1)(d), unless, of course, the mark is combined with other matter to make an acceptable whole.

- **FUTURE**

The word FUTURE is considered, prima facie, to be devoid of any distinctive character in relation to goods where technical development and innovation are occurring such as computers. Object under section 3(1)(c). The word is acceptable for most non-technical goods. The word is not acceptable for financial services.

## **G**

### **• GLEN**

If applied for in combination with, or as part of, a word which (as a totality) suggests Scottish origin e.g. GLENOBAN, GLENOCITE, HIGHLAND GLEN, the mark will be open to objection under section 3(3)(b) of the Act unless the specification is limited accordingly - but only if Scotland has a reputation for the goods or services e.g. woollens, whisky. [See also Guide at DECEPTIVE MARKS (Geographic), paragraph 3]

### **• GOLD**

In some instances the word GOLD is open to objection because it is used in some industries in a laudatory manner. The Appointed Person has upheld the refusal of BONUS GOLD ([1998] RPC 859) for financial services accepting that the word GOLD is used in a laudatory fashion in this industry. Where appropriate object under sections 3(1)(b) and (c).

### **• GRAPES**

Devices of bunches of GRAPES are considered to be devoid of any distinctive character in respect of wines since such devices are a common feature of wine labels. The same would apply to wine bar, restaurant and public house services. Marks consisting of such features are not acceptable prima facie; object under section 3(1)(b).

### **• GREEK OR CYRILLIC LETTERS: ACCEPTABILITY**

The fact that Greek letters are quite common in trade marks does not mean they are necessarily without any distinctive character. The lambda, psi, omega, beta and sigma symbols and the words delta, omega, gamma and beta are registered in many classes and successfully serve the purpose of a trade mark. However, Greek letters are frequently used as symbols for electrical purposes and care must be taken when examining marks consisting of or containing Greek letters, or the phonetics of these, applied for in relation to Class 9 goods. Similarly some Greek letters have a significance in mathematics e.g. delta, pi and sigma and are therefore devoid of any distinctive character for calculators and the like. The European Community have adopted a reverse Greek letter epsilon to indicate aerosol dispensers which meet certain standards. For this reason the letter epsilon is without distinctive character if used in relation to aerosol dispensers or goods related thereto (there might also be a section 3(4) objection in such cases).

### **• GREEN**

Green has a meaning in relation to ecology and environmentally "friendly" products. Objection should be raised under section 3(1)(b) and (c) when GREEN is presented alone or combined with other descriptive words such as 'safe', 'friendly', 'care', or 'system', unless the mark is not being applied to products or services which could be considered environmentally "friendly."

# H

- **HALLMARK**

Practice on the acceptance of this has been mixed in the past - it has laudatory connotations apart from the obvious descriptiveness of the mark for Class 14 goods. In future we can accept the word prima facie for goods and services other than goods/services relating to precious metals.

- **HEADS OF WOMEN**

Devices of women's heads are commonly used for advertising purposes in the perfumery trade and especially for hair preparations and hairdressing and/or beautician's services. They are therefore regarded as being devoid of any distinctive character in Class 3 in respect of hair preparations and beauty products, for similar medicated goods in Class 5 and for hairdressing or beauticians services in Class 42; object under section 3(1)(b) and (d).

- **HEAVENLY**

May not be acceptable prima facie for goods that appeal strongly to the senses such as perfume and wine. Collins dictionary defines HEAVENLY as "alluring, wonderful or sublime." Likely to be accepted for many other goods and most services.

- **HIGH TECH (OR PHONETIC EQUIVALENTS)**

This term is considered to be devoid of any distinctive character and attracts objections under sections 3(1)(b) and (c) in the prima facie for technological goods and for services which employ technology, for example engineering, health screening or research.

- **HIGHLAND**

This is a large administrative region in Scotland and consequently may be open to objection on geographical grounds prima facie (object under sections 3(1)(b) and (c)). It is also open to objection under section 3(3)(b) if applied for in relation to goods for which Scotland has a reputation (unless the specification is limited accordingly).

- **HIGHLAND GLEN**

This relates to or implies Scottish goods and would be deceptive if used on goods or services for which Scotland has a reputation but which do not have that origin. Object under section 3(3)(b).

- **HOLOGRAMS (See Guide at UNCONVENTIONAL MARKS)**

- **HOUSE OF**

Marks that include the words HOUSE OF with a descriptive or non distinctive word should be accepted unless the word 'house' is established within the relevant industry. For example, 'House of Fashion' would not be acceptable because a fashion house is a well known term. The same would apply to finance, e g HOUSE OF FINANCE

Examples of marks that are acceptable in the prima facie are

HOUSE OF SPEED for computers, kitchen equipment etc.

HOUSE OF PLAY for Toys, games etc

HOUSE OF FLOWERS florists, silk/fresh flowers etc

HOUSE OF TRAVEL travel agency services

# I

## • I or i

The letter "i" is a generic abbreviation for Internet, for example, i-music and i- magazine. In addition, the letter "i" is also an abbreviation for "interactive".

An application for a word which describes the goods or services applied for and is prefixed with "i" may be objectionable under section 3(1)(b) and (c) of the Act and in some cases 3(1)(d) may be appropriate. When considering an application, the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or services. The Internet will be searched where necessary, but it should be remembered that the fact that a term is not already in descriptive use does not preclude an objection under section 3(1)(c) if the likelihood of normal descriptive use of the term is foreseeable at the date of application.

## • IDEAL

Often unacceptable in the prima facie for goods or services because it means "a person or thing considered to represent perfection" (Collins English Dictionary) and is consequently laudatory.

## • IMPERIAL

Past practice has been to object in the prima facie because the word has a laudatory connotation. However IMPERIAL is now regarded as somewhat old fashioned and is no longer in common use. It can consequently be accepted prima facie, for goods or services other than those (e g measuring apparatus in Class 9) where the word still has a specific meaning.

## • ISOTONIC

This is a generic term for balanced drinks adapted to replace salts and minerals lost when taking part in sports activities. Object under sections 3(1)(b),(c) and (d).

## J

### • JUST /SIMPLY

There are circumstances where marks containing the words 'just' or 'simply' will attract an objection under section 3(1).

Depending on the goods or services claimed, the word 'just' can mean 'we specialise in'. To illustrate this point, the mark 'JUST EDUCATION' applied for in respect of educational services, will face an objection under section 3(1) because it denotes a characteristic of those services. This practice is consistent with the High Court Judgement in *Just Employment (a firm) v Just Employment Law Ltd* [2007] EWHC 2203 (Ch).

For certain goods, the word 'just' can equally be used to denote purity or concentration. For example, the mark 'JUST JUICE', intended for use in respect of fruit drinks, would attract an objection under section 3(1)(b) and (c).

Used as part of a phrase, statement or instruction, the word 'just' can also mean 'all that is required', and/or have an obvious laudatory meaning. To illustrate, the marks 'JUST PLUG IT IN' and 'JUST THE ONE YOU WANT' would also both attract an objection under section 3(1)(b) and (c).

A similar practice will apply to marks containing the word 'SIMPLY'.

Whilst the aforementioned examples are clearly objectionable, the Registrar should emphasise that this practice will not be applied blindly, and trade marks containing words such as 'just' and 'simply' will be assessed in their totality. Examiners will take into account other elements which may be present in the mark, and will also consider the nature of the goods or services intended for protection.

This latter point may be determinative - particularly in some cases where protection is intended for goods rather than services. The mark 'SIMPLY WOMEN'S' for retail of clothing will attract an objection under section 3(1)(b) and (c) because it denotes a characteristic of that service i.e. retail services which specialise in women's clothing. However, on clothing itself, the mark would function as an indicator of origin. Likewise, the trade mark 'SIMPLY LOCKERS' is inherently distinctive when used in respect of lockers. As always, each case will be assessed on its own merits.

### • JUMBO

Where the size of packaging is relevant e.g. detergent, foodstuffs, some DIY materials, objections under section 3(1)(b) and (c) should be taken in the prima facie.

# **K**

- **KINGSIZE**

A word commonly used in relation to cigarettes and other goods. It is devoid of any distinctive character prima facie so object under sections 3(1)(a),(b) and (c).

- **KRETEK**

The generic name for a cigarette made in Indonesia, containing cloves. Object under section 3(1)(d) as appropriate.

## L

- **LA**

This should now be regarded as devoid of any distinctive character for low alcohol beers, ciders, wines etc and is not acceptable prima facie. Object under section 3(1)(b),(c) and (d).

- **LABEL: WORD USED IN COMBINATION WITH A COLOUR**

Word marks such as RED LABEL or WHITE LABEL may be accepted. The same applies to composite marks consisting of such words presented with label devices. A device of a simple coloured label should be objected to as devoid of any distinctive character.

- **LABELS: DEVICES OF**

A device of a simple label is considered to be devoid of any distinctive character; object under section 3(1)(b). The following mark would be open to objection under section 3(1)(b) and (d) prima facie because labels similar to the one depicted are commonly found on the necks of wine or beer bottles.



- **LAP TIME**

Devoid of any distinctive character for watches because it is a function of a watch to measure such times. Object under section 3(1)(c) as appropriate.

- **LAND**

The word has been objected to in the past. However, marks such as LAND, when used in conjunction with a word characteristic of the relevant goods e.g. LAND OF SPEED, or SPEEDLAND; LAND plus the name of the goods e.g. LAND OF COMPUTERS, or COMPUTERLAND for computers are now considered acceptable.

- **LANDSCAPES**

Scenes of cows grazing in a field are not acceptable in respect of dairy products because they are of a type commonly used as mere decorative matter on butter wrappers, condensed milk labels etc. Object under section 3(1)(b) and (c). Similar considerations apply to fields of cereals for cereal products, bread etc. Examiners should consider each case on its own facts and if there is evidence or their own knowledge that such matter is used in other areas, e.g. to designate free range or organic foods, then objections can be raised as necessary.

- **LASER**

This means a powerful light emitting device (Light Amplification by Stimulated Emission of Radiation). It is therefore devoid of any distinctive character for goods incorporating or produced by LASERS or for services performed using LASER equipment. Where appropriate, object under section 3(1)(b) and (c).

Laser is sometimes used to indicate speed. It is thought unlikely that an objection can be sustained on this basis. However, LASER can indicate a degree of precision in the production of goods e.g. manufacture of precision tools. Object as appropriate.

- **LEDA**

Even though the word is close phonetically to the unacceptable word LEADER it can be accepted prima facie.

- **LETTERS (See Guide)**

- **LETTERS: FICTITIOUS**

No objections are raised to marks which consist of or contain hieroglyphics purporting to be foreign characters but which upon examination are found to be fictitious and without meaning.

- **LIFESTYLE**

LIFESTYLE may be accepted for goods but care should be exercised in relation to services such as insurance, travel agency services and provision of leisure facilities: other words where the services may be tailored for different "lifestyles".

- **LIGHT/LITE**

It is not necessary to raise an objection under section 3(3) (b) when LIGHT or LITE is used in relation to cigarettes. Historically it was considered necessary to limit the specification to cigarettes having yields of not more than 0.8mg nicotine and 10mg of tar per cigarette, or

agree to a condition of registration that the mark would be used in relation only to cigarettes yielding not more than 0.8mg nicotine and 10mg tar per cigarette. No limitation or condition will be required in future.

- **LINE**

This word is descriptive if preceded by a word which describes a type or category of goods e.g. PASTEL LINE (for a range of plastic coated steel products in pastel shades). As a rule of thumb, substitute the word 'Range' for the word LINE and if the mark as a whole is descriptive consider objecting under sections 3(1)(b) and (c).

- **LINK**

LINK marks should be treated as follows:

1. LINK: alone

If LINK describes a characteristic of the goods or services, object under section 3(1)(c) prima facie e.g. for telephones or telecommunication services, computers, software and associated services or for transportation services.

If the connection is less obvious accept prima facie e.g. for trucks, industrial design, marketing or employment agencies.

If there appears to be no connection with the goods/services accept e.g. for tea, coffee, café services or restaurant services.

2. LINK: as prefix or suffix

LINK together with a word where the combination has a clear meaning, should be objected to under section 3(1)(b) and (c) e.g. HEATHROW LINK for bus or train services; COMPUTERLINK for network communication apparatus; FASTLINK for computer software and telecommunication services

For other combinations LINK will usually be acceptable.

- **LUX**

This is defined as a unit of light. It is not normally objected to because of this: the only instance would be if the item has some control over the amount of light being emitted.

## **M**

### **• M or m**

Care should be taken when examining applications with the prefix "m". The letter is increasingly being used as an abbreviation for "mobile" (as in mobile phone) and terms such as m-banking, m-payments and m-commerce are used to describe services provided via a mobile phone.

An application for a word which describes the goods or services applied for and is prefixed with "m" may be objectionable under section 3(1)(b) and (c) of the Act and in some cases section 3(1)(d) may be appropriate. When considering an application, the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or services. The Internet will be searched where necessary, but it should be remembered that the fact that a term is not already in descriptive use does not preclude an objection under section 3(1)(c) of the Act if the likelihood of normal descriptive use of the term is foreseeable at the date of application.

### **• MAGIC**

Colloquially, has the laudatory meaning "brilliant", "excellent", "super." However, following another word, even a descriptive word, it may be acceptable because it then has less of a laudatory connotation. As a guide, the following have been accepted:

MIRROR MAGIC for mirrors etc.  
ANIMAL MAGIC for printed matter  
BEDROOM MAGIC for bedroom furniture  
MILK MAGIC for feeding apparatus

**NB** When used alone or before a descriptive word the word MAGIC may still retain laudatory connotations and be the sort of language used in some classes of goods/services e.g. those aimed at the young or trendy. Therefore objection under section 3(1)(b) and (c) may be appropriate. For other classes the word would be fanciful e.g. MAGIC ACCOUNTANT for accountancy services.

### **• MALL**

Non distinctive in Class 35 for retail services. Consider other cases on their own merits.

### **• MANOR**

This is devoid of any distinctive character for accommodation services; object under section 3(1)(b).

- **MANAGER**

A term widely used to denote software that manages different aspects of a programme. The term is not distinctive for software. Object under section 3(1)(b) and (c) if used alone or with words where the totality is descriptive e.g. FILE MANAGER.

- **MAPLE LEAF (see Guide at PROTECTED WORDS - 6ter marks)**

The maple leaf is one of the state emblems of Canada which is protected under Article 6ter of the Paris Convention. As with other protected emblems it cannot be included in a registered mark without the consent from the appropriate body. The logo below, or any closely resembling this, should be objected to:



The words MAPLE LEAF is not a sign that may be used in trade to designate the geographical origin of goods from Canada and should not face an objection under section 3(1)(b) or (c).

- **MART**

Mart means "a market or trading centre" but is normally acceptable in combination with other descriptive terms, including the name of the goods e.g. TILEMART for tiles.

- **MASTER**

In view of the decision made by Robin Jacob QC (as he then was) sitting as the Secretary of State's tribunal in the case of THE MASTER for Class 33 goods, the practice relating to MASTER marks was reviewed. MASTER has, in the past, been recognised as having a laudatory meaning and the BUSMASTER case (1953 RPC141) and the EARTHMASTER case (1956 RPC73) outlined the practice to be adopted. Since these cases were reported, use of the word MASTER in a non trade mark sense, i.e. to suggest goods of a superior nature, has become less popular. Dictionary references to MASTER now concentrate on the significance when used in relation to people i.e. (according to Collins Dictionary) "a person with exceptional skill at a certain thing", for example MASTER BUILDER, MASTER

CRAFTSMAN, MASTERCROOK. MASTER is consequently much more likely to be meaningful in relation to services than to goods.

An alternative meaning given for MASTER is "a machine or device that operates to control a similar one" (Collins Dictionary). MASTER may therefore be a term that is used in trade to describe goods with a control function for example MASTER CONTROL.

As a guide:

MASTER (alone) is acceptable for goods which do not have a control function (e.g. whisky) or for services not provided by "artisans". The word is therefore not acceptable for goods with a control function or for services provided by artisans. (See below.)

MASTER (combined with descriptive words) is acceptable for goods which do not have a control function e.g. MASTERBUS or BUSMASTER (for buses), SWINGMASTER for golf clubs, but would not be acceptable if applied to goods with a control function e.g. MASTERSWITCH for electric switches.

MASTER is acceptable in combination with a word which does not describe, directly, goods or services provided by an artisan. The following would be acceptable –

OFFICE MASTER (for cleaning services)  
MASTERHEAT (for plumbing services)  
MASTERCOURT (for legal services)  
MONEYMASTER (for accountancy services).

The following would not be acceptable:

MASTERPRINTERS (for printing services)  
MASTER BAKER (for foodstuffs)  
MASTERCLEANER (for cleaning services).

#### • MATE

Accept prima facie even when following descriptive words e.g.:

CHISEL MATE - chisel sharpening apparatus  
DRAIN MATE - cleaning preparations for drains  
GROW MATE - foodstuffs for animals  
BRUSH MATE - anti hardening chemicals for paint brushes

#### • MAXI

A mark consisting of the prefix MAXI (meaning large, great or much) together with a word which is meaningful for the goods/services concerned is not usually open to objection. The

word has a more limited trade usage than MINI. Therefore, the following examples are acceptable:

MAXI INSURANCE for insurance  
MAXICOVER for paint  
MAXICOVER for insurance  
MAXICRUISE for travel services  
MAXITOOl for tools

#### • **MEDALS**

Devices of MEDALS or awards on the labels of bottles need not be justified.

#### • **MEDI**

It is considered that the use of MEDI meaning 'medical' is well-known. Prima facie objections under section 3(1)(b) and(c) should be taken to any application consisting of MEDI plus a word which, as a whole, may be used in trade as a description in a medical context.

#### • **MEGA**

Meaning "large". MEGA alone or MEGA plus the goods should be objected to prima facie where size or volume of goods (e.g. MEGA PACK) are likely to be relevant.

#### • **MERIT**

This word was not considered registrable for cigarettes under the old law (1982 FSR 72) but is now considered to be registrable prima facie for most goods.

#### • **MICRO**

Examiners will wish to note that Collins Dictionary (Second Edition) defines MICRO as, inter alia, "short for microwave oven." There are many foodstuffs which are specially prepared for cooking in microwave ovens. MICRO (alone) is therefore usually devoid of any distinctive character for foodstuffs; object under section 3(1)(b) and (c). No deceptiveness objections need be taken.

MICRO is also an abbreviation for 'microcomputer' and is thus devoid of any distinctive character for computers (Collins English Dictionary); object under section 3(1)(b) and (c).

#### • **MILLENNIUM/MILLENNIUM**

Both spellings of the word were not considered distinctive for goods or services associated with the recent millennium such as printed matter, figurines, jewellery, celebratory versions of consumer products including foodstuffs, souvenirs, organisation of parties or restaurant services. The word is now considered to have lost its descriptive appeal and relevance. Therefore the word can be accepted unless clearly the subject matter of the goods/services applied for e.g. MILLENIUM PROJECTS for printed matter (relating to building projects to mark the millennium).

- **MINI**

Consider whether to object to marks consisting of the prefix MINI (indicating something small) when combined with the name of the goods/services or of some feature of the goods/services. A source of reference is MINIGROOVE (1955 RPC 183) which was refused registration in respect of long playing gramophone records (i.e. records having smaller grooves than the short playing type.) By way of guidance:-

MINI together with a word directly descriptive of the goods/services may be objected to under section 3(1)(b) and (c) e.g. MINILIFT for small lifts, MINICRUISE for short cruises, MINIBUS/MINICAB (for bus and taxi services utilising small buses/cars).

MINI together with indirect reference to the goods/services will usually be acceptable e.g. MINISWEEP (chimney sweeping services), MINIGUARD (security services).

- **MIRACLE**

Acceptable for many goods and services when used on its own but care is required in relation to some articles of clothing such as MIRACLE PANTS and goods in e.g. classes 3 & 5 and related services where claims to a MIRACLE product are widely used in advertising. When used in combination with other words e.g. MIRACLE CURE, MIRACLE OF BIRTH etc. the word is more likely to have descriptive connotations.

- **MISSPELLINGS - phonetic equivalents of objectionable words (See Guide at PHONETIC EQUIVALENTS)**

- **MIST**

A deceptiveness objection should not normally be raised in future when this term appears in a mark - even in Classes 1 and 5.

- **MISTER/MR**

Although the word MISTER can have a laudatory connotation when combined with a word describing subject matter and applied to a person, the view is now taken that the laudatory

significance is somewhat reduced when such words are considered in the context of goods or services. However it is descriptive for fitness competitions; object under section 3(1)(b) and (c).

Applications for marks consisting of the word MISTER, or the abbreviation MR, combined with the name of the goods or services will, in future, be regarded as capable of distinguishing and, therefore, acceptable e g MR BARBECUE (for barbecues).

#### • **MONO**

Consider whether to object under section 3(1)(b),(c) and (d) when it has a meaning through common usage e g MONO has come to mean "monochrome" in relation to TV sets etc.

MONO on its own or with descriptive words will be acceptable in most other cases.

Examples of acceptable marks are:

MONOBIT (for drill bits), MONOCLEAN (for cleaning services), MONOGRIP (for tools).

#### • **MULTI**

Where the combination is clearly descriptive, consider whether an objection under section 3(1)(b) and (c) will be appropriate e.g.: MULTIBLADE (razors) . MULTIFABRIC (dyes) MULTICHOICE (pension services).

MULTI in combination with other descriptive words can often be accepted prima facie where the combination is not apt for use as a description e g MULTICLENS (cleaning services), MULTIWIPE (cleaning materials), MULTISTITCH (textile repair services), MULTISUIT (dry cleaning services).

#### • **MUST**

Meaning "to indicate necessity" (Collins English Dictionary) is regarded as being devoid of any distinctive character because it is used in the context of, for example "this product is a must!". Object under section 3(1)(b) and (c).

#### • **"MY" and "MY FIRST" marks**

The use of "My" in trade marks has become increasingly common as a way of marketing goods and services of a personalised nature. Examiners must consider whether the goods or services applied for are such that "My" will fail to indicate to the average consumer that they are giving their custom to a single undertaking. As a guide, the following may be helpful:

What sorts of goods and services are "personal"?

"My" plus the name of such personalised goods or services will be likely to be unacceptable. This is not intended to be an exhaustive list, but examples include diaries, calendars, photograph albums, recipe notebooks, gardening notebooks, address books, birthday books, wedding planners, baby books, guest books etc. Services of a personalised nature, e.g. pet insurance, colour analysis and wedding planning, may also attract an objection.

Not all "my" marks will necessarily face an objection; practice should not be applied blanket-fashion, without due regard to the merits of each case. For example, "MY TRAVEL" is acceptable for travel agency services and "MY PLACE" is acceptable for night-club services: their imprecise meanings create a distinctive impression.

"My First..."

Are the goods or services aimed at children?

This area of goods also requires caution because it is common in the toy trade to market toys in this way, particularly as "my first..." e.g. "My First CD player", "My First Bike", "My First Train Set", "My First Bed", "My First Toothbrush", "My First Bra" etc

## **N**

### **• NAPOLEON**

This is devoid of any distinctive character for cognac and subject to an objection under section 3(1)(b)(c) and (d). No section 3(3)(b) objection arises.

### **• NATURAL SPRINGS**

If the mark consists of the name of a place where springs are known to exist, i.e. the name of the spring is listed in a reference book, it is necessary to raise a geographic objection under section 3(1)(b) and (c) prima facie. This can be overcome if the applicant shows that he/she owns the exclusive rights to the spring.

### **• NET**

1. The word NET is recorded in Collins Dictionary as an abbreviation for 'network.' The words NET and NETWORK are interchangeable for electronic goods and services. Consequently applications to register trade marks, which contain the word NET for such goods or services, whether or not as part of a domain name, are unlikely to be accepted prima facie if the same mark with the word NETWORK substituted would be refused.

2. This means that applications to register the word NET in combination with a word describing characteristics of electronic networks (e.g. FAST NET) are likely to be refused registration for network apparatus and services in Classes 9 and 38 unless there is evidence that the mark has acquired a distinctive character. The same is true of marks in Class 9 which describe characteristics of computer software (e.g. NET ACCESS).

3. Applications to register a trade mark consisting of the word NET in combination with the name of a subject (e.g. WEATHER NET) are also likely to be refused prima facie registration for electronic information services in Class 38 but not for software in Class 9.

4. A number of marks have been accepted in the past which are not in line with the above practice. However in view of the increasing use by traders of the abbreviation Net referred to above, the registrar considers that the significance of the word has changed.

### **• NEWSPAPERS: GEOGRAPHICAL WORDS IN NEWSPAPER TITLES**

The titles of newspapers often combine geographic names with other words commonly used in the trade such as 'Echo', 'Chronicle' and 'Gazette.' The public are used to seeing such combinations and treating them as trade marks. In future, therefore, titles of newspapers may be accepted prima facie where they consist of geographic names combined with words used in the trade, but which are not actually descriptive in totality e.g. 'Sunderland Chronicle'

or 'Gwent Echo.' However care should be exercised where the totality describes the goods. For example, 'Monmouth News' or 'Beds Advertiser' for newspapers, magazines etc would still be open to objection under section 3(1)(c) on the basis that the totality describes the nature and general area of circulation of the goods.

- **NEXT**

Previously objected to but now acceptable for most goods and services. Care is required when the word is used as part of a descriptive phrase e g 'The Next Fashion.'

- **NUMERALS (see Guide at LETTERS AND NUMERALS)**

## O

- **OFFENSIVE DESIGNS (See Guide at OFFENSIVE MARKS)**
- **OLYMPIAD/OLYMPIADS /OLYMPIAN/OLYMPIANS (See Guide at PROTECTED WORDS)**
- **OLYMPIC/OLYMPICS (See Guide at PROTECTED WORDS)**
- **OLYMPIC MOTTO (CITIUS, ALTUS, FORTIUS) (See Guide at PROTECTED WORDS)**
- **OPEN**

This is meaningful in relation to computer services. OPEN is a term used to describe a type of computer system. Objections should be taken under section 3(1)(b) and (c) against marks containing this term if the mark as a whole is descriptive, for example OPEN SYSTEMS (computers and software, etc), OPEN SOLUTIONS (services that provide remedies for the customers open system problems).

- **OPTIMA**

This is the plural form of OPTIMUM (which is devoid of any distinctive character - see below). Although it has laudatory connotations it is not a word in common use and is consequently considered acceptable. An example is the mark OPTIMA for golf clubs.

- **ORGANIC**

Marks containing the word ORGANIC would lead the average consumer to assume that the goods were either produced organically or derived from organic produce. Consumers would pay a premium for these goods and would be deceived if the goods were not organically produced.

As such an objection under section 3(3)(b) should be raised if the specifications are not limited. This objection can be overcome by limiting all the goods to being of organic origin.

In respect of agricultural products, use of the word organic (in terms of product labelling, marketing and marking) is governed by Council Regulation (EC) No. 834/2007 ('On organic production and labelling of organic products...' see Regulation [here](#)). In terms of which products are covered by this legislation, the Regulation makes reference to 'plant, livestock and aquaculture production' which includes '... wild plants, seaweeds, processed food

(including wine), feed, and organic yeast.' Although, in most cases, a section 3(3)(b) objection will suffice (and a suitable limitation will resolve the issue), there may be scenarios in which the use of an 'organic' trade mark directly contravenes Regulation (EC) No. 834/2007 (see Article 23), and so an objection under section 3(4) may also be appropriate.

- **ORIGINAL/ORIGINALS**

Objection under sections 3(1)(b) and (c) will be justified for most goods and possibly some services.

## **P**

- **PACIFIC (See Guide at GEOGRAPHICAL NAMES)**

- **PACK, PAC, PAK**

Devoid of any distinctive character for packaging materials, equipment or services and for goods sold in packs or packages, both in the physical sense (packs of screws, stationery) and the metaphorical sense (software packages). Object under section 3(1)(b) and (c) for these reasons where appropriate.

- **PAINTINGS: FAMOUS (See Guide)**

- **PARCELS**

PARCELS is often used to describe dishes the main constituents of which are wrapped in pastry, pasta, dough, edible leaves etc, or which are simply wrapped in foil for cooking. This word is therefore without distinctive character for many food dishes and open to objection under section 3(1)(b) and (c) in appropriate cases. It is advisable to consult recipe books etc where a word appears to be descriptive. Such recipes should be quoted to justify any objections raised.

- **PARTNER**

Meaning "ally or companion" (Collins English Dictionary). It is acceptable alone or when combined with another word unless the totality is meaningless. Examples of acceptable marks are:

CHISEL PARTNER - chisel sharpening apparatus

DRAIN PARTNER - cleaning preparations for drains

BRUSH PARTNER - anti-hardening chemicals for brushes

MARRIAGE PARTNER, for dating services, would not be acceptable.

- **PASTORAL SCENES (See LANDSCAPES)**

- **PATTERNS: DECORATIVE**

Neither devices which are likely to be used as patterns on the goods themselves, nor words describing such devices are regarded as acceptable in respect of those goods e.g. flower

devices or the words ROSE DESIGN in relation to, for example, textile piece goods or wallpaper, would not be acceptable. Object under sections 3(1)(b) and (c).

- **PHARMACEUTICAL NAMES (See Guide at PROTECTED WORDS, paragraph 5)**

- **PLUS**

PLUS is frequently used in connection with advertisements for various savings accounts operated by building societies and banks. Consider whether to object to PLUS on its own or following a descriptive word for finance related services. Proceed with caution for other goods and services where the word PLUS is commonly used to indicate goods and services which offer something extra. PLUS alone, or as a prefix or initial word is usually acceptable prima facie.

- **POLY**

Words with the prefix POLY (meaning "more than one, many or much" - Collins Dictionary) will normally be acceptable unless there is evidence that the totality is already in use. When used alone POLY is generally acceptable except where it has, by common usage, become an adjective in its own right e.g. POLY is now virtually generic for polythene e.g. "Poly bag" and therefore objectionable under section 3(1)(b) and (c) for goods which are made from polythene.

- **POWER**

POWER can denote strength or a particular form of energy. The guidance is: POWER alone or combined with the name of the sort of powered goods (especially if there are non-powered versions e.g. power tools) - object prima facie under section 3(1)(b) and (c).

POWER plus a characteristic can generally be accepted. However each case must be assessed on its own facts.

- **PRECINCT (See MALL)**

- **PRO**

PRO (professional) is meaningful for certain goods, especially in Classes 7, 8 and 28, because it indicates goods adapted for professional use as opposed to 'non professional' or 'D-I-Y' use. Objections arise most obviously in the sporting field where the term Professional is in common use. PRO may be devoid of any distinctive character for sporting goods and services. Each case must be assessed on its own merits.

- **PROFILE**

PROFILE has a specific meaning when applied to building materials (particularly windows and doors) and bicycles because these can be profiled to cut down on wind resistance. Such bicycles are referred to as "low profile" and their parts are referred to as "profiled". It is considered to be devoid of distinctive character for building materials, bicycle parts and vehicle tyres in Class 12 and care needs to be exercised in relation to other goods. Object under section 3(1)(b) and (c) as appropriate.

- **PUBLIC HOUSES: NAMES**

The issue is whether the name is common to the trade not just whether some other business has adopted the name. Pub names can be trade marks. Objection should not usually be taken simply because there are a few pubs listed with the same name. Some names are frequently used for public houses e g RED LION, WHITE HORSE, PRINCE OF WALES. Dunkling and Wrights "Dictionary of Pub Names" is one source of names common to the trade. If a pub name is common, (i e dozens of pubs nationwide have the same name,) it cannot be a distinctive mark and should be objected to under section 3(1)(b) and (d) prima facie as being devoid of any distinctive character.

# R

- **REGAL**

Over the years the practice on REGAL marks has become mixed. Websters Dictionary defines REGAL as "relating to royalty" and "of notable excellence or magnificence" and the latest edition of the Concise Oxford Dictionary retains the meaning of "magnificence". Collins and Chambers Dictionaries however suggest that "relating to royalty" is becoming the main signification. Whilst the word retains its laudatory signification, changing use of the English language indicates that it can be accepted prima facie. (See also Guide at ROYAL)

- **RESTAURANTS (See Public House: Names)**

- **ROAD SIGNS**

Devices of road signs adopted officially by the Department for Transport are open to objection under section 3(1)(b) if the goods concerned are motor vehicles or other goods /services directly connected with the roads, road traffic or road transport.

- **ROSETTES**

Devices of ROSETTES are considered devoid of any distinctive character for goods/service that may have won an award.

- **ROYAL (See Guide)**

- **ROYAL SOVEREIGN (See Guide at ROYAL MARKS)**

- **ROYAL WARRANT (See Guide at ROYAL MARKS, paragraph 6)**

## S

### • SAFE

There is no objection to accepting marks incorporating the word SAFE provided the mark as a whole is distinctive. An objection under section 3(3)(b) will only arise when the mark creates strong impressions in relation to such goods as glass and helmets. The addition or conjoining of the word SAFE to another descriptive word may result in a term that may serve in trade to designate the intended purpose of the goods or services e.g. WORKSAFE for scaffolding; SAFE INVESTMENTS for financial services.

### • SCOTTISH REFERENCES

Words and devices such as THISTLE, TARTAN, HIGHLAND, GLEN or LOCH strongly suggest Scotland or Scottish goods. In the case of goods where Scotland has a reputation, like whisky, knitwear, salmon, spring water, beef, biscuits etc, a section 3(3)(b) objection may be appropriate. This could be overcome by a limitation of the specification but of course, the mark as a totality must also be distinctive.

### • SHAMROCK (See Guide at PROTECTED WORDS, paragraph 2)

The shamrock is one of the State emblems of the Republic of Ireland which is protected under Article 6ter of the Paris Convention (the other being the harp). As with other protected emblems it cannot be included in a registered mark without consent from the appropriate body. The logo below, or any closely resembling this, should be objected to:



The word SHAMROCK is not a sign that may be used in trade to designate the geographical origin of goods from Ireland and should not face an objection under section 3(1)(b) or (c).

### • SHAREWARE

Means computer programs that can be downloaded from the Internet free of charge. It is therefore devoid of distinctive character for computer programs and associated goods and services. Object under section 3(1)(b) and (c).

- **SHILLING (OR 60/)**

Found on beer labels in Class 32 it indicates a strength of beer: 60/ - light or mild beer; 70/ - heavy or bitter beer; 80/ - export beer. Therefore they are terms devoid of any distinctive character and are open to objection under section 3(1)(b) and (c).

- **SHOP**

A shop is a building or room for the retail sale of goods, services etc and may consequently be regarded as being devoid of any distinctive character. Objections under section 3(1)(b) may be raised for goods and many services e.g. SHARE SHOP for financial services.

- **SHRUBS (See FLOWERS)**

- **SILK**

In future it will not be necessary to take a deceptiveness objection to a mark containing the word SILK for an application in Class 3. When used in relation to goods such as cosmetic preparations and hair care products the word SILK is more likely to indicate to the public a property imparted by the product e.g. "as smooth as silk" or "silky hair", rather than that the product contains silk. The word is non distinctive in Class 3. There is a section 3(3) objection for silk for clothing unless the specification is limited.

- **SIMPLY (See JUST)**

- **SOFTWARE: PRACTICE ON RELATIVE GROUNDS**

In the MERCURY case the breadth of this term was criticised. Where two potentially conflicting marks cover software for use in distinct applications or as an operating system rather than an application, these may not be regarded as similar enough to cause confusion. However there would need to be a very clear separation between the uses of the respective software before they would be considered dissimilar goods.

The registrar does not believe that he has vices to object to the general term 'software' which therefore remains acceptable for classification purposes.

- **STARS**

Star devices are commonly used in marks for tobacco and spirits (whisky, brandy etc) and are consequently considered to be devoid of any distinctive character for these goods. Simple star or crown devices are considered to be devoid of any distinctive character in

respect of hotels and restaurants since these are often classified by star or crown ratings. Object under section 3(1)(b),(c) and (d) as appropriate.

Star devices may be devoid of any distinctive character for other services since their use is creeping into other activities, for example gas central heating maintenance service are provided giving differing levels of service, dependent on whether the customer has a 1 star, 2 star or 3 star contract. Object under section 3(1)(b),(c) and (d) as appropriate.

#### • 5 STAR/FIVE STAR

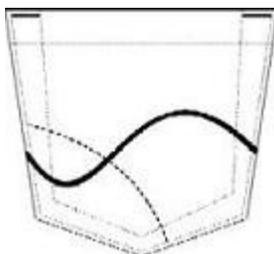
This is widely used in relation to services and is open to objection as it has a laudatory signification. The mark has been accepted for "weed killers" as its use, in relation to these goods, is somewhat fanciful and others would be unlikely to wish to use the term in this area of trade.

#### • STERLING

The word does have laudatory connotations, mainly in relation to abstract qualities, for example a sterling performance, sterling work etc. However there have been a number of prima facie acceptances in the past and it is now considered that STERLING can be accepted for a broad range of goods and services. Clearly the mark will continue to be unacceptable for some goods and services, for example jewellery (sterling silver), currency dealing etc. Object under section 3(1)(b) and (c) in such cases.

#### • STITCHING: DEVICES OF

Practice has been reviewed in this area following developments in case law. The decision of the General Court in T-388/09 *Rosenruist v OHIM* held that the mark shown below was devoid of any distinctive character in relation to goods in Class 18 and 25. The mark consisted of the position of the decorative stitching lines; the unevenly broken lines representing the perimeter of the pocket to which the applicant made no claim and which only serve to indicate the position of the mark on the pocket.



In relation to these kinds of marks, the Registrar is obliged to consider whether the average consumer would perceive the sign solely as a decorative feature, and also whether it is merely a variation of a common feature found on pockets of clothing and on other fashion goods covered by specification.

It is important to remember that whether or not a mark may serve a decorative or ornamental purpose is irrelevant for the purposes of assessing its distinctive character. It is always necessary to consider that even if the sign may serve a decorative purpose, is whether it possesses sufficient distinctive character to distinguish the goods from those of other undertakings.

The General Court stated that the mark at issue did not have any memorable or eye-catching features likely to confer a minimum degree of distinctive character. As such if a mark possesses one of these features, it may assist when assessing distinctiveness. The Court also confirmed that the mark above did not depart significantly from the standard presentation of pockets and will therefore be perceived simply as a decoration. As a general guide, if marks are similar to the one above and are fairly standard presentations of stitching on pockets, they will be likely to face an objection under Section 3(1)(b).

#### • **STUDIO**

This has become fashionable and has connotations wider than a mere workshop. Practice relating to STUDIO marks has been mixed in the past but it should in future be regarded as being devoid of any distinctive character for goods/services which may be sold/provided in a studio, such as works of art. Object under section 3(1)(b) as appropriate.

#### • **SUPRA**

The word means "over", "above", "beyond or greater than." It has obviously laudatory connotations and in the past practice has been mixed. It is now considered that it is not a word that traders normally use in their day to day business in the same way that they would use SUPER and it can be accepted prima facie.

# T

## • TARTAN

Tartan is regarded as a commonly used pattern or background which traders in general should be free to adopt for ornamentation purposes in their labels. Consider whether to object under section 3(1)(b) and (c) prima facie.

Care is required because the essential element of a tartan is the colour scheme and there may be variations in the way the actual stripes etc are put together. Therefore, the fact that a precise replica of the pattern cannot be found in the relevant reference books does not necessarily mean that the pattern will not be recognised as a particular tartan. In case of doubt the advice of the Tartan Society should be sought.

## • TECH

An accepted abbreviation for "technology" (Collins English Dictionary) which is objectionable under section 3(1)(b) and (c) when used in a combination which is an appropriate description. TEC should be similarly treated as it is a variant of "tech". Usually acceptable in combination with the name of non-technical goods, e.g. POOLTEC (swimming pools), SEALTEC (seals) have been accepted. Can also be accepted for some technical goods where the other word is not quite the name of the goods e.g. TILLTEC (tilling machines). HI-TEC has been refused. COMPUTER TECH, NETWORK TECH would also be refused.

## • TEX

Information provided by the British Man-made Fibres Federation and the Textiles Finishers Association suggest that although TEX is not a recognised abbreviation for textiles it is a technical term for a metric measure of the thickness of yarn. Under these circumstances Registry practice will, in future, be as follows:

TEX alone or in combination; accept except in Class 23.

Tex alone or in combination with a descriptive word in Class 23 may be rejected if the totality is an apt description of yarn e.g. SILKTEX.

## • THANK YOU

This is non-distinctive for goods whose intended purpose is as a 'thank you' present e.g. it has been refused for chocolates. Object under section 3(1)(b) and (c) if necessary.

## • THERMO/THERM

A combining form meaning "related to, caused by or measuring heat" (Collins English Dictionary). It does not necessarily relate to high temperatures and is therefore unlikely to convey any precise meaning; it could relate to articles for use in high temperatures, or low temperatures, or for producing heat, for shielding from heat, insulating, etc. In most cases it can be accepted even when combined with another word which creates a meaningful term e.g. THERMOSHIELD.

- **THISTLES**

Unless highly stylised, thistle devices are open to objection under section 3(1)(b) and (c) in respect of goods for which Scotland is widely famed (e.g. whisky) because such devices are commonly used by traders for the purpose of indicating the Scottish origin of the goods. If the goods do not originate in Scotland an objection under section 3(3) may also arise. If they only form a small part of the background of a label no objection need be taken. The word THISTLE is not subject to this objection.

- **TREAT**

This is non distinctive for foodstuffs and beverages. Object under section 3(1)(b) and (c) prima facie.

- **TREES (See FLOWERS)**

- **TTS**

These initials stand for Transdermal Therapeutic System. This is the method whereby drugs etc. can be administered by means of a patch worn somewhere on the body. Clearly, neither the initials nor words are acceptable in connection with pharmaceutical products.

- **TWENTY FOUR SEVEN: 24/7**

Non distinctive for services and for goods sold through convenience stores e.g. food and drink.

# U

- **ULTRA**

Treatment depends on the totality of the mark but if ULTRA is combined with words which describe characteristics of the goods (ULTRAFINE for thread), the mark as a whole will attract objections under section 3(1)(b) and (c). Each case should be assessed on its merits.

- **UNIVERSITIES**

Names of universities may be accepted prima facie.

## V

### • VARIETAL NAMES

Varietal names will no longer face an objection on absolute grounds at the prima facie stage, but trade mark consisting of varietal names are liable to be declared invalid if the name was generic at the date of application. If it is apparent to the examiner that the name is generic (s)he will object in the usual way under section 3(1)(b), (c) and (d).

### • VEGGIE OR PHONETIC EQUIVALENT

Collins English Dictionary lists "veggie" as meaning an informal word for vegetarian. Furthermore, Collins lists "vegeburger" as a burger made from vegetables. It is now commonplace for animal-free products to be prefixed with 'veggie' and phonetic equivalents of this word. Vegetarian "friendly" products extend beyond Classes 29, 30 and the drinks classes (as beers and wines can use animal products for fermentation). Some pet foods in Class 31 are vegetarian and, in Class 3, soaps which do not use animal oil are vegetarian. There are Vegetarian Society approved tablet coatings for pharmaceuticals, and clothing and imitation skin and fur goods which do not contain animal products. There are also services relating to the above, such as vegetarian restaurants.

Since "veggie" has come to denote "vegetarian", applications to register VEGGIE, VEGGY, VEGGI, VEGY, VEGI and VEGE (and other phonetic equivalents of VEGGIE) in combination with the name of the goods or services, or a words descriptive of the goods or services, such as VEGE NUGGETS and VEGESOAP and, for services, VEGECAFE and VEGE MENU are no longer acceptable and will be objected to under section 3(1)(b) and (c) of the Act. Previous acceptances will not be regarded as precedents for further acceptances. Invented words, such as VEGECATESSEN, remain acceptable.

### • VINE LEAVES

Pictures of VINE LEAVES are considered to be devoid of any distinctive character in respect of wines since such devices are a common feature of wine labels. The same would apply to wine bar, restaurant and public house services. Marks consisting of such features are not acceptable; object under section 3(1)(b) prima facie.

### • VR

This means Virtual Reality and is now generic. It is therefore devoid of any distinctive character for games and software, object under sections 3(1)(b) and (c). There is also a section 3(3) objection if the games are not virtual reality.

- **VS**

These letters are generic indications of qualities of cognac. Object under sections 3(1)(b) and (c) as appropriate.

- **VSOP**

These letters are generic indications of qualities of cognac. Object under sections 3(1)(b) and (c) as appropriate.

- **VVSOP**

These letters are generic indications of qualities of cognac. Object under sections 3(1)(b) and (c) as appropriate.

# W

## • WAREHOUSE

Becoming used in trade to characterise retail trading premises which resemble a warehouse, usually because of their size and layout. Objectionable alone. May be acceptable in combination with some other non-distinctive terms, but less likely to be distinctive when combined with the name of the goods, particularly where these are the sort of goods that are likely to be sold through specialist retail outlets.

## • WEB

This can be taken as a reference to the World Wide Web and is interchangeable with Internet. Object under section 3(1)(b). Applications to register the word WEB in combination with words describing characteristics of electronic networks (e g WEB SERVER) are likely to be refused registration for network apparatus and services in Classes 9 and 38, unless there is some evidence that the sign has acquired a distinctive character as a trade mark through use.

The same applies to applications to register signs in Class 9 which describe characteristics of computer software (e g WEB ACCESS). Applications to register a trade mark consisting of the word WEB in combination with the name of a subject (e g WEB SOCCER) are also unlikely to be accepted prima facie for electronic information services in Class 38, or for downloadable software in Class 9.

## • WORLD

In the case of Mecklermedia Corporation v D.C. Congress Gesellschaft GmbH (passing off - unreported), Jacob J decided that the words "Internet World" were not so descriptive for trade shows (about the Internet) that people familiar with past trade shows organised by the plaintiff (of which there had been 3) would not expect further trade shows under that name to be run by the same people who had used that name in the past. Trade Marks consisting of the word "World" in combination with the name of, or a description of, the goods or services will normally be accepted prima facie. Applications to register everyday generic terms, such as "business world" and "financial world" are unlikely to be accepted without very convincing evidence of distinctiveness.

**X**

• **X**

This denotes strength of beer or lager and is considered to be particularly without distinctive character for such goods; object under section 3(1)(b). No deceptiveness objection need be raised.

# Chapter 4 Certification and Collective Trade Marks

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# **1 INTRODUCTION**

## **1.1 Purpose of this chapter**

The purpose of this chapter is to detail, for the benefit of both customers and staff of the Trade Marks Registry, the way in which we will examine applications for certification and collective marks.

## **1.2 Definitions of, and comparisons between, certification, collective and ordinary trade marks**

A certification mark is defined in Section 50(1) of the Act as:

*“A certification mark is a mark indicating that the goods and services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.”*

The main feature of a certification mark is that it is used not by the proprietor of the mark but instead by his authorised users for the purpose of guaranteeing to the relevant public that goods or services possess a particular characteristic. The proprietor’s mark certifies the presence of the characteristic and will authorise the use of the mark to anyone who can demonstrate that the goods and services for which it will be used have that characteristic.

A collective mark is defined in Section 49(1) of the Act as:

*“A collective mark is a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.”*

The main feature of a collective mark is that it is used as an indication to the relevant public that goods or services originate from a member of a particular association. It is therefore a sign of membership.

Certification and collective marks therefore differ from “ordinary” trade marks because an ordinary trade mark is one that distinguishes the goods and services of one particular trader (a single trade source) from those of other traders.

## **1.3 Overview of the examination process**

The examination of certification and collective marks consists of two distinct phases. Firstly comes the initial examination of the application itself; this includes an assessment of the mark’s inherent acceptability under both absolute (distinctiveness and deceptiveness) and relative (confusion with other marks/rights) grounds together with some additional aspects of examination peculiar to collective and certification marks. Secondly comes an examination of the regulations (that are required not less than three months after the application date) that govern the use of the certification or collective mark.

## 2 INITIAL EXAMINATION

### 2.1 Section 3(1) – criteria for distinctiveness

#### 2.1.1 Essential distinguishing function to be considered

As with ordinary trade marks, certification and collective marks will be examined against the absolute grounds for refusal contained in Section 3(1) of the Act. The fundamental aim of these provisions is to ensure that a mark is capable of carrying out its essential distinguishing function. When considering the distinctiveness of a mark it is therefore important to appreciate that the distinguishing function of certification and collective marks differs from that of ordinary trade marks.

Paragraph 2 of Schedule 1 gives the distinguishing function of a collective mark as:

*“..distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings”*

Paragraph 2 of Schedule 2 gives the distinguishing function of a certification mark as:

*“...distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.”*

In many cases an objection applicable to an ordinary trade mark will be equally applicable to a certification or collective mark, however, there will also be circumstances where it is not. For example, the mark shown below may not be acceptable as an ordinary trade mark in respect of meat or meat products (it is unlikely that the average consumer will regard it as pointing towards a single trade source for these goods) but would be acceptable as a certification mark as it is capable of performing that particular distinguishing function.

*The applicant claims the colours red and blue as elements of the mark*



### **2.1.2 Underlying interests remain the same**

The interests underlying Section 3(1) do not change when considering the acceptability of certification or collective marks. Further information on these interests, together with the Registrar's main practices relating to them, can be found in The Examination Guide. However, the underlying interests can be summarised as:

**Section 3(1)(b)** – that the mark has the capacity to perform its essential distinguishing function in the eyes of the average relevant consumer.

**Section 3(1)(c)** – the need to keep descriptive indications free for the legitimate use by other traders.

**Section 3(1)(d)** – the need to avoid granting monopolies in respect of signs or indications that are already customary in the trade.

### **2.1.3 Assessing acceptability under Section 3(1)**

When considering the acceptability of certification and collective marks it is therefore important to consider the underlying interests of Section 3(1) (all of which have independent scope) together with the marks particular distinguishing function. The following examples aim to provide an explanation of the approach that will be taken.

#### **GUARANTEED 100% COTTON**

(certification mark in respect of cotton shirts in Class 25.)

This mark will face an objection under Sections 3(1)(b) & (c) of the Act. The term is a descriptive one that all traders should be free to use to send the descriptive message that the goods offered are guaranteed as being made from 100% cotton. Although the mark indicates a guarantee of a particular characteristic (100% cotton) it does not indicate that a certification scheme (and not just the individual trader) is guaranteeing the presence of the characteristic.

#### **COTTONMARK 100% COTTON**

(certification mark in respect of cotton shirts in Class 25.)

This is not a simple descriptive term that other traders would legitimately require to describe cotton shirts, therefore no Section 3(1)(c) objection is appropriate. As well as indicating that the goods are 100% cotton, there is something else in the mark (the words "cottonmark") that ensures that it has the capacity to distinguish goods that have been certified from those that have not.

## **CHARTERED MORTGAGE ADVISOR**

(collective mark in respect of financial services in Class 36.)

Royal charters are granted by the Crown to certain associations whose members can then use particular terms to indicate their chartered status. The charter only allows members of the association to use the particular terms, therefore there is no need to keep them free for use by other traders. The essential function of this collective mark is to distinguish services provided by members of an association from those of other traders. This mark is capable of doing so as it sends a message to the consumer that the services are provided by a chartered mortgage advisor who necessarily belongs to the particular chartered association. The mark is therefore acceptable as a collective mark.

It should be noted that an application for the same mark as an ordinary trade mark would not succeed as the mark would be unable to distinguish services provided by one particular chartered mortgage advisor from those of others. It should also be noted that proof of the association's chartered status will need to be supplied otherwise an objection under Section 3(3)(b) of the Act will be raised as the mark would mislead the public into believing that the association and its members have chartered status.

## **MORTGAGE ADVISORS ASSOCIATION**

(collective mark in respect of financial services in Class 36.)

The mark in totality does not describe a characteristic or the services, it instead describes an association whose members provide such services, consequently, there can be no objection under Section 3(1)(c) of the Act. Under Section 3(1)(b) the average consumer will likely perceive the mark as an indication that the services are provided by a member of the particular association, the mark is therefore capable of distinguishing services provided by members of an association from those of other traders. Marks of this type will, in general, be acceptable save where the name is already in common usage by more than one organisation.

## **MORTGAGE ADVISOR**

(collective mark in respect of financial services in Class 36.)

The mark describes the services in question as being provided by a mortgage advisor. Furthermore, the mark is incapable of distinguishing services provided by mortgage advisors of a particular association from those of other mortgage advisors (it is also likely to be in common use by the trade). This mark will face objections under Sections 3(1)(b), (c) & (d) of the Act.

## **2.1.4 Section 3(1) - Geographical names & protected geographical indications (GIs)**

### Geographical names in general

A geographical name will normally fall foul of Section 3(1)(c) of the Act if it is likely to be required by other traders to designate the geographical origin of the goods or services sought for registration. However, Schedule 1 (collective marks) and Schedule 2 (certification marks) of the Act provides the Registrar with discretion to accept geographical indications as certification or collective marks. Being discretionary means that this is not an automatic right of acceptance.

The Registrar's practice is that a geographical name will only be accepted as a certification or collective marks if it has the capacity to perform its distinguishing function. Certain names will be unable to perform the distinguishing function, e.g. BRITISH (as a certification mark for lamb) will be unable to distinguish lamb that has been certified as being produced in Britain from lamb that has not; this is because the consumer will only ever see this sign as a simple indication of geographical origin and not as an indication that the goods have been certified.

In practical terms, the Registrar will accept geographical names that would otherwise be debarred under Section 3(1)(c) if the applicant can establish that the geographical name is capable of distinguishing the goods and services of members of the applicant association (collective marks) or that the goods and services are certified by the holder's mark as having the relevant geographical origin, and distinguishing them from other goods/services which are not. This necessarily requires the Registrar to consider whether, due to custom and practice, a particular name is capable of distinguishing certified goods. For example, Bordeaux appears to be capable of distinguishing certified wines from Bordeaux, French wine names having been used for decades to certify geographical origin. On the other hand, "Bordeaux" would probably not be registrable as a collective mark for wines, there being a number of different trade associations to whom producers of Bordeaux wine belong.

It should also be noted that if a geographical name is accepted for registration, the proprietor of such a mark is not entitled to prohibit the use of the name in accordance with honest practices, in particular, by a person entitled to use the geographical name.

### Protected geographical indications (GI's)

EC regulations protect certain geographical names in the fields of agricultural products and foodstuffs, drinks, wines and spirits. The purpose of these regulations is to prevent the misappropriation or misuse of the names which are used by the trade to establish a connection between certain goods and their geographical origin normally in order to evoke a quality standard.

An application to register an ordinary trade mark which consists solely of a GI will face insurmountable objections. This is because the registration of a GI to one single trader would amount to misappropriation and misuse of the GI the purpose of which is to guarantee geographical origin and not trade origin.

However, an application to register a GI as a certification mark will not be regarded as misappropriation or misuse. The function of certification marks can be seen as complimentary to a GI as opposed to an ordinary trade mark which is antagonistic to it. For example, a certification mark for a geographical name sends a message to the consumer that the goods are certified as being the produce of the particular location, this therefore supports the function of a GI. Collective marks may also be acceptable in the face of a GI so long as the circumstances (such as the association being of producers of the goods protected by the GI) permit.

#### 2.1.5 Evidence of acquired distinctiveness

A trade mark that has been objected to under the provisions of Section 3(1)(b), (c) or (d) of the Act may nevertheless be accepted for registration if, in consequence of the use made of it, it has in fact acquired a distinctive character. This is equally applicable to the examination of collective and certification marks as it is to ordinary trade marks. Further guidelines on the filing of evidence of use are provided in The Examination Guide.

Case-law exists (*Re Legal Aid Trade Mark Application* (High Court 2000 No.00817) & *Stilton Trade Mark Case* [1967] RPC 173) that supports the view that it is not a prerequisite that the relevant public know who is actually certifying the goods or services, or even know that the proprietor has actually carried out formal certification in the past. It is the nature of the use and the message that it sends to the relevant consumer that is important when deciding if the use made of the mark transforms it into one that is capable of carrying out its distinguishing function. Thus, if a mark is shown to have become capable of certifying a characteristic of goods or services, or membership of an association, by the date of application, it should be accepted. It is not essential that the mark should have been used that way prior to the relevant date.

#### **2.2 Other absolute (Section 3) grounds**

There are a number of other absolute grounds objections that have the potential to be raised against collective and certification mark applications. These include objections under Section 3(2) (registrability of shape marks), Section 3(3) (public policy, morality or deceptiveness), Section 3(4) (other enactment or rule of law), Section 3(5) (protected emblems) and Section 3(6) (applications made in bad faith). There is nothing in any of these potential objections that are peculiar to the examination of collective and certification marks, therefore, for a more detailed explanation of these objections please refer to the Examination Guide, which deals with the examination of ordinary trade marks.

## 2.3 Relative grounds examination

As part of the examination process of certification and collective marks a search will be undertaken to ascertain if there exist any earlier marks (certification, collective or ordinary trade marks) owned by someone other than the applicant that conflict with the subject application. When assessing potential conflict the same principles apply as they do to the examination of ordinary trade marks, namely, after considering the similarity between the respective marks and their goods and services, is there a likelihood of confusion between them. For a full explanation of the factors taken into account when making this assessment please see The Examination Guide which deals with the examination of ordinary trade marks.

## 2.4 Co-existence with ordinary trade marks

Schedule 2 Paragraph 4 of the Act states that:

*“A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods of the kind certified.”*

If during the examination of a certification mark it comes to light that the applicant is also the proprietor of an earlier ordinary trade mark in respect of goods or services identical to those of the certification mark, this will be taken as a *prima facie* indication that the proprietor of the certification mark also carries on a business in the supply of the goods certified. This is not a relative test, there is, for example, no need for the marks in issue to be similar. In this situation, an objection will be raised under Schedule 2 Paragraph 4 of the Act.

To overcome an objection of this sort it is sufficient for the applicant to make a statement that he does not carry on a business in the goods or services certified. It will not be necessary to withdraw or surrender the ordinary trade mark so long as this statement is made. It should be noted however that grounds for revocation and invalidation exist (upon application from a third party) should this prove to be false or to become false by the applicant beginning to trade in the goods or services.

There is no equivalent prohibition in Schedule 1 relating to collective marks. Therefore, no objection of the kind described above will be raised against a collective mark application if the applicant is also the proprietor of an ordinary trade mark even in respect of identical goods or services. It should also be noted that no objection will be raised against either certification or collective marks where the applicant is also the proprietor of ordinary trade marks for similar goods or services to that sought by the certification or collective mark application.

## **2.5 Misleading as to the nature of the mark**

### **2.5.1 When will objection be raised?**

Paragraph 4 of Schedule 1 and Paragraph 5 of Schedule 2 indicate, respectively, that collective and certification marks shall not be registered if the mark would mislead the public as regards its character or significance, in particular if it is likely to be taken as something other than a collective or certification mark.

In practice, this means that an objection will be raised if the mark is likely to be taken as something other than its true designation i.e. that it is more likely to be taken as an ordinary trade mark as opposed to its true designation. The following examples aim to illustrate the practice:

#### **AMCF – ASSOCIATION OF MASTER CARPET FITTERS**

(collective mark for carpet fitting services)

The nature of the mark sends a clear message that the services offered stem from a group of traders belonging to the particular association. General consumer knowledge is likely to appreciate that an association does not normally offer the services themselves and therefore the sign is likely to be perceived as a badge of membership. No objection will be raised.

#### **AMCF**

(collective mark for carpet fitting services)

The answer here is less clear cut. Combinations of letters are commonly used as ordinary trade marks, but they are also commonly used to denote the name of an association. It is therefore equally plausible that the mark may be seen as an ordinary trade mark as it is to being seen as a collective mark. In the circumstances, it is difficult to say that the mark is likely to be taken as an ordinary trade mark as opposed to its true designation and therefore an objection is unlikely to be raised.

#### **PREMIER CARPET FITTERS**

(collective mark for carpet fitting services)

There is little in this mark to indicate to the public that it is collective mark. It is therefore likely that it will be taken as an ordinary trade mark as opposed to its true designation. An objection will therefore be raised.

### **2.5.2 Overcoming any objections**

An objection of the above nature can be overcome by adding to the mark the words “certification mark” or “collective mark”. This form of amendment is permissible irrespective of the provisions of Section 39 of the Act.

Alternatively, the regulations governing the use of the mark may include a clause (which should be entered under the category of “conditions of use of the mark”) stipulating that when in use the mark will be used in conjunction with an indication of its nature. The following form of wording would be acceptable:

*“It is a condition of use that the mark shall not be used without indicating that is a collective/certification mark.”*

Applicants are not limited to the above form of wording. As long as the mark in use, as described by the clause, is unlikely to be taken as an ordinary trade mark.

## **2.6 Specifications of goods and services**

### **Specification must reflect intended use by authorised users**

The specifications of collective and certification marks should either (i) denote the goods and/or services being provided by an association's membership (in the case of collective marks) or (ii) denote the goods and services whose characteristics are being certified (in the case of certification marks).

Although previous practice stipulated that applicants should make a statement to this effect in all cases, IPO will no longer require any such supplementary declaration in respect of *collective mark* applications. Upon receiving a duly completed and signed application form containing a clear specification, IPO will now assume that the collective mark is intended to represent those goods and/or services provided by association members.

However, in the case of certification marks, IPO will continue to require supplementary statements as part of the application process. Such statements should confirm that the goods and/or services listed in the application form - which are being certified as possessing particular characteristics - are being provided by the authorised users, and are not being provided by the applicant itself.

All applicants are reminded that failure to use a collective or certification mark in the appropriate manner may render it vulnerable to revocation proceedings.

### **3 EXAMINATION OF REGULATIONS GOVERNING USE OF CERTIFICATION/COLLECTIVE MARKS**

#### **3.1 Regulations and their approval**

The requirement to file regulations governing the use of collective and certification marks exist for a number of reasons. There is a need that regulations governing the marks use are clear and accessible so that anyone intending to make use of the mark can easily access the relevant information (regulations are open for public inspection once the application is published) and can understand the requirements that must be met before an authorised user can make use of it.

Furthermore, the Registrar has what can be described as a public interest role in ensuring that the regulations are not contrary to public policy or to accepted principles of morality. This later point is particularly important when considering the regulations governing the use of certification marks; the registration of a certification mark may introduce into the market an important industry standard, the Registrar must therefore be certain that the regulations do not unfairly restrict the use of the mark (by, for example, charging excessively high fees) which would have anti-competitive results.

Prior to accepting the mark for registration the regulations must be approved by the Registrar. The regulations must comply with required content, must not be contrary to public policy or morality, and, in respect of certification marks, the applicant must be competent to certify. Further details on these requirements are given below.

#### **3.2 Time & manner of filing**

The Act states that regulations for both collective and certification marks must be filed within not less than three months of the date on which the application is made. In practice, the examination of regulations does not take place until after the initial examination matters have been resolved, therefore, applicants may request an extension of the not less than three month period for this reason. If the initial examination matters have been resolved within initial period allowed, extensions of time can still be requested if further time is required to compile the regulations; as with any extension of time, the request should be accompanied by adequate reasons explaining why further time is required.

The regulations themselves must be accompanied by a Form TM35 together with a fee of £200. If the regulations cover more than one application only one form and one fee will be required.

Once filed, the regulations are examined. If found to be unacceptable, they may be revised until they are in a form acceptable to the Registrar. For ease of reference and clarity, the regulations should preferably consist of a standalone document providing the required information (see below). However, it is acceptable to annex further documents to them which can then be cross referenced.

### **3.3 Collective mark regulations**

#### **3.3.1 Status of the applicant**

##### Applicant must be an association

A collective mark distinguishes the goods and services of members of the association which is the proprietor of the mark from those of other undertakings (Section 49(1) of the Act). This means that an association with members should be the proprietor of the mark.

The term “association” is not defined in the Act. When considering whether an applicant qualifies as an association, the key factor to consider will be whether the claimed association has a form of membership and can point toward the normal indications present in any form of association with members, examples include payment of membership fees, issuing of membership card/numbers, membership meetings, conditions of membership. The fact that an association may be a Limited Company has no bearing on this matter; it is the manner of organisation and operation of the applicant that is important.

It is likely that any concerns the Registrar will have on this aspect will only surface when examining the content of the regulations. Any concerns the Registrar does have will be expressed to the applicant who will then be given an opportunity to provide information (and to amend their regulations) demonstrating that they do operate as an association with members.

##### Capacity to hold property rights

It should also be noted that, as with any trade mark, the applicant must have sufficient legal personality to hold it in their name. Unincorporated associations do not normally have the capacity to hold property rights (although partnerships do). The Registrar will not routinely question the property holding capacity of the applicant unless it is readily apparent from their name or from the content of the regulations that the association has no legal personality.

#### **3.3.2 Content of regulations**

The information that is required in the regulations is detailed in Schedule 1 paragraph 5 of the Act. The distinct pieces of information are:

##### The persons authorised to use the mark

Here the category of persons authorised to use the mark must be detailed. Is it simply every member of the applicant association or is it limited to certain sub-categories of membership? If there are any other requirements (save for the conditions of membership of the association) that a would-be authorised user must possess (e.g. a certain qualification) then these should also be detailed.

Previous practice has required that the regulations identify the exact persons who at any given time are authorised users. This will no longer be required. However, if the applicant wishes to make reference to the existence of a register of authorised users (and its location) then this may still be done under this heading.

### The conditions of membership of the association

Associations will normally have conditions of membership that must be met before a member can be admitted to it. For example, it may be a condition of membership that a person must have worked in the particular field for set period of time before being permitted to join. All the conditions of membership of the association must be detailed in order that would be users of the collective mark can clearly and objectively see what conditions they must fulfil before being allowed to join the association and to subsequently use the collective mark.

Similarly, if the collective mark is to be used to identify only certain members of the association, e.g. to identify a particular class of membership, the conditions that apply to these members should also be detailed.

### Conditions of use of the mark (if any exist)

Conditions of use, if any exist, relate to the manner in which the members of the association may use the collective mark. For example, if the collective mark may only be used on printed matter in a size not exceeding certain limits, then this, together with any other such conditions should be detailed.

Any clauses that are formulated to overcome an objection that the mark is misleading as to its significance should also be entered under this heading (see paragraph 3.2.2 for further information).

### Sanctions against misuse of the mark (if any exist)

If the association intends to impose any sanctions (such as expulsion from the association) against a member who misuses the mark then these should be detailed under this heading. Misuse of the mark would include using it in a manner that does not meet the conditions of use or using the mark when not permitted to do so.

### **3.4 Certification mark regulations**

#### **3.4.1 Status and competence of the applicant**

Unlike collective marks (the proprietor of which must be an association with members) there is no limitation on who can be a proprietor of a certification mark except that the applicant/proprietor must have a legal personality. However, certification marks are normally applied for by trade associations or other similar bodies who have an interest in monitoring and maintaining standards in their particular field.

It is important to note that the proprietor of the certification mark cannot be engaged in the supply of the goods being certified. The Registrar does not investigate the applicant's position in the market, but potential applicants should be wary that if this requirement is not met then the mark may be challenged by a third party through invalidity or revocation procedures. A *prima facie* objection will however be raised if the applicant for a certification mark is also the owner of an ordinary trade mark for the same goods and services as those being certified (see paragraph 2.4 above).

An additional requirement is that the applicant must be competent to certify the goods and services for which the mark is to be registered. If the Registrar is not satisfied on this point then the mark shall not be registered (Para 7 (1)(b) of Schedule 2 of the Act). If the applicant is an established trade body or Government Department then it is unlikely that the Registrar will raise any questions relating to their competency. Save for the aforementioned circumstances, the applicant will, as part of the examination process, be asked to provide information to clarify why they are competent to certify. There is no set manner of providing this information, but an explanation of the applicant's history in the particular field will often suffice.

#### **3.4.2 Content of regulations**

The required content of regulations governing the use of a certification mark is listed in Paragraph 6(2) of Schedule 2 of the Act. The information required is detailed below:

##### **Who is authorised to use the mark**

Most certification marks are available for use by any person whose goods or services demonstrate the relevant characteristic being certified. If this is the case then this should be stated. If, however, due to the nature of the goods/services being certified the mark is only available to certain types of person, for example only those with particular qualifications, then this should likewise be detailed. To illustrate this, if a certification mark is intended to certify a characteristic of a particular legal service, then the use of the mark may be limited to practising solicitors.

Previous practice has required that the regulations identify the exact persons who at any given time are authorised users. This will no longer be required. However, if the applicant wishes to make reference to the existence of a register of authorised users (and its location) then this may still be done under this heading.

### The characteristics to be certified by the mark

This is the key element of a certification mark. What is the specific characteristic of the goods or services that the proprietor is certifying as being present? The regulations should not simply list the goods and services being certified, they should explain what characteristic present in the goods and services is being certified. For example, if the proprietor is certifying that the goods (apples) are all the origin of a particular area (Normandy) then the characteristic being certified by the mark is:

“The characteristic being certified by the mark is that the goods in question, apples, are all the produce of Normandy, France.”

The aim of the regulations on this aspect is to provide a clear and objective statement that would allow anyone reading them to know precisely what characteristic is being certified.

### How the certifying body is to test those characteristics and supervise the use of the mark

Here, an explanation of how the proprietor will test the presence of the characteristic will be needed. Testing does not need to be carried out by the proprietor themselves, but if this is the case an explanation of who (and how) will carry out the testing on their behalf will be needed. An explanation should be given as to how the proprietor will subsequently supervise the use of the mark.

The aim of the regulations on this point is two-fold. Firstly, anyone wishing to use the certification mark will be able to see what testing regime they will be subject to; secondly, the Registrar, from a public interest point, needs to be satisfied that adequate testing takes place to ensure that the public can have confidence that the mark and its proprietor is truly carrying out a certification process.

### The fees, if any, to be paid in connection with the operation of the mark

The fees, if any, charged in connection with the scheme should be listed in the regulations or attached as an annex to them. This information not only allows would be users to have clear access to the fees information, but the Registrar, from a public interest point, can ensure that fees are not excessively high so as to prevent would be users from accessing the scheme.

There is no requirement that the certification scheme should be operated on a “not for profit” basis. The fees should however be proportionate to the nature of certification necessary, particularly where the holder’s mark is the *de facto* standard for the goods and services concerned.

### The procedures for resolving disputes

Disputes in this context normally means a dispute between the proprietor of the mark and an authorised user (or would be authorised user) regarding the proprietor’s decision not to allow use of the mark. It is important that an appeal mechanism against the proprietor’s decision is in place to ensure fairness and equality. Such a mechanism should allow an ultimate view on the matter to be taken by an independent person or body such as a specialist arbitrator or tribunal. Please note that the Registrar cannot fulfil this function in view of its statutory role in examining certification marks and their regulations.

## **4 POST REGISTRATION MATTERS**

### **4.1 Amendment of regulations**

Once a mark (and its regulations) have been accepted and published for opposition purposes, the proprietor may request that the regulations governing use of the mark be amended. Any such request must be accompanied by a Form TM36 together with the appropriate fee (currently £100).

It is important to note that the amendment will not be recorded automatically. The Registrar will firstly need to approve the amended regulations and will consequently examine them in the same way as newly filed regulations (see Paragraph 3 above). Amended regulations will have no effect unless approved by the Registrar – see Schedule 2 Paragraph 11 (certification marks) and Schedule 1 Paragraph 10 (collective marks).

Furthermore, if the Registrar considers it appropriate, the amended regulations will be published for opposition purposes. In practical terms, all but the most insignificant of amendments will be published as amendments could potentially affect the accessibility of current and prospective users to the mark. Publication is not required for minor amendments such as changing the applicant's address.

If publication is required a notice will be placed in the Trade Marks Journal stating that a request to amend the regulations has been proposed. Any third party may then request to inspect the amended regulations (via the Office's Information Centre on 0300 300 2000 or by e-mail at [information@ipo.gov.uk](mailto:information@ipo.gov.uk). ) and may oppose the proposed amendment during the three month opposition period. If an opposition is received then the opposition procedure outlined in Rule 17 of the Trade Mark Rules 2008 will be followed. If no opposition is received then the regulations will then become effective.

### **4.2 Assignment of registration**

Certification and collective marks may be assigned to a new owner in the same way as ordinary trade marks. However, Schedule 2 Paragraph 12 states, in respect of certification marks, that an assignment is not effective without the consent of the Registrar. This is to ensure that the new proprietor has the necessary competence to run the certification scheme; consequently, the assignee will need to meet the requirements as outlined in paragraph 3.4.1 before consent to the assignment will be given.

A change in ownership of either a collective or certification mark will also necessitate the amendment of the regulations. The amendments will need to reflect the new name of the proprietor together with any other amendments that may be required to reflect the new entity owning the mark e.g. amended conditions of membership etc. The request to amend should be made in the manner detailed in paragraph 4.1 above and should be filed at the same time as the request to record the assignment.

### **4.3 Invalidity of registration**

Section 47 of the Trade Marks Act provides that a mark may be declared invalid if it was registered in breach of Section 3 or 5 of the Act. This provision applies equally to collective and certification marks as it does to ordinary trade marks. However, collective and certification marks face further potential grounds for invalidity if the mark was registered in breach of:

- i) Schedule 2 Paragraph 4 – proprietor (certification marks only) carrying on a business in the kind of goods or services certified.
- ii) Schedule 2 Paragraph 5(1) & Schedule 1 Paragraph 4(1) – the public is liable to be misled as to the character or significance of the mark.
- iii) Schedule 2 Paragraph 7(1) & Schedule 1 Paragraph 6(1) – approval of regulations, i.e., that the regulations did not contain the required information, that they were against public policy or morality or, that (in relation to certification marks) the proprietor was not competent to certify the goods and services sought.

The procedure for filing an application for invalidity is detailed in Rule 41 of the Trade Marks Rules 2008 (as amended).

### **4.4 Revocation of registration**

Section 46 of the Act lists various grounds upon which a trade mark may be revoked. These grounds apply equally to certification and collective marks as they do to ordinary trade marks. However, certification and collective mark may be revoked on the additional grounds contained in Schedule 1 Paragraph 14 and Schedule 2 Paragraph 16; these can be summarised as:

- i) Schedule 2 Paragraph 4 (certification marks only) – that the proprietor of the mark has begun to carry on a business in the supply of the goods or services certified.
- ii) Schedule 2 Paragraph 5 (1) & Schedule 1 Paragraph 4(1) – that the manner in which the mark is used has caused it to become misleading as regards its character or significance.
- iii) That the proprietor has failed to observe or secure the observance of the regulations governing the use of the mark.
- iv) That an amendment has been made to the regulations so that they no longer comply with Schedule 2 Paragraph 6(2) (certification marks) or Schedule 1 Paragraph 5(2) (collective marks) relating to the content of the regulations governing use of the mark, or that the amended regulations are contrary to public policy or accepted principles of morality (certification marks).

- v) That the proprietor is no longer competent to certify the goods or services for which it is registered (certification marks).

It should also be noted that one of the basic grounds of revocation of any form of trade mark concerns whether a mark has been put to genuine use within the five year period following its registration (or any other five year period). It is important to note here that the use of a mark solely on goods and services that have been certified as possessing a particular characteristic is unlikely to count as use in relation to a specification in respect of the actual service of certification.

#### **4.5 Infringement of registration**

The proprietor of a collective or certification mark has the same rights to prevent an infringement of their mark as the proprietor of an ordinary trade mark does. Infringement proceedings in general are detailed in Section 10 of the Act. Authorised users of collective and certification marks are given particular powers to raise infringement proceedings in their own name (as opposed to relying on the proprietor of the mark to do so). More detailed information on this can be seen in Paragraph 11 of Schedule 1 (collective marks) and Paragraph 13 of Schedule 2 (certification marks).

#### **4.6 Merger of marks**

Nothing prevents the merging of either collective or certification marks. However, mergers cannot be entertained for marks performing different functions e.g. it is not possible to merge a collective mark with a certification mark or an ordinary trade mark.

## **Introduction**

### **Purpose of this Guide**

The purpose of this guide is to explain procedures for registering and processing marks under the International System, utilising [the Protocol to the Madrid Agreement](#). It also gives an overview of the Community Trade Mark (CTM) system and the role of the Intellectual Property Office in relation to CTM marks.

The guide indicates to examiners the procedures to follow when examining a mark filed under the international system. The registrability of a mark is determined in the same manner as for a mark filed under the national system applying the judgements and decisions from a variety of sources including, in particular the European Courts of Justice (ECJ), Court of First Instance (CFI), UK Courts and the Appointed Persons and is not covered in this guide. For further information on registrability issues please refer to [The Examination Guide](#).

### **Role of the UK Office**

The office is responsible for:

- Receiving, examining and processing through to the final outcome, international trade marks which designate the UK under the Protocol to the Madrid Agreement.
- Receiving, checking and certifying, forwarding and administering new international applications filed under the Madrid Protocol which are based on UK national trade marks.
- Updating our records to reflect changes to the details of international registrations, where those details are relevant to the UK.
- Receiving trade mark and/or design applications on behalf of the CTM office and forwarding the applications to Alicante, Spain. Certifying requests from trade mark and design practitioners for entry onto the CTM list of professional
- Providing information and advice to colleagues and customers regarding aspects of the international system.

## **The International Trade Mark (Madrid) System**

### **Background to the Madrid System**

[The Protocol to the Madrid Agreement](#) was introduced in 1989 with a view to generating new interest in international trade mark registration. The Agreement and the Protocol together form the „Madrid System’. The system is administered by the International Bureau at the World Intellectual Property Organisation (WIPO) which is based in Geneva, Switzerland.

The United Kingdom ratified the Protocol in December 1995 and it came into force on

1 April 1996. Holders of UK trade marks may use the system to gain protection for their marks in one or more member countries of the Protocol. Similarly, holders of marks in other Protocol member countries can use the system to apply for protection in the UK.

Reference in this section to „Article’ („Art.’) refers to the Article of the Protocol. Reference to „Rule’ refers to the Rules listed in the Common Regulations under the Madrid Agreement and the Protocol to that Agreement.

## **Basic Requirements for using the Madrid System**

### **Filing criteria**

The applicant must be able to meet one of the following three criteria to be eligible to file through the international system:

#### [Art. \(2\)\(1\)\(i\)](#)

- be a national of one of the Protocol member countries; or
- be domiciled in one of the Protocol member countries; or
- have a real and effective business or commercial establishment in one of the Protocol member countries. (The question whether a person has a real and effective commercial undertaking is determined under national law. In the UK we would not accept a PO Box or something that would suggest that a persons establishment is only temporary.)

### **Requires a UK application/registration**

To use the Protocol, applicants must also have a national trade mark application or registration in one of the Protocol member countries. This national mark will be used as the basis of the international application. The international application will cover the same trade mark and a list of goods and services identical **or no wider than** that of the basic (national) mark. The international application will designate one or more other Protocol member countries, these being countries where the applicant would like to protect his mark.

### **Through the Office of Origin**

The international application **must** be filed via the national trade mark office where the basic mark is held. This national office is referred to as the „Office of Origin’ the international application (see [Art. 3](#)).

The Office of Origin is required to certify that the international application falls within the scope of the basic mark, following the criteria described above. The application can then be passed to WIPO.

## WIPO formalities check

At WIPO a formalities check of the application will be carried out and the mark is translated into the three languages of the system, English, French and Spanish. The mark will then be registered and the details of the registration will be published in the [International Gazette](#). A copy of the Gazette advertisement will be forwarded to the national trade mark office in each of the member countries where the applicant of the mark seeks protection (see [Art. 5\(2\)](#)). Each country will examine the mark according to their national systems and must inform WIPO within a set time limit whether or not the mark may be protected in that country. Notifications of provisional refusal in designated contracting parties will be published in the International Gazette and also forwarded to the applicant for the mark.

## Advantage of the Madrid System

The advantage of using the Madrid system is that applicants may protect their trade marks in several countries simultaneously by means of a single international application filed at their own national trade mark office. For trade mark owners based in the UK, there is the added benefit that the international application may be completed in English which is one of the working languages of the system (the others being French and Spanish).

## UK as an Office of Origin Filing an international application

### [Art. 2\(2\)](#)

The UK Intellectual Property Office acts as „Office of Origin’ for international applications that are based on existing UK trade mark rights. The international application **must** be filed via the Intellectual Property Office in order so that we can perform the certification checks required by Article 3 of the Protocol.

## The application form

### [Art. 3\(1\)](#)

International applications must be made on the official form [MM2](#), which can be downloaded from the WIPO website. The form **must** be completed in typescript. An original representation of the mark must be placed in the box on the form. If the mark is to be applied for in colour, or colour is to be claimed as one of the essential features of the mark, then a colour representation should be attached. Representations of the mark must be no larger than 8 cm by 8 cm and must be placed in the box on the form. It is not acceptable to attach representations of the mark to the back of the application form.

If the European Community is designated and the applicant can claim seniority from a prior registration within the Community, then a form [MM17](#) must be completed.

If the United States of America is included amongst the designations, form [MM18](#) must be filed at the same time as the application form. This is the „declaration of intention to use’ the mark in the USA and is a legal requirement. If the form is not filed with the application, an irregularity will be raised and this could lead to delay in the processing of the application.

The Intellectual Property Office only handle the MM17 and MM18 forms when filed with the form MM2. If the forms are not filed with the MM2 the applicant will need to send these forms to WIPO directly.

The application form must be sent to the Intellectual Property Office, together with a handling fee sheet ([Form FS4](#)) and handling fee. New international applications are received by Finance Section, who allocates a filing date. The international application is then sent to the Trademarks International Section to process the application..

### **Filing date**

#### [Art. 3\(4\)](#)

The Office of Origin is responsible for certifying, amongst other things, the filing date of the application. Applications must be passed to WIPO within two months if they are to retain the date of filing at the national office as the official filing date. If problems are encountered and the Office of Origin is unable to certify the case and forward it within the two month deadline, then the case will be given the date on which WIPO receives the application as its filing date.

The filing date will, on registration of the mark, become the international registration date. Rights acquired by protection of the mark will run from this date.

### **Certification by UK Office**

#### [Art. 3](#)

One of the criteria for using the system is that the applicant must hold trade mark rights, either as an application or a registration, in one of the member countries of the system. The international application will be based on these national rights. The certification procedure is to ensure that each international application meets this criterion.

[Article 3 of the Protocol](#) states:

*The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be.*

#### [Rule 9\(4\)/9\(5\)](#)

The particulars that should, or may, appear in an international application are listed in Rule 9. The certification process may be summarised as a check that:

- **the same applicant**, should be applying for
- **the same mark**, (in all aspects!) in respect of
- **the same or no wider goods and services** than are covered by the basic mark.

There is no provision under the Madrid system to register a series of marks. If an international application is to be based on a UK series mark, then the applicant will be asked to choose one of the marks in the series to act as the basis for his international mark. The chosen mark will be the mark which is registered internationally. If an applicant wishes to register all the marks in his UK series internationally, he must file a separate application for each one.

Similarly, if an international application is to be based on a mark where colour has been claimed, then the international mark must be in colour. As indicated above, the rights in the international application must be the same as or no wider than those of the basic mark.

**The certification check is not an examination of the application or of its acceptability.** This check is simply to ensure that the applicant meets the entitlement criteria and has a mark in one of the member countries of the Madrid system. The certification check **does** ensure that the application form contains all the information necessary for the case to be given a filing date. If information is missing we cannot forward the case to WIPO.

If for any reason the application does not meet the criteria for filing, we will contact the applicant or his representative and explain the problem. In cases where the applicant is seeking to protect a list of goods or services which is wider than that of his basic mark, we will confirm that the international application exceeds the scope of the basic mark(see [Art. 3\(4\)](#)). Any problem with the application prevents the certification of the case and, if the applicant is not to lose his filing date, must be resolved within the two month deadline for passing the case to WIPO.

When everything is in order and the case has been certified, we will forward the application electronically to WIPO.

### **Formalities Checks taken at WIPO**

The International Bureau of WIPO is a paperless office. All documents received by the office are scanned into their electronic system and assigned an internal working number. Figurative marks are scanned separately using a colour scanner.

#### [Rule 9\(5\)/9\(6\)](#)

New applications receive a formalities examination. WIPO checks that all filing requirements have been complied with, that the classification of the goods and services listed on the application form is correct and that all appropriate fees have been paid.

**This is not a check as to the validity or acceptability of the mark** but simply a formalities check.

### **Irregularities**

#### [Rules 11-13](#)

If WIPO finds irregularities in an application, both the applicant, or their representative, and the Office of Origin of the mark will be contacted. WIPO will highlight the problem and set a three month deadline for response. **This deadline cannot be extended.**

[Rules 11, 12 and 13](#) of the Common Regulations cover fees and filing deficiencies, classification and vague terminology respectively. Fee irregularities may be dealt with directly by the applicant.

## **Additional Class Fees**

If the irregularity related to a reclassification of certain goods and services, WIPO may insist upon adopting their own proposal for reclassification of those goods and services and may require additional fees. If an irregularity is not responded to within the time allowed or if the additional fees are not paid, the international application will simply be abandoned. For irregularities relating to vague wording, WIPO will publish the wording but with a proviso that they consider the wording to be too vague for classification purposes. It is then left to individual designated contracting parties to object to the wording.

## **Non-extendable Time Limits**

The time limit given for responding to letters of irregularity is non-extendable. It is therefore imperative that applicants or their representatives respond to us in good time so that we can send these responses to WIPO before the deadline

## **Reply through the Office of Origin**

If the irregularity may only be put right by changing the content of the application, then the irregularity letter **must** be responded to by the Office of Origin. Responses sent directly from the applicant or their representative to WIPO will be disregarded even if they contain a clear response to the irregularity raised. This is because such responses do not comply with [Rule 11](#). It should be remembered that international applications are based on national trade marks. It is the job of the Office of Origin to ensure that any amendments to international applications are within the scope of the basic mark.

## **Registration**

Once the formalities check is complete, the application will be registered and assigned an international registration number. It will be published in the [International Gazette](#). A certificate of registration will be sent to the holder. At this point the mark has achieved registration but is not yet „protected’ in any of the designated contracting parties.

A copy of the Gazette publication of the mark will be sent to each of the countries where the holder requested protection. Each country will then examine the mark **according to the national system in that country** and will notify WIPO whether or not the mark may be protected in that country. Details of this procedure can be found on WIPO’s website.

## **Post-Registration Matters**

### **Ceasing of effect and cancellation**

#### [Ceasing of Effect during dependency period](#)

If a basic mark is cancelled, refused, successfully opposed, withdrawn, or the rights cease for other reasons, then WIPO must be informed. We will send a letter to WIPO

giving details of the extent (total or partial) to which the basic mark has ceased to be valid. This letter may also request WIPO to cancel the international mark either in part or in totality. As previously noted, an international registration is based on a national trade mark for a period of five years. It may not be wider in scope than the mark upon which it is based. Hence, if the basic mark narrows in scope or ceases to be valid, then this must be reflected by the international registration.

We will write to WIPO who will then inform all interested parties of any change in the scope of the international mark or of the cancellation of the mark. This information is also published in the [International Gazette](#).

In the UK, national marks which are the basis of an international application are flagged on UKTM which alerts us of any changes to the basic mark and the need to review the matter and inform WIPO of any changes necessary to the international registration.

### **Central attack**

If anyone wishes to attack an international registration, this may be done in two ways:

- they may oppose individual designations in individual member countries, by following the national opposition or invalidation procedures of that country; or
- if the mark is still within its five year dependency period, it may be possible to attack the basic mark.

If the attack is successful, the basic mark will die and the entire international application, in all designated contracting parties, will have to be cancelled. Thus by attacking the base on which the international registration relies; it is possible to completely topple the international trade mark rights.

### **Dependency**

#### [Art. 6\(3\)/\(4\)](#)

Each international application is, as noted above, based on one or more trade mark applications or registrations in the country of origin of the application. It is the duty of the Office of Origin to monitor these marks for a period of five years from the date of the international registration. Any „ceasing of effect’ of the basic mark, whether it is total or partial, will have an effect on the international registration. The Office of Origin is responsible for notifying WIPO of changes to the basic mark during this five year period. If the international application is based on an UK application which never reaches registration, then the international case will be cancelled. It is possible that an international application may become registered before the national application upon which it is based. Even so, if the basic application is refused or cancelled for any reason, the international application will also be cancelled.

Other changes to the status of the basic application or registration which will affect the international application include successful opposition of the basic application or rectification or invalidation of the basic registration.

[Article 6\(2\)](#) states that the international registration is dependent on the basic mark for a period of 5 years from the international registration date. Actions taken on the basic mark after this date will not affect the international mark unless action resulting in changes to the basic mark was begun before the five years expired.

## Renewal

### [Art. 7](#)

An international mark is valid for a period of ten years from the date of registration (see [Art. 7\(3\)](#)). WIPO will send an unofficial reminder to the holder of the international mark approximately six months before the mark is due for renewal. This reminder will also be copied to the holder's representative in the country of origin of the mark, together with a copy of the renewal form. Renewals should be sent directly to WIPO,

A request to renew an international registration may be sent to WIPO up to six months before the renewal date. However, holders should be aware that if they file a request for renewal more than three months in advance of the renewal date and the fees are changed before the renewal date, they will be expected to pay the new fee.

Requests for renewal may be filed in the form of a letter or by using the official renewal form [MM11](#), which can be printed from the WIPO website. It is important to ensure that WIPO receives the renewal fee before the due date. A request for renewal cannot be actioned without the necessary fee.

It is possible to renew international trade marks for six months after the expiry of the registration. However, if renewal requests are filed in this six month „grace period' a surcharge will be added to the renewal fee.

## Replacement

### [Art. 4bis](#)

An international registration may replace an existing national registration in any designated contracting party. To be eligible to replace a national mark, the international designation must:

- be in respect of the same mark;
- be held by the same holder;
- cover all the goods and services covered by the existing national mark.

The international designation must also have been granted protection in the relevant country (see [Art.4\(bis\)\(2\)](#)). Replacement is deemed to happen automatically if the above criteria are met. However, it is only recorded by a particular country if a request to record is made. Holders of international marks which have designated the UK who wish these designations to be recorded as replacing their existing national rights in this country, must ask us to record this fact by filing form [TM28](#). We will examine the request to check that it meets all the relevant criteria as defined above and we will include these details on UKTM and MPS, indicating its link with the international case. When the national mark is due for renewal the holder may then choose to let his national

registration lapse. His trade mark rights will continue embodied in the international registration.

### **Subsequent Designation**

#### [Art. 3ter](#)

At any time **after registration** the holder of an international mark may apply to add to the list of countries where his mark is protected. Such „territorial extension’ of an international trade mark is referred to as „subsequent designation’.

#### [Rule 24\(1\)\(a\)/Rule 24\(2\)\(b\)](#)

The holder of the international mark can file a subsequent designation - complying with the criteria laid down in [Article 2 of the Protocol](#) - using the official form [MM4](#), which can be printed from the WIPO website. The form must be filed directly to WIPO.

#### [Art. 3ter\(2\)](#)

WIPO examine the application for subsequent designation. Irregularities will be brought to the attention of the holder of the mark. A non-extendable three month deadline for response is set. Once the formalities check is complete, the subsequent designation will be registered and the details published in the [International Gazette](#). Details of the designation will be passed to each of the newly designated contracting parties. The mark will be examined in each new country and WIPO will be notified whether the subsequent designation can or cannot be protected in that country. The rights in each new country will run from the date of the subsequent designation.

A subsequent designation is not a separate international mark. It is simply a means to add countries to an existing international registration. The international mark must be registered if a subsequent designation is to be made.

The protection gained in the new countries will only run until the international registration is due for renewal. If the subsequent designation is filed nine-and-a-half years into the ten year life cycle of the international mark, the mark will only be protected for six months in the new countries. For this reason, most subsequent designations are made shortly after the registration or shortly after the renewal of the international mark.

### **UK as a Designated Contracting Party**

In the same way that holders of UK Trade Marks may use their national mark as a basis for an international registration seeking protection in other member countries of the Protocol, so holders of marks in other Protocol member countries may use their national rights as a basis of an international registration designating the UK.

[Article 3\(4\)](#) and [Rule 14](#) of the Common regulations states that once an international mark is registered:

*The International Bureau shall notify the international registration without delay to the Offices concerned.*

## **Receipt of Designations**

We receive notification from WIPO on a weekly basis of new international marks seeking protection in the UK. The information is received in electronic format via our electronic filing system, MPS.

We are required to inform WIPO within 18 months of the notification date whether each mark can be protected in the UK. We issue a provisional decision to WIPO at examination stage if objections are raised against the mark and follow this up with a final decision once all proceedings before this office, including any appeals to the courts, have been completed. WIPO forward all letters from us relating to the international designation to the holder, or their representative, of the mark.

## **Examination of designations at the UK Office**

International designations under the Madrid Protocol are examined under the [Trade Marks Act 1994](#) in exactly the same way as national applications. Examination procedures are described in [The Examination Guide](#). New international designations are examined to ensure they comply with the Act, and searches of the UK Trade Mark Register are carried out to check for earlier rights.

The nature of the Madrid system is different from that of our own national registration system. Two main differences become evident when administering the system:

- the status of international trade marks in the UK; and
- the communication chain between the Intellectual Property Office and the holder of the mark.

## **Status of international trade marks**

International designations are already „registered’ status when we receive them, having been placed onto the International Register prior to publication. This means that in practice:

- there are limitations on what action may be taken on the case; and
- the vocabulary, when working with international marks, differs from that associated with domestic applications.

## **Limitations on action**

The limitations when dealing with an international designation fall into two categories:

- issues relating to formalities of trade mark examination;
- issues relating to the communication of information.

## **Issues relating to formality checking of designations**

[The Trade Marks \(International registration\) Order 2008](#) specifically excludes international designations from the parts of the Act which relate to examination of formalities. Examination of international designations does not include a check that filing requirements are met or that the representation of the mark and the classification of goods and services are acceptable. These aspects have already been checked and the mark has been found to be acceptable for international registration before it is sent to the UK.

### **Issues relating to the communication of information**

International examiners may not always communicate directly with the holder of the international designation, but must pass certain information through WIPO. Under the Madrid system, national offices must inform WIPO of any action that may affect the scope of protection of a mark within that country. WIPO pass this information to the holder or his representative as well as to all other countries involved with the mark. The information is also published in the International Gazette.

### **Vocabulary used in respect of international marks**

When international designations reach the UK they are already „registered’ status. It is therefore necessary to adopt a new vocabulary when dealing with international designations. A [glossary of terms](#) used in relation to international trade marks is at the back of this guide.

### **The Examination Procedure**

International designations to the UK are subjected to the same examination procedure as new national applications. They are tested under [Section 3 of the Trade Marks Act 1994](#) and searches are carried out to identify any earlier rights that are thought to be similar to the designation ([Section 5 of the Trade Marks Act 1994](#)). Examiners carry out examination of international marks using ACSEPTO and MPS systems, which records all findings.

### **Important Differences**

An important difference between the international and domestic examination procedures is that international examiners do not send a „report’ of the examination directly to the holder of the designation (see [Art. 5](#)) where a substantive objection under [Section 3](#) is raised. If objections are found, a letter of provisional refusal is sent to WIPO. This will then be forwarded to the holder by the International Bureau once the Bureau has recorded the information on the international register.

Where examination of the designation finds only earlier rights issues, information regarding any conflicting earlier rights is sent directly to the representative before WIPO, or if there is not one recorded, to the holder.

### **Possible outcomes of examination**

Examination of international designations has four possible outcomes:

- **acceptance** of the mark for all goods and services; or
- **provisional total refusal** of the mark, i.e. refusal of the mark for all goods and services; or
- **provisional partial refusal** of the mark, i.e. objections are raised in respect of some but not all of the goods and services listed on the application, or
- **information regarding earlier rights**, i.e. earlier rights have been identified which conflict with the mark for some or all of the goods/services of the designation

Whilst the examination process mirrors closely that for domestic applications, there are certain differences in administration which are necessary simply because International Section are dealing with trade marks which have already been registered. These differences are detailed below.

### **Acceptance of designations**

If an international designation is found to be acceptable at examination stage, then the case will be forwarded directly for advertisement in the Online UK Trade Marks Journal. There is no requirement to notify WIPO regarding the case at this point. The holder/representative before WIPO will be notified of the publication of the International Registration

International designations are published in the [Trade Marks Journal](#) and the marks are open to opposition in the same way as national marks.

### **Administrative Differences in examination procedure**

#### **Collective/Certification/Guarantee marks**

International applications may be filed as a collective, certification or guarantee mark. The international application form does not distinguish between the types of mark and we will receive notification of the designation with the statement reading: „collective/certification/guarantee’ mark.

Designations for collective/certification/guarantee marks are examined in the same manner as international trade mark designations. However, in **all** cases it will be necessary to raise a ‘**provisional total refusal of protection**’ for the case to be sent to WIPO. The reason for this is that for UK examination purposes, we can only accept marks as either a collective or certification mark. We do not accept guarantee marks. Therefore the holder needs to specify the type of protection applied for and they should therefore be requested to confirm this. It is also a requirement of [Schedules 1 and 2 of the Trade Marks Act](#) that a copy of the regulations governing use of the collective or certification marks are filed. The letter will request filing of form [TM35](#) and fee together with the filing of the regulations.

Any other objections raised against the mark, such as Section 3(1)(b) or (c) objections or earlier rights, must be dealt with before the international file is examined under Schedule 1 or 2 of the Trade Marks Act 1994.

### **Priority claims**

A claim to International Convention priority appears as a simple statement on the notification of a new international designation. The date should be checked and if this is within six months of the filing date, the claim to priority may be accepted.

The rapid processing of domestic applications may lead to a circumstance where a domestic mark, with a later filing date, has already proceeded to advertisement and even to registration before the receipt of an international designation, which has an earlier priority date.

When a conflicting domestic mark with later filing date is discovered in the course of searching for earlier rights, then the status of this mark should be considered. If it has not yet proceeded to advertisement, then the domestic examiner should be informed in order that the international mark may be raised as a late notification of an earlier right. If the domestic case has already been advertised or registered, then no action can be taken against it. The international designation, having earlier rights through priority or filing date, may also proceed.

### **Publication of descriptions**

Descriptions filed by applicants will appear in the Trade Marks Journal advertisement for the case.

### **Section 3(1)(a)**

WIPO examine and register representations of marks and hence there should be no reason to object to a representation of a mark. However, there are times when an objection under Section 3(1)(a) of the Act is unavoidable. It may be that it is not possible to examine the mark from the representation provided. This may be, for example, because the holder claims that the mark is three-dimensional but it is not possible to ascertain this from the representation, or the mark may consist of a graphic representation and a description but the description does not match the representation provided

### **Specifications listing 'retail services'**

[The Trade Marks \(International registration\) Order 2008](#) excludes international designations from the provisions of [Section 34 of the Trade Marks Act 1994](#). Hence, it is not possible to raise the same objections to the wording of specifications listing [„retail services’](#) as are raised by domestic examination units.

International designations which include a reference to [„retail services”](#) or other wording which indicates retail services will be subject to objection under Section 1(1) and Section 3(1)(a) of the Act „...because such claims do not clearly identify „services’ within the meaning of Section 1 (1)’. Holders will be given the option to overcome the objection by „defining their area of interest more precisely’.

The objection may be overcome by adopting the wording for definition of retail services which is given in the Class 35 heading of the Nice Classification Index, together with a statement of the manner of providing the service and the goods of interest, for example:

Retail services connected with [indicate goods or type of services]

Retail services connected with the sale of [indicate goods or type of services]

Mail order retail services connected with [indicate goods or type of services]

The bringing together, for the benefit of others, of a variety [indicate goods or type of services] enabling customers to conveniently view and purchase those goods.

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a clothing and accessories catalogue by mail order or by means of telecommunications.

Further guidance on this issue can be obtained by consulting Classification Section at the Trade Marks Registry.

### **Three-dimensional marks**

If a mark claims three dimensions, then it must be clear from the representation what those dimensions are. If the three dimensions are not clear, the mark will be open to objection under Section 3(1)(a), as described above.

There are no hard and fast rules as to how many representations of a mark are necessary to establish three dimensions. This will depend on the mark. WIPO’S requirement that the international mark must be fitted into a box 8cm x 8cm on the application form should also be remembered. This requirement may restrict the number of representations of a mark that a holder can provide.

### **UK Clauses**

International designations may include any amount of information relating to the mark. Clauses include descriptions of the mark or three dimensional claims. If the written information does not match the representation given, then the mark will be open to objection under [Section 1 \(1\) and 3\(1\)\(a\) of the Act](#). For example, a clause may indicate that colour A is claimed, but the representation of the mark shows it in colour B.

Similarly, in cases where three dimensions are claimed but the representation only shows two dimensions, it may be necessary to raise an objection.

### **Vague terms in specifications**

Generally, these should be left. The term has already been accepted by WIPO. However, it may be that a term gives us absolutely no idea what the goods or services being described actually are, to the extent that it is not possible to examine the case in respect of those goods/services.

[Rule 13](#) of the Common Regulations allows WIPO to object to vague terms in specifications. This objection will be raised prior to the registration of the international mark and a time limit for clarification will be set. However, if the holder does not clarify the term within the time allowed [Rule 13\(2\)\(b\)](#) will apply. This states that if the Office of Origin has classified the term then WIPO will include it in the international registration, albeit with an indication that the term is considered too vague. Thus, we may receive designations with the phrase „terms considered too vague by the International Bureau ([Rule 13 \(2\)\(b\)](#))’ appearing in one or more specifications of goods or services.

Where WIPO have objected to the term and we also consider it to be too vague we will query it. The query should be raised under the heading ‚Specification’ and should state that ‚...the following term is considered too vague for the purposes of examination.... Please clarify this term’. If no other objections have been raised then a partial refusal may be offered, deleting the objectionable term and allowing publication of the acceptable terms within the specification.

### **Wrongly classified terms in specifications**

On occasions, it may appear that a term listed in the specification of goods or services for an international designation has been wrongly classified. Classification of international trade marks is checked at WIPO prior to the international registration of the mark. The classification has been accepted and should not be queried post-registration except on the rare occasion when there has been a mis-translation from the original French or Spanish list. Occasionally, where goods and services appear to have been wrongly classified, investigation may reveal that the queried term has in fact been mis-translated. The language of the original international application can be found on the paper that notifies us of the new designation. French or Spanish versions of specifications can be found on [Madrid express](#). If a mis-translation is spotted, a brief telephone call to the International Bureau is sufficient to arrange a correction of the translation in order that the queried terms are accurately represented in English and in the correct class.

### **Conflicting Earlier Rights**

Where the designation is found to be acceptable under Section 3 and no issues are

identified in relation to the specification, but a search of the ACSEPTO has identified earlier conflicting marks, then the holder will be informed of the conflicting marks. As earlier marks are not an official objection and are provided for information, but do not prevent the designation from proceeding to advertisement, under the rule of the Protocol it is not necessary to inform WIPO. (see also [Notifications in Examination guide](#)).

Information regarding earlier marks is sent directly to the holder, or their representative. Any amendments to the specification submitted to avoid the need to notify earlier mark, **must** be filed on form MM6 and sent direct to WIPO. The holder is requested to confirm they have filed the MM6 with WIPO. We will then suspend the designation to await confirmation from WIPO that they have restricted the designation.

### **Corrections received from WIPO**

Under [Rule 28](#) of the Common Regulations, where the International Bureau of WIPO considers that there is an error in the information recorded on the register, it will correct that information. Corrections may be initiated by the holder of the mark, by a national office or by the International Bureau itself. They may be corrections to any part of the information originally provided and may widen the scope of the specifications originally filed or even change the mark ([see Rule 28\(3\)](#)). However, requests by national offices to correct the international register must be made within nine months of the date of publication of the relevant information. The 18-month time limit, within which we are required to issue any refusal of protection for a case, starts from the date on which we are notified of the correction.

Corrections which limit the scope of a mark can be actioned. However, if a correction makes the case wider or changes the mark from that originally received, then the case will need to be re-examined in respect of the corrected information. If new goods or services appear in a correction then the case will be re-examined for those goods/services.

If the correction relates to a change in the substance of the mark itself, then it will be necessary to halt the progress of the original case and restart the examination procedure with the new mark. In such cases the date on which we are notified of the correction will become the new protection date for the case. If the case has already been advertised and the mark is changed, then it will be necessary to withdraw the advertisement, so that the case can be re-examined and re-advertised in respect of the amended mark. It is important to note that in these circumstances the 18-month period commences from the date of sending the notification of correction to the Registry.

It may be that a notice to correct a mark is received after that mark has been protected in the UK. Corrections that widen the coverage of the protected mark will be considered and treated as a subsequent designation. Any rights in the additional goods will derive from the date of notification of the correction.

### **Irregularity letters in respect of Examination issues from WIPO**

[Rule 18](#)

In order for WIPO to accept letters refusing protection of a mark, these letters must contain certain information as listed in [Rule 17](#). If our refusal letters do not comply with Rule 17, WIPO will send us a letter of irregularity pointing out the error. WIPO will send the holder our refusal letter and a letter explaining that they consider our refusal to be irregular and that if the irregularity is not corrected within two months then they will not regard our refusal to protect the mark as valid. Thus, the holder of the mark need do nothing about our refusal until they see whether the irregularity is to be corrected.

It is the responsibility of the examiner dealing with the case to correct the irregularity. The refusal letter is re-issued ensuring that the missing information is included. **The re-drafted letter should include a statement to say that it is issued in response to an irregularity letter and that it totally replaces the earlier refusal letter. The examiner should set a new reply by date.**

An irregularity should be corrected within two months. A deadline for receipt of the correction is normally given in the WIPO letter. However, irregularity letters must be dealt with as a matter of priority in order to ensure that all deadlines are met.

### **Provisional Refusal of Protection**

#### [Art. 5\(1\)](#)

If examination of an international designation produces objections under absolute grounds, then that mark will be **provisionally** refused protection in the UK (see [Rule 17](#)). This refusal of protection must be communicated to WIPO. The refusal letter must contain certain information. In particular, paragraph (2) (vi) of [Rule 17](#) states that if the refusal does not cover all goods/services, then the letter should indicate which goods/services are or are not affected by the refusal.

### **Provisional Total Refusal**

A total refusal of protection may be raised under absolute grounds. The mark itself may be open to objection under [Section 3 of the Act](#) for all goods/services listed in the application. A letter is sent to WIPO to explain that the mark is provisionally being refused protection. This is headed with the words „Provisional Total Refusal’ states in the first paragraph that the refusal is for all goods and services. The letter details the grounds for refusal of protection of the mark and may include information regarding any earlier rights that are deemed to conflict with the designation.

WIPO records the information contained in the letter and then forwards it to the holder of the international mark or to his representative. The holder of the mark can make representations, within the time limit set by the designated office, against the provisional refusal of protection.

### **Provisional Partial Refusal**

This refusal may also be raised on absolute grounds. The difference is that the objections raised will not be for all goods and services. There will be some goods or

services for which the mark may be accepted. This will occur, for example, if an objection is raised against one class of a multi-class designation. The case may be protected for the classes of goods or services not affected by the objection. As above, it is made clear in the letter which International Section despatch to WIPO that the designation is only being refused protection in respect of certain classes. The letter will be headed „Provisional Partial Refusal’. Again the letter will detail the grounds and the relevant Class where refusal of protection of the mark is raised. It may also include details of any earlier rights that are deemed to be in conflict with the designation. A deadline for response is given, to allow the holder to make representations against the partial refusal of protection, if he so wishes. The letter will be sent to WIPO in order that the information it contains may be recorded in the International register. WIPO will then forward the letter on to the holder of the mark or his representative. An International registration may not be divided to overcome objections in the same way as national marks.

### **Time limits for raising objections by the UK Office**

#### [Art. 5\(2\)](#)

Any member country of the Protocol has the right to refuse to protect an international mark within its territory. However, this refusal must be received by WIPO within a given time limit. For the United Kingdom, this time limit is 18 months from the date on which WIPO notified the UK of the new designation. A refusal letter may be reissued, for example, to correct an irregularity, provided that the case is still within the 18 month time limit.

Objections raised against a mark can of course be resolved through correspondence. However this takes time and may take an international designation beyond its 18 month time limit.

An opposition is a reason for total refusal of a case and a new provisional refusal letter must therefore be sent to WIPO. If this is sent after the 18-month deadline, it will not be accepted unless WIPO has been informed before the 18-month deadline that there is a possibility that late oppositions may be filed.

#### [Art. 5\(2\)\(c\)\(i\)](#)

Article 5(2) requires that in cases where an outcome will not be finally resolved within the 18 month period allowed, WIPO is informed **before** the end of the 18 months that it is possible that oppositions will be filed against the case **after** the 18 months. [Rule 16\(1\)\(b\)](#) requires that WIPO is informed of the start and finish dates of the opposition period, as soon as these are known. Thus, as soon as it becomes clear that a case is not going to be finally resolved before the end of the 18 month period, WIPO is informed of the possibility of late oppositions. This is done automatically with a computer-generated letter. Correspondence rounds may then be continued and the objections resolved, without fear of incurring problems with WIPO at a later date.

### **Post Examination**

#### **Possible action following a provisional refusal.**

The holder of an international designation that is provisionally refused protection in the UK may choose to make representations against that refusal. Representations may take the form of:

- written submissions from representatives;
- request for more time;
- filing of evidence of use of the mark in the UK
- request for a hearing.

A hearing to discuss the case may be held before a senior officer at the Trade Marks Registry by telephone, video conference link or face to face; the former two options are preferred by the Registrar.

Where problems are small and a simple agreement to a proposal will allow the case to proceed, the holder may write directly to the examiner dealing with the case. However, an address for service in the EC, Channel Islands or the European Economic Area (EEA) is required.

### **Appointing an EU, Channel Islands or EEA based representative**

To appoint a representative, complete a form [TM33](#) with the relevant details. A copy of the form may be downloaded from our website. Once form TM33 has been completed and forwarded to the office, the representative's details will be updated.

It should be remembered that **the UK representative can be different to the representative acting before WIPO** in respect of the case. The UK representative will be responsible for all action carried out on the case before the Intellectual Property Office.

This includes responses to correspondence, attendance at hearings and requests for extensions to time deadlines. However, requests to change the substance of an international registration, such as changes to the holder's details or limitations to the goods or services, must be filed via WIPO. It may be necessary for the holder of the mark or his representative before WIPO to file the official forms requesting these changes.

### **Appeal Period for response to the provisional refusal**

A letter provisionally refusing protection of an international mark in the UK usually carries a two month period for response in respect of an absolute grounds objection. If the holder of the mark wishes to appeal against the refusal he must ensure that he contacts the Intellectual Property Office by the date given for response. If nothing has been heard from the holder by the deadline, then the case must be allowed to continue to its outcome.

## **Failure to respond**

If the holder does not respond within the set time period, there are two possible ways forward at this point.

## **Proceeds in respect of some of the Goods/Services**

### [Rule 17\(2\)\(vi\)](#)

If a Provisional Partial Refusal letter was issued at examination stage, this will have listed those goods and services for which the mark could be accepted. If nothing is heard by the deadline for response, cases subject to provisional partial provisional refusal will be advertised in respect of those goods and services not affected by the provisional refusal.

## **Refused in respect of all goods/services**

### [Rule 17\(5\) \(a\) \(i\)](#)

If a provisional total refusal letter was issued at examination stage and nothing further is heard, then the refusal will become final.

## **Final Refusal of the designation in the UK**

### [Rule 17\(5\) \(a\) \(i\)](#)

Total final refusal of a designation occurs in two circumstances: either there has been no response to original provisional total refusal, or there has been an exchange of correspondence and possibly a hearing, but the objections raised have been maintained.

If a form [TM33](#) has been filed and a representative has been appointed, a refusal letter will be issued providing one month for the filing of Form [TM5](#). If no [TM5](#) is filed the provisional refusal of protection issued at examination stage will become final.

If the provisional refusal is appealed by filing form [TM5](#), a statement of grounds will be issued. A month is allowed for receipt of any further appeal. If an appeal against the statement of grounds is lodged, either to the Appointed Person or to the courts, then when a final decision is reached the provisional refusal of protection issued at examination stage will become final.

WIPO are then informed of the final refusal of protection for the case. The letter refers back to the original refusal of protection and confirms that the decision is now final, for all goods and services. The letter is sent to WIPO, who record the decision and publish it in the [International Gazette](#). WIPO forward the letter to the holder of the mark.

## **Publication of acceptable marks**

Every international designation that is accepted in the UK is published in the Trade Marks Journal and is open to opposition, in exactly the same way as domestic applications. Anyone may file observations or oppose an international mark within the

set opposition period, in the same way as for national marks.

## **Observations**

[The Trade Marks \(International registration\) Order 2008](#) allows for written observations to be sent to the registrar, about whether a mark should or should not be protected in the UK. Observations may also be sent about international designations. Observations can only be filed on absolute grounds. Any observations on international marks will be considered in the same manner as observations against domestic marks, that is, they should bring to the notice of the registrar new information regarding, for example, a descriptive or generic meaning of a mark. Observers will need to provide evidence in support of their comments. Observations on earlier rights will not be considered as an observation and will need to be addressed via the opposition or revocation route.

Observations will be duly considered and if we feel that the designation has been accepted in error, then the holder must be informed and given an opportunity to respond. If the designation is to be allowed to proceed despite the observations, the holder must nevertheless be informed of the observations. Correspondence regarding observations will always be directly between the Intellectual Property Office and the holder of the mark or his representative. It is not necessary to involve WIPO in such matters.

## **Oppositions**

International designations are opposed in exactly the same way as national marks, that is, by filing [form TM7](#), together with a statement of grounds of opposition and a fee.

WIPO must be informed of oppositions since an opposition is a reason for provisional refusal of protection of a designation.

It is important that WIPO is provided with all information about the opposition. A copy of the form TM7, including details of any marks referred to in the statement of case, is therefore attached to the letter informing WIPO of the provisional refusal of protection of the mark.

In cases where it has taken longer than the prescribed 18 months to process the case, we are also required to tell WIPO the start and finish dates of the opposition period [Rule 16\(1\)](#). In such cases, the refusal letter to WIPO will be accompanied by a separate letter providing this information.

In the UK notices of opposition are „served’ upon the applicant for a mark and the two month period allowed for filing of a counterstatement begins on the date of serving the papers. Oppositions are time-critical and provisional refusals of protection based on opposition are therefore faxed to WIPO in order that they can be forwarded to the holder as quickly as possible.

The IPO sends a copy of the international opposition papers to holder, or their address for service in the EEA (if applicable). This copy is sent in addition to the formal notification issued to WIPO.

Opposition to an international designation is equivalent to opposition to a national application. Because oppositions are filed under the Trade Marks Act 1994, these are dealt with by Tribunal Section and not by International Section.

## **Protection**

When the opposition period has expired and no opposition has been received, or when any filed opposition are not successful or are resolved in the favour of the holder, an international designation will gain „protected’ status in the United Kingdom. [Section 3 \(2\) of the International Order 2008](#) states that:

*..... a protected international trade mark (UK) shall be treated as if it were a trade mark registered under the Act and the holder shall have the same rights and remedies but shall be subject to the same conditions as the proprietor of a registered trade mark*

If no opposition has been received, we regard protection to have been achieved the day after the end of the opposition period for the case. This date is important for non use revocation purposes as the 5 year period for non use begins from the date of protection in the UK. However, the rights of the trade mark will date from the international registration date in the same way that the rights of a UK registration date from the filing of the UK application.

It should be noted that **no registration certificate is issued** with regard to international designations. The reason for this is that the mark received its „registration certificate’ from WIPO when it was registered internationally, prior to being forwarded to the UK for examination. The holder will learn that his mark is protected in the UK via one of the three „final’ letters which are sent to WIPO regarding cases. All final letters are sent via WIPO in order that the final status of the UK designation may be recorded on the international register, and published in the International Gazette for the information of third parties. WIPO will forward a copy of the final decision to the holder or their representative.

## **Confirmation of Protection in the UK**

The UK office will notify WIPO when a designation is protected in the UK. This is done at the time the mark achieves protection in the UK and follows the procedure laid out in the Common Regulations.

## **Statement of Grant of Protection**

### [Rule 18ter\(1\)](#)

This letter is sent in cases where no provisional refusal has been issued. The grant of protection letter allows WIPO to „close the case’ as regards the UK designation and the holder’s rights in respect of the UK are confirmed without the need to wait until the

end of the 18 month period. The protection of the mark is recorded and published in International Gazette and the grant of protection letter is forwarded to the holder.

### **Statement of Withdrawal of Provisional Refusal**

#### [Rule 18ter\(2\)\(i\)](#)

This letter is issued in cases where the provisional refusal issued at examination stage was waived or overcome **in its entirety**. The mark was advertised in the UK Trade Marks Journal **for exactly the same goods and services as are recorded at WIPO**. The letter informs WIPO that the provisional refusal raised has been **completely withdrawn**, and that the mark is now protected in the UK. The protection of the mark is recorded and published in International Gazette and the statement of withdrawal letter is forwarded to the holder

### **Confirmation of Final Decision**

#### [Rule 18ter\(2\)\(ii\)](#)

This letter is issued in circumstances where a provisional refusal has been partially overcome and the case has been allowed to proceed to advertisement in respect of **part of the list of goods and services originally notified**. We then inform WIPO that the mark has been **partially protected** in the UK. The letter lists the goods and/or services that have been protected and also confirms that all other goods and services have finally been refused protection.

This information is recorded in the international register and the letter is then forwarded to the holder or his representative.

A final decision may not refuse protection to more goods and services than the provisional decision. This means that if no refusal is issued at provisional stage, then the mark **will** be published and protected in the UK in respect of the goods and services covered by the international designation. Similarly, if a partial refusal is issued at examination stage, we are bound to publish and protect the goods listed as acceptable. Therefore, if the holder wishes to limit the scope of his mark more than the registry proposes, or to withdraw the UK designation completely, he must do this directly with WIPO.

### **Transformation to national application**

#### [Art. 9quinques](#)

Where an international application is cancelled at the request of the Office of Origin of the case, the holder may opt to try to obtain protection for his mark in some or all of his designated countries by filing national applications in those countries. If the national application is filed within three months of the recordal in the international register of the cancellation of the international mark, then the holder may claim the filing date of the international application. This procedure is known as „transformation’.

Transformation is defined in [Article 9quinques](#) of the Madrid Protocol. Applications must meet the following criteria in order to transform:

- the national application must be filed within three months of the death of the

- international mark;
- the national application must be for the same mark and for the same or no wider goods and services than the international mark;
- all national filing requirements, including payment of fees, must be met.
- The request will be filed on [form TM4](#)

Applicants wishing to transform international rights to national (UK) rights will do so by completing and filing the relevant national application form. Details of the international mark on which the transformation is based must be provided. If the application meets all requirements and transformation is allowed, the case will be given the same status as the international mark prior to cancellation. If the international mark had „protected’ status prior to being cancelled, then the transformed „national’ will automatically be given „registered’ status. This is possible because the case has already been through the UK examination procedure as an international designation. If the international mark was „examined’ status, then the new national application will be „examined’ status. It will continue through the registration procedure as a domestic application.

### **The International Register**

The international register is kept and updated by WIPO. Any changes to details held on the international register, such as limitations to the goods or services covered by a mark or updates to the holder’s details, must be notified to WIPO. WIPO are responsible for recording these details onto the international register.

### **Who may update the international register?**

Clearly not everyone may request changes to the details of an international registration. WIPO must be assured that the party filing the official form has authority to act with respect to the international mark in question. Persons with authority to act fall into three groups:

- the holder or their representative in the country of origin of the mark;
- the Office of Origin of the international application; and
- the Office of the contracting party of the holder.

### **The holder or their representative**

Every international application form carries the name and address details of the holder of the mark. The holder may also choose to allow a representative to file his application and to act for him in matters relating to the international trade mark. These are the only names that WIPO records for the mark. These are therefore the only people from whom WIPO will accept forms requesting changes to details of a mark.

### **The Office of Origin of the application**

The Office of Origin has to inform WIPO (under [Rules 22 & 25](#)) of changes to the national mark on which the international application is based. If the basic mark is refused, opposed or falls away for some reason, within the first 5 years following filing,

WIPO must be informed. Similarly, if the basic mark is registered for a narrower list of goods and services than that originally applied for, WIPO will need to limit the international mark in line with the case upon which it is based. So, the Office of Origin may forward letters from the holder requesting partial or total cancellation of an international trade mark, or may notify WIPO of ceasing of effect of the basic mark.

The Office of Origin is also authorised to accept and pass on certain of the official [forms MM5](#), where the holder's address is in the UK. These forms may be endorsed by the Office of Origin.

### **Office of the contracting party of the holder**

In cases where an international mark has been assigned to a holder in another member country of the system, the national office of the new holder may forward official forms to WIPO, if requested to do so.

The notable exception to the list of persons who may act before WIPO in respect of an international mark is **the representative appointed in a single designated contracting party**.

### **Representatives in designated contracting parties**

Representatives appointed to deal with individual designations of an international registration may **not** normally file official forms requesting updates to the international register. These individual representatives are not recorded on the international register. Clearly, it would not be acceptable that the international register be updated by any third party that has no connection with the mark in question. Therefore, since WIPO is unable to recognise representatives from designated contracting parties, any limitations or changes to individual designations are required, such requests must be sent to WIPO by the holder or by the instructing attorney in the country of origin of the mark.

This may cause problems for attorneys dealing with UK designations of international marks.

### **Changes to international registrations - ([Rule 25](#))**

#### **Transfer of ownership - form [MM5](#)**

[See Rule 25\(3\)](#)

Under the Madrid system assignment of a trade mark is referred to as 'transfer of ownership'.

If the assignment of an international registration is to be recorded on the international register, then the new owner of the mark must be entitled to hold marks under the Madrid system ([entitlement to be new holder](#)). He must **also** be entitled to hold the mark in question. For example, if the mark is registered under the Madrid Agreement and the new holder is a national of, resident in, or holds a real and effective commercial establishment in a 'Protocol only' country, then the assignment of rights will not be recorded in the international register. Holders in 'Agreement only' may only hold

„Agreement designations’ of international marks; likewise holders in „Protocol only’ countries. It follows that if the new owner of the mark is in a country which is party to both the Agreement and the Protocol, he will be entitled to hold all designations of the mark.

[Form MM5](#) is used to record the transfer of ownership of a mark to a different legal entity. (Compare [form MM9](#), which is used to change the holder’s name and address details in circumstances where the legal ownership of the mark has not changed.)

The form may be sent to WIPO by the holder or by the national office of the holder. It may also be filed by the national office of the transferee, it being understood that this office is in a member country of the Madrid system. A fee is payable for recording the transfer in ownership. The new holder of the mark will be required to indicate on the form his entitlement to hold the mark.

Transfer of ownership is recorded as the date when WIPO receive a form [MM5](#) which complies with all filing requirements. Transfers are published in the [International Gazette](#).

### **Limitation, renunciation and cancellation**

These three actions all have the same result - a limit in the original scope of the international registration. The difference between them is:

- Limitation - limits **some** of the list of goods and services, in respect of **some or all** of the designated contracting parties.
- Renunciation - renunciation of protection for **all** goods and services, in respect of **some but not all** designated contracting parties.
- Cancellation - cancels **some or all** goods and services, in respect of **all** designated contracting parties.

From the above definitions it will be clear that a limitation and a cancellation have much in common. There is however one important difference. A **limitation** means that the goods that have been struck out are no longer covered by the international registration. But if protection for the goods that have been struck out **is** required in the future, this can be obtained by filing a subsequent designation form. **The goods and services have not been taken out of the international registration itself.** They are simply „not protected’ in the designated contracting parties affected by the limitation.

A **cancellation**, however, has the effect of **removing the cancelled goods or services from the international registration.** It would not be possible to protect the cancelled goods and services by making a subsequent designation. This could only be achieved by filing a new international application in respect of the cancelled goods or services.

So the effects of a limitation and a cancellation are different and hence, the choice of which of these actions to take in given circumstances must be made with care.

## **Limitation of the list of goods and services - [form MM6](#)**

An international mark may be limited in respect of some or all designations. Even if the limitation of the list of goods and services is only valid in one designated contracting party, it is still necessary to request the limitation centrally at WIPO.

It is the ultimate responsibility of the holder of the mark to ensure that his rights are reflected accurately, both on the international register and in designated contracting parties. It is therefore imperative that the desired limitation is clearly set out when filing the official form. WIPO will not interpret instructions given on the form but will simply pass on the request to limit to the designated contracting parties concerned. If a limitation is not clearly worded, then designated contracting parties may find it impossible to record the limitation. For example if it appears to widen the list of goods and services originally filed or if it requests that goods and services are struck out of the original list when in fact these do not feature in the original list.

[Form MM6](#) is used to limit an international mark in some or all designated contracting parties, by the removal of some goods or services from the list originally filed. The form must be sent to WIPO by the holder of the mark. The form does not specify how the limitation should be set out and holders have the choice of listing the goods or services to be excluded, or stating that „the limited list should now read as follows „...’. Whichever of these options are taken, the desired end result should be clearly and unambiguously stated.

Limitations are recorded and published in the International Gazette. The instruction to limit is then forwarded to all the designated contracting parties concerned.

## **Renunciation - [form MM7](#)**

Under UK law a trade mark application will be withdrawn or refused if the applicant decides that he no longer wishes to pursue it. The Madrid system requires a positive final outcome in respect of every designation to the UK. Thus, if a holder decides that he does not wish to continue with his international designation, he may choose either to renounce his rights in the UK by filing form MM7 to WIPO, or if a provisional total refusal has been raised request that we formally and finally refuse protection for the case in the UK.

[Form MM7](#) is used to request the complete withdrawal of a request for protection of a mark in one or more of the designated contracting parties to a case. This is equivalent to the withdrawal of an application to the Intellectual Property Office. The holder no longer wishes to protect his mark in a designated contracting party where he renounces protection.

The form should be sent to WIPO directly by the holder. The holder is simply required to list the designations where he wishes the renunciation to be effective. If he wishes to

renounce the mark in its entirety, that is, in all designated contracting parties, he should use a request for cancellation ([MM8](#)) rather than a renunciation form.

The renunciation will be recorded and published in the [International Gazette](#). Copies of the publication will then be forwarded to all designated contracting parties affected by the action.

### **Cancellation of the International Registration - [form MM8](#)**

Cancellation of an international mark will be effective in all the countries designated in the international application. As with limitations, it is the responsibility of the holder of the mark to ensure that his rights are accurately reflected on the international register and in the designated contracting parties where his trade mark has protection. The difference between cancellation, limitation and renunciation should be noted and care taken to ensure that the desired result is achieved.

[Form MM8](#) is used to request cancellation of some or all of the goods and services in all countries listed on the international registration. The cancellation has the effect that goods or services are removed from the international registration as though they had never been listed.

The form may be filed by the holder or by the office of the contracting party of the holder. The holder will be required to state whether the cancellation is to be recorded in respect of some or all goods and services covered by the international registration. If specific goods are to be cancelled the holder will need to list these.

WIPO will record the cancellation and publish it in the [International Gazette](#). A copy of the publication will be forwarded to all designated contracting parties, since all will be affected by a cancellation.

### **Change in name and/or address of the holder - [form MM9](#)**

[Form MM9](#) is used to record changes in the holder's name and address details when there has been no change in the legal entity of the company (compare [form MM5](#) - „Transfer of ownership’). One form may be used to record the change for several international registrations held by the same holder.

The form may be filed to WIPO directly by the holder or his representative, or via the office of the contracting party of the holder.

WIPO will record the change and publish it in the [International Gazette](#). It will then be forwarded to all designated contracting parties concerned.

### **Change in name and/or address of the representative - [form MM10](#)**

[Form MM10](#) is used to update the details of the recorded representative, for example if

the representative moves to new premises. One form may be used to update the representative details on many international applications.

The form may be sent directly to WIPO.

#### **Renewal - [form MM11](#)**

[Form MM11](#) may be used to request renewal of an international registration. Use of this form is not compulsory. Requests to renew international registrations can also be made by letter. It is important to ensure that renewal fees are paid on time as renewal requests cannot be actioned without the fees.

The form may be sent directly to WIPO.

#### **Appointment of a representative - [form MM12](#)**

[Form MM12](#) is used to appoint a representative or to change to a different representative. It is not compulsory to use this form when appointing a representative.

The form may be sent directly to WIPO.

#### **Recording a licence - [form MM13](#)**

##### [Rule 20bis](#)

[Form MM13](#) allows holders to record licences against international marks. The licence may be recorded against all designations covered by the international mark, or just against certain designations. The form is fee-bearing and the appropriate fees must be paid before a licence can be recorded.

The form may be sent directly to WIPO.

#### **Amendment of a licence - [form MM14](#)**

[Form MM14](#) should be filed directly to WIPO. It is used to amend the details of an existing licence, i.e. one that **has been recorded** on the international register. This form is fee-bearing and it is important to ensure that the correct fees are paid since amendments will not be actioned without the fee.

#### **Cancellation of a licence - [form MM15](#)**

[Form MM15](#) is used to cancel a licence that has been recorded on the international register. Like other forms for licences, it may be filed directly to WIPO. One form may be used to request the cancellation of a licence from several international registrations. If more than one licence is recorded against an international mark, it must be made clear beyond all doubt which licence is to be cancelled.

There is no fee for cancellation of a licence.

## **Claim to Seniority –[Form MM17](#) (for applications designating the EU)**

Where applicants designate the Community, they must also complete form [MM17](#) when they are claiming seniority from prior registrations within the Community **Declaration of intention to use the mark [Form MM18](#) (for applications designating USA)**

Where applicants designate the USA, they must attach a completed form [MM18](#) to their international application form or subsequent designation form. This form contains the exact wording of the declaration of intention to use the mark required under United States law. If the MM18 is not filed with the MM2, it should be sent directly to WIPO.

## **Records held by the Intellectual Property Office**

The Intellectual Property Office is required keep a record of all international registrations valid in the United Kingdom. This is called the supplemental register. All records are maintained on the MPS system.

WIPO is responsible for the flow of electronic information to the MPS system. The details relating to new international registrations which have designated the UK are received on a weekly basis. The MPS system contains details of international registrations **insofar as these are valid in the UK.**

## **Details recorded on MPS**

All international marks designating the UK will be examined according to the Trade Marks Act 1994. MPS is an electronic case file management system which shows the status of a designation and the history held on the system can be used to trace the progress of a case through the UK examination process.. As the case proceeds, we will record changes in status and add clauses which are agreed with representatives or holders prior to publication of the mark in the UK Trade Marks Journal. To facilitate this, certain of the UK national forms '[TM' Forms](#) may also be used when dealing with international designations.

Some Intellectual Property Office forms have already been mentioned in this chapter. [Form TMA](#) is used when holders file an application transforming their international rights into national (UK) trade mark rights. [Forms TM7 and TM8](#) are used in the opposition of an international designation since the mark is being opposed under the Trade Marks Act 1994. Other „TM' Forms used with international designations are listed below:

[TM4](#) Request to transform an International mark designating the UK into a domestic application

[TM5](#) Request for a statement of grounds. This form is used when the

provisional refusal is maintained after the holder has made written representations to the office, or after a hearing before one of the registrar's hearing officers. The holder has the right, in the same way as national applicants are entitled, to request a written statement of the grounds for refusal of protection.

- [TM7](#) Notice of opposition and statement of grounds. This form is used to file formal opposition against a published UK or International trade mark.
- [TM8](#) Notice of defence and counterstatement. This form is used to submit applicants defence and counterstatement following the filing of form TM7.
- [TM7A](#) Notice of Threatened Opposition. This form is for any party which is considering filing an opposition against a published UK or International trade mark, and who wishes to extend that mark's opposition period from two to three months.
- [TM8\(N\)](#) Notice of defence and counterstatement for use in revocation on the grounds of non-use.
- [TM9](#) Where extra time is necessary to extend a time period that has not yet expired to resolve matters at the ex officio examination stage, after a hearing or during opposition or invalidation proceedings form TM9, (with appropriate fee post hearings), must be used to request this.
- [TM9R](#) Where extra time is necessary to extend a time period that has already expired to resolve matters at the ex officio examination stage, after a hearing or during opposition or invalidation proceedings form TM9R, (with appropriate fee post hearings), must be used to request this.
- [TM9c](#) Request for a cooling off period or for an extension of such a period. This form is used in opposition proceedings.
- [TM9e](#) Request for an extension to the cooling off period.
- [TM9t](#) Request to terminate a cooling off period.
- [TM21A](#) Used during opposition proceedings to request limitation to the list of goods or services of an international designation in order to overcome the opposition. Limitations to the list of goods and services are normally recorded by filing form MM6 to WIPO. However, opposition is a reason for provisional refusal of protection to **all** goods and services covered by an international designation. Having provisionally **totally** refused protection for a designation, the Intellectual Property Office may then agree limited protection to overcome any problems originally raised.

- [TM24](#) This form is used for recording of registrable transactions against international designations in the UK.
- [TM28](#) Concurrent registrations are recorded using this form (see „Replacement“). If a holder has existing UK national trade mark rights he may request that his international mark replace his national mark. This is done by recording a concurrent registration at any time after the international mark achieves protected status in the UK.
- [TM31M](#) Information about international designations is requested using this form (compare TM31C - used for requesting information about UK trade marks). Third parties will file this form to request that they be notified for example, when the designation is published or refused.
- [TM33](#) Used to appoint an EC, Channel Islands or EEA representative to act on the holder's behalf in respect of an international designation in the UK (see „Appointing a UK representative“).
- [TM35](#) Used for filing copies of the regulations governing use of a certification or collective mark. Appropriate fees must be paid.
- [TM36](#) This form covers amendments to the regulations governing use of a certification or collective mark. Appropriate fees must be paid.

## **Recording licensees**

### [Rule 20bis](#)

The Common Regulations allow for licences to be recorded on the International Register. A licence may be recorded in respect of one or several of the contracting countries covered by an international mark

Licences are now recorded in the international register of trade marks maintained by WIPO. However, those licences which were recorded in the UK Registry's supplementary register prior to the current revision of the Common Regulations (that is, before April 2002) will continue to have effect.

## **Requests for certified copies**

The international register is held by WIPO. The Intellectual Property Office is therefore unable to give certified copies of international trade marks. These may be obtained by writing to WIPO directly. There is no official form for use when requesting certified copies. A fee is payable when requesting a certified copy from WIPO.

## **International Fees**

Fees for international trade mark applications are paid in Swiss francs.

The fee structure is made up of many parts. Applicants pay according to the mark they are seeking to protect and the countries where protection is sought. Fees fall into two categories:

- fees relating to the mark; and
- fees relating to the designated contracting parties.

### **Basic Fees**

Every applicant will be required to pay an application fee – described by WIPO as a „basic fee’. This covers an application with up to three classes of goods and services. Further fees relating to the application are payable according to the nature of the mark.

### **Is the mark in colour?**

If a colour representation of the mark is provided then it will be necessary to pay the higher „basic fee’ applicable to coloured marks. If colour is claimed as an element of the mark then a colour representation **must** be provided. Applicants may also **choose** to file a colour representation of the mark even if they do not claim colour. But in any circumstances where a colour publication of the mark is either necessary or desired it will be necessary to pay the higher basic fee.

### **Supplementary fees**

The basic application fee covers up to three classes of goods and services. For each additional class a supplementary fee is payable.

Supplementary fees cover the additional classes in designated contracting parties that do not charge individual fees. Therefore, if all the countries designated in an application charge individual fees, then it will not be necessary to pay supplementary fees.

### **Fees relating to the Designated Contracting Parties**

Applicants must pay a fee for each designated contracting party that is listed on the application. These fees are paid in addition to the basic fees, which are detailed above.

### **Individual fees**

Certain member countries of the Protocol have exercised their right to collect individual fees ([see Article 8\(7\) of the Protocol](#)). To designate these countries it is necessary to pay the „individual fees’ specified. An up-to-date list of the fees for individual countries is available on [W IPOs fee calculator](#). It should be noted that different member countries specify that their fees cover different numbers of classes of goods and services. Further, some of the countries charge different individual fees depending

upon whether the international application is for a trade mark or a collective mark. Thus, it is important to be clear about the nature of the mark for which international protection is being sought.

Some countries split the fee they will collect and require part of the fee when the application is filed and the rest at protection of the mark in their particular country. This will result in the applicant being requested to pay fees again, after the mark has been registered internationally and passed to individual designations. Applicants need to be aware of this, since if the fees are not paid, this may result in the designation being abandoned.

The Community Trade Marks Office requires „direct’ applicants to pay the fees in two parts – an „application’ and a „registration’ fee. The individual fee for designating the EU under the Madrid Protocol is equivalent to **both parts** of this fee and is payable at the time of designation. If for any reason the designation to the EU does not become protected, the part of the individual fee equivalent to the „registration’ fee paid by direct Community applicants will be refunded.

### **Complementary fees**

Where there are no individual fees listed for a country, applicants wishing to designate that country will instead pay a „complementary fee’.

The total application fee for an international application is the sum of the fees relating to the mark and those relating to the designated contracting parties. A [fee calculator](#) is available on the WIPO website.

### **UK handling fee**

Where the international application is based on an UK mark, the Intellectual Property Office will be the Office of Origin for that case and the international application will be filed via the Intellectual Property Office. A handling fee (currently £40) is charged. This covers the cost of certification of the case, as well as, courier fees for transportation of the case to WIPO.

The application form is the only international form on which we are permitted to charge a handling fee at the Intellectual Property Office. Other forms filed via the Intellectual Property Office are forwarded to WIPO after a basic check.

### **Payment of international fees**

International fees may be paid by:

- deduction from a WIPO current account;
- bank transfer to WIPO’s bank account Bank name: Credit Suisse - 1211 Geneva 70 - Switzerland

Account name: WIPO/OMPI  
Account number (IBAN): CH51 0483 5048 7080 8100 0  
SWIFT code: CRESCHZZ80A

- payment or transfer to the Swiss postal cheque account of WIPO, Account number (IBAN): CH03 0900 0000 1200 5000 8  
at SWISS POST/Postfinance – Engehaldenstrasse 37 – 3030 Bern  
SWIFT/BIC: POFICHBE

Alternatively, if customers hold a deposit account with the Intellectual Property Office, they may instruct the Intellectual Property Office to pay the fee and debit their account with the requisite amount of Swiss francs. The Intellectual Property Office will also pay fees for customers who send a cheque in sterling.

## **Community Trade Marks**

### **Background to the system**

The [Office for Harmonization in the Internal Market \(OHIM\)](#) is based in Alicante, Spain. It was set up to process applications to register Community trade marks and designs. Applications for trade marks were accepted from 1 January 1996 and the office opened officially on 1 April 1996. All applications received prior to 1 April were given a filing date of 1 April 1996.

Applicants for Community trade marks file a single application, but if successful gain trade mark rights which cover all member states of the EU and are valid for ten years and renewable for further periods of ten years. The UK holds a register of all trade mark applications and registrations which are valid in the UK, including information relating to Community trade marks.

Community trade marks are examined by the OHIM under [European Council Regulation 40/94](#) on the Community Trade Mark (referred to in this chapter as „CR 40/94’ or „the Community Trade Mark Regulation’). The Community Trade Mark Regulation is intended to harmonise the laws of member states of the European Union. The UK Intellectual Property Office is not involved in the examination of Community trade marks and our contact with the Community office is limited. However, there are certain procedures that we are required to carry out and these are outlined below.

### **Certification of professional representatives**

#### *Art. 89CR 40/94*

Whilst anyone may file a Community trade mark or Community design application, applicants from outside the Community must appoint a representative from within the Community to act for them before the OHIM in all proceedings after filing. Legal practitioners (solicitors or barristers) who are qualified in one of the member states of the EU are automatically entitled to act before the OHIM. Other representatives need to be entered onto the OHIM’s list of professional representatives before they may represent applicants for Community marks and/or Community designs.

Article 89(2) of the Community Trade Mark Regulation requires the Intellectual Property Office to certify representatives living or with their place of business in this country, who wish to be entered onto the OHIM's list of professional representatives. Representatives must apply **on an individual basis** to be entered onto the list. There are certain criteria they must meet, namely (see Art.89(2) CR 40/94):

- be a national of one of the member states;
- have a place of business within the EU; or
- be entitled to represent applicants before the Intellectual Property Office, this being the national office of the member state of the EU where the representative's place of business is located.

Entitlement to act before the Intellectual Property Office is assessed either by special professional qualification (such as a member of the Solicitor's Roll) or by habitual practice before the UK office over a 5 year period (as detailed in Article 89(2)(c) of the Regulation).

International Policy Section examines applications to be entered on the OHIM list of representatives, to ensure that applicants meet all of the above criteria. We then sign the certification form and send the complete application on to the OHIM. We inform the representative that we have forwarded the application. The OHIM confirms directly with the representative when they have been entered onto the official list of professional representatives.

### **Conversion to national trade mark application**

*Art. 108, 110 CR 40/94*

Holders of Community trade mark applications or registrations may apply to convert their Community marks into national trade marks and may request conversion of the Community trade mark to a national trade mark if the Community application is refused, withdrawn, deemed to be withdrawn, or ceases to have effect. (Conversion is not permitted where the Community mark has been revoked on grounds of non-use.)

For conversion to be permitted, there must have been a valid Community application or registration to begin with, that is, the mark must have satisfied all filing requirements and have been granted a filing date.

A request for conversion should be made in writing, to the OHIM within three months of the date of OHIM's final decision. The form for making this request can be downloaded from the OHIM website. If the request for conversion is admissible, the papers relating to the case will be forwarded to the national offices of the countries where conversion is requested.

Partial or total conversion is possible. For example, where one class of a multi-class application is successfully opposed, that class could be converted to national trade mark

applications in any or all of the countries of the EU, except in the country where the opposition originated. The rest of the application, that is, the „unopposed’ classes, will continue life as a Community mark.

Converted cases retain the filing date of the application to the OHIM. The papers are passed to us exactly as they were filed to the OHIM - this could mean that they will be in any of the officially accepted languages of the Community Office. If the papers are in a language other than English we will ask the applicant or his representative to provide a translation.

### **Filing a Community application via the Intellectual Property Office**

*Art. 25(1)(b) CR 40/94*

The Intellectual Property Office is authorised under Article 25(1)(b) of the Community Trade Mark Regulation to receive Community trade mark applications on behalf of the OHIM. Finance Section is responsible for the receipt of Community applications. We do not examine applications in any way at the Intellectual Property Office, but simply check to ensure that they are complete and can be given a filing date.

If an application complies with all the filing requirements, then the filing date assigned to the case at the OHIM will be the date on which we at the Intellectual Property Office received the application. We forward applications by courier to the OHIM in Alicante. We send the applicant a confirmation slip confirming the filing date assigned to the case and the number of pages, including attachments, which have been forwarded. The handling fee we charge for receiving and forwarding Community applications covers the cost of the courier service.

The advantage of filing a Community application via the Intellectual Property Office is that the filing date is quickly established and confirmed. However, Community applications do not have to be filed through this office. They can be filed directly to OHIM using any of the prescribed ways which now include electronic filing.

### **Sources of information**

#### **The OHIM database**

Community trade marks and designs are examined and registered by the OHIM. The register of Community trade marks is maintained by the OHIM. They send the Intellectual Property Office a limited amount of information about each new mark to enable us to conduct searches of the national register.

#### **The OHIM website**

The OHIM website [www.oami.europa.eu](http://www.oami.europa.eu) includes an on-line search facility as well as general information about the Community trade mark registration system.

#### **The Bulletin and the OHIM Journal**

The OHIM publishes all new Community trade marks for opposition purposes. The „OHIM Bulletin’ which is published weekly, is a source of information about individual trade marks. Community trademarks are published in all officially accepted languages of the Community Office.

The OHIM also publishes information such as decisions and updates in law and practice in a monthly journal, the „[OHIM Bulletin](#)“.

## ANNEX

### Glossary of international (Madrid) terms

- Applicant** Holder of national trade mark rights in a member country of the system, who applies to register his mark internationally and gain protection in other designated member countries.
- Application** A new request to register an international trade mark. Applications are filed to WIPO via the Office of Origin of the trade mark
- Article** Refers to Articles of the Protocol relating to the Madrid Agreement concerning the International Registration of Marks.
- Basic mark** National trade mark rights upon which the international application is based. Under the Protocol, the basic mark may be an application or a registration, whereas under the Agreement only registered rights may be used as the basis for an international application.
- Certification** Required by Article 3 of the Protocol. To use the system an international application must be based on existing national rights. The national administration where those rights are based (Office of Origin) is required to certify that the international application is in line with the existing national rights.
- Common Regulations** The „Rules’ which govern the practical administration of the „Madrid System’.
- Dependency** International applications are based on existing national trade mark rights - see [Article 6\(2\) of the Protocol](#). For the first five years of the life of the international mark, it is „dependent upon’ the national mark. Thus, if the national trade mark rights die for any reason during this five year period, the international mark will also die. After the five year period the international mark will become independent of the basic mark.
- Designated Contracting Party (DCP)** Any member country of the system which is listed in an international application as being a country where the holder wishes to seek protection for his mark.
- Designation** When an international application is filed, the applicant will „designate’ other member countries of the system where he would like his mark to be protected. When the mark is registered, copies of the details will be sent to each of the designated contracting parties. In each individual country the application for protection will be known as a „designation’. For examiners

of international trade marks the term „designation’ is approximate to the term „application’ used on domestic examination units.

**ENN** The code used by WIPO to classify the details of a new mark which is seeking protection in the UK. An ENN carries all the details of the mark which we need in order to examine the case.

**EXN** The code used to classify the details of an existing international mark which has just applied for protection in the UK (see „subsequent designation’).

**Filing date** Date on which the international application was filed. In most cases this will be the date on which the application was received by the Office of Origin. When the mark is registered, the filing date will become the international registration date.

**Holder** . The „registered proprietor’ of an international trade mark. The holder of an international mark is recorded on the international register.

**International Gazette** Published by WIPO, this contains details of new International trade marks as well as any updates to details of existing marks on the International Register.

**Irregularity Notice** Notice from WIPO to the applicant for international registration to notify him of any instance where the application does not comply with the Common Regulations. Irregularity notices are sent both to the holder and the Office of Origin for the mark. Irregularity notices may also be sent to Designated Contracting Parties where refusal letters do not comply with the Regulations.

**Madrid Agreement** Treaty of April 1891 (and still in force) allowing for the international registration of trade marks. Member countries of the Madrid Agreement are referred to in this chapter as „Agreement countries’.

**MPS** **MADRID PROTOCOL SYSTEM the Intellectual Property Offices electronic file system**

**Madrid Protocol** Protocol to the Madrid Agreement, adopted in 1989 with a view to making the Protocol more accessible to a greater number of parties. Member countries of the Protocol are referred to in this chapter as „Protocol countries’.

**Madrid System** System for the international registration of trade marks based on two system international treaties - the Madrid Agreement and the Protocol to the Madrid Agreement.

**National Representative** Trade mark attorney, lawyer or other individual representing the holder in respect of one designation of the international registration before the national administration of the designated contracting party.

**Office of Origin** National trade mark office where the basic mark is held - thus the office of the international application. The Office of Origin never changes, even if a mark is transferred into the ownership of another party who is based in another of the member countries of the system.

**OHIM Bulletin** This publication contains details of new Community trade marks which are published for opposition purposes, as well as marks which have achieved registration.

**OHIM Journal** Details of updates to law and practise as well as legal decisions are published in the OHIM Journal.

**Protected** Similar to domestic „registered’ and indicates that an international designation has successfully passed through the UK examination and advertisement procedure. International designations are already „registered’ when they come to us and the term „protected’ is therefore used to describe the final status of cases which have achieved protection in the UK.

**Refusal** We examine all designations to the UK under the Trade Marks Act 1994. Just as with UK trade marks, international marks will be accepted or refused protection. Where there are grounds to object to a mark a „provisional refusal letter’ will be drafted (may be compared to the domestic „examination report’). Partial or total refusal is possible.

**Registration/Registered** A registered international mark is one which has been recorded in the Registered international register. Marks are registered internationally before being sent out to the member countries of the system which are designated in the international application. Thus, a registered mark may not yet have achieved any protection in countries other than its country of origin. (See also „Protected’).

**Representative** Trade mark attorney, lawyer or other person designated by the applicant to act on his behalf before WIPO. (Compare „national representative’).

**ROMARIN** A record of the current marks on the International Register. This is produced by WIPO and available on the WIPO website.

**Rule** Refers to the „Common Regulations under the Madrid Agreement and the Protocol relating to that Agreement’.

**Safeguard** This phrase refers to [Article 9sexies of the Protocol](#) as amended in September 1, 2008, repeals the safeguard clause. New paragraph (1)(a) of Article 9sexies provides that the Protocol, and the Protocol alone, will, in all aspects, apply between Contracting Parties bound by both the Agreement and the Protocol. As a result, as from September 1, 2008, designations of a Contracting Party bound by both the Agreement and the Protocol made in an international application or subsequent to an international registration, by an applicant or holder of a Contracting Party also bound by both the Agreement and the Protocol will be governed by the Protocol. For convenience, such designations are hereinafter referred to as “designations governed by the Protocol by virtue of new Article 9sexies”..

**Subsequent Designation** Once an international trade mark is registered, the holder may apply to add further countries to the list of those where he seeks or has protection. This is done, as the name suggests, by filing an application to **designate** further member countries **subsequent** to the registration of the international mark.

**Transformation** [Article 9quinques](#) of the Protocol deals with this. Where an international registration is cancelled at the request of the Office of Origin (i.e. because of the death of the basic mark) then the holder of that registration may request transformation of his international rights in one or all of the countries designated to national rights in those countries. This request must be made within three months of the cancellation of the international application. Partial or total transformation of a case is possible.

**WIPO** World Intellectual Property Organisation.

## **Chapter 6                    Register Maintenance**

- 1        Introduction**
- 2        Renewals**
- 3        Restorations**
- 4        Registrable transactions**
  - 4.1     Assignments**
  - 4.2     Licences**
  - 4.3     Other registrable transactions**
- 5        Other amendments to the register**
- 6        Certified copies**
- 7        Requests for information about applications and registered marks (Caveats)**
- 8        Supplying copies of the register and documents held in the Registry (Sales)**

### **1        Introduction**

The Register Maintenance Section is responsible for:

- \$        maintaining the register of trade marks, and its linked database of names and addresses, ensuring they are as accurate as possible; and
- \$        supplying, and certifying where requested, information held on the register.

The register of trade marks is a legal document and may not be amended in any way other than by the correct processing of a valid request (usually on an official form), normally by the proprietor of a registration, or someone authorised by them.

Most requests are made by agents. We need proof of someone's authority to request a particular action only where:

- \$        an agent is appointed for the first time during the course of proceedings;
- \$        there is a change of agent during the course of proceedings; or
- \$        there are any doubts about someone's authority to act, or that authority is challenged or questioned by someone else.

## 2 Renewals

**References:** Act: Sections 42-43 Rules: 27-29 Form: TM11 +fee

A trade mark is registered for ten years from the date of registration (*Section 42(1)*) which in effect is the date of filing of the application (*Section 40(3)*). At the end of this period, the registration may be renewed for further periods of ten years (*Section 42(2)*). The renewal date is calculated from the date that the trade mark application was originally filed even where the applicant may have claimed an international priority date, except for transformation applications under the Madrid Protocol and Community Trade Mark conversions which are deemed to have been filed on the date of designation of the UK or the CTM date respectively.

All 'old Act' marks which were renewed before 31 October 1994 and are still within a 14-year renewal period will continue as such. Their next renewal will be for a period of ten years, which will become the cycle after that.

We issue renewal reminder letters approximately three months before renewal is due (*Section 43(2) and Rule 27*). Registrations may be renewed by returning this letter, duly signed, or by filing form TM11, with the appropriate fee.

Multi-class registrations require a fee for each class to be renewed. A proprietor may choose to renew all, or only some, of the classes covered.

### Late renewal

If a registration is not renewed by the renewal date, that fact will be published in the Trade Marks Journal. However, the mark may still be renewed within six months of that date on payment of the standard renewal fee **plus an additional renewal fee** (*Rule 29(1)*).

### Late registration

If an application takes more than ten years to become registered, that is, after the first renewal date, the eventual registration may be renewed on payment of the standard renewal fee **plus an additional renewal fee** within six months of the actual date of registration (*Rule 29(3)*).

### Effect of non-renewal

If a registration is not renewed by the appropriate date, it will be shown as 'Expired' on the register, with effect from the renewal date, and removed from the register six months after that. It is not possible to take any action, for example, assignment, licensing, merger, on a mark which is expired. It may be possible to restore a registration within a year of expiry (see next section).

We publish both the renewal and removal of marks in the Trade Marks Journal (*Section 43(6) and Rule 29(4)*).

## 3 Restorations

**References:** Act: Section 43 Rule: 30 Form: TM13 +fee

If a registration is not renewed within six months of its renewal date, the proprietor (who may not necessarily be recorded as the registered proprietor) may still apply for it to be restored to the register within the next six months, that is, up to one year after its renewal date. In addition to the Renewal Request (form TM11) and its fee, the proprietor will need to file a Restoration Request (form TM13) and its fee, **together with a full explanation of why the mark was not renewed within time.** The request to restore the mark will be considered by the Team Leader, who may restore the mark to the register and renew the registration **if, having regard to all the circumstances of the failure to renew, he is satisfied that it is just to do so** (*Rule 30(1)*).

In exercising this discretion, the Team Leader must have due regard to all the circumstances surrounding the failure to renew, for example, there should have been a continuing underlying intention to maintain the registration. A proprietor should not be refused restoration because of the failure of his appointed agent to ensure renewal.

If there has been a change of ownership of the mark since its last renewal, the current proprietor will need to demonstrate his right to ownership, for example, to establish the chain of title in the mark. In such circumstances, assignment action is also usually required, but this cannot take place until after the mark has been restored to record.

If the Team Leader declines to restore a registration, he should inform the proprietor in writing of his reasons for so doing, and offer a hearing. If, after a hearing, or in the absence of any response to that letter, the registration is still not restored to record, then **only the renewal fee will be refunded**, not the restoration fee.

The restoration of marks is published in the Trade Marks Journal (*Section 43(6) and Rule 30(2)*).

#### **4 Registrable transactions**

*References: Act: Sections 24-25 & 63 Rules: 40-41 Form: see below*

Anyone who claims to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction, or to be affected by such a transaction, may apply to have the details of that transaction entered in the register.

**It is only necessary to file original documentation to establish a registrable transaction if the appropriate signature(s) cannot be provided on the official form.** This means the signatures of both parties to an assignment (*Rule 41(2)(a)*) or the signature of the grantor of the licence or security interest (*Rule 41(2)(b)*). Section 82 provides that anything required to be done by a person in connection with a registered trade mark may be done by an agent acting on their behalf. We take this to mean that an agent can sign any form on behalf of a person, including a registrable transaction.

The following are registrable transactions:

- \$ the assignment of a registered trade mark or any right in it;
- \$ the grant of a licence under a registered trade mark;

- \$ the granting of a security interest (whether fixed or floating) over a registered trade mark or any right in or under it;
- \$ the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it (an assent is a release by an executor or legatee); and
- \$ an order of a court or other competent authority transferring a registered trade mark or any right in or under it.

In the case of pending marks, a request to enter particulars of one of the above transactions in the register is, under Section 27(3) of the Act, regarded as giving the Registrar notice of those particulars. This means the transaction does not take effect until the application is registered.

#### **4.1 Assignments**

**References:** *Act: Sections 24-25*                      *Rules: 40-41*                      *Form: TM16 +fee*

An assignment is the transfer of ownership of a mark from the registered proprietor to someone else. This includes changes of ownership such as company mergers, changes of partners in partnerships at will, and changes of trustees where the mark is registered in the name of trustees. The new owner must apply to the registrar for the assignment to be entered on the register.

An assignment request must be signed by, or on behalf of, **both parties** to the transaction (*Section 24(3) and Rule 41(2)(a)*). If one of the parties is in liquidation or receivership, for example, we will accept the signature of the liquidator or Official Receiver. If either (or both) party cannot sign the request, we require sight of satisfactory documentation (such as the deed of assignment) to verify the transaction (*Rule 41(2)*). Such documentation must corroborate the names of the assignor and assignee shown on the form TM16 and be signed by someone authorised to act in their name.

Rule 40(a) requires that the following shall be entered in the register:

- \$ the name and address of the assignee;
- \$ the date of the assignment; and
- \$ in the case of a partial assignment (see below), a description of the right assigned.

If we are not notified of the transaction within six months of it taking place, we also record the date when we received such notification as the ‘effective filing date’ (*Section 25(4) refers*).

#### **Partial assignment (also called ‘splitting’ a mark)**

Section 24(2) provides for the partial assignment of a registered mark for:

- \$ some but not all of the goods or services; or
- \$ use of the mark in a particular manner or a particular locality.

It is not possible to split a series of marks.

Once a mark is split, each part becomes a registration in its own right, identified by a single-letter suffix, and must be separately renewed.

## Stamp Duty

Assignments which took place before 28 March 2000 may be subject to Stamp Duty. Advice about whether Stamp Duty is applicable should be referred to the appropriate Inland Revenue Stamp Office (their Helpline is). 0300 200 3510

## 4.2 Licences

**References:** *Act: Sections 25 & 28-31 Rules: 40-41 Form: TM50 TM51*

A mark may be used by someone other than the registered proprietor with the latter's agreement. The Act provides licensees with rights, in particular circumstances, to take action themselves against anyone infringing the mark. By registering licensees, the proprietor indicates who may use his mark and this information clarifies the position for third parties.

### Limited licence

Section 28(1) provides for a licence to be limited, for example, in relation to:

- \$ some but not all of the goods or services; or
- \$ use of the mark in a particular manner or a particular locality.

Licences can be of three types:

### Exclusive

An exclusive licence is a licence (which may be general or limited, as above) granted by the registered proprietor **to the exclusion of all others including himself**. An exclusive licensee has the same rights against any subsequent proprietor who is bound by the licence as he has against the person granting the original licence (*Section 29(2)*).

### Non-exclusive

A non-exclusive licence is a licence (which may be general or limited, as above) granted by the registered proprietor to any number of other persons, permitting them to use the same mark.

### Sub-licence

Where a licence so provides, a sub-licence may be granted by the licensee to a third party. References in the Act to a licence or licensee include a sub-licence or sub-licensee (*Section 28(4)*).

Rule 40(b) requires that the following shall be entered in the register:

- \$ the name and address of the licensee;
- \$ whether the licence is exclusive;
- \$ whether the licence is limited, and what that limitation is; and
- \$ the duration of the licence.

Form TM50 is used to record a licence, and form TM51 to amend or delete a licence.

## 4.3 Other registrable transactions

**References:** *Act: Section 25*

**Rule: 40**

**Form: TM24**

The following registrable transactions may also be entered in the register:

**a) The grant of a security interest over a registered trade mark or any right in or under it**

Rule 40(c) requires that the following shall be entered in the register:

- \$ the name and address of the grantee;
- \$ the nature of the interest (whether fixed or floating); and
- \$ the extent of the security and the right in or under the mark secured.

**b) The making by personal representatives of an assent in relation to a registered trade mark or any right in or under it**

Rule 40(d) requires that the following shall be entered in the register:

- \$ the name and address of the person in whom the mark or any right in or under it vests by virtue of the assent; and
- \$ the date of the assent.

**c) An order of a court or other competent authority transferring a registered trade mark or any right in or under it**

Rule 40(e) requires that the following shall be entered in the register:

- \$ the name and address of the transferee;
- \$ the date of the order; and
- \$ where the transfer is in respect of a right in the mark, a description of the right transferred.

Form TM24 may also be used to record, cancel or amend a memorandum or statement relating to a mark (*Rule 39(g)*). It must not be used to record assignments or licences (see above).

## **5 Other amendments to the register**

The section is also responsible for the following register maintenance functions:

### **Recording voluntary disclaimers or other limitations**

**References:** *Act: Section 13*

**Rule: 24**

**Form: Not applicable**

The proprietor of a registered mark may:

- \$ disclaim any right to the exclusive use of any specified element of the mark; or
- \$ agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

by giving us notice in writing.

Although disclaimers and limitations are voluntary, we have a responsibility to ensure that the proposed entry in the register is:

- (a) not so ambiguous as to give rise to serious legal uncertainty – in other words, it must be possible to understand what is being disclaimed or what limitation of rights is being introduced;
- (b) a disclaimer or limitation of rights and not something else, such as an amendment of the registered trade mark (in this connection, see the [judgment of the Court of Appeal](http://www.hmcs-judgments.service.gov.uk/HMCSJudgments/View.do?id=2716&searchTerm=nestle&ascending=false&index=0&maxIndex=0) [link to <http://www.hmcs-judgments.service.gov.uk/HMCSJudgments/View.do?id=2716&searchTerm=nestle&ascending=false&index=0&maxIndex=0>] in *Nestle v Mars (POLO mint)*, reported as [2005] RPC 5, page 77).

We will make the appropriate entry in the register and publish such disclaimer or limitation.

### **Merging applications or registrations**

**References:** *Act: Section 41(1)(b)*                      *Rule: 20*                      *Form: TM17*

It is possible to merge completely separate applications if the marks:

- \$ are the same, that is, identical; and
- \$ are in the same ownership; and
- \$ have the same filing date,

but applications cannot be merged after preparation for publication and before registration.

It is possible to merge completely separate registrations or split marks (see paragraph 6.1 above) if the marks:

- \$ are the same, that is, identical; and
- \$ are in the same ownership.

If the registrations to be merged have different dates, the merged registration will take the date of the **latest** registration.

Because it is cheaper to renew a multi-class registration than separate single class registrations of the same mark, proprietors frequently apply to merge registrations when they renew their marks. We **strongly recommend** that they apply to merge marks at least a month before renewal is due, so that we have enough time to complete our computer and manual checking processes.

### **Altering a registered mark**

**References:** *Act: Section 44*                      *Rule: 25*                      *Form: TM25*

A mark may only be altered if:

- \$ it includes the proprietor's name or address; and
- \$ the alteration is limited to alteration of that name or address; and
- \$ the alteration does not substantially affect the identity of the mark.

This means, for example, that a mark cannot be altered if it consists only of the proprietor's name or address; there must be other elements in the mark for an alteration to be allowed.

### **Examples**

1. A pictorial mark of a Scottish rural scene, such as a whisky label, including the address 'The Old Distillery, Aberdeen' in small print could be changed to 'The New Distillery, Glasgow', because the mark **includes** an address and the alteration would not substantially affect the identity of the mark.
2. If a proprietor called CRABTREE EVELYN changed their name to CRABTREE & EVELYN and wanted to change their mark 'CRABTREE EVELYN Song de Chine' to 'CRABTREE & EVELYN Song de Chine', this could be allowed because the mark **includes** the proprietor's name and that name would still be seen as two separate surnames. The addition of the ampersand emphasises this but would not substantially affect the identity of the mark.
3. However, if the mark had been 'EVELYN CRABTREE Song de Chine' and the request was to alter it to 'EVELYN & CRABTREE Song de Chine', this would **not be allowed** because the original mark would be seen as containing a person's name, whilst the altered mark would be clearly seen as two surnames. In this case the alteration would substantially affect the identity of the mark.

### **Surrender, or partial surrender, of a registration**

**References:** *Act: Section 45*                      *Rule: 26*                      *Form: TM22 (Full)*  
*TM23 (Partial)*

A proprietor can give up their rights in a trade mark, either in its entirety or in part. They must tell everyone who has an interest in the mark, for example, any licensees, that they intend to do so three months before they apply to surrender and declare that they have done so on the form.

**Once a mark has been surrendered, it cannot be restored to the register.**

### **Rectification or correction of the register**

**References:** *Act: Section 64(1)*                      *Rule: 34*                      *Form: TM26(R)*

Law Section checks all rectification requests and processes those made by someone other than the proprietor of the mark, or where there is an issue concerning ownership of the mark. All other requests, such as correcting simple errors or name or address details, are processed by Register Maintenance Section. Rectification does not include correcting irregularities in procedure in the Office, such as omitting goods from a registration, which are dealt with under Rule 66.

### **Changes of name or address of proprietor**

**References:** *Act: Section 64(4)*                      *Rule: 44(1)*                      *Form: TM21*

Changes in the proprietor's name or address should be requested on form TM21; changes in the ownership of a mark must be recorded as an assignment (form TM16). We will query where we believe a form TM21 has been filed by mistake in such circumstances, for example, changing from an individual to a company name, and *vice versa*. Changes will normally affect all marks

owned by the proprietor, though we recognise that, in some circumstances, a request may be made to change only some of the marks owned.

We will also query changes to an applicant's name, and may require the person making the request to provide a witness statement to justify their request.

**Note:** Form TM21 may also be used to request other changes to an application after publication; in these circumstances, the form is processed by Law Section.

### **Changes of name or address for service**

**References:** *Act: Section 64(4)*                      *Rule: 44(2)*                      *Form: TM33*

An applicant or proprietor may appoint or change an agent, or simply change their address for service, at any time during the prosecution of an application or after the registration of a mark. They should notify us of the marks affected, using form TM33.

Where a firm of agents or attorneys changes its name or address and wants all the records for which it is the address for service altered, they should write and tell us by letter rather than use multiple forms TM33.

## **6 Certified copies**

**References:** *Act: Section 63(3)*                      *Rule: 43*                      *Form: TM31R +fee*

We may issue a certificate verifying the details of applications or registrations. These are known as certified copies. If a certificate needs to be legalised by the Foreign Office for use in a particular country, this should be stated on the form.

Certified copies may be requested for various reasons, the most common being:

- \$ for use in obtaining registration abroad;
- \$ to provide proof of ownership or licensing, perhaps in legal proceedings;
- \$ to provide proof of registration, renewal, assignment, etc. for foreign registries.

If anyone wants such details, but does not need to have them certified, it may be easier for them to use our internet search pages, where the register is freely available and may be printed out.

We cannot certify the details of applications for, or registrations of, Community or international marks. This can only be done by OHIM or WIPO respectively. However, we are prepared to issue a notice setting out what we believe is protected under an international registration for the purposes of the UK, which may help applicants in obtaining registration in some former UK territories which appear to have difficulty in accepting WIPO certificates.

## **7 Requests for information about applications and registered marks (Caveats)**

**References: Act: Section 67**

**Rule: 48**

**Form: TM31C +fee**

Anyone can ask for information about an application or registration, or to be advised when a particular event takes place in the life of an application or registration.

Information may be requested under the following categories:

CATEGORY	EVENT
A	Application is published or withdrawn, refused or deemed abandoned before publication.
B	Current or future formal opposition is filed against an application.
C	Application is registered or withdrawn, refused or abandoned after publication.
E	Registration is renewed or removed.
F	Full surrender or successful revocation results in the removal of a mark from the register.
G	An assignment application is received.
H	A mark is fully or partially assigned. Any other event takes place.

Each category requires a separate fee to be paid. When the specified event takes place, we will notify the person who made the caveat request.

These events can also be checked on the register available on our internet search pages.

We also provide a [free electronic caveat service](#) on our website. After registering, and saying which UK case or cases you are interested in, we will send an e-mail whenever any changes happen to the case. We will say when the case changes and what the reason for the change is. We cannot tell you when the case changes for a particular reason. If you want to know that, then you should continue to use form TM31C and the paid-for service described above.

## **8 Supplying copies of the register and documents held in the Registry**

**References: Act: Sections 63, 67 & 76(1) Rules: 42 & 50 Form: Not applicable +fee**

You may inspect the [register of trade marks](#) on our website. You may also inspect all documents filed at the registry after 31 October 1994 in relation to:

- \$ an application filed on or after that date which has been published; or
- \$ a registered mark.

However, some documents may be excluded from this provision under the terms of [Rule 50](#), which provides a full list of excluded documents. These provisions take precedence over the disclosure provisions of the [Freedom of Information Act 2000](#), as they are one of the exemptions under section 44 (1)(a) of that Act.

### **To view documents**

Files may be viewed in London or Newport, but requests should be made through the Central Enquiry Unit. Adequate notice of personal visits should be given, to allow files to be retrieved. There is a handling charge for each file requested, which includes the cost of any copies taken.

### **To obtain copies of documents**

Copies of the above documents may be provided in response to requests by:

\$	Letter to:	Trade Marks Sales The UK Intellectual Property Office Cardiff Road NEWPORT NP10 8QQ
\$	Phone	01633 811191
\$	Fax	01633 811415
\$	E-mail	tmsales@ipo.gov.uk

If a request for copies of documents is made by an agent who takes over a pending application, we will ask the new agent to provide the **applicant's written specific approval** to release copies of correspondence between the registry and the former agent. We do not charge for copying in these circumstances.

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## **1. INTRODUCTION**

### **1.1 Purpose of this chapter of the work manual**

The purpose of this chapter of the manual is to outline procedures and give guidance on inter partes proceedings by:

- Clearly defining the different types of proceedings
- Indicating the sections of the Trade Marks Act 1994 (the Act) and the Trade Marks Rules 2008 (the Rules) which regulate each aspect of inter partes proceedings
- Setting out the requirements for the filing of documents, pleadings and evidence
- Detailing the practice of the Trade Marks Registry's Tribunal Section
- Detailing the activities of the Trade Marks Registry as a Tribunal
- Setting out the avenues for appeal against decisions by the Trade Marks Tribunal

### **1.2 Decisions of other Courts and Tribunals**

The management of inter partes actions under the Act must be by reference to the provisions of that Act, taking account, where appropriate, of existing practice as laid down or endorsed by appellate bodies.

#### **Court of Justice of the European Union (CJEU)**

Decisions of the CJEU on points of law are binding on the Tribunal. They are usually cases referred to the Court by EU member states for a 'preliminary ruling' on a point of law or cases on appeal from the General Court (GC).

#### **General Court (GC)**

Decisions of the GC on points of law are binding on the Tribunal and decisions of fact are of persuasive value in cases where similar considerations apply. The GC is used for appeals involving Community institutions such as the OHIM. There is the right of appeal from the GC decision to the CJEU.

#### **UK Courts**

These decisions are binding on the Tribunal.

#### **Appointed Person (AP)**

Decisions are not binding on the Tribunal other than in the case being dealt with. However they are of persuasive value in considering similar cases. These decisions are published on the Office website under '*HEARINGS (Results of past decisions)*'. Appointed Persons are experienced intellectual property law practitioners who are appointed by the Lord Chancellor. A decision of the Tribunal may be appealed to the Appointed Person (see section 7) but is not subject to further appeal.

### 1.3 Decisions of Tribunals/Courts in other Member States

Decisions of other national tribunals/courts within the EU may be of persuasive value in determining the meaning of the Directive based provisions of the Act, but they are not binding upon the Registrar. In *Wagamama* [1996] FSR 716, Laddie J. held that:

*"It would not be right for an English Court, if it is firmly of a different view, to follow the route adopted by the courts of another Member State simply because the other courts expressed a view first. The scope of European legislation is too important to be decided on a 'first past the post' basis."*

### 1.4 Accessing decisions

Decisions in earlier cases are available from several sources:

**British Library (BLs)** - all decisions of the Tribunal's Hearing Officers and the Appointed Persons are first published for dissemination through the British Library. Subsequently, and if they are of particular interest or importance, they may be republished in other legal reports such as RPCs, FSRs or ETMRs. Decisions are available from the IPO website at:  
<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

**Reports of Patent, Design and Trade Mark Cases (RPCs)** - these normally include reports of appeals to the courts and sometimes to the Appointed Person. They may also include decisions of the Tribunal where the decision contains statements of practice and interpretation of the law.

**European Trade Mark Reports (ETMRs)** - these contain reports from around the European Union (EU) by examination offices, tribunals & courts which bear upon the interpretation of the European Community Directive underlying all EU national and supranational trade mark law.

**Fleet Street Reports (FSRs)** - these also contain reports of intellectual property cases of interest and are published by Sweet and Maxwell.

### 1.5 Practice guidance

In addition to case law the Tribunal publishes the following practice guidelines:

**Tribunal Practice Notices (TPNs)** – these provide guidance for practitioners on how the Registrar is regulating tribunal activities and are incorporated within this chapter.

**Law Practice Directions (LPDs)/Patent Directorate Notices (PDN)** - LPDs and/or PDNs are published on the Intellectual Property Office website to notify practitioners and the public of any changes to, or clarification of, internal guidelines.

## 1.6 The role of the Tribunal and its inherent power to regulate procedures

The inherent jurisdictions of the Tribunal to act in inter partes matters are defined in *Pharmedica*<sup>1</sup>, when Pumfrey J stated:

*“Notwithstanding the fact that the Registrar is, like the County Court, a tribunal which is established by statute, I have no doubt that the Registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her.”*

In inter partes proceedings the Tribunal is acting in a quasi-judicial capacity. Those who represent it must remain impartial at all times and are therefore unable to advise litigants on the strength or weakness of their cases.

The Tribunal can help on matters of procedure but not substance. This was made clear by the Appointed Person in the *Trocadero* case (BL O/440/99) in which it was held that it is not for those arbitrating these disputes to become involved in ‘debate’:

*“10) Accordingly, in relation to opposition and revocation proceedings, the Registrar’s officers cease to perform an administrative function and act solely in a judicial (or quasi judicial) capacity. The distinction is I believe an important one, particularly in the circumstances of the present case. When acting in an administrative capacity, the Registrar has to enter the debate with the applicant, has to reason with him and necessarily will engage in correspondence or in conversations with the applicant in order to seek to resolve any matters arising. If this can be done to the applicant’s satisfaction, there is no need for a hearing.*

*11) Once the Registrar begins to perform his judicial function, the position is different. The Registrar or his officer is acting as a judge. The proceedings are adversarial, the issues are circumscribed by the pleadings and the parties are free to adduce the evidence and the arguments that they wish. It is the Registrar’s duty to adjudicate upon the issues raised. It is not his duty and, indeed, it would be wrong for him, when exercising this function, to enter into a debate with either party as to the validity or otherwise of the contentions put forward on any of the issues raised in the proceedings.”*

In correspondence, initial views may be expressed by the Tribunal on the basis of what the parties have said up to a particular point. An example would be in relation to a request for an extension of time. It must be stressed that an initial view does **not**

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<sup>1</sup> [2000] RPC 536, page 541

represent a final determination of the matter, which may come after a hearing or written submission.

### 1.7 The Civil Procedure Rules

In its role as a tribunal, the Tribunal adheres to the same overriding objective as the court for dealing with cases justly. This is set out in rule 1.1 of the Civil Procedure Rules 1998 (as amended) and includes, so far as is practicable:

- (2) (a) Ensuring that the parties are on an equal footing
- (b) Saving expense
- (c) Dealing with the case in ways which are proportionate –
  - (i) to the amount of money involved
  - (ii) to the importance of the case
  - (iii) to the complexity of the issues and
  - (iv) to the financial position of each party
- (d) Ensuring that it is dealt with expeditiously and fairly and
- (e) Allotting to it an appropriate share of the court's resources, while taking into account the need to allot resources to other cases

### 1.8 Procedures before the Tribunal

- 1) Opposition
- 2) Revocation (on grounds of non-use)
- 3) Revocation (on grounds other than non-use)
- 4) Invalidation
- 5) Rectification

### 1.9 Responsibility of one party to another

The rules require the Tribunal to send copies of the forms commencing an action to the other party; the same is true of any defence filed. However, the Tribunal will not, as a matter of course, copy any other document. Disputes before the Tribunal are *inter partes*, which means that the Tribunal is acting as an impartial adjudicating body between two (or more) parties. To ensure fairness and transparency of proceedings, **it is imperative that any correspondence, including forms, sent to the Tribunal are copied to the other side and contain confirmation that it has been so copied.** Failure to indicate copying and failure to copy is detrimental to the other side and to the resources of the Tribunal and its ability to allot resources to other users fairly. Copying of correspondence also applies to statutory forms. In particular, failure to copy requests for extensions of time can create unnecessary complications if time is granted and the other side has hitherto been unaware of the request. Similarly, failure to copy evidence to the other side, which is a requirement of rule 64(6)(b), results in the evidence not being considered filed.<sup>2</sup> If parties

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<sup>2</sup> TK PATROL, BLO/426/02, Paragraph 7

persistently fail to copy correspondence and documents to the other side, this will be regarded as unreasonable behaviour and there may be cost implications at the conclusion of the proceedings.

An increasing proportion of litigants using the Tribunal are without professional legal representation. The Tribunal provides information on its procedures on the IPO's website and would expect users to look at this information prior to contacting the Tribunal. However, the Tribunal recognises that unfamiliar legal territory sometimes gives rise to questions. We will give reasonable information about procedures and clarification of directions but all parties using the Tribunal have a duty to respect its inter partes nature. This means that the **Tribunal will not enter into telephone debates or give further reasons for a preliminary view (for example on extension of time requests) to just one party over the telephone**. Such calls will be terminated because the other side is not party to the discussion. If a party disagrees with the other side's/Tribunal's view on a particular procedural issue, then it must **put its comments in writing (either by letter or email), copied to the other side**. Both for reasons of fairness and efficient use of the Tribunal's resources, its officers will terminate telephone calls when their nature ceases to be appropriate, whether that is because of the content or the length of time the call is taking.

### **1.10 Right to Appeal**

(Full details of appeal procedure can be found at section 7).

Under the Act any decision of the Tribunal can be appealed to the Court or to the Appointed Person.

### **1.11 Tribunal contact points**

Inter partes proceedings are handled by the Tribunal Section. If you have a telephone query then you can expect a response within normal business hours - 9.00am - 5.00pm. The general enquiry number is: 0300 300 2000. Alternatively you can send an email to [tribunalsection@ipo.gov.uk](mailto:tribunalsection@ipo.gov.uk)

## **2. FORMALITIES**

### **2.1 Address for service**

*Rule 11 of the Trade Marks Rules 2008*

For the purposes of any proceedings under the Act or Rules an address for service in the UK, Channel Islands, or another EEA state, must be filed.

Failure to file an address for service may result in a party being considered by the Tribunal as having not defended or withdrawn from the proceedings or may result in an opposition or cancellation action being struck out.

### **2.2 Hours of business and excluded days**

*Section 80 of the Trade Marks Act 1994*  
*Rule 80 of the Trade Marks Rules 2008*

Section 80 of the Act provides that the Tribunal may give directions specifying the hours of business and the days which are 'business days'.

Business done after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

Rule 80 requires the Registrar to publish, on the IPO website, any directions which may be given in relation to specified hours and business days.

The Registrar has made the following Directions<sup>3</sup> under section 80(1) which came into force on 15 July 2011:

- Trade Mark applications which do not claim priority under section 35 or 36 can be filed at all times on every day of the week including weekends, public holidays and bank holidays
- All other forms, applications and other documents can be filed at all times from Monday to Friday
- The Office shall be open from Monday to Friday between 09:00 and 17:00 for all other types of business not detailed above
- For all purposes under the Act, other than the filing of new trade mark applications without a priority claim, the following shall be non-business days: All Saturdays and Sundays, Good Friday, Christmas Day and any day which is specified or proclaimed to be a bank holiday in or under section 1 of The Banking and Financial Dealings Act 1971<sup>4</sup>

### **2.3 Interruptions to the normal operation of the Office and/or the postal service**

#### *Rules 75 and 76 of the Trade Marks Rules 2008*

Rule 75 allows the Registrar to certify that a day or days have been subject to 'interruption' and accordingly, if any period of time specified in the Act or Rules

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<sup>3</sup> In these Directions:

'the office' means the Patent Office;

'business' means business transacted by the public under the Act or any class of such business;

'non-business day' means a day excluded for any such business or class of business;

'applications' means applications for trademarks filed under the Act.

'forms' means documents containing the information required by the relevant Trade Marks Forms as set out in Directions under Section 66 of the Act.

The Directions of the same title which were given in November 1994 and came into force on 31 October 1994 are revoked.

<sup>4</sup> Except for the filing of applications in respect of which no declaration for the purpose of sections 35 or 36 of the Act is made.

expires on such a day, then that period shall be extended to the next following day not being an 'interrupted' or 'excluded' day<sup>5</sup>.

Rule 76 allows the Registrar to extend any time limit specified under the Rules where the Registrar is satisfied that the failure to do something was wholly or mainly attributable to a delay in, or failure of a communication service<sup>6</sup>. For example, if a person uses a postal service which guarantees next-day delivery but the documents do not actually arrive at the Office until a later date, the Registrar may invoke rule 76, if the person can provide proof of such postage. The effect of invoking rule 76 will mean that the documents will be deemed to have been filed on the date that the postal service had guaranteed.

## 2.4 Filing of documents

*Rules 2(3), 78 and 79 of the Trade Marks Rules 2008*

The terms 'to file' or 'filing' means to 'deliver to the Registry'.

- Documents can be filed by post, facsimile, email, in person or by courier to either, the London or Newport Offices
- The fax number recommended to be used for all **fee-bearing forms**, is 01633 817777
- The Trade Marks Tribunal Section fax number, 01633 811175 or e-mail address, [tribunalsection@ipo.gov.uk](mailto:tribunalsection@ipo.gov.uk), can also be used for all other **non-fee bearing** forms and documents in relation to trade marks inter partes proceedings
- Certain forms must be filed using the e-Form provided on the IPO website e.g. TM7A

Regardless of the method by which documents are filed, they will be dealt with in order of date of receipt.

### **Faxed documents in inter partes proceedings**

Documents filed by facsimile in inter partes proceedings should not be supported by confirmation copies through the normal postal system, **unless specifically requested**. The Tribunal will assess whether the facsimile copies received are of good enough quality and only if they are not will the originals be requested.

Where a party wishes to file non-standard size items as exhibits, or where colour may be an important factor, filing facsimile documents is not appropriate and such evidence should be filed through the normal postal system or by hand/courier.

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<sup>5</sup> 'excluded day' means any day which is not a business day as specified in a direction given by the registrar under Section 80; and

'interrupted day' means any day which has been certified as such under Rule 75(1).

<sup>6</sup> 'communication service' means a service by which documents may be sent and delivered and includes post, facsimile, e-mail and courier.

## 2.5 Use of email

The Tribunal has no objection to the use of email communication, provided it is copied to the other side and marked as such. The Tribunal will deal with all correspondence in date order regardless of the method of filing. Emailed correspondence will not be answered out of turn merely because it has been electronically mailed.

## 2.6 Forms and fees in inter partes proceedings

The following table lists the forms which are applicable in inter partes proceedings before the Tribunal Section. All fee-bearing forms must be accompanied by that fee at the time of filing. The forms, guidance notes and current fees can be accessed at the following link: <http://www.ipo.gov.uk/types/tm/t-formsfees.htm>

FORM	PURPOSE
<b>TM7a - Notice of Threatened Opposition</b>	The form filed by anyone seeking to extend the opposition period to three months beginning immediately after the date of publication of the application. <b>It must be filed on-line through the Office website.</b>
<b>TM7- Notice of Opposition</b>  <b>TM7F- Notice of Fast Track Opposition</b>  <b>TM7G - Request to add grounds to a notice of opposition</b>	The forms filed to launch opposition proceedings against a trade mark application.  The form which must be used to make a request to add grounds <b>other than</b> 5(1)/5(2) to an existing opposition.
<b>TM8 - Notice of defence and counterstatement</b>	The form which must be filed by the applicant if they wish to defend their application from opposition proceedings. It must also be filed by the registered proprietor in invalidation, rectification and revocation (other than non-use) if they wish to defend their registration. In all cases, the form must include a counterstatement.

<b>TM8(N) - Notice of defence and counterstatement in revocation (on the grounds of non-use)</b>	The form which must be filed by the registered proprietor in revocation proceedings (on the grounds of non-use) if they wish to defend their registration. It must include a counterstatement.
<b>TM9 - Request for an extension of time</b>	The form which must be filed by a party seeking to request an extension of time to a statutory period. However, parties should note that there are certain periods which cannot be extended (these are listed in Schedule 1 of the Trade Marks Rules 2008).
<b>TM9C - Request to enter the cooling-off period</b>	The form which must be filed in opposition proceedings if both parties wish to enter into the cooling-off period for the purpose of negotiating a settlement.
<b>TM9E - Request to extend the cooling-off period</b>	The form which must be filed in opposition proceedings if both parties wish to extend the cooling-off period for the purpose of negotiating a settlement.
<b>TM9T- Request to terminate a cooling-off period</b>	The form which must be filed by the Opponent in opposition proceedings to terminate the cooling-off period.
<b>TM21B - Request to change the details of an application</b>	The form which must be used when the applicant for a trade mark wishes to amend the goods/services covered by their application.
<b>TM22 - Notice to surrender a registration</b>	The form which must be used by the registered proprietor to surrender their registered mark in full.
<b>TM23 - Notice of partial surrender of a registration</b>	The form which must be used by the registered proprietor to surrender <b>only some</b> of the goods/services covered by their registered mark.
<b>TM26(I) - Application to declare invalid a registration or a protected international trade mark (designating</b>	The form which must be used by an applicant for invalidity to apply to remove a trade mark from the register.

the UK)	
<b>TM26(N) - Application to revoke a registration or a protected international trade mark (designating the UK) for reasons of non-use</b>	The form which must be used by an applicant for revocation to try and remove a trade mark from our register on the basis that it has not been used.
<b>TM26(O) - Application to revoke a registration or a protected international trade mark (designating the UK) for reasons other than non-use</b>	The form which must be used by an applicant for revocation to remove a trade mark from our register on the basis that the mark has become common in trade, for the name for a good or service for which it is registered, or where it is likely to mislead the public.
<b>TM26(R) - Application to rectify the register.</b>	The form which can be used to rectify an error or an omission in the details of a registered mark. It can be filed by the registered proprietor or anyone who can show that they have a 'sufficient interest' in the mark.
<b>TM27- Application to intervene in proceedings</b>	The form which must be used by a party, other than the registered proprietor, who claims to have an interest in a registered trade mark and that party wishes to take part ('intervene') in those proceedings.
<b>TM29 - Application to set aside a decision</b>	The form which must be used to apply to set aside a decision issued in inter partes proceedings.
<b>TM53 - Request to proceed to evidence rounds</b>	The form which must be used in opposition proceedings to notify the Tribunal that one or more of the parties wishes to proceed to the evidential rounds, after the Tribunal has issued a preliminary indication.
<b>TM55P - Notice of Appeal to the Appointed Person</b>	The form which must be used when a party wishes to appeal against a decision of the Tribunal <b>to the Appointed Person.</b>  (This form is not to be used if the party wishes to appeal to the Court.)

## 2.7 Payment of fees

*Rule 2 of the Trade Marks (Fees) Rules 2008*

Rule 2 of the Trade Marks (Fees) Rules 2008<sup>7</sup> provides that forms requiring payment of a fee **must be accompanied by that fee**. The fee must be filed at the same time as the relevant form. The term ‘accompany’ does not allow for the fee to follow shortly after the form is filed.<sup>8</sup> The Tribunal will accept instructions such as, ‘Please debit our deposit account, being account number x’ however the party must ensure that the account contains sufficient funds, at the time of filing the form, to allow the fee to be taken. Payment can also be made by cheque, payable to ‘The Patent Office’, credit/debit card, bank transfer or other means acceptable to the Office.

## 3. PROCEDURES BEFORE THE TRIBUNAL

### 3.1 Opposition

*Section 38 of the Trade Marks Act 1994*  
*Rules 17, 18, 19, 20, 21 and 43 of the Trade Marks Rules 2008*

Once an application for registration has been examined and accepted by the Registry, it is published in the Trade Marks Journal. Once published, an application is open to opposition. Opposition may be filed in respect of all, or only some, of the goods and/or services for which registration of the trade mark is sought. The opposition period is two months but may be extended to 3 months.

Generally, oppositions are based upon section 3 and/or section 5 of the Act which set out absolute and relative grounds for refusal of registration. These sections should not be confused.

**Section 3 of the Act:** relates to an *absolute ground*; that is, generally speaking, something inherent in the mark itself which prohibits it from being registered.

**Section 5 of the Act:** relates to *relative grounds*; that is, where registration of the trade marks would impinge upon another person’s existing marks or rights.

Opposition based upon section 5 (relative grounds) can only be launched by the owner of the mark or right(s) on which the opposition is based. (Other parties who may have an interest in the proceedings, e.g. a licensee, would have to intervene after the proceedings were joined, (see section 4.10 for intervention).

The publication in the Trade Marks Journal of the following is also open to opposition:

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<sup>7</sup> The Trade Marks (Fees) Rules 2008 replaced and revoked the Trade Marks (Fees) Rules 2000. Rule 2 of the Trade Marks (Fees) Rules 2008 is equivalent to what was Rule 3 of the Trade Marks (Fees) Rules 2000.

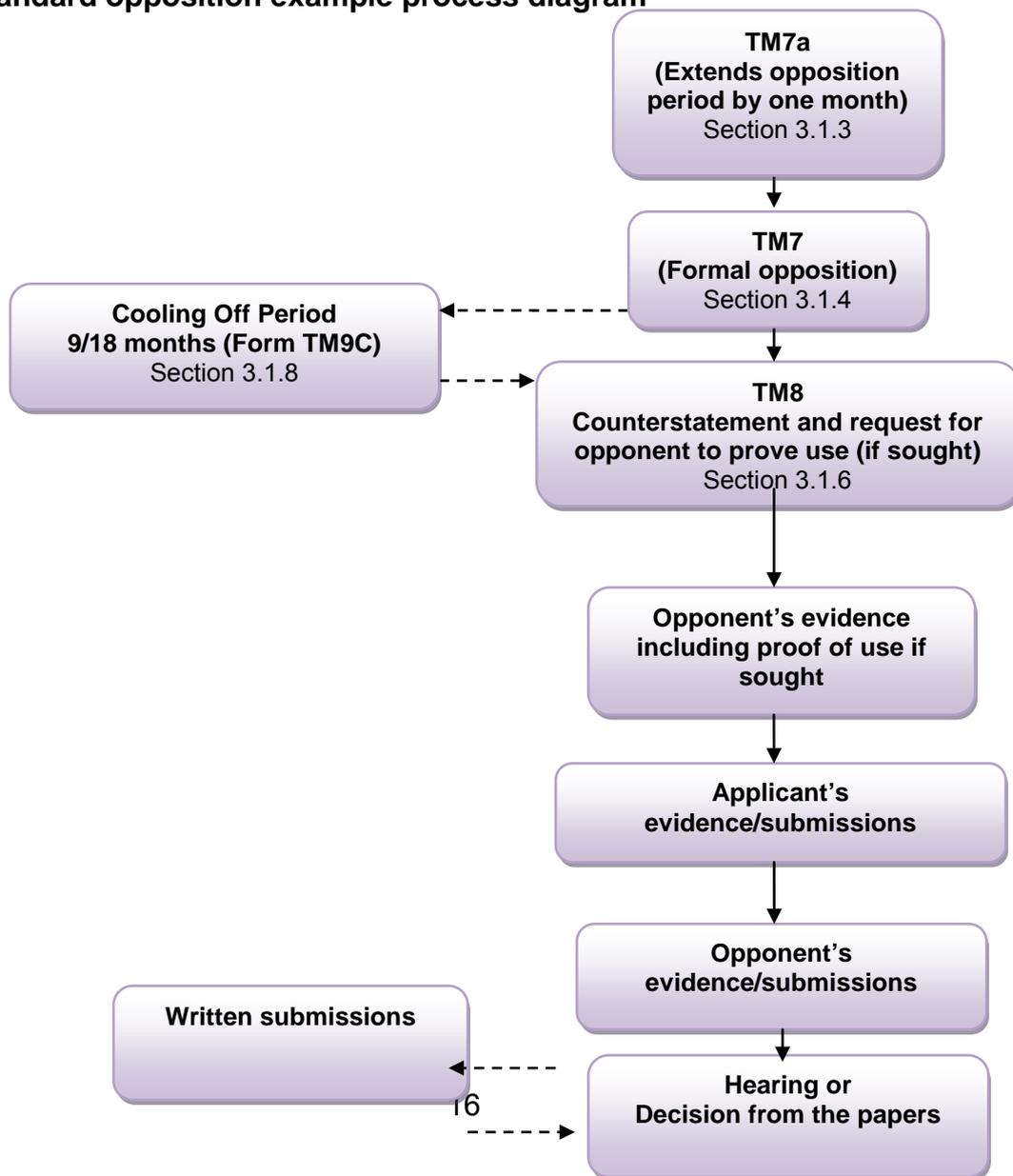
<sup>8</sup> *TITAN* (BL O/460/01). This case related to the filing of a Form TM7 in opposition proceedings, where insufficient funds were present in the opponent’s deposit account to pay the fee which must accompany the TM7.

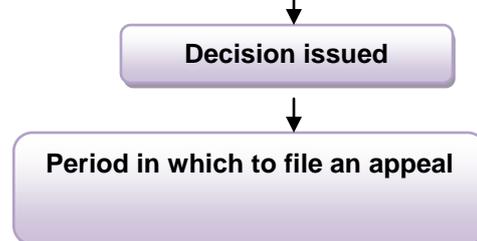
- a. Applications amended after publication (rule 25(2))
- b. Regulations for collective/certification marks applied for under the 1994 Act (paragraph 8 schedule 1, paragraph 9 schedule 2)
- c. Amendment of regulations of collective/certification marks (rule 30(4))
- d. Amendments to registered marks (rule 32(3))
- e. Removal of matter from the register (rule 53(2))
- f. Reclassification of marks (rule 55(1))

Any person who wishes to lodge an opposition against any of the above should file Notice of Opposition on a TM7 with the appropriate fee within the period allowed. For "b" "c" "d" "e" and "f" above, the period for lodging opposition is two months. For "a" above, the period is one month.

It should be noted that under the provisions of rule 77(5), no extension of the opposition period is allowed for lodging opposition.

### 3.1.1 Standard opposition example process diagram





OTHER RELEVANT ISSUES	
<b>Defences</b>	Section 4.5/6
<b>Evidence</b>	Section 4.8
<b>Partial refusal</b>	Section 4.11
<b>Case Review</b>	Section 4.2

### 3.1.2 Notice of opposition

*Rule 17 of the Trade Marks Rules 2008*

Any party wishing to oppose a published mark has a period of two months beginning immediately after the date of publication within which to indicate their intention to oppose the published mark on a TM7a or to launch a formal opposition on a TM7.

At the end of the two month period following publication in the trade mark journal every mark that has had neither a TM7a nor a TM7 filed against it will proceed to registration.

### 3.1.3 TM7a

The TM7a is, in effect, a request for an extension of the period for filing the TM7. It must be filed within the two month period allowed for opposition and must be filed electronically using the system provided on the IPO website. Upon acceptance of this form the party filing it has an additional one month in which to file the TM7 to formally commence opposition proceedings. Where the TM7a is filed by a company, the TM7 may be filed by a subsidiary or holding company of that company.

### 3.1.4 TM7

Where a TM7 is filed during the third month following the advertisement of the application a check is undertaken to ensure that the filer of the TM7 had previously filed a TM7a.

Formal notice of opposition must be filed at the Tribunal on a TM7 which should include a statement of grounds, setting out the basis of the opposition. The rules state that a fee is also required and must accompany the opposition documents.

Where the opposition is based on an earlier trade mark, a representation of that trade mark must be included.

In addition, if the mark relied on by the opponent constitutes an earlier trade mark as defined in section 6(1) and 6(2) of the Act; (i.e. a UK trade mark, an International trade mark (UK), a Community trade mark or an International trade mark (EC) which has a date of application or seniority earlier than that of the application in question taking into account priority dates) the following must also be provided:

- The jurisdiction in which the mark is registered or has been applied for
- The application or registration number of the mark
- The goods and services for which that mark is registered
- The goods and services on which the opposition is based and, where necessary
- A statement of use (if the opposition is based on an earlier registered mark, which has been registered for more than five years, the opponent will be required to state the goods and services for which the mark has been used during the relevant period or give any proper reasons for non-use during the relevant period)

or

- Where the mark is not registered and the opponent is utilising section 5(4)(a) of the Act, a representation of the mark must be provided with a list of the goods and services in respect of which protection is claimed together with details of when and where the earlier right was used including a date of first use

On receipt of the notice of opposition and other documents the Tribunal will scrutinise the statement of grounds in accordance with section 4.13.

## **THE PERIOD FOR FILING A TM7a AND/OR A TM7 CANNOT BE EXTENDED.**

### **3.1.5 Serving the notice (TM7)**

*Rule 18 of the Trade Marks Rules 2008*

The Tribunal will send the TM7 with the statement of grounds and any other documents to the applicant, by recorded delivery, at their last recorded address for service. The date on which these are sent is known as the “notification date”.

### **3.1.6 TM8**

The applicant has two months beginning immediately after the “notification date” in which to file a TM8, notice of defence, (no fee required), which should incorporate a counter-statement. The purpose of the counter-statement is to admit, deny with explanation or indicate that proof is required of any of the grounds set out by the opponent in its statement of grounds. If no TM8 is filed and there is no request for a

“cooling off” period (see section 3.1.7 below) within this two month period, the applicant is deemed to have abandoned his application for registration.

### **THE PERIOD FOR FILING A NOTICE OF DEFENCE ON A TM8 CANNOT BE EXTENDED.**

The Tribunal will send the TM8, incorporating the counter-statement, to the opponent at their last recorded address for service. The Tribunal will also notify the parties of the timetable for filing evidence.

#### **3.1.7 Failure to file a defence (TM8)**

*Rule 18 of the Trade Mark Rules 2008*

Where an opposition is undefended and only some of the goods and/or services have been opposed, the Tribunal will notify both parties that the application will be deemed to be abandoned in respect of the goods and/or services which were opposed on the TM7. The remainder of the application will proceed to registration. If all of the goods and/or services have been opposed, the entire application will be deemed abandoned.

Also see section 4.11 for full details of partial refusals.

#### **3.1.8 The Cooling Off period**

*Rule 18 of the Trade Marks Rules 2008*

If the parties wish to take advantage of a *further* period within which to negotiate a settlement, a request can be made on a TM9C (by either party) to extend the period for filing the counter-statement. The period allowed for filing a TM9C is two months beginning immediately after the “notification date”.

The cooling off period can only be initiated when both the applicant and the opponent(s) agree to it.

Taking advantage of the initial ‘cooling off’ period will give the parties nine months from the “notification date” to negotiate a settlement.

#### **Extension to the initial Cooling Off period**

*Rule 18 of the Trade Marks Rules 2008*

If the parties require additional time in ‘cooling off’, to continue negotiations, a TM9E can be filed to request a further extension of time for the filing of a TM8. This request can be filed by either party, but again, only if both parties agree to the further extension. Any request to extend a cooling off period must include a statement confirming that the parties are actively negotiating a settlement to the opposition proceedings.

This further extension of the 'cooling off' period will give the parties eighteen months beginning immediately after the "notification date" to negotiate a settlement. If the parties are unable to reach an agreement within the cooling off period (or extended cooling off period) and the applicant wishes to continue with its application it must file a TM8 incorporating a counter-statement before the expiry of the 'cooling off' period.

If the notice and counter-statement are not filed within the appropriate period, the applicant is deemed to have abandoned its application.

### **THE 'COOLING OFF' PERIOD CANNOT BE EXTENDED ANY FURTHER.**

Failure to resolve matters in the cooling off period does not fetter settlement negotiations which may continue in parallel to the proceedings. It is unlikely, however, particularly where the parties have had a period of eighteen months for cooling off, that a stay of proceedings will be granted unless there are extremely compelling arguments to show that successful conclusion of the proceedings is imminent and both parties agree to it.

#### **Early termination of the Cooling Off period**

*Rule 18 of the Trade Marks Rules 2008*

When the cooling off period has been entered but negotiations break down before it comes to an end the cooling off period should not be continued.

#### **Negotiations terminated by the opponent**

The opponent should file a TM9T, copied to the other party, to notify the Tribunal of their wish to terminate the cooling off period. The parties will be notified that the TM9T has been filed and confirmation of the date by which the TM8 must be filed by the applicant will be issued. The applicant will have a period of one month from the date of filing the TM9T, (or two months beginning immediately after the "notification date", whichever is the later), within which to file a TM8, incorporating a counter-statement, if they wish to continue with the proceedings.

#### **Negotiations terminated by the applicant**

In the event that the applicant wishes to terminate the cooling off period early they should file a TM8, incorporating a counter-statement.

### **3.1.9 Preliminary Indication**

*Rule 19 of the Trade Marks Rules 2008*

Where the grounds of opposition include sections 5(1) or (2) of the Act, the Registrar has the power to issue a Preliminary Indication (PI). The purpose of the PI is to provide the parties with an indication on a prima facie basis as to the likely decision in respect of those grounds of opposition (based on information currently before the Tribunal).

In accordance with rule 19(2), following the receipt of a counter-statement, the Tribunal will consider whether a PI is appropriate and the parties will be notified by letter. Preliminary indications are only issued where the Tribunal has reason to believe that they will bring the proceedings to an early conclusion. They are usually an indication that one side's case appears hopeless.

If a PI has been issued there are several ways in which the case may proceed:

### **Non-acceptance by the parties**

If either party does not accept the PI it has the right to formally give notice to that effect. The parties have a period of one month from the "indication date" to file a TM53 to give notice of their intention to proceed to the evidence rounds.

### **Acceptance by the parties**

If the parties accept the PI and it indicates total success to the opponent, the application will be refused. If the indication was that the opposition would fail in its entirety then the application will proceed to registration. In both cases the proceedings will be closed. The PI will be considered the final decision with no right to subsequent appeal under section 76 of the Act.

### **Additional grounds**

If no TM53 is filed by the opponent and the TM7 specifies grounds other than sections 5(1) and 5(2), then the opposition will proceed on the additional grounds with the 5(1)/(2) grounds being deemed to have been withdrawn.

### **Partial success/failure**

Where the PI indicated partial success and no TM53 is filed by either party, how much of the application will proceed to registration will depend upon how much of the specification(s) was originally opposed on the TM7 and how much of the contested specification was liable to be refused according to the PI. Where straightforward deletion of goods/services overcomes the objection<sup>9</sup> those goods/services which can be deleted simply will be removed and the application will be allowed to proceed to registration.

In some cases the amendment of the specification will not be able to be resolved by straightforward deletion of goods/services to overcome the objection. In these circumstances the applicant will be allowed a further period, of one month, within which to file a TM21 to restrict their goods and/or services to those for which it appeared the mark could be registered. Failure to file the TM21 within the time period specified will result in the application being refused for the entirety of the goods and/or services opposed.

In accordance with rule 19(7) the Tribunal need not give reasons for a PI, nor is it subject to appeal.

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<sup>9</sup> *SENSORNET* (BL O/136/06) at paragraph 57

### 3.1.10 Proof of use in opposition proceedings

The period of five years during which use must be shown of the earlier trade mark is the five years ending on the date of publication of the application under opposition. This obligation only applies to registered marks and therefore proof of use may not be requested for unregistered rights claimed under section 5(4) of the Act or well known marks protected under article 6bis of the Paris Convention.

Section 100 of the Act states:

*“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”*

This establishes an obligation for the registered proprietor of a trade mark to show that it is using its mark in a genuine manner. Thus on the TM7 there is a section for the opponent, basing their action on marks registered for five years or more at the date of publication of the opposed mark to state on which goods and/or services their trade mark is used or, in the alternative, any proper reasons for non-use of the mark.

The statement may say *“To the best of my knowledge the trade mark has been used on all the goods and/or services for which it is registered”*. The party will be permitted to narrow the defence if it subsequently becomes clear that the mark has not been used on a good or service.

If evidence of use is required then this is **not** required immediately but should be filed with the opponents' evidence in chief (See section 4.8).

The Tribunal does not inquire of its own volition as to whether the earlier trade mark has been used or not, it is a matter for the applicant to request proof if it is required by him.

On the counter-statement the applicant must accept or require proof of the opponent's statement of use. If the applicant does not accept the statement of use, this will be taken as a requirement for the opponent to file evidence of use or evidence validating that there are proper reasons for non-use.

### 3.1.11 Evidence in opposition proceedings

*Rule 20 of the Trade Marks Rules 2008*

The Tribunal will specify the periods for each of the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified, and in certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

Failure to file evidence in respect of those grounds which are entirely dependent on evidence to support and substantiate the claims will result in the opponent being deemed to have withdrawn the opposition.

For full details of the procedure for filing evidence in proceedings before the registrar see section 4.8.2.1

### **3.1.12 Request to add additional grounds to a notice of opposition**

If an opponent wishes to add additional grounds, other than 5(1) and/or 5(2), to an opposition, they should file a TM7G 'Request to add grounds to a notice of opposition' with a fee of £100 at the earliest opportunity. Any request must contain full reasons to explain why the new grounds were not included in the original notice of opposition and why the request should be accepted. In the event that the request is rejected, the fee will not be refunded.

Requests to add additional grounds under Section 5(1) and/or (2) can be made by a letter or an email.

### **3.1.13 Fast Track opposition**

*The Trade Marks (Fast Track Opposition)(Amendment) Rules 2013*

The fast track procedure differs from the standard opposition procedure in a number of ways. For example, the fast track procedure:

- Limits grounds of opposition to Section 5(1) and/or 5(2) grounds only
- Limits opposition to maximum of three earlier registered or protected trade marks
- Requires the opponent to file proof of use with the notice of opposition if the earlier mark(s) has been registered for five years or more at the date of publication of the opposed mark in the Trade Marks Journal
- Requires that either party needs permission to file any further evidence
- Means that the Hearing Officer's decision will normally be made from the papers without an oral hearing

Upon receipt of a fast track opposition the Tribunal will serve the TM7F on the applicant who will have two months in which to either file a TM8 'notice of defence and counterstatement' or to make a request for 'cooling off'.

If the opposition is undefended and only some of the goods and/or services have been opposed, the Tribunal will notify both parties that the application will be deemed abandoned in respect of the goods and/or services which were opposed on the TM7F. The remainder of the application will proceed to registration. If all of the goods and/or services have been opposed, the entire application will be deemed abandoned.

If a notice of defence is filed, the TM8 will be served upon the opponent and the case will be ready for a written decision unless a request is received by either party to file evidence.

Any request to file evidence should provide a full description of what the evidence will show and set out the reasons why it is necessary. If the opponent makes such a request it should additionally explain why, having elected to use the fast track process which does not provide an automatic right to file (further) evidence, it now considers that an exception should be made for such evidence to be filed.

If permission to file evidence is granted then an evidential timetable will be set.

When the case is ready for a decision to be made, the Hearing Officer will decide whether an oral hearing is necessary or whether the decision can be made from the papers. If, in exceptional cases, the Hearing Officer decides that an oral hearing is necessary, a date and time will be sent to the parties.

Any request to be heard from the parties must explain why a hearing is felt to be necessary; proportionate to the cost to both parties and to the commercial value of the matter at stake.

If the request is made by the opponent, it should also explain what has changed since it opted to use the fast track procedure which does not normally include an oral hearing.

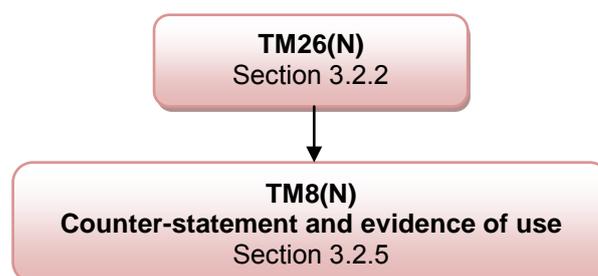
Further guidance on Fast Track Opposition is provided in Tribunal Practice Notice 2/2013 and the Fast Track User Guidance available from the web site.

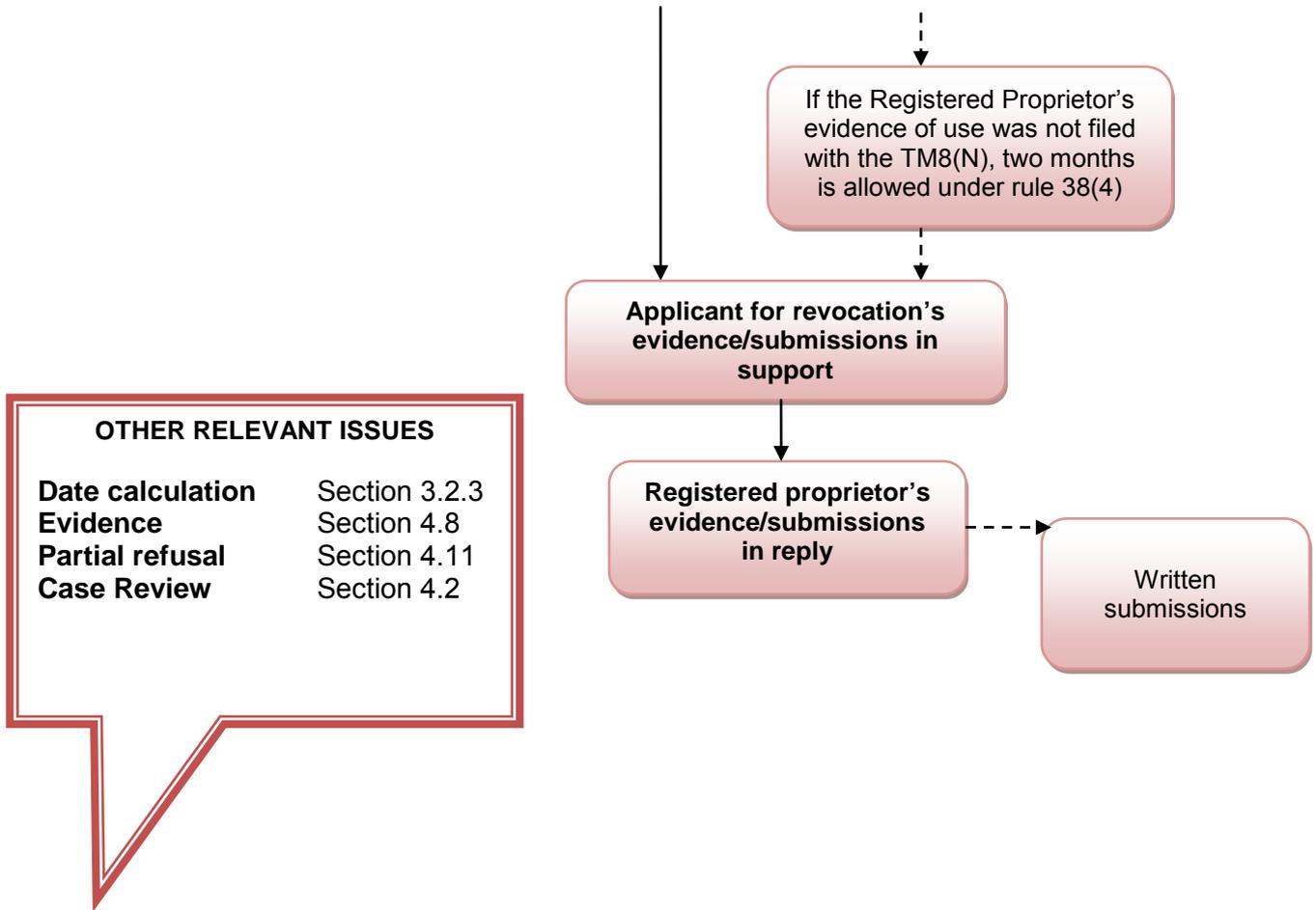
### **3.2 Revocation on grounds of non-use**

*Section 46 of the Trade Marks Act 1994  
Rules 38, 43 and 45 of the Trade Marks Rules 2008*

Revocation on grounds of non-use is the legal procedure which allows anyone to seek to remove a registered trade mark from the UK register because they think that the trade mark has not been used. It is possible to apply in respect of all or only some of the goods and/or services for which the trade mark is registered.

#### **3.2.1 Revocation (on grounds of non-use) example process diagram (see 3.2.7)**





### 3.2.2 Application for revocation (on grounds of non-use)

*Rule 38 of the Trade Marks Rules 2008*

An application for revocation on grounds of non-use may be made by anyone. It shall be made on a TM26(N). A fee is also required.

Boxes 5, 6, 7 and/or 8 establish the dates for which revocation is sought. Entering text such as “see attached statement of case” will be considered a failure to complete the application correctly and the form will be returned for correction.

### 3.2.3 Calculation of dates for revocation (on grounds of non-use)

The relevant sections of the Act are as follows:

**46(1)(a)** - The trade mark has not been used in the UK on the goods or services for which it is registered, either by the proprietor or by someone else with the proprietor's agreement in the five years since the trade mark was registered;

**and** there are no proper reasons why the trade mark has not been used.

**46(1)(b)** - The trade mark has not been used in the UK on the goods or services for which it is registered, either by the proprietor or by someone else with the proprietor's agreement for any uninterrupted period of five years after the completion of the registration procedure **and** there are no proper reasons why the trade mark has not been used.

By way of example, if the registration procedure was completed on 18 March 2000, the five year period would expire on 18 March 2005. An application for revocation for non-use could only be made after the latter date. The earliest date that an application for revocation could be made would therefore be 19 March 2005.<sup>10</sup>

Consequently, where an application for revocation on the grounds of non-use is made under section 46(1)(a), the applicant should ensure that it is made, at the earliest, on the day following the fifth anniversary of completion of the registration procedure. If the revocation action is successful, rights in the registration (partial or full) will cease to exist, under section 46(6)(a), on the day following the fifth anniversary of the completion of the registration procedure.

<b>Completion of registration procedure</b>	<b>Five year period in which to commence use starts</b>	<b>Five year period in which to commence use ends</b>	<b>Earliest date the revocation application can be made</b>	<b>Successful revocation date</b>
<b>18.3.2000</b>	19.3.2000	18.3.2005	19.3.2005	19.3.2005

In the case of a revocation action founded upon section 46(1)(b) of the Act, where the applicant claims that the mark has not been used in the five years prior to the application, section 46(6)(a) of the Act will also apply to a successful revocation. In this instance, if the application is made on 18 March 2005 and this is the revocation date that is sought, the five year period during which there was no use will run from 18 March 2000 to 17 March 2005.

<sup>10</sup> See Philosophy di Alberta Ferretti Trade Mark [2003] R.P.C. 15 and WISI Trade Mark [2006] RPC 17, paragraph 22

Completion of registration procedure	Application for revocation filed	Revocation date sought	Five year period in which no use of the mark	Successful revocation date
2.4.1998	18.3.2005	18.3.2005	18.3.2000 to 17.3.2005	18.3.2005

Revocation actions may also be brought on the grounds of section 46(1)(b), but for a five year period which does not coincide with the date of the application (that is, that section 46(6)(b) will apply). For example, if the applicant claims a revocation date of 18 March 2005, this means that the five year period for which there has been no genuine use of the mark will run from 18 March 2000 until 17 March 2005, with the rights of the proprietor ceasing to exist on 18 March 2005: the revocation date.

Application for revocation filed	Revocation date sought	Five year period in which no use of the mark	Successful revocation date
1.12.2006	18.3.2005	18.3.2000 to 17.3.2005	18.3.2005

If the application is made in respect of more than one date, care should be taken to ensure that all of the relevant dates are clearly indicated on the TM26N.

### 3.2.4 Serving the application

*Rule 38 of the Trade Marks Rules 2008*

The Tribunal will send the TM26(N) to the registered proprietor in accordance with rule 38(2). It will be sent by recorded delivery to the last registered address for service.

The onus rests with the registered proprietor to ensure that the relevant details attached to their registration are correct, in particular the name and address details along with the details of their legal representation. If an old and incorrect address is recorded on the register this cannot be regarded as a defence in the event of the failure to file a TM8(N) and counter-statement. In the event that the package sent by recorded delivery is undeliverable for any reason and is returned to the Tribunal during the two month period for filing a defence it will be resent via normal mail. The date for filing the defence will not be reset.

### 3.2.5 The counter-statement (TM8(N)) and evidence of use

*Rule 38 of the Trade Marks Rules 2008*

The registered proprietor has a period of two months commencing on the date the TM26(N) is sent to them within which to file their defence.

A defence is filed on a TM8(N), which shall include a counter-statement, and may be accompanied by evidence of use or evidence supporting reasons for non-use.

**THE PERIOD FOR FILING A NOTICE OF DEFENCE ON A TM8 (N) CANNOT BE EXTENDED.**

If the TM8(N) is not received within the two month period the Tribunal may treat the proprietor as not opposing the application and issue a short, default decision revoking the registration.

Whilst the TM8(N) period cannot be extended, if the registered proprietor fails to file evidence of use or evidence supporting proper reasons for non-use, with the TM8(N), a further period of not less than two months will be allowed for the filing of such evidence.

If, within the additional period allowed, the registered proprietor fails to file evidence of use, or evidence supporting proper reasons for non-use, the Tribunal may treat the opposition to the application for revocation as withdrawn and issue a short, default decision revoking the registration.

Proper reasons for non-use are reasons outside the control of the proprietor.

**3.2.6 Failure to file a defence (TM8(N))**

*Rules 38(6) and 38(7) of the Trade Marks Rules 2008*

If the registered proprietor fails to file a defence but opposes the application before the Tribunal has revoked the registration, there is a discretion vested in the Tribunal which allows for consideration of reasons for a defence not having been filed. In very limited circumstances the defence may be admitted into the proceedings late.

In the event that no defence is filed in cases of revocation on the grounds of non-use, the Tribunal will write to the parties giving them a period of 14 days within which to either request a hearing or to provide a submission stating why discretion should be exercised in proceedings.

The exercise of the discretion is a judicial function. It is anticipated that it will normally only be exercised by a Hearing Officer. In determining whether the proprietor will be treated as opposing the application, considerations of the sort outlined in *Music Choice*<sup>11</sup> will be taken into account. These include:

- The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed

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<sup>11</sup> *Music Choice Limited v Target Brands, BL O/280/07*

- The nature of the applicant's allegations in its statement of grounds
- The consequences of treating the proprietor as opposing or not opposing the application
- Any prejudice caused by the delay
- Any other relevant considerations, such as the existence of related proceedings between the same parties

Also see section 4.11 for partial refusals.

### **3.2.7 Evidence in revocation non-use proceedings**

*Rule 40 of the Trade Marks Rules 2008*

In the case of an application for revocation on grounds of non-use the registered proprietor is required to file evidence of use with their defence (TM8(N)), otherwise a further period, usually of two months will be allowed in order for it to be submitted to the Tribunal. Evidence filed at this stage in proceedings by the registered proprietor is effectively the first evidential round.

The Tribunal shall specify the further periods for the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified, and in certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

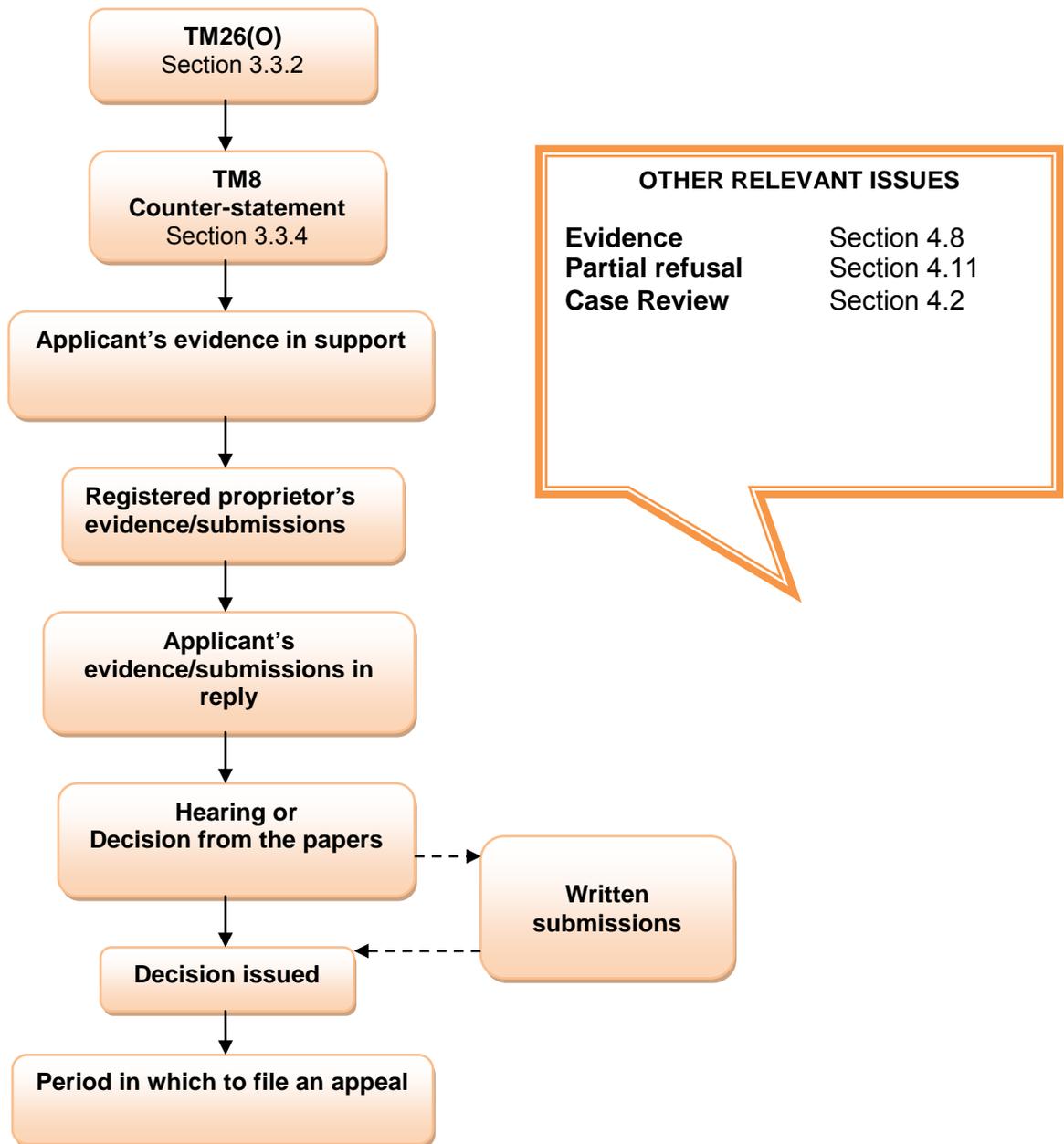
For full details of procedure for filing evidence in proceedings before the Tribunal see section 4.8.2.2

### **3.3 Revocation on grounds other than non-use**

*Section 46 of the Trade Marks Act 1994*

*Rule 39, 40, 43 and 45 of the Trade Marks Rules 2008*

**3.3.1 Revocation (on grounds other than non-use) example process diagram (see 3.3.6)**



Revocation for reasons other than non-use allows anyone to try and remove a registered trade mark from the UK register because they consider that:

- the trade mark has become the common name in the trade for goods or services for which it is registered, due to the action or inaction of the registered proprietor, (we describe this as the trade mark becoming 'generic')

or

- because of the use of the trade mark, either by the proprietor or by someone else with the proprietor's consent, the mark is likely to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services on which it has been used

It is possible to apply to revoke the registration in respect of all or only some of the goods and/or services for which the trade mark is registered.

Registered marks which become 'generic' or 'misleading' due to the action, or inaction, of the proprietor are vulnerable to revocation. Proprietors need to police their marks to avoid them becoming used generically as a descriptive term by other people, but also they need to be careful how they use the mark themselves. By way of example words, such as 'Hoover' and 'Rollerblade' have been used by the proprietor purely in a trade mark sense and have been protected vigorously under the law to ensure that they are not used as generic titles for goods.

### **3.3.2 Application for revocation on grounds other than non-use**

*Rule 39 of the Trade Marks Rules 2008*

An application for revocation to the Tribunal shall be made on a TM26(O) accompanied by a statement of grounds on which the application is made. A fee is also required.

### **3.3.3 Serving the application**

*Rule 39 of the Trade Marks Rules 2008*

Once the Tribunal has accepted the application and statement, it will send the documents to the registered proprietor who will be given two months from the date of sending (the notification date) in which to file a TM8, incorporating a counter-statement.

### **3.3.4 TM8**

A TM8 should incorporate a counter-statement. The purpose of the counter-statement is to admit, deny with explanation or require proof of any of the grounds set out by the applicant in its statement. If no TM8 is filed within this two month period, the period for filing cannot be extended, and if the documents are not received within the period the Tribunal may treat the opposition to the application as withdrawn.

### **3.3.5 Failure to file a defence (TM8)**

*Rule 39(3) of the Trade Marks Rules 2008*

The consequences of failure to file a defence in such proceedings is analogous to those dealt with under rule 38(6), see section 3.2.6 above for full explanation.

In the event that no defence is filed in cases of revocation on grounds other than non-use, the Tribunal will write to the parties giving them a period of 14 days within which either to request a hearing or to provide a submission stating why discretion should be exercised in their favour and providing reasons in support.

### 3.3.6 Evidence in revocation on grounds other than non-use proceedings

*Rule 40 of the Trade Marks Rules 2008*

The Tribunal shall specify the periods for the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified, and in certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

For full details of procedure for filing evidence in proceedings before the registrar see section 4.8.2.3

## 3.4 Invalidation

*Sections 47 and 48 of the Trade Marks Act 1994*

*Rules 41, 42, 43 and 45 of the Trade Marks Rules 2008*

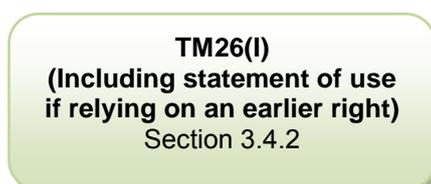
Invalidation is a procedure which enables a party to seek to remove a registered trade mark from the UK register and deem that registration never to have been made. An application may seek to remove the entire registration, or only some of the goods/services it covers.

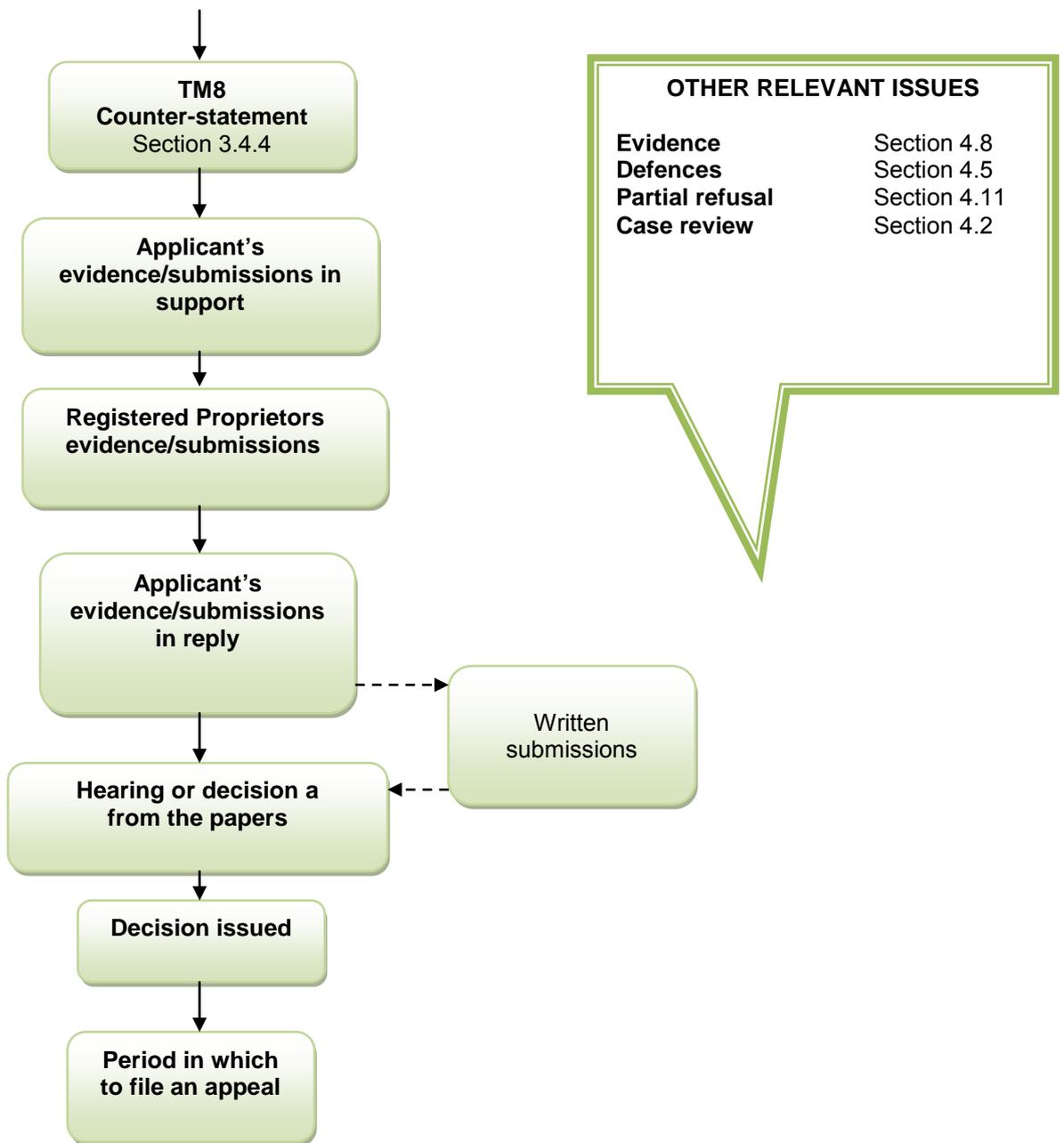
Applications for invalidity are based on section 3 and/or section 5 of the Act which set out absolute and relative grounds for refusal of registration. These sections should not be confused.

Section 3 of the Act: relates to *absolute grounds* that is, generally, something inherent in the mark itself which renders it unsuitable to be registered as a trade mark.

Section 5 of the Act: relates to *relative grounds*, that is, where registration of the trade mark would impinge upon another person's existing marks or rights.

### 3.4.1 Invalidation example process diagram





### 3.4.2 Application for declaration of invalidity

*Rule 41 of the Trade Marks Rules 2008*

An application can be made at any time following the registration of the contested mark. In contrast to revocation, if a mark is declared invalid (for all or some of the goods or services specified) the registration is deemed never to have been made.

An application based upon section 5 (relative grounds) can only be launched by the owner of the mark or right on which the application is based or a licensee<sup>12</sup> (Other parties who may have an interest in the proceedings would have to intervene after the proceedings were joined, see section 4.10 below.)

An application to the Tribunal for a declaration of invalidity shall be made on a TM26(I) accompanied by a statement of grounds on which the application is made. A fee is also required.

Where the application is based on an earlier registered trade mark, the following must also be included:

- The jurisdiction in which the mark is registered
- The registration number of the mark
- The goods and services for which that mark is registered
- The goods and services on which the application is based

and, where necessary,

- A statement of use; (if the application is based on an earlier registered mark which has been registered for more than five years, at the date of the application for invalidity, the applicant will be required to state on what goods and services it has been used during the relevant period or give proper reasons for non-use during the relevant period)

or

- Where the mark is not registered and the applicant is utilising section 5(4)(a) of the Act, a representation of the mark must be provided with a list of the goods and services in respect of which protection is claimed together with details of when and where the earlier right was used including a date of first use

### **3.4.3 Serving the application**

*Rule 41 of the Trade Marks Rules 2008*

Once the Tribunal has accepted the application and statement, it will send the TM26(I) with the statement of grounds and other documents to the registered proprietor at their last recorded address for service. The date on which these are sent is known as the “notification date”.

### **3.4.4 TM8**

The registered proprietor has a non-extendible two months from the “notification date” in which to file a TM8, which should incorporate a counter-statement. The

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<sup>12</sup> The Trade Marks (Relative Grounds) Order 2007

purpose of the counterstatement is to admit, deny with explanation or require proof of any of the grounds set out by the applicant in its statement. If no TM8 is filed within this two month period, the Tribunal may treat the proprietor as not opposing the application and registration of the mark shall unless the Tribunal otherwise directs, be declared invalid.

The consequences of failure to file a defence in such proceedings is analogous to those dealt with under rule 38(6), see section 3.2.6 above for full explanation.

### **3.4.5 Acquiescence**

*Section 48 of the Trade Marks Act 1994*

If the basis for the claim is relative grounds the registered proprietor may have a defence if the owner of the earlier marks or right has acquiesced in the use of the registered mark for a continuous period of 5 years. Section 48 of the Act makes it clear that the owner of the earlier mark or right must have been aware of and tolerated the use of the trade mark under attack for a continuous period of 5 years starting after it was registered. Further, the defence can only be relied upon if the trade mark under attack was not applied for in bad faith.

### **3.4.6 Proof of use in invalidation proceedings**

Section 100 of the Act states:

*“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”*

This establishes an obligation for the registered proprietor of a trade mark to show that it is using its mark in a genuine manner or has proper reasons for its non-use. The obligation to demonstrate use of the trade mark is not applicable immediately after registration of the trade mark; instead the registered proprietor has five years following the completion of the registration procedure to put the trade mark into use on the goods and/or services for which the trade mark was registered. Before this period of five years expires the registration is protected for all the goods and/or services for which it is registered. Once the mark has been registered for five years proof of use may be required.

On the TM26(1), where applicable, for certain earlier marks claimed as the basis for the action, a statement of use is required. The statement may say *“To the best of my knowledge the trade mark has been used on all the goods and/or services for which it is registered”*.

If evidence of use is required then this is **not** filed immediately but is filed with the applicants' first evidence round. See section 4.8.2.4

The Tribunal does not inquire of its own volition as to whether the earlier trade mark has been used or not. It is a matter for the registered proprietor to request if proof of

use is required by him. On the counter-statement the registered proprietor must deny, require proof of or admit the applicants' statement of use.

If the proceedings progress into the evidence rounds then the Tribunal will then set a period for the applicant to file such evidence, which will run in parallel with the first evidence round.

### **3.4.7 Failure to file a defence (TM8)**

*Rule 41(6) of the Trade Marks Rules 2008*

Under this rule there is a discretion vested in the Tribunal in the event that the registered proprietor fails to file a defence. The consequences of failure to file a defence in such proceedings is analogous to those dealt with under rule 38(6), see section 3.2.6 above for full explanation.

In the event that no defence is filed in cases of invalidation, the Tribunal will write to the parties giving them a period of 14 days within which to either request a hearing or to provide submissions stating why discretion should be exercised in these proceedings. See section 4.11 for partial refusals.

### **3.4.8 Evidence in invalidation proceedings**

*Rule 42 of the Trade Marks Rules 2008*

The Tribunal shall specify the periods for the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified and, in certain circumstances, it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

Failure to file evidence in respect of those grounds which are entirely dependent on evidence to support and substantiate the claims will result in the opponent being deemed to have withdrawn the invalidation.

For full details of procedure for filing evidence in proceedings before the Tribunal see paragraph 4.8.2.4

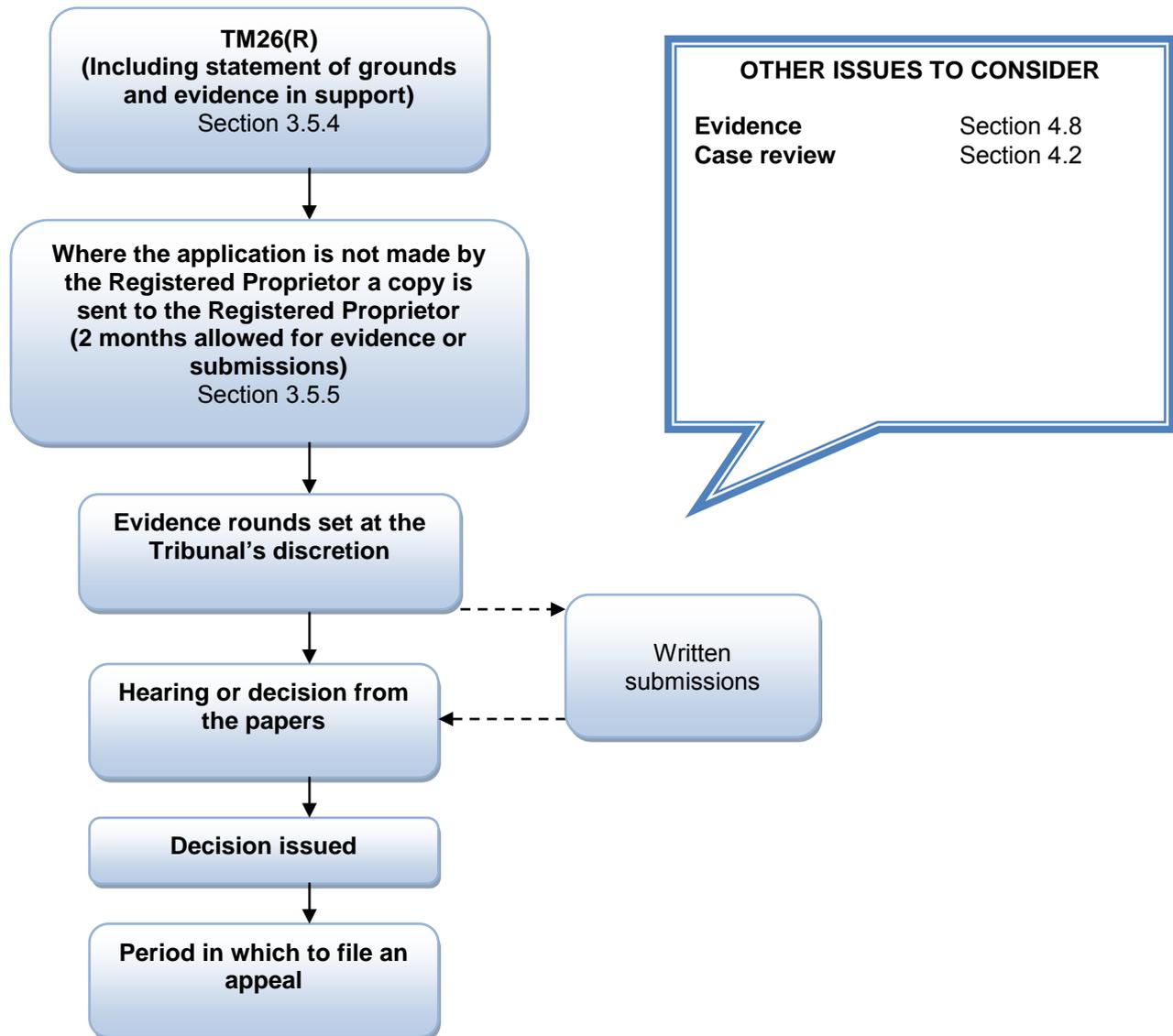
## **3.5 Rectification**

*Sections 60 and 64 of the Trade Marks Act 1994  
Rules 44 and 45 of the Trade Marks Rules 2008*

Rectification is the procedure which allows someone to apply to correct (rectify) an error or an omission that has been made in the details of a trade mark as recorded in the UK register of trade marks. Anyone can request rectification of a trade mark at any time following its registration by submitting a TM26(R) for which no fee is required. However, section 64 requires that the person applying to rectify has

'sufficient interest' and this may have to be established where the applicant has no obvious interest: beneficial, registered or otherwise.<sup>13</sup>

### 3.5.1 Rectification example process diagram



### 3.5.2 Section 64 of the Act

Under this section any person having a sufficient interest may apply for the rectification of an error or omission in the register provided that the application for rectification is not be made in respect of a matter affecting the validity of the registration of a trade mark.

The term 'validity', as it appears in the proviso, is to be interpreted quite broadly. The section cannot be used for example to:

<sup>13</sup> *Commercial Power Solutions Ltd v Turbo Chip UK Ltd & Specialist Autosports Ltd* BL O/112/09

- Alter the identity of the mark itself
- Increase the breadth of the specification
- Request that another person be substituted as the owner of the trade mark because they have an earlier right to the trade mark (other than the owner of a well known mark registered in the UK by an agent of the foreign owner) and/or it is alleged that the application was made in 'bad faith'. In such cases an application for invalidity may be more appropriate

or

- Any other matter which might otherwise be more properly dealt with under another section of the Act, or which might involve circumvention of statutory requirements

Examples of rectifications which the Tribunal would accept are:

- Terms used in the specification which are self-evidently erroneous and no other party could possibly be disadvantaged by their correction<sup>14</sup>
- Applicant's or proprietor's name and/or address, which appears on the register incorrectly and, on the basis of evidence provided, is incorrect<sup>15</sup>
- Cases of genuine mistaken identity where the person filing the original forms was unaware of the correct ownership position in law. The Tribunal has held that section 64 was available to those who were unaware of the true position in law as to ownership but who, much later, realised their error<sup>16</sup>

### 3.5.3 Section 60(3)(b)

Specific provision is made in section 60(3)(b) for an application for rectification to be made where an agent or representative has 'taken' a mark belonging to a person who is the proprietor of the mark in a convention country, that is, by virtue of section 55, a country other than the UK. Section 60 enacts Article 6*septies* of the Paris Convention.

### 3.5.4 Application for rectification

*Rule 44 of the Trade Marks Rules 2008*

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<sup>14</sup> *Andreas Stihl* [2001] RPC 12, the rectification allowed 'hard' operated hedge clippers in the specification to be changed to 'hand' operated hedge clippers.

<sup>15</sup> The section should not be used to record changes of name or corporate identity for which there is specific provision under section 64(4) of the Act and rule 52.

<sup>16</sup> However, this was in circumstances where the rightful owner, capable of holding the property, existed at the time the application was made and the facts were not disputed.

An application to rectify the register shall be made on a TM26R. A statement of grounds on which the application is made and any evidence to support those grounds is also required. If an application lacks a statement and/or evidence the Tribunal may write to the applicant asking for the requisite documents within a specified period. Similarly, if the grounds are unclear or do not appear to support the request, the registry will ask for clarification prior to a decision being taken.

The following information should be included:

- What trade mark you want to rectify
- Who owns it
- Who you are
- Who is your representative (if you have one)

and

- What is the error or omission you want to correct

Details must be given in the statement of reasons of why the rectification is wanted and how the error or omission occurred.

### **3.5.5 Serving the notice and filing the counter-statement where the applicant is not the proprietor**

*Rule 44 of the Trade Marks Rules 2008*

Where an application is made by someone other than the proprietor, rule 44(2) applies. The Tribunal will send a copy of the application, statement and evidence to the registered proprietor and may give such direction with regard to the filing of subsequent evidence upon such terms as it sees fit. A direction under this rule will most likely entail setting a period for filing a counter-statement and giving both sides opportunity to file evidence to support their respective contentions.

### **3.5.6 Evidence in rectification proceedings**

*Rule 44 of the Trade Marks Rules 2008*

The Tribunal shall specify the periods for the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified. In certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

For full details of procedure for the filing evidence in proceedings before the Tribunal see section 4.8.2.5

## **4. ISSUES COMMON TO PROCEEDINGS BEFORE THE TRIBUNAL**

### **4.1 Amendment of pleadings**

As parties will, as first instance, be expected to file focused statements of case and counter-statements, the Tribunal will consider requests to amend these documents later in the proceedings.

Amendments may include:

- Adding or removing a ground of opposition/revocation/invalidity
  - Adding or removing an earlier mark or right
- or
- Correcting, clarifying or supplementing information contained therein.

If an amendment becomes necessary parties should seek leave to make the amendment at the earliest opportunity. When seeking leave to amend, full details of the amendment together with the reasons for the amendment should be submitted.

Whilst each request to amend will be considered on its merits, the Tribunal will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties more quickly and at less cost. Whether to allow the amendment is matter of discretion. In making its decision the Tribunal will consider, in particular, any inconvenience or prejudice suffered by the other side, and whether the party seeking amendment could reasonably have been expected to have fully particularised their case at an earlier stage. In other words, a party seeking amendment will have to dispel any suspicion of abuse of process.

If the amendment requires the other party to file an amended counter-statement or additional evidence, an award of costs to cover this may be made.

### **4.2 Case review**

When the evidential rounds have been completed a letter will be issued to the parties listing the evidence filed and stating that the case is ready for a decision. From the date of this letter the parties will have 14 days within which to request a hearing. If no hearing is requested, they have a period of 28 days from the date of the letter to file written submissions in lieu of a hearing.

If a hearing is not requested a decision will be taken 'from the papers', i.e. from the documents, evidence and submissions on file, a decision from the papers filed may well be quicker and less costly for the parties.

### **4.3 Confidentiality**

*Section 67 of the Trade Marks Act 1994  
Rule 59 of the Trade Marks Rules 2008*

Section 67 of the Act states:

*67. - (1) After publication of an application for registration of a trade mark, the registrar shall on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject, however, to any prescribed restrictions.*

Under these provisions, documents filed are available for public inspection. It should be noted that there is an obligation on the Tribunal to permit documents to be made available for public inspection, subject to the exclusions and conditions set out in rule 59.

Any request for confidentiality will therefore, prima facie, be taken to be a request for a direction to withhold the document from inspection by the public. If it is intended to seek to withhold the document from the other party or parties to the proceedings (or made available only to their legal representatives), then the request that evidence be treated as confidential under the provisions of rule 59 of the Rules must make it clear that this is the case.

### **Confidential from the public at large**

In relation to the general public's access to the file, a request for confidentiality must be made at the time of filing of the document. Reasons for the request must be given, along with a clear statement of the extent of the confidentiality request.

This will be examined by the Tribunal and, if it is granted, a direction given. If a direction is given, no details pertaining to the relevant evidence can be given in any decision, but may instead form the subject of a redacted public version of the decision or a confidential annex to the decision.

### **Confidential from another party to the proceedings**

A party may ask to make the document available to the other party's legal representative or agent on the condition that the evidence is not disclosed to the party themselves or the public. However, this should be avoided unless the circumstances are considered exceptional, as the other side can reasonably expect to see the extent of the case against them.

If possible the evidence can be re-filed in more general terms, e.g. turnover in excess of X or, between Y and Z, and sales according to geographical areas or customer type rather than specific details.

It may be possible to come to a less restrictive agreement whereby nominated people on the other side are allowed to see the evidence under strict terms.

In all cases the parties are encouraged to explore all possibilities but if an agreement cannot be reached a Hearing Officer of the Tribunal will determine the matter (following a procedural hearing if necessary) in accordance with the discretion provided in Rules 62(1) and 62(3) which state:

62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may—

(a) require a document, information or evidence to be filed within such period as the registrar may specify;

(3) When the registrar gives directions under any provision of these Rules, the registrar may—

(a) make them subject to conditions; and

(b) specify the consequences of failure to comply with the directions or a condition.

Orders for confidentiality will not be issued as a matter of course. Requests must be supported by full and detailed reasons in each case. In considering requests the Tribunal will bear in mind the comments of Upjohn LJ in *Re K (Infants)* [1963] Ch 381; where he stated:

*"It seems to be fundamental to any judicial enquiry that a person or other properly interested party must have the right to see all the information put before the Judge, to comment on it, to challenge it and if needs be to combat it, and to try to establish by contrary evidence that it is wrong. It cannot be withheld from him in whole or in part. If it is so withheld and yet the Judge takes such information into account in reaching his conclusion without disclosure to those parties who are properly and naturally vitally concerned, the proceedings cannot be described as judicial."*

Also the comments of Whitford J in *Diamond Shamrock Technologies SA's Patent* [1987] RPC 91; where he states:

*"It is commonplace with a variety of proceedings, and patent proceedings are no exception, that the parties to the proceedings want material to be kept confidential. There are matters which they do not want to be disclosed to the public at large. What is said in these letters is that this, that or the other information contained in the declarations or exhibits should be kept confidential because "it contains sensitive commercial information".*

*I think it is desirable that a more exact indication should be given as to the reasons why in truth the document ought not to be disclosed because it is easy enough to talk about the material being of commercial interest and to talk of it being sensitive. That fact in itself does not necessarily mean that the material, which would otherwise become public property because it was*

*included in the documents which are going to be open to public inspection, is to be excluded from public inspection.”*

Where confidentiality is not granted the filer will be allowed the opportunity to withdraw the disputed document/s.

#### **4.4 Consolidation of proceedings**

Consolidation is an administrative procedure which aims to reduce costs and the work involved in dealing with two or more sets of related proceedings. It means the proceedings are combined, with each side in the dispute filing one set of evidence headed for, and covering, all of the consolidated proceedings.

Consolidation can be requested by any party; but in most cases will be raised by the Tribunal.

#### **Opposition and Invalidation proceedings**

In opposition and invalidity proceedings consolidation will not be allowed until after the defence (TM8) is filed.

#### **Revocation on grounds of non-use**

In revocation proceedings based upon non-use under section 46(1)(a) or 46(1)(b), consolidation may be allowed prior to the filing of the defence (TM8(N)) and evidence of use, if the Tribunal is satisfied that the issues raised are identical (or substantially identical) in all proceedings.

The reason for the different treatment of non-use revocation proceedings is that evidence of use is required from the proprietor at an earlier stage than in other proceedings. Even where consolidation is allowed, separate TM8(N)s and counter-statements will be required for each set of proceedings, although only one set of evidence of use will be required.

Instances of where consolidation may occur are:

- Cross-opposition, where the applicant in one case is the opponent in another and the marks are related
- Cross-opposition/revocation/invalidation, where the proprietor of one mark opposes a mark he believes to be too close to his own mark and the applicant has applied to revoke or invalidate that mark

In ordering consolidation, the Tribunal will take into account the following:

- Whether the parties are the same or economically connected
- Whether the 'legal basis' on which the cases are founded are connected

- Whether the marks are the same for each case or whether they share the same objection
- The stages of the respective proceedings and whether it will save cost to consolidate the proceedings or lead to unacceptable delay
- Whether a single decision covering all proceedings can be issued or whether it would cause complications in the event of an appeal

Even if consolidation is not considered appropriate by the Tribunal, they may proceed in tandem through the evidence stages and be heard on the same day, one following the other, and by the same Hearing Officer.

#### **4.5 Defences in opposition and invalidation proceedings**

##### **Claims that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.**

A counter-statements in opposition and invalidation actions may seek to introduce, as a defence, a claim that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application), for the same, or, a highly similar trade mark, to that which is the subject of the proceedings and which predates the earlier mark upon which the attacker relies.

Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) T-269/02:

*"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.*

*25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.*

*26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 Matratzen Concord v OHIM - Hukla Germany*

*(MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."*

### **The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark**

The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

Parties are reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.

### **4.6 Defences – Absence of confusion in the marketplace**

Claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

*"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."*

In *Rousselon Frères et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

*"99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says..."*

In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

#### **4.7 Disclosure**

*Rule 65 of the Trade Marks Rules 2008*

Rule 65 gives the Tribunal the power of an official referee of the Supreme Court in respect of the discovery<sup>17</sup> and production of documents.

In the first instance one party should make the request for the disclosure of documents to the other party to the proceedings. If the other party refuses to disclose documents, then the matter can be referred to the Tribunal. If a party is to disclose documents it will normally supply a list of the documents which relate to the matter in question to the other party, it will then advise which documents it wishes to have supplied to it.

Disclosure is a matter between the parties, even though the Tribunal may have ordered it. If a party wishes to use evidence that has been disclosed, it will need to be introduced into the proceedings as evidence. The disclosing party may make a request to the Tribunal for the reasonable cost of copying documents at the end of proceedings (even if the documents have not been adduced into the proceedings).

Disclosure should only be ordered by the Tribunal insofar as the documents relate to matters in question in the proceedings.<sup>18</sup> There will be no order for disclosure in relation to matters that will not affect the outcome of the case.<sup>19</sup>

#### **4.8 Evidence**

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<sup>17</sup> 'Discovery' was the term used for 'disclosure' prior to the introduction of the Civil Procedure Rules 1999.

<sup>18</sup> *Merrell Dow Pharmaceuticals Inc's (Terfenadine) Patent* [1991] RPC 221

<sup>19</sup> *Gracey v Unilever Plc* BL O/475/99

*Section 69 of the Trade Marks Act 1994  
Rules 20, 62, 64 and 65 of the Trade Marks Rules 2008*

The general rule is that it is for the parties to decide what evidence they wish to file. The Tribunal will not normally provide advice on the content of evidence as this is essentially a matter for the parties, these being quasi-judicial proceedings.

*“Judicial evidence is used to prove either facts in issue, or facts from which facts in issue may properly be inferred. It comprises the testimony of witnesses, documents and things.”*

*“The main facts in issue are all those facts which the plaintiff in a civil action, or the prosecutor in criminal proceedings, must prove in order to succeed, together with any further facts that the defendant or accused must prove in order to establish a defence.”<sup>20</sup>*

The Tribunal has the power under rules 62(1)(a), 62(2) and 62(3) of the Rules to require parties to submit evidence or information covering particular issues. The Hearing Officer may also require the production of particular documents if this appears necessary to enable him or her to reach a fair and properly informed decision on a matter that the parties have raised.

#### **4.8.1 Submissions are not evidence**

To be relevant, evidence must provide the facts which clearly relate to the issues raised in the case. Submissions per se are not debarred but if a party wishes only to comment on the other side’s evidence or make submissions about the truth of it, written submissions are the more appropriate vehicle.

#### **4.8.2 Time periods for filing evidence**

The Rules require the Tribunal to specify the time periods for filing evidence or written submissions in inter partes proceedings. It is desirable and possible to determine trade mark inter partes cases within 12 months of the filing of a defence.

The period specified by the Tribunal for the parties to file evidence and submissions should normally be two months. More time will be provided where the grounds of opposition appear to merit it. In respect of evidence in reply, the relevant party will normally be given one month in which to notify the Tribunal of their intention to file further evidence of fact and, where this is the case, the party will be set a one month period in which to file such evidence.

The Tribunal routinely consolidates related proceedings. Where the proceedings have been consolidated, the Tribunal will usually set a common timeframe for the filing of evidence and written submissions. The time periods permitted will be determined on a case by case basis and will therefore not necessarily follow the time periods described below. However, as a general rule the periods for filing evidence/submissions in contested trade mark proceedings are as follows:

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<sup>20</sup> Cross & Tapper on Evidence, at Section 3

#### 4.8.2.1 Opposition proceedings

*Rule 20 of the Trade Marks Rules 2008*

##### **Evidence and submission rounds:**

**The opponent** - Following the serving of the counterstatement, the opponent will normally be allowed **two months** to file any evidence or written submissions in support of its case. In cases where the opponent has been required to provide proof of use of one or more of the earlier trade mark(s), the evidence should be filed in this period.

**The applicant** - The period permitted for the applicant to file evidence or written submissions on the opponent's evidence will normally be **two months**.

**The opponent** - If the applicant files evidence, the opponent will be given **one month** from receipt of the applicant's evidence, in which to notify the Tribunal of their intention to file evidence of fact in reply. The period for filing the evidence will then be set; normally to **one month** (i.e. one further month will be allowed).

The evidence rounds will be regarded as complete when:

- The period for the applicant to file evidence of fact/submissions has passed and the applicant has filed no evidence of fact; or
- The applicant has filed evidence of fact and the period has passed for the opponent to file evidence in reply

#### 4.8.2.2 Revocation (on the grounds of non use)

*Rule 38 of the Trade Marks Rules 2008*

##### **Evidence and submission rounds:**

**The registered proprietor** - Having been served with the applicant's TM26(N), the registered proprietor will be allowed **two months** to file a TM8(N) together with the evidence of use (or proper reasons for non-use) it intends to rely upon in order to defend the registration. If a counterstatement is filed without evidence (as the rules permit), the Tribunal will specify a further period, normally of **two months**, within which any evidence in support of the trade mark registration may be filed.

**The applicant for revocation** - Following the serving of the counterstatement, the applicant will normally be permitted **two months** to file any evidence or written submissions in response to the registered proprietor's counterstatement and evidence of use of the trade mark (or proper reasons for non-use).

**The registered proprietor** - If the applicant files evidence of fact, the registered proprietor will be given **one month** from receipt of the applicant's evidence, in which to notify the Tribunal of their intention to file evidence of fact in reply. The period for

filing evidence in reply will then be set; normally to **one month** (i.e. one further month will be allowed).

The evidence rounds will be regarded as complete when:

- The period for the applicant to file evidence of fact/submissions has passed and the applicant has filed no evidence of fact; or
- The applicant has filed evidence of fact and the period has passed for the registered proprietor to file evidence in reply

#### **4.8.2.3 Revocation (on grounds other than non-use)**

*Rules 39 and 40 of the Trade Marks Rules*

##### **Evidence and submission rounds:**

**The applicant for revocation** - The period permitted for the applicant to file evidence in response to the TM8 will usually be **two months**.

**The registered proprietor** - The time allowed for the registered proprietor to file evidence or written submissions on the applicant's evidence will usually be **two months**.

**The applicant for revocation** - If the registered proprietor files evidence of fact, the applicant will be given **one month** from receipt of the registered proprietor's evidence, in which to notify the Tribunal of their intention to file evidence of fact in reply. The period for filing evidence in reply will then be set; normally to **one month** (i.e. one further month will be allowed).

The evidence rounds will be regarded as complete when:

- The period for the registered proprietor to file evidence of fact/submissions has passed and the registered proprietor has filed no evidence of fact; or
- The registered proprietor has filed evidence of fact and the period has passed for the applicant to file evidence in reply

#### **4.8.2.4 Invalidation**

*Rule 42 of the Trade Marks Rules 2008*

##### **Evidence and submission rounds:**

**The applicant for invalidation** - Following the serving of the counterstatement, the applicant will normally be allowed **two months** to file any evidence or written submissions in support of its case. In cases where the applicant has been required

to provide proof of use of one or more of the earlier trade mark(s), the evidence should be filed in this period.

**The registered proprietor** - The registered proprietor will usually be given two months to file evidence or written submissions on the applicant's evidence.

**The applicant for invalidation** - If the registered proprietor files evidence, the applicant will be given **one month** from receipt of the registered proprietor's evidence, in which to notify the Tribunal of their intention to file evidence of fact in reply, then the period for filing evidence in reply will be set, normally to **one month** (i.e. one further month will be allowed).

The evidence rounds will be regarded as complete when:

- The period for the registered proprietor to file evidence of fact/submissions has passed and the registered proprietor has filed no evidence of fact, or
- The registered proprietor has filed evidence of fact and the period has passed for the applicant to file evidence in reply

#### **4.8.2.5 Rule 44 Rectification**

*Rule 44 of the Trade Marks Rules 2008*

##### **Evidence and submission rounds:**

**The registered proprietor** - Where an application to rectify the register is made by a party other than the proprietor of the registered trade mark, the Tribunal will send a copy of the TM26(R) to the registered proprietor who will be allowed **two months** to file evidence or written submissions.

**The applicant for rectification** - If the registered proprietor submits evidence or written submissions in response to the TM26(R), the applicant will, at the Registrar's discretion, be permitted a further period of time within which to respond to the registered proprietor's evidence or written submissions.

The above practice will not prevent the Tribunal from using his powers to set different arrangements for the filing of evidence/submissions in any other case where the situation justifies it. Nor will it prevent the parties from making a request at any time for leave to file further evidence.

For details on how to request an extension of time in which to file evidence see section 4.9.

#### **4.8.3 Types of evidence**

*Rules 62 and 64 of the Trade Marks Rules 2008*

Rule 64 prescribes the form in which written evidence must be filed as follows:

64.—(1) Subject to rule 62(2) and as follows, evidence filed in any proceedings under the Act or these Rules may be given—

(a) by witness statement, affidavit, statutory declaration; or

(b) in any other form which would be admissible as evidence in proceedings before the court.

#### **4.8.3.1 Witness Statement**

Evidence will normally be in the form of a witness statement unless the Tribunal directs otherwise. Instructions as to the correct form of a witness statement can be found in Part 32 Practice Direction 32 paragraph 17.1 *et seq* of the Civil Procedure Rules, which can be found on the website of the Ministry of Justice here:

[http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice\\_directions/pd\\_part32.htm](http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_part32.htm)

A witness statement may only be given in evidence if it includes a statement of truth.

The Tribunal may require evidence to be filed by way of affidavit or statutory declaration rather than by witness statement.

#### **4.8.3.2 Affidavit**

Instructions as to the correct form of an affidavit can be found in Part 32 Practice Direction 32 paragraph 2 *et seq* of the Civil Procedure Rules, which can be found on the website of the Ministry of Justice at:

[http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice\\_directions/pd\\_part32.htm](http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_part32.htm)

#### **4.8.3.3 Statutory Declaration**

Section 5 and the First Schedule to the Interpretation Act 1978 provide that “A *Statutory Declaration means a declaration made by virtue of the Statutory Declarations Act 1835*”. It is a written statement of facts which is signed by the declarant and which is solemnly declared to be true before a solicitor or magisterial officer. In the United Kingdom<sup>21</sup> the declaration should be witnessed by a solicitor, justice of the peace, commissioner for oaths or an officer authorised by law to administer oaths. The correct form for a statutory declaration is provided below.

It must be correctly headed for the proceedings for which it has been filed. Statutory declarations may relate to more than one set of proceedings for example, where cases have been consolidated, in which case the evidence should be headed to refer to all of the proceedings to which it relates. Any defect may attract adverse comments from the Court or Appointed Person if used in a later appeal. The exact wording of the heading may differ from case to case but should include sufficient details to identify the proceedings:

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<sup>21</sup> England, Scotland, Wales and Northern Ireland but not the Isle of Man or the Channel Islands

**Trade Marks Act 1994**  
In the matter of application  
No. 2999999 in Class 29 in the  
name of Gingerfred Foods Ltd  
and opposition thereto under No. 65432  
in the name of Bowen & Jones Luxury Organics Inc.

A statutory declaration must be made by a person or persons so it cannot be made in the name of a company but can be made by two or more people. In such a case the names of each person must be included, e.g. 'We, Joe Smith and Fred Brown . . .'. If such a declaration is made then the declarants must all be conversant with all of the facts of which the declaration speaks. A statutory declaration should begin 'I (name) of (address) hereby solemnly and sincerely declare that.....' **and end** 'And I make this declaration conscientiously believing the same to be true and by virtue of the Statutory Declarations Act 1835.' Statutory declarations must always be signed by the declarant and the authorised person before whom the declaration is made. The statement of belief and all signatures should be on the same page as the last page of written evidence. A fundamental defect such as lack of signature will mean that a statutory declaration cannot be taken into account when making a decision on the case as it is not considered to be 'evidence'. The signature and/or seal of the declarant must also appear at the end of the document.

#### **4.8.3.4 Oral evidence**

Most evidence in inter partes proceedings before the Tribunal is in writing, in the form of a witness statement, statutory declaration or affidavit. However, in any particular case the Tribunal may allow oral evidence to be given instead of, or in addition to, written evidence. For example, oral evidence may be given if a witness is unable to read or write or it has not been possible to obtain written evidence within the relevant period. A party wishing to rely on oral *rather* than written evidence must give at least one month's notice prior to any hearing and copy the request to the other party who will be invited to comment on the request.

#### **4.8.4 Exhibits**

Evidence may refer to exhibits to support the case. These are usually referenced by the initials of the declarant, deponent or witness and numbered sequentially, e.g. a document filed by Frederic John Butler may have three exhibits, which would be referred to in the evidence as FJB1, FJB2, and FJB3.

Exhibits consisting of a bundle of papers should have a header sheet as its top document. The header sheet should identify the exhibit, e.g. 'This is exhibit FJB1 referred to in the statutory declaration made by Frederick John Butler this.....day of..... 2011'. The date on the header sheet should be the same as the date when the evidence was signed.

Where the exhibits are bulky and are placed in a container, the header sheet may be firmly attached to the container. Where the exhibit is merely a single sample e.g. a

bottle, the header sheet may take the form of a tag attached to the sample either by sticky tape or elastic band etc. The Tribunal encourages use of photographs rather than bulky exhibits wherever possible, but the original may be required for viewing prior to or at the hearing.

All individual exhibits of more than 4 pages are to be paginated. Where the pages have not been paginated, the evidence will be returned to the party which has adduced the evidence, for pagination to be applied. The page number should be applied to the bottom right hand corner of each page. The Tribunal is happy for parties to paginate the entirety of their evidence, regardless of the size of individual exhibits.

Lengthy documents that already bear page numbers, e.g. magazines and annual reports, can be the subject of single exhibits and the existing page numbering can be relied upon, as long as it is clearly visible on each page; parties must make sure that the page numbering is clear, particularly where the material has been photocopied.

#### **4.8.4.1 Evidence filed in the form of electronic media**

Evidence supplied in this form must be copied to the other party or parties at the same time as the evidence to which it is exhibited. No copyright infringement will occur as proceedings before the Tribunal constitute legal proceedings for the purposes of section 45(1) of the Copyright Designs and Patents Act 1988.

Furnishing such evidence in an electronic format gives rise to various considerations:

- The ability of the other party to access it
- The compatibility of the media with the systems used by the IPO and the other party
- The compatibility of the media with the systems used by the appellate bodies, e.g. the High Court and the Appointed Persons
- The potential for corruption of data
- The possibility that, unknown to the supplier of the media, it carries a virus
- For the purpose of a hearing, the contents might have to be printed for both the Hearing Officer and the other party

Where evidence is filed in the form of electronic media it should be in a standard, easily accessible format e.g. Windows® Media compatible

#### **4.8.4.2 Statements in foreign languages**

Statements made in foreign languages will normally be accepted as being valid under local law unless successfully challenged by the other party. If a challenge is made it should be supported with the reasons to explain the basis of the challenge. Any challenge should be made as soon as possible. Unless the person making the declaration has a good command of the English language, they will be unable to

testify in English. In such cases, the declaration may be filed in their mother tongue accompanied by a certified translation prepared by a competent translator. Exhibits must similarly be translated if they are to be relied upon.<sup>22</sup> The translator should prepare their own witness statement, statutory declaration or affidavit stating that they are (at least) familiar with English and the other language. As an exhibit to the declaration, the translator should file copies of the foreign declaration and its translation.

#### **4.8.4.3 Evidence filed in earlier proceedings**

Evidence filed in earlier proceedings may be taken into account in a later case if a party considers it to be relevant. But it may be necessary to file such evidence as an exhibit to a further statutory declaration, affidavit or witness statement, particularly where the original witness is no longer available.

Evidence filed at examination stage to secure acceptance of an application may be used in later, inter partes, proceedings. But the person filing it must serve a copy of it and any supporting exhibits on the other party.

Evidence filed by a party in earlier inter partes proceedings may also be adopted into later proceedings on the basis of a request made in correspondence. This is of course subject to the evidence being available in the Tribunal. It should be noted that papers from inter partes proceedings are normally destroyed two years after the completion of the proceedings. Further, if the other party has not been served with the evidence in on-going proceedings between the parties, a copy of it should be served on the other side when the request is made to the Tribunal to adopt the earlier filed evidence into the proceedings.

#### **4.8.4.4 Function and weight of expert evidence**

An expert witness instructs the judge in those matters he would not otherwise know but which are material for him to know in order to give an informed decision.<sup>23</sup> It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge might otherwise be ignorant and which may be relevant to the likelihood of confusion.

It is **not** legitimate to call such witnesses merely in order to give their opinions as to whether or not two marks are similar. The question of similarity, confusion and other detriment to the earlier mark is normally one for the judge not the witnesses.<sup>24</sup>

In any event, if the opinion of an expert is to be relied upon then weight can only be attached to that opinion if it is an opinion based on experience and is explained in sufficient detail so that the Tribunal can comprehend why the expert holds that opinion.<sup>25</sup>

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<sup>22</sup> *Pollini* (BL O/146/02)

<sup>23</sup> *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283

<sup>24</sup> *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842

<sup>25</sup> *Valucci Designs Ltd t/a Hugo Hogs v IPC Magazines Ltd* BL O/455/00

#### 4.8.4.5 Survey evidence (including evidence from expert witnesses)

Survey evidence is regularly filed in proceedings and is regularly deeply flawed. Survey evidence and expert witness evidence can only be adduced into trade mark proceedings before the Intellectual Property Office with the permission of the hearing officer.

In *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 the Court of Appeal considered survey evidence and expert witness evidence:  
Arden LJ:

“62. Firstly, given that the critical issue of confusion of any kind is to be assessed from the viewpoint of the average consumer, it is difficult to see what is gained from the evidence of an expert as to his own opinion where the tribunal is in a position to form its own view.....If more cogent evidence of customer perception is needed, the traditional method of consumer surveys must (subject to my second point) carry more weight and is to be preferred.....

63. ....There is much to be said for the practice initiated by the late Pumfrey J (as he then was) in *O2 Ltd v Hutchison 3G Ltd* [2005] ETMR 61, and subsequently followed by Rimer J in *U K Channel Management Ltd v E!Entertainment Television Inc* [2008] FSR 5. Under this practice, case management directions are given at an interim stage requiring the parties to seek the directions of the court as to the scope or methodology of any proposed consumer survey that the parties may desire to put in evidence at trial. Those directions can then be given in advance of the trial (see, for example, the further proceedings in the *U K Channel Management* case given by Lewison J, [2007] EWHC 2339 (Ch)). “

Kay LJ:

“82. Where litigation is commenced in the ordinary courts, the calling of expert evidence is now controlled by CPR 35.1. As I understand it, that does not apply to proceedings before a hearing officer in the Trade Marks Registry. Perhaps it should. However, even without its express application, it must be open to the Trade Marks Registry to control the nature and quality of evidence sought to be adduced before it as expert evidence. It should be encouraged to ensure that the sort of evidence that has attracted the disapproval of all three members of this court is excluded. In a case such as this, neither a hearing officer nor a judge in the Chancery Division requires the assistance of an “expert” when evaluating the likelihood of confusion from the standpoint of the average consumer.”

The production of survey evidence increases costs for all parties; as the party not producing the survey has the costs of considering the survey evidence. The production of survey evidence will normally also give rise to delay in the prosecution of proceedings.

If a party intends to draw conclusions from a survey, based upon its statistical validity, it will be necessary to furnish evidence from a suitable expert; adding further to costs and delay.

If a party wishes to adduce survey evidence it must seek the permission of the hearing officer. In seeking the permission of the hearing officer it must advise the hearing officer of all details of how it is intended for the survey to be conducted eg:

- The purpose of the survey
- The questions that are to be put.
- What those interviewed are to be shown as stimulus material.
- The nature of the population sample, in terms of size, social class, gender and location.
- The types of persons who will conduct the survey.
- The instructions that will be given to those people.
- The types of locations where the survey will be conducted.
- Whether it is intended that statistically based conclusions are expected to be drawn from the survey

The hearing officer will consider whether the proposed survey is likely to have any determinative effect upon the proceedings.

If the hearing officer gives permission for survey evidence to be adduced, it will be necessary for it to conform to the criteria set out in the head note to *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

### **Expert witness evidence**

There is generally little need in proceedings before the tribunal for an expert witness. The tribunal does not, for instance, require an expert to give an opinion as to how a word will be pronounced by an English speaker. Evidence will not be permitted which supplants the role of the decision maker e.g. evidence from a branding expert stating that there is, or is not, a likelihood of confusion or dilution.

There may be instances where, owing to the technical or specialised nature of the goods or services under consideration, that expert evidence about the way that the market operates may be helpful. However, it is considered that expert witness evidence will seldom be of assistance and permission for the adducing of expert witness evidence will therefore be the exception rather than the rule.

The position in relation to expert witnesses will be similar to that of the Civil Procedure Rules:

“35.4 (1) No party may call an expert or put in evidence an expert’s report without the court’s permission.

(2) When a party applies for permission under this rule he must identify -  
(a) the field in which he wishes to rely on expert evidence; and  
(b) where practicable the expert in that field on whose evidence he wishes to rely.

(3) If permission is granted under this rule it shall be in relation only to the expert named or the field identified under paragraph (2).

(4) The court may limit the amount of the expert’s fees and expenses that the party who wishes to rely on the expert may recover from any other party.”

In proceedings before the Intellectual Property Office, the evidence can only be given in relation to the issue identified and it will be necessary to name the expert(s) from whom evidence is to be sought. If permission is given for adducing expert evidence, the evidence must only be in relation to the issue identified and by the expert(s) identified.

If both parties wish to produce expert witness evidence on the same matter, they will be encouraged to agree one mutually acceptable expert witness.

If the hearing officer gives permission to adduce survey and/or expert witness evidence, a strict deadline will be given in relation to its being adduced and the party(ies) will be expected to keep to this deadline.

#### **4.8.5 Additional evidence**

A party may ask to file additional evidence. The Tribunal will consider the reasons for the request, the nature of the evidence and the views of the other party. In considering a request to file additional evidence the Tribunal will primarily consider the following<sup>26</sup>:

- The materiality of the evidence to the question needed to be determined
- The justice and fairness of subjecting the opposite party to the burden of evidence in question at that stage of the registry proceedings, including the reasons why the evidence was not filed earlier
- Whether the admission of the additional evidence would prejudice the other party in ways that cannot be compensated for in costs (e.g. excessive delay)

#### **4.8.6 Defective evidence**

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<sup>26</sup> *Lappet Manufacturing Co Ltd v Yosif Abdulrahman Al-Bassam Trading Establishment* BL O/467/02

On receipt, the Tribunal will scrutinise the evidence for defects in its format. Defects may arise in the heading, content itself, exhibits or attestation. The defect(s) will be brought to the attention of the filer and an opportunity will be given to put matters in order. Under no circumstances will the Tribunal correct evidence on behalf of the filer; to do so may bring the admissibility of the evidence, particularly if it goes to appeal, into question.

A copy of the evidence will be kept on the dispute file by the Tribunal and the original evidence will be returned to the filer who will be invited to remedy matters within a specified period. Generally this will result in a suspension of the proceedings. Any amendments to the text of the evidence must be initialled by the declarant or deponent and the witness and returned to the Tribunal.

Ultimately the admissibility of evidence or otherwise will be a matter for the Tribunal and any appellate body. Where defects are minor, the Tribunal may accept the evidence as filed, but caution the filer that his evidence may be considered inadmissible at a later stage.

#### **4.8.7 Evidence in reply**

The aim of 'evidence in reply' is to achieve finality in the proceedings; evidence in reply must not involve a departure from a case put in chief, but may include comment on the other side's evidence. It should not '*seek to adduce additional evidence...*'<sup>27</sup> However, it should be noted that this is no longer a requirement of the Rules. The Tribunal has the power to direct what evidence should be filed and may specify that the evidence should be limited to evidence in reply. If the evidence is not in reply it may still be admissible as additional evidence.

#### **4.8.8 Objections to evidence by the other party**

In addition to formal defects raised by the Tribunal, the other party may also object to evidence and argue that it should be struck out. The following reasons may be put forward for evidence (or parts of evidence) to be struck out:

- The evidence comprises 'without prejudice' material and therefore should not be put before a Hearing Officer or appeal authority
- The evidence is vexatious and discloses no bona fide case
- The evidence is illegible
- The evidence is of questionable relevance and so voluminous as to be oppressive

This is a non-exhaustive list.

Any such objections to evidence ought to be raised at the earliest opportunity. A procedural hearing/CMC may be appointed, if necessary, to resolve the matter.

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<sup>27</sup> *Ernest Scragg & Sons Ltd's Application* [1972] RPC 679

#### 4.8.9 Challenging evidence

It is normally unacceptable for parties to invite a Hearing Officer to disbelieve the factual evidence of a witness without that witness having had the opportunity to respond to the challenge either by filing further written evidence or, by answering the challenge that his or her evidence is untrue in cross-examination.<sup>28</sup>

Normally, this will mean the opposing party making written observations within the period allowed for filing its evidence in response to the witness's evidence explaining why the witness should not be believed. Alternatively, the opposing party can file factual evidence in reply of its own which shows why the evidence in question should not be believed. In the further alternative, the opposing party can ask to cross-examine the witness in question at a hearing.

However, requesting cross-examination may be disproportionate and unnecessarily costly and burdensome, since in trade mark proceedings the evidence stages are sequential, providing opportunities to deal with points during the proceedings.<sup>29</sup> In addition, cross-examination may not be permitted if the truth or otherwise of the challenged statement manifestly has no bearing on the outcome of the case.

Written submissions, or evidence which contradicts the witness's evidence, are therefore likely to be the most satisfactory ways to dispute the factual evidence of the other side in the majority of cases.

For full details of the cross-examination procedure see section 6.8.3.

#### 4.8.10 Hearsay

Hearsay evidence is oral or written statements made by someone who is not a witness in the case but which the Court or Tribunal is asked to accept as evidence for the truth of what is stated.

If a witness statement, affidavit or statutory declaration contains hearsay evidence, it should be filed in sufficient time and it should contain sufficient particulars to enable the other party or parties to deal with the matters arising out of its containing such evidence. If the provision of further particulars of or relating to the evidence is reasonable and practicable in the circumstances for that purpose, they should be given on request.

It is also to be borne in mind that in estimating the weight (if any) to be given to hearsay evidence in proceedings before the Tribunal, the Tribunal and those acting on its behalf shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence. In estimating the weight, if any, to be given to hearsay evidence attention is drawn to the provisions of section 4 of the Civil Evidence Act 1995, which states:-

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<sup>28</sup> *EXTREME Trade Mark* BL O/161/07

<sup>29</sup> *BRUTT Trade Marks* [2007] RPC 19

4.—(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following—

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.

Parties to proceedings have on occasions solicited letters from third parties for the purposes of the proceedings, rather than getting the third party to file evidence by witness statement, affidavit or statutory declaration. These are often headed ‘to whom it may concern’, or, in some cases, are addressed directly to the Tribunal. Such letters will be treated as hearsay evidence. Parties are encouraged to present such evidence in the form of a witness statement rather than in the form of a letter if they wish to rely on it. A signatory to a witness statement, who can be cross-examined, is likely to exercise greater care and precision than a signatory to a letter.

#### **4.8.11 Withdrawal of evidence**

A party may apply to withdraw evidence already filed and any such request will be considered in the light of comments from the other party.

#### **4.8.12 Ownership of evidence**

At the conclusion of proceedings, all evidence, including statutory declarations, affidavits and exhibits will be retained for two years. The evidence must be kept because it is part of the case which is, under the Act, open to public inspection, subject to various qualifications, under rule 59.

If the filer wants an exhibit returned within this period because of, for example, its value etc, consideration will be given to the request. In both cases, alternative methods of meeting the Tribunal’s obligation to the public will be considered, such as

retaining a photograph of the evidence, or the filer providing an undertaking that, in the event that a third party wishes to inspect the evidence, the evidence will be made available within a specified time.

## 4.9 Extensions of time and stays in proceedings

### *Rule 77 of the Trade Marks Rules 2008*

As the rule states, some time limits can be extended but some cannot. In relation to inter partes proceedings, the following periods cannot be extended:

- Time for filing opposition, (except as allowed in the relevant rule with regard to the extension of the opposition period by filing a TM7A)
- Time for filing counter-statement in oppositions, (except as allowed in the relevant rule with regard to the cooling off period)
- Time for responding to a preliminary indication by filing a TM53
- Time for filing counter-statement in revocation (non-use and other grounds) and invalidity proceedings
- Time for setting aside a decision of cancellation of an application, or of the revocation or invalidation of a registration

All other periods, whether prescribed by the rules or specified by the Tribunal, can be extended by successful application in the appropriate manner.

### 4.9.1 Extensions of time

#### **Tribunal procedure**

Following the filing of a defence, the Tribunal sets and notifies the parties of the timetable for filing evidence and/or submissions.

The timetable is to be adhered to. It provides more than enough time, in the vast majority of cases, for facts or submissions pertinent to the pleaded grounds to be gathered and presented to the Tribunal. Parties should not regard this timetable as a 'starter for ten', to be varied at a later date. The Tribunal will, **in exceptional cases**, consider requests to extend the time allowance. Such requests will need to be fully supported with explanations as to not only what has been done to date but, more particularly, what is left to do and how long it will take to produce the evidence. The Tribunal will also need to be satisfied that the extra time is warranted in the context of the pleaded grounds and what is necessary to determine the case efficiently and fairly.

Further, the Tribunal will use its discretion to set time periods as it sees necessary, which may be less than the further time which the party has requested. Parties should particularly note that, if they have specified a time when the evidence will be

ready and been allowed that further period of time, the Tribunal will look unfavourably upon further extension requests.

On receipt of a properly filed TM9 the Tribunal will make a preliminary decision on its grant or refusal and notify the parties accordingly, in writing. A period of fourteen days from the date of the letter will be allowed for either party to the proceedings to provide full written arguments against the decision and to request a hearing. If no such response is received within the time allowed, the decision will automatically be confirmed.

When filing a TM9 the requester must confirm the form (and any attachment) has been copied to every other party to the proceedings in accordance with rule 77(3) of the Rules.

An application to extend any prescribed period must be made in writing, before the relevant period expires, and is subject to the filing of a TM9 and payment of the fee. If an application to extend is made outside the relevant period it must be accompanied by an explanation for the delay. In deciding whether to allow the extension, the Tribunal will need to be satisfied that it is just and equitable to do so. Several decided cases have provided guidance in respect of extension of time requests. The following paragraphs only set out to summarise salient points in relevant decisions. Each case will depend on individual circumstances and it is advisable to read each decision referred to in greater depth.

### **Key points from decided cases**

The party seeking the extension has the evidential burden of justifying it. The reasons for the extension should be 'strong and compelling'.<sup>30</sup>

It is for the party in default to satisfy the Court that despite his default, discretion should be exercised.<sup>31</sup>

The fact that evidence is available at the time a Hearing/CMC on a contested extension of time takes place is not determinative, though it is an important factor.<sup>32</sup>

While ongoing negotiations do not relieve a party of its obligation to file evidence they could still be a relevant factor in exercising discretion.<sup>33</sup>

In *Siddiqui's Application*<sup>34</sup> the Appointed Person said that it was incumbent on the party requesting the extension to put forward facts which merited the extension. The Appointed Person said:

*"In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he*

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<sup>30</sup> *A.J and M.A Levy's Trade Mark* [1999] RPC 292

<sup>31</sup> *Liquid Force* [1999] RPC 429

<sup>32</sup> *Ibid*

<sup>33</sup> *Ibid*

<sup>34</sup> BL O/481/00

*has acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the Registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.”*

The applicant for an extension (and the opposer) must, therefore make a full disclosure of the relevant facts in writing prior to the hearing.<sup>35</sup>

#### **FAILURE TO COPY TO THE OTHER SIDE OR TO PROVIDE DETAILED REASONS WILL RESULT IN REFUSAL OF THE EXTENSION.**

##### **4.9.2 Stay of proceedings**

Following the *Liquid Force* decision, the Tribunal makes a clear distinction between an extension of time to file evidence and a stay or suspension, jointly requested by the parties, in which they can negotiate. If granted, the Tribunal may impose conditions in respect of any stay or suspension.

The Tribunal does not intend to force parties into the filing of evidence where parties can ultimately reach a negotiated settlement. Nevertheless, the Tribunal has an overriding objective to ensure that all proceedings are completed within a reasonable time and avoiding unnecessary expense. There is a clear public interest that third parties should have certainty as to the outcome of proceedings.

Consequently, there may come a point where the Tribunal directs the parties to file evidence or face their case being struck out, despite the fact that they are still in long running discussions.

Rules 18(4) and (5) allow parties to enter a cooling-off period to attempt to resolve their dispute by negotiation. The period of time is generous, particularly if the option to extend the initial cooling-off period is used. The Rules expressly limit the length of the cooling-off period to a maximum of 18 months. Staying proceedings for further negotiations at the end of the cooling-off period effectively circumvents the maximum period allowed for cooling off. Consequently, once parties have exited cooling-off and the proceedings have been joined (by the filing of the defence), **the Tribunal will not permit an immediate stay of proceedings for further negotiations unless:**

**a) The parties can state a date, within the next month or so, by which time agreement is expected, or**

**b) The parties have agreed to mediation**

Where, following the cooling off period, proceedings are stayed until a date provided by the parties (as in a) above), the Tribunal will look unfavourably upon further stay

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<sup>35</sup> *Style Holdings Plc's application* BL O/464/01 and *Ministry of Sound* BL O/136/03

requests. A stay request for further negotiations made after the parties have seen each other's evidence will be at the discretion of the Hearing Officer responsible for the case and may form the subject of a CMC (see section 6.6).

## **Procedure**

Where a stay is requested on the basis that the parties are trying to negotiate an amicable settlement, the parties will need to show what they have done in their negotiations in the period prior to the request. Consequently, it will be expected that details of the dates of the actions that they have taken and the nature of those actions will be included in the statement. The statement will not need to go into confidential or without prejudice details but it will need to show that there has been serious and continuing work towards a settlement going on prior to the request. As well as listing communications between the representatives it should also show any communications with instructing clients.

A list of actions might be something like this:

- **3 September 2011**  
letter to representative of x re settlement conditions
- **13 September 2011**  
letter from representative of y
- **13 September 2011**  
letter to client re proposal from y

The parties will also need to make a statement of the progress to date and give an indication as to whether outstanding issues are merely minor issues of clarification or whether they represent potentially significant barriers to a resolution of the matter. The parties will be expected to state realistically and clearly when they expect the negotiations to be completed and the proceedings concluded.

If the request for a stay or suspension follows immediately after a counterstatement has been received and where there has been no cooling off period, it is possible that all the parties will have been able to achieve is an agreement to start negotiations. In such cases the Tribunal will look sympathetically at the first request to stay the proceedings. However, repeat requests will be looked at more critically and the Tribunal will need to be reassured that real progress is being made towards a negotiated settlement.

## **4.10 Intervention**

### *Rule 45 of the Trade Marks Rules 2008*

This rule allows any person, other than the registered proprietor, claiming to have an interest in proceedings on an application for:

- Revocation on grounds of non-use

- Revocation on grounds other than non-use
- Invalidation

or

- Rectification

to file an application on a TM27 for leave to intervene, stating the nature of its interest.

The Tribunal may grant or refuse leave to intervene and if leave to intervene is granted conditions may be attached, e.g. undertaking as to costs. The intervener is treated as a party to proceedings.

#### **4.11 Partial refusals**

##### **4.11.1 The Law**

Article 13 of the First Council Directive 89/104 of December 21, 1988, to approximate the laws of the Member States relating to trade marks, states:

"Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only."

In *Sensornet Trade Mark*,<sup>36</sup> Mr Richard Arnold Q.C., sitting as the Appointed Person stated that:

"50....if an objection to registrability only applies to some goods or services in the specification applied for, then the application should only be refused in so far as it covers those goods or services and should be allowed to proceed in respect of the remainder. I consider that this is equally true during examination and during opposition.

52. Suppose, for example, that an applicant applies to register a mark in respect of "motor cars; motor cycles; bicycles" and that, for whatever reason, the Registrar concludes that the requirements for registration are met so far as the application relates to "motor cars; motor cycles" but that they are not met so far as the application relates to "bicycles". In those circumstances I consider that the Registrar can and should decide to refuse the application so far as it relates to "bicycles" but accept it so far as it relates to "motor cars; motor cycles".

53. Furthermore, I do not consider that in such circumstances it is necessary for the applicant to amend the specification under section 39 in order for the acceptable part to be accepted and published for opposition. All that is

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<sup>36</sup> BL O/136/06

needed is to identify which part of the specification is acceptable and which is not, and the Registrar's decision can and should do this. To my mind, section 39 has a different function, which is to enable applicants to make voluntary restrictions to specifications, whether in the hope of side-stepping a ground of objection or for other reasons... I consider that it is possible that section 39 enables applicants to make amendments to the wording of the specification and that this is not a power which the Registrar has...

...57. Thus if the hypothetical case considered in paragraph 52 arose in opposition proceedings, I consider that the result should be the same. The hearing officer could and should decide to refuse the application so far as it related to "bicycles" but accept it so far as it related to "motor cars; motor cycles". Again it would be unnecessary for the applicant to request amendment of the specification under section 39...

...59. It will be seen that the situations discussed above all involve taking the specification as it stands and, in the event that it is decided that grounds for refusal exist in respect of certain of the goods or services specified but not others, deleting the objectionable goods or services from the specification i.e. applying a blue pencil approach."

In *Giorgio Armani SpA v Sunrich Clothing Ltd*<sup>37</sup> Mann J considered the correct approach to arriving at a fair specification in opposition proceedings where there were grounds for partial refusal and where he had concluded that the application of the metaphorical "blue pencil" by the Hearing Officer was not appropriate and no unconditional restriction had been offered by the applicant. He considered the application of the principles applied by Mr Arnold in *SENSORNET* and said:

"52. [...] there is no case law binding on me which deals with the point I have to decide, and I have to decide it on the footing of the statutory provisions as to applications and amendment, such rules of procedure as govern the proceedings, and on the footing of normal requirements of procedural and substantive fairness. Mr Arnold's views do not really deal with this sort of situation [...]. So far as they indicate that the Hearing Officer has to take the specification as he or she finds it, he is not dealing with a case where there needs to be a debate in inter partes proceedings about the scope of the permitted registration. If applied too literally the concept would prevent the proper resolution of part of the real dispute.

53. What the present situation involves is the proper identification and resolution of the dispute arising out of the opposition, and the following points apply:

- (i) Since this case was one of partial opposition (in terms of the goods covered), Article 13 requires that there be registration of the mark in relation to goods in relation to which the mark was not opposed. The

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<sup>37</sup> [2010] EWHC 2939 (Ch)

available procedures should enable that to be done fairly and efficiently.

(ii) [...] the proper scope of registration [...] is the [potential area of dispute]. In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling that which is not admissible, or it might be obvious that a plain express qualification ("save for [the goods in respect of which the opposition succeeded]") will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities.

Mann J went on to consider the range of procedures that could be adopted in which a dispute as to residual wording could be determined, as referred to by Mr Geoffrey Hobbs, sitting as the Appointed Person in *Citybond Trade Mark* [2007] RPC 13. The range of procedures identified range from the applicant deciding to limit its application to some different specified wording in an unconditional amendment application, to a deferment of the question of alternative wording to the stage after consideration of the formulated objection, with other possibilities in between. He concluded by stating that the Hearing Officer should provide a mechanism for ensuring that he/she is able to give a ruling as to what was left of the registration after a successful opposition.

#### **4.11.2 Practice**

##### **Undefended opposition/invalidation/revocation ("the proceedings")**

In a case where amendment to the specification(s) of goods/services is required because the proceedings are undefended, the Tribunal will, where appropriate, adopt one or a combination of the following approaches:

- a) Where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Tribunal will take a "blue pencil" approach to remove the offending descriptions of goods/services. The application will be deemed to be abandoned in respect of the goods and/or services specified in the TM7 or TM26 and the remainder of the application will proceed to registration
  
- b) Where the extent of the opposition cannot be easily reflected through simple deletion, the Tribunal can add a "save for" type exclusion to the existing descriptions of goods/services that reflects the goods/services specified in the TM7 or TM26 and leaves a comprehensible list of goods/services. The application will proceed to registration (or remain registered) with a "save for" type exclusion

c) Where there is uncertainty regarding the suitability of either of the first two approaches, the case will be considered by a Hearing Officer who will indicate in their own words, the extent to which the proceedings succeed and invite the parties to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings. After considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services

## **Defended proceedings**

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings, the Hearing Officer will, where appropriate, adopt one or combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that proposed rewording into account subject to it being sanctioned as acceptable from a classification perspective

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that proposed rewording into account subject to it being sanctioned as acceptable from a classification perspective

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly be reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer will indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to

the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered “men’s and boys’ clothing”, thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the ‘blue pencilling’ approach or the ‘save for’ type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal.

#### **4.12 Pleadings**

The rules make no mention of the word ‘pleadings’ which is an alternative term for statements and counter-statements. Pleadings serve a simple function: to identify the issues between the parties which will then be the subject of evidence. Evidence and pleadings are quite different and should not be confused. Unless there is express provision in the rules, the Tribunal does not expect evidence to be filed at the pleadings stage. Pleadings should contain:

- The facts to be relied upon
- The basis in law for the action, and
- The relief being sought and whether costs are requested

Parties to Tribunal proceedings should, in order to avoid wasted time and costs, provide fully focussed and particularised pleadings. Mere recitation of various sections of the Act will not suffice; parties must know in detail the case they have to answer or the basis on which an attack is defended/accepted.<sup>38</sup>

The Tribunal, prior to formal serving of pleadings, will use appropriate powers to require a party to better particularise, or explain, its pleadings. Further, if in the view of the Tribunal, a particular ground of attack is plainly unsustainable, objection may also be raised. It is important to note, however, that the Tribunal does not intend to prejudge matters of substance, which should properly be decided once all the evidence and submissions have been made. Nor will the Tribunal force parties to

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<sup>38</sup> NASA [2000] RPC 21

incur unnecessary cost at an early stage of proceedings. There will be circumstances where the Tribunal will allow matters to continue but serve notice that it would expect evidence later filed to support a particular claim or indicate that there may be a penalty in costs.

### **Section 5(3) Grounds pleaded in opposition/invalidation**

Section 5(3) reads as follows:

“A trade mark which—

is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Section 5(3) can be pleaded in relation to identical, similar and/or dissimilar goods and/or services on the basis that there will be unfair advantage to the junior mark or detriment to the distinctive character or repute of the earlier mark.

### **THE OPPONENT/APPLICANT FOR INVALIDITY MUST STATE WHAT THE OBJECTION IS AND WHY.**

The claim could be particularised in the following ways (where relevant):

- "It will take unfair advantage of our reputation by....."
- "It will tarnish our reputation because...."
- "It will be detrimental to the distinctive character of our trade mark because.... and will affect the economic behaviour of consumers by causing them to....."

The other side must know the scope of the claim against them. If the opponent/applicant for invalidity has simply quoted the text of the Act they will be required to particularise the claim by reference to the specific damage and basis of the claim for that damage.

### **Section 5(4)(b) Grounds pleaded in opposition/invalidation**

Section 5(4)(b) prohibits the registration of a trade mark if its use in the United Kingdom is liable to be prevented by virtue of an earlier right (other than earlier rights under sections 5(1)(3) and 5(4)(a)) but "*in particular by virtue of the law of copyright, design right or registered designs*".

The requirement that the applicant for invalidation or opponent be the owner of the right relied upon applies and is defined in section 5(4) of the Trade Marks Act as a person who is entitled to take legal action under copyright or design law in order to prevent the use of the trade mark.

## Copyright

The law of copyright in the United Kingdom is governed by the Copyright, Designs and Patents Act 1988 (CDPA). There is a qualification requirement as to the nationality (which extends to domicile/residence) by reference to the author of the copyright work (section 154 of the CDPA) or, alternatively, by reference to the country of first publication (section 155 of the CDPA). The pleadings must identify the **author** of the work and the manner in which the work meets these nationality based requirements. Furthermore, as copyright is limited in duration, the date at which the work was created must also be provided.

The owner (proprietor) of the copyright must be identified in the pleadings. The author and the owner may be one and the same, but the position claimed must be clearly stated. If the owner is not the author then the method by which they became the owner should be detailed. It should be noted the first owner of a copyright work is its author unless (in the case of a literary, dramatic, musical or artistic work, or a film) the work is created by an employee in the course of employment (in which case the employer is the first owner of any copyright in the work). This can vary by agreement and the copyright may be assigned to a different party, be it upon creation or later. Any assignment must, though, be in writing for it to be effective (section 90(3) of the CDPA).

The pleadings should set out:

- What the work relied on is, including a representation of it.
- Who created the work and when it was created
- The nationality of the author (or, if the author of the work is a corporate body where the corporate body is incorporated) at the time the work was created
- If domicile/residence of the author is relied upon, where the author was domiciled/resident at the time the work was created
- If the publication of the work is relied on, where the first publication of the work took place and when
- Who the current owner of the work is and, if such a person is not the author, by what method was ownership transferred

There is no requirement for proof of the above to be filed at the pleadings stage.

## Design right

The unregistered United Kingdom design right is also governed by the CDPA. There is a qualification requirement by reference to the designer (section 218 CDPA), by reference to a commissioner or employer (section 219 CDPA) or by reference to the person who first marketed the design (section 220 CDPA). The requirement is met by citizens/subjects/people (including legal persons) of, or incorporated in or habitually resident in, the United Kingdom, the European Economic Area or other qualifying countries (mainly Commonwealth countries) at the time that the design was created. Furthermore, as design right is limited in duration, the date at which the work was created must also be provided.

The owner of the design right is the only person able to oppose. As per section 215 CDPA, the first owner of a design right is the designer, unless the design was produced in the course of employment or by way of a commission (in which case the employer/commissioner is the first owner). This can vary by agreement and the design assigned to a different party, be it upon creation or later. Any assignment must, though, be in writing for it to be effective (section 222(3) CDPA).

The pleadings should set out:

- A representation of the design relied upon
- Who designed the design and when this took place
- The nationality of the designer at the time the design was created or, if domicile/residence is relied upon, where the designer was domiciled/resident at the time the design was created
- If qualification is by reference to an employer or a commissioner, the nationality of the employer/commissioner (or if the employer/commissioner is a legal person where it was incorporated), or if domicile/residence is relied upon, where the employer/commissioner was domiciled/resident at the time the design was created (or in the case of a legal person where it has a place of business conducting a substantial business activity)
- If qualification is by reference to the first marketing of the design relied upon, who the first marketer was (and that they were authorised to market the design in the United Kingdom), that person's nationality/domicile/place of business, and where and when the design was first marketed
- Who the current owner of the design right is and, if such a person is not the designer/commissioner/employer, by what method was ownership transferred

## **The unregistered Community Design Right**

The unregistered Community Design Right is governed by the Community Design Regulation 6/2002 ("CDR"), (particularly Articles 11, 85(2) and 110a (5)). The right arises following a publication of the type described in those Articles. The owner of the design right is the only person able to oppose. The first owner of a design right is the designer; unless the design was produced in the course of employment in which case the employer is the first owner (a commissioner does not do so unless this is provided by contract). This can vary by agreement and the design can be assigned to a different party, be it upon creation or later. The validity of an assignment is governed by the national law applicable under CDR Article 27.

The pleadings should set out:

- A representation of the design relied upon, together with an indication, if it is not evident, of what constitutes its individual character
- Who designed the design, when this took place, and whether he/she was an employee acting in the course of duties as such or under instructions from the employer
- Where and when the design was first disclosed (other than in confidence), and all the circumstances of the disclosure
- Who the current owner of the design right is and, if such a person is not the designer/employer, by what method was ownership transferred

## **Registered designs**

All that is required is the respective number of the registered design in question and a print from the relevant database showing the details of the design in question. The owner of the registered design is the only party entitled to oppose the registration of a trade mark based on such a right.

### **4.13 Procedural irregularity**

In addition to an inherent jurisdiction to regulate proceedings, the Tribunal has a rule-based power, under rule 74, to rectify any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the Office. This can be raised by the parties or by the Tribunal.

If a party wishes to raise the issue of procedural irregularity they should do so in writing. A decision of the Tribunal under rule 74 will be issued to the parties in writing, normally as a preliminary view, with a period set in which to request a hearing if either of the parties should disagree with the Tribunal's decision.

#### **4.14 Publication of amendments**

*Rule 25 of the Trade Mark Rules 2008*

Amendments to the list of goods/services made by the applicant (on a TM21) after publication will continue to be published and the amendment open to opposition for a period of one month as required by rule 25. However, deletion of particular descriptions of goods/services, whether by 'blue pencilling' or through the addition of 'save for' type qualifications, will not be regarded as an amendment under s.39 and therefore will not be subject to the further one month opposition period specified in rule 25.

#### **4.15 Representation before the Tribunal**

In inter partes proceedings before the Tribunal, litigants based in the UK, EEA and the Channel Islands can prosecute the matter themselves; there is no requirement to have a solicitor, trade mark attorney or other representative.

That said the Tribunal invites those involved, or likely to become involved, in disputes, to consider appointing a legal representative. This is because, unlike applying for registration of a trade mark which is an administrative procedure, becoming engaged in a dispute involves the parties and the Tribunal in judicial or quasi-judicial proceedings. The Tribunal is in the position of a judge with some of the powers of the court. The proceedings can be complex, for example, they may involve competing rights and/or may impact upon a party's business.

A TM33 will be required if a new agent is appointed. No fee is required.

If a representative is appointed, it is possible to appoint for limited duties, for example, to represent the client at any hearing or to deal only with certain matters. The need for an address for service in the UK, EEA and the Channel Islands still applies. It is the applicant/opponent or registered proprietor's responsibility to notify the Tribunal of any changes to their address for service.

The Tribunal has the power to refuse to deal with certain agents if:

- They have been struck off the Register of Trade Mark Attorneys
- They have been found guilty of an offence such as would render them liable to have been struck off (section 88 of the Act)

If a representative is appointed, they do not have to be on the Register of Trade Mark Attorneys to act before the Tribunal.

#### **4.16 Setting aside cancellation of an application or setting aside revocation/invalidation of a registration**

*Rule 43 of the Trade Marks Rules 2008*

This rule applies where:

- An application for registration is treated as abandoned under rule 18(2)
- The registration of a mark is revoked under rule 38(6) or rule 39(3) or
- The registration of a mark is declared invalid under rule 41(6)

If the applicant or proprietor wishes to request a decision be set aside under this rule they must, within a period of six months beginning immediately after the date the application was refused, (or the mark was invalidated or revoked, as the case may be), file a TM29 requesting that the decision be set aside. This request must be accompanied by evidence in support of the application. The form and evidence must be copied to the other party to the original proceedings.

In considering whether to set aside the original decision the Tribunal must consider the following:

- Whether the person seeking to set aside the decision made an application, promptly upon becoming aware of the original decision
- Any prejudice which may be caused to the other party to the original proceedings if the original decision were to be set aside

The evidence filed must demonstrate that the failure to file a defence on a TM8 within the time specified was due to a failure to receive the TM7 (or TM26(N)/TM26(O)/TM26(I), as the case may be). If this can be established to the satisfaction of the Tribunal then the original decision may be set aside.

#### **4.17 Substitution of parties**

Whilst the rules make no express provision, it has been held that parties can be substituted in proceedings.<sup>39</sup> For example, where an interest in a mark or marks forming the basis of an opposition is assigned to another party, that party, may apply to the Tribunal to be substituted for the original opponent or applicant. It should be noted that this only applies if the transfer takes place after the proceedings have commenced, whether or not any inextensible periods for filing pleadings have expired.<sup>40</sup> Once such a substitution takes place however, this does not give the new party a right to recommence proceedings based on fresh pleadings and/or evidence. There is discretion to amend pleadings, withdraw evidence or file fresh evidence, but the substitution of an opponent/applicant gives no additional right to revisit the pleadings and/or evidence.

Any application to substitute a party must be made in writing, supported by copies of any transfer document (e.g. an assignment). The other party will be invited to

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<sup>39</sup> *Pharmedica* [2000] RPC 536

<sup>40</sup> In cases where proceedings have been launched in the wrong name, the ability to correct the misnomer will depend on the intention of the people responsible for filing the forms which commenced proceedings: *Caswick Ltd v The Thompson Minwax Company* BL O/197/00.

comment before any determination is made. If substitution is allowed, the new party will be asked to provide written confirmation that they:

- Have had sight of any forms and evidence already filed and if not suitable arrangements will have to be made
- Stand by the grounds of the original pleading and evidence and confirm that where the name of the original opponent/applicant appears this should be read as if it is their own name
- Are aware of and accept their liability for costs for the whole of the proceedings

Where the Tribunal is asked to allow a new party to be added or substituted in place of the opponent and that request is not due to a transfer of the rights to a pending application or a registered mark, the request may not be allowed.

#### **4.18 Suspension**

Suspension is generally requested when there are other proceedings, either before the Tribunal or in another jurisdiction, which will have a bearing on the outcome of the proceedings at issue. If the other proceedings are in the Tribunal, then the Tribunal will normally propose consolidation rather than suspension of the later proceedings.

#### **4.19 Summary judgment and striking out**

Although there is no mention in the rules of 'summary judgment' it is considered, in appropriate circumstances, to be within the Tribunal's inherent jurisdiction - both on application by one of the parties and of its own volition.

The CPR gives the general basis for striking out at part 3.4 and summary judgment at part 24.2. Rule 3.4 makes provision for the court to strike out a statement of case or part of a statement of case if it appears that it discloses no reasonable grounds for bringing or defending a claim.

A party may seek summary judgment on a case, i.e. have the entire case thrown out, because the other party is estopped from its action or, because its action is an abuse of process. In cases of estoppel and abuse of process it is for one party to raise the issue, the hearing officer will not raise the matter of his/her own motion.

In other cases it may be appropriate when scrutinising the statement and counterstatement for the Tribunal to consider striking out a ground of objection or a ground of defence. A ground of objection may be struck out as it has no chance of success e.g. relying on a trade mark that has a later date of filing for an action under section 5(2) of the Act.

#### **Case law**

The considerations that are to be made in relation to striking out/summary judgment have been the subject of a number of judgments of the courts.

For the principles of summary judgment see *Three Rivers District Council v Bank of England (No 3)* [2001] 2 All ER 513 at [94] and *Swain v Hillman* [2001] 1 All ER 91 at [92].

For abuse of process and multiple proceedings see *Walbrook Trustees (Jersey) Ltd & Others v William Simon Fattal & Others* [2009] EWCA Civ 297

For analysis of a ‘real’ chance of success see *William Evans and Susan Mary Evens (a partnership trading together as Firecraft) v Focal Point Fires Plc* [2009] EWHC 2784 (Ch) and *Franbar Holdings Limited v Casualty Plus Limited* [2011] EWHC 1161 (Ch) Proudman J

#### 4.20 Without prejudice and privileged correspondence

In general, the principles of without prejudice correspondence applicable in the court will likewise be applied before the Tribunal. The public interest justification for without prejudice communications not being used as evidence is that parties should be at liberty to pursue negotiations and settlement without running a risk that documents relating to such discussions will be put forward in relation to the strengths or weaknesses of their substantive cases.

A useful definition of the ‘without prejudice’ rule is provided by the following cases:

In *Unilever PLC v The Procter & Gamble Company*<sup>41</sup> (hereafter ‘Unilever’), Walker LJ quoted Lord Griffiths as stating in *Rush & Tompkins v Greater London Council*<sup>42</sup>:

“The ‘without prejudice’ rule is a rule governing the admissibility of evidence and is founded upon the public policy of encouraging litigants to settle their differences rather than litigate them to a finish. It is nowhere more clearly expressed than in the judgment of Oliver LJ in *Cutts v Head*<sup>43</sup>:

*‘That the rule rests, at least in part, upon public policy is clear from many authorities, and the convenient starting point of the inquiry is the nature of the underlying policy. It is that parties should be encouraged as far as possible to settle their disputes without resort to litigation and should not be discouraged by the knowledge that anything that is said in the course of such negotiations (and that includes of course, as much the failure to reply to an offer as an actual reply) (my emphasis) may be used to their prejudice in the course of the proceedings.’*”

Documents do not have to be marked “without prejudice” to be such.<sup>44</sup> It was held in *Chocoladefabriken Lindt & Sprungli AG v Nestle Co. Ltd*<sup>45</sup> that:

<sup>41</sup> [2001] 1 All ER 783

<sup>42</sup> [1989] AC 1280 at 1299

<sup>43</sup> [1984] Ch. 290 at 306

<sup>44</sup> *Prudential Assurance Co Ltd v Prudential Insurance Co. of America* [2004] ETMR 29

*“Any discussions between the parties for the purpose of resolving the dispute between them are not admissible, even if the words “without prejudice” or their equivalent are not expressly used.”*

Any communications between a party and their trade mark attorney (being a registered trade mark attorney) is privileged or protected from disclosure in legal proceedings.<sup>46</sup>

The phrase without prejudice is also used in letters to the Tribunal meaning that the writer is preserving their position, e.g. they withdraw the application without prejudice to their clients' rights. In this instance the wording is part of an open statement and is not afforded any protection.

The without prejudice rule can be excluded in very limited circumstances which are set out in Unilever and the CPR. They are as follows:

- Where the issue is whether a concluded compromise agreement was reached
- Where the issue is whether an agreement between the parties should be set aside on grounds of misrepresentation, fraud or undue influence
- Where a statement made might give rise to an estoppel
- Where the exclusion of evidence would act as a cloak for perjury, blackmail or other ambiguous impropriety
- Where the statement made would explain delay or apparent acquiescence

In Tribunal proceedings, for example, evidence of the fact that negotiations have taken place (and their state of play, insofar as this may be relevant to an application for an extension of time) would be admissible.

Where inadmissible documents are filed with the Tribunal, the Tribunal will return the documents and/or state that they cannot be taken into account in determining the substantive matters.

## **5. COSTS**

*Section 68 of the Trade Marks Act 1994  
Rules 67 and 68 of the Trade Marks Rules 2008*

### **5.1 Liability for costs**

A party to proceedings before the Tribunal may incur a liability for costs. It is impossible to give precise guidelines on an exact award of costs as this will be dependent on the circumstances. It is established practice that the Tribunal uses an

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<sup>45</sup> [1978] RPC 287

<sup>46</sup> S.87 of the Trade Marks Act 1994

official scale. The scale reflects a variable amount for the preparation, filing and examination of forms; compilation of evidence; research and investigation; letters and for representation at hearings. In the evidence stages the scale gives a range for the award, which will depend on the amount and relevance of the evidence filed.

If resulting decisions are appealed then further costs may be incurred.

Any award is unlikely to reimburse the total cost of the proceedings as the award is regarded as contributory rather than compensatory. This is in line with the policy objective to provide a low-cost Tribunal by which no-one should be deterred from seeking, protecting or defending their intellectual property rights.

## 5.2 Unrepresented parties

Any cost awards made in favour of an unrepresented party will include the full cost of any official fees, but will only cover 50% of the amount from the published scale. This ensures that the unrepresented party is not overcompensated for the cost of the proceedings.

When an award is given by the Hearing Officer either with, or after, the issue of the substantive written decision, the unrepresented party will be invited to provide a breakdown of the costs incurred. This itemised account will include the number of hours spent on the proceedings including travel costs.

The Litigants in Person (Costs and Expenses) Act 1975 sets the minimum level of compensation for litigants in person in Court proceedings at £9.25 per hour.

## 5.3 The current scale is as follows:

Task	Cost
<b>Preparing a statement and considering the other side's statement:</b>	From £200 to £600 depending on the nature of the statements, for example their complexity and relevance.
<b>Preparing evidence and considering and commenting on the other side's evidence:</b>	From £500 if the evidence is light to £2000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.
<b>Preparing for and attending a hearing:</b>	Up to £1500 per day of hearing, capped at £3000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.

<b>Expenses:</b>	<p>(a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time).</p> <p>(b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.</p>
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This scale also now takes into account the requirement on a party to give reasonable notice that they intend to proceed with a legal remedy and allows the other party to take appropriate action to avoid this if they wish.

See section 5.8 regarding the requirement to notify.

#### **5.4 The request for costs**

A statement or counter-statement will usually include a claim for an award of costs. Nevertheless, if the statement or counter-statement does not include a claim the Tribunal will still consider making an award to the successful party. However, in proceedings concluded without reaching a final decision, the Tribunal will only consider making an award if a specific request is made to it within a reasonable time. Costs will not usually be awarded until both parties have had the opportunity to comment. If a request for costs is received, within a reasonable time, the other party in the dispute will be sent a letter informing them of the claim and inviting comments. They will be allowed 14 days from the date that notification of the claim is sent to them by Tribunal Section. If by this date a response has not been received the award will be decided from the papers on file.

#### **5.5 Joint opponents and cross-proceedings**

Where two or more parties have joined to oppose an application and the opposition is successful, any costs awarded to the opponents are calculated as being for one opponent only. If the opposition is not successful, the amount which each is to pay may be specified unless it is considered that the joint opponents are jointly and severally liable. The same principle applies in respect of joint applicants for invalidation/revocation/rectification, the Tribunal will award one payment and it is for the parties to agree their respective shares.

In cross-proceedings the award is usually against the same party in both proceedings. Unless the proceedings were consolidated a separate calculation is made in each proceeding. These must be capable of independent justification in case of appeal.

#### **5.6 Costs off the scale**

It is vital that the Tribunal has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. In *Rizla Ltd's application* [1993] RPC 365 (a patent case) it was held that the jurisdiction to award costs, derived from section 107 of the Patents Act 1977, conferred a very wide discretion on the Comptroller with no fetter other than to act judicially. It is considered that the principles outlined in *Rizla's* application apply also to Tribunal proceedings. Thus, if the Tribunal felt that a case had been brought without any bona fide belief that it was soundly based or, if, in any other way, its jurisdiction was being used for anything other than resolving genuine disputes; it has the power to award compensatory costs. It would be impossible to outline all of the situations which may give rise to such an award; however, Hearing Officers have stated that the amount should be commensurate with the extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This "extra costs" principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour. Hearing Officers should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this is not indicative, in itself, of unreasonable behaviour. Any claim for costs approaching full compensation or for "extra costs" will need to be supported by a bill itemising the actual costs incurred.

Depending on the circumstances, the Tribunal may also award costs below the minimum indicated by the standard scale. For example, the Tribunal will not normally award costs which appear to exceed the reasonable costs incurred by a party.

## **5.7 Security for costs**

Security for costs is the provision of an amount of money by one party sufficient to cover that party's liability for costs in proceedings should they lose. Under section 68 and rule 68 the Tribunal has the discretion to make an order for security to be granted. Where the circumstances justify the granting of an order, the Tribunal may do so against any party in proceedings before it. This includes:

- A person making an application for a trade mark which has come under opposition
- A person opposing an application for a trade mark
- An applicant for revocation, invalidation or rectification or the proprietor of the mark under attack

In proceedings before the Tribunal it is usually requested where a party does not carry on business in the United Kingdom or does not appear to have any, or sufficient, assets in the United Kingdom to cover any award of costs made against them, or has not paid previous costs ordered by the Tribunal, OHIM or a Court. Where security is agreed between the parties, appropriate sums of money are deposited or undertakings agreed by third parties such as trade mark agents, solicitors or banks. If there is no agreement that security should be paid, the Tribunal can be asked to intervene and determine the matter.

Requests by UK parties for security for costs from a party which is a national or resident in another member state party to the Brussels or Lugano Conventions may not be granted, unless very cogent evidence of substantial difficulty is provided.<sup>47</sup> In the case of *Sun Microsystems Inc v Viglen*<sup>48</sup> the Appointed Person held, following *Nasser v United Bank of Kuwait*,<sup>49</sup> that security for costs applications needed to be determined on their own merits; simply because a party was resident abroad outside a Brussels or Lugano Convention country would not automatically result in security being ordered. Whether to order security is an act of discretion.

A failure to pay previous costs awards will usually be accepted as good evidence of a difficulty in recovering costs.

## **5.8 Notification of intention to commence proceedings**

If the first a party receives of the action against their mark is the receipt of the notification that proceedings have been launched and the application is subsequently withdrawn, or the mark surrendered, before a counter-statement is filed, the Tribunal will decline to make any award at all.

However, if the applicant files a counter-statement this will be taken as an intention to defend the attack. If the application is then withdrawn or the registration is voluntarily cancelled a deduction will not usually be made to any costs award. If as a result of a failure to maintain a current address with the Tribunal a party does not receive a communication from a prospective adversary and an attack is then launched without warning and disposed of other than by a hearing, the Tribunal is likely to consider that there should be an award of costs.

Where an award of costs is to be decided without a hearing on the question, the parties may provide examples of correspondence, evidence or other matter to support their position (such as a letter proving that warning was given of the impending action).

## **5.9 Consolidation**

If the proceedings were consolidated before any evidence had been filed, the cost calculation should normally award the amount for each stage of the evidence as if it was a single set of proceedings. However, if the consolidation had been ordered after evidence had been filed, the calculation should normally award costs separately for each set of proceedings up to the stage when consolidation was requested, and as though they were one set of proceedings thereafter.

## **5.10 Negotiations and an award of costs**

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<sup>47</sup> This is because the Civil Jurisdiction and Judgments Act 1982, clarified by a decision in the Court of Appeal (*Fitzgerald v Williams*, *The Times*, January 3, 1996, C.A.), determines that the Registrar does not have the power to automatically award costs against such a party, as the Conventions introduced an effective means by which a successful defendant resident in the UK can enforce an order for costs against an unsuccessful plaintiff in another contracting state.

<sup>48</sup> BL O/585/01

<sup>49</sup> [2001] EWCA Civ 556

Parties in proceedings often reach an agreement which enables the action to be settled without the need for a decision. This can result in an applicant or registered proprietor agreeing to limit their application or registration in some way, most usually in relation to the goods or services. It can also result in the application being withdrawn or the registration surrendered. Where the proceedings are settled by negotiation, the Tribunal would expect the agreement to cover the question of costs and for the parties to make their own settlement. Where the request is made following a negotiated settlement, the Tribunal is unlikely to deem an award to either party to be appropriate.

An applicant or proprietor may request an amendment other than as the result of negotiations. This may remove the basis for the proceedings and result in the opponent, applicant for revocation, invalidation or rectification withdrawing them. The withdrawal of a party from proceedings is usually taken as a success for the other side but, where an application or registration has been amended this should be considered as a partial success for the party that launched the proceedings. Where an action is partially successful the Tribunal may award costs which reflect the extent to which it succeeded.

Where an award of costs is made following abortive negotiations, the usual principle of the court applies, namely, that no party will have to pay any costs incurred in the proceedings after an offer by him of as much as the decision gives to the other party. If, on the other hand the offer was only less than the eventual award, he may expect to have to pay all the usual costs.

### **5.11 Discretionary items affecting an award of costs**

Discretionary items are not added to the award of costs unless evidence has been filed. Consular and other stamps on declarations sworn abroad can be considered. When the cost award is to take this expense into account, the calculations and total amount awarded must be shown separately in the costs estimate. They are, however, included as part of the total of the Order. Declarations which are completely disregarded by the Hearing Officer will not usually be included in any cost calculation. There may be exceptions to this where, for example, the declarations or affidavits were filed to meet a challenge that was subsequently abandoned.

### **5.12 Enforcement of an award of costs**

The enforcement of an award is a matter for the party in whose favour the award was made. Section 68(2) of the Trade Marks Act 1994 provides that an order for costs may be enforced in the same way as an order of the High Court. To enforce an order, an application must be made to the Court, but it is not necessary to obtain a judgment. This is done by filing a N322A to the High Court. Application can also be made to the Court of Session in Scotland or the High Court of Justice in Northern Ireland as appropriate. To enforce an award of costs in a Brussels or Lugano Convention country the application needs to be made through the appropriate national court; these are detailed in the Conventions.

Failure to pay an award may also have a consequence in relation to subsequent proceedings as it is likely to be a factor should security for costs be required.

### **5.13 Enforcement of Community Judgments**

Statutory Instrument (SI) 1998 No 1259 (the European Communities (Enforcement of Community Judgments) (Amendment) Order 1998) was laid before Parliament on 1 June 1998 and came into force on 22 June 1998. This SI amended SI 1972 No 1590 (the European Communities (Enforcement of Community Judgments) Order 1972) which provided for the registration and enforcement in the United Kingdom of certain decisions, judgments and orders of Community institutions which Member States are required to make enforceable in accordance with natural law.

The amendment provides that decisions made under Article 82 of Council Regulation 40/94 (the Community trade mark regulation) by the OHIM shall be registrable and enforceable in the United Kingdom in addition to all those decisions, judgments and orders for which provision is already made under SI 1972 No 1590. Decisions made by the OHIM under Article 82 only relate to the fixing of awards of costs.

Upon request the Tribunal will verify the authenticity of a decision fixing costs made by the OHIM for this to then be enforced in the UK.

### **5.14 Non- payments of costs**

It is assumed that parties to proceedings, having an award of costs in their favour, will pursue all the normal avenues to enforce the award. In the event that the award remains unpaid they may then approach the Tribunal.

The Tribunal will then write to the party against whom the award was made reminding them of their obligation, giving them an additional period within which to pay the sum due and stating that if they do not notify the Tribunal that the costs have been paid the details of the failure to pay the costs will be published on the IPO website here: <http://www.ipo.gov.uk/pro-types/pro-tm/pro-t-dispute/t-unpaid-details.htm>

Our aim in publishing these details is to provide an incentive for parties who owe the sums covered by cost orders to settle matters without the need for the successful party to incur further legal costs enforcing the order. Although the Tribunal has no power directly to enforce the order, the rules provide that it may require security for costs from a party engaged in proceedings. If there is reason to doubt that an award of costs outstanding against a party would be honoured, this is a factor which may be taken into account by a Hearing Officer in exercising discretion in terms of considering a request for security for costs.

If the Tribunal is notified that the award of costs has been paid, the details will be removed.

## **6. HEARINGS, CASE MANAGEMENT CONFERENCES AND DECISIONS**

*Rules 62, 63 and 66 of the Trade Marks Rules 2008*

### **6.1 The right to be heard**

## *Rule 63 of the Trade Marks Rules 2008*

Where the Tribunal takes a decision under the Act or Rules, which is, or may be adverse to any party to the proceedings, that party has the right to be heard (or to make oral submissions) on the matter before the decision is made. This is a right which can be waived. For example, if the parties would rather file written submissions on the matter, and the Hearing Officer considers it appropriate, the decision may be made from the papers on the case-file instead.

There are three types of hearing which may occur during the course of proceedings. These are a Procedural Hearing<sup>50</sup>, Case Management Conference (CMC)/Pre Hearing Review and Main (or Substantive) Hearing.

Procedural Hearings and Case Management Conferences will deal with procedural issues and disagreements, usually after a party has objected to a preliminary view. Main Hearings will deal with the substantive issues of the case and complete proceedings. Further details of the different types of hearing and when they arise are given below at sections 6.6, 6.7 and 6.8.

### **6.2 Preliminary view**

If a dispute arises during the course of the proceedings over a procedural issue, which may either be between the parties or the Tribunal and party/parties, the Tribunal will issue a preliminary view on the matter. Parties should note that, in relation to procedural issues that come before it, the Tribunal will not usually ask the other side for comments before it issues its preliminary view in writing. The Tribunal's preliminary view will become final unless a party objects to it and provides written reasons for doing so (copied to the other side). If that happens, a CMC or Procedural Hearing will usually be appointed.

### **6.3 Representative for the Tribunal**

All Hearings and CMCs are conducted by senior officers of the Tribunal who have delegated powers to act on behalf of the Registrar. Hearing Officers may have an assistant or observer who does not generally take an active part in the proceedings.

In addressing the Hearing Officer, parties may use either his or her normal address e.g. Mr X/Mrs Y, but Sir/Madam will be acceptable.

The Tribunal may also make arrangements for a shorthand writer to be present, if appropriate, or in the case of video conference Hearings, for an audio recording. Where a record is being taken the parties will be told and entitled to ask for a copy of the record.

### **6.4 Representative for the parties**

A person can represent themselves or appoint a representative. It should be noted that there is no requirement for any person or appointed representative to be legally

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<sup>50</sup> Procedural hearings are also referred to as Interlocutory or Joint hearings. See the glossary for full explanation of these terms.

qualified. In the case of *Denis McCourt and Darren Chapman's Application (BL O/299/02)* the Hearing Officer stated:

*'The Trade Mark Tribunal is intended to be a relatively informal, low cost, easy access alternative and to make it compulsory for representation to be legally qualified persons is inconsistent with these objectives'.*

A party is also not obliged to attend any hearing and, if they choose not to attend, they may instead wish to rely on written submissions made beforehand and copied to the other party.

### **6.5 Oral submissions (and the order in which they are given) by the parties**

The Hearing Officer will first introduce the proceedings and indicate any preliminary issues that need addressing. The party on whom the onus rests or, in other words, the party on whom the 'burden of proof' lies will then be invited to commence oral submissions.

For example, at a main hearing in an opposition case, the opponent will provide their submissions first. Once the opponent has finished making his submissions, the applicant will be invited to make his. The opponent will then have an opportunity to make final submissions in reply to those of the applicant.

An example with regards to the right to begin submissions at a procedural hearing would be where a party is seeking amendment of pleadings. In this instance, the party seeking the amendment would speak first, followed by the other party. The party seeking amendment would then be given the opportunity to reply to the other party.

It is ultimately for the Hearing Officer to determine the manner in which a Hearing will be conducted and the order in which parties will make submissions. If the right to begin is disputed, this must be resolved as a preliminary issue at the direction of the Hearing Officer.

### **6.6 Case Management Conference**

*Rule 62 of the Trade Marks Rules 2008*

Rule 62 empowers the Tribunal to give case management directions. There is a public interest in resolving disputes before the Tribunal efficiently and within a predictable timescale. Swift and effective determination of cases not only reduces the burden of litigation and the accompanying costs for the parties involved but creates certainty for third parties. Furthermore, drawn-out proceedings which become unnecessarily complicated or sidetracked, affect the resources which the Tribunal is able to fairly allocate to other users.

If procedural disagreements arise during the evidential time periods or later, the matter will usually be resolved through appointment of a Case Management Conference. Examples of matters resolved at such a hearing would be extension of time requests, whether cases should be consolidated, issuing of confidentiality

orders, suspension of proceedings and the granting/refusal of requests to cross-examine witnesses. This is not an exhaustive list.

Hearing Officers will use their wide case management powers to make appropriate directions to the parties covering all aspects of the future management of the case in order to meet the overriding objectives of the Tribunal. For example, it is currently not uncommon for parties pleading a section 5(2) (b) ground to rely upon several earlier marks, including a mark which is subject to proof of use for a narrower specification of goods and services than another earlier registration of the same mark for a wider specification, but which is not subject to proof of use. In such a case, the Hearing Officer may refuse further time to file evidence of genuine use because it will not assist the determination of the case, instead only adding unnecessary time and cost to the proceedings, and ultimately cost for the parties concerned (rule 62(2)). Similarly, rule 62(h) allows for part of any proceedings to be dealt with as separate proceedings. For example, a case may be potentially resolved by a relatively simply pleaded section 5(2) ground rather than by a contentious bad faith ground (section 3(6)) with attendant complicated evidential issues. In such a scenario, the Hearing Officer may direct that the proceedings be separated so that evidence on the 3(6) ground will only be necessary if the case cannot be resolved on the simpler section 5(2) grounds.

Parties should also note that rule 62 allows the Tribunal to direct the parties to attend a case management conference, even if the parties have not requested to be heard on a matter. Such direction will be given where the Tribunal considers it is necessary in order to meet the overriding objectives. For example, if there are a number of ongoing cases between the same parties with numerous and complex overlapping issues, the Tribunal may appoint a Case Management Conference in order that directions can be given on the future conduct of the cases. Such directions may include the setting of a timetable and structured framework to ensure that the proceedings are concluded within a timely manner whilst keeping costs to a minimum.

#### **6.6.1 Appointment of the date and location**

Where a Case Management Conference is due to be held, the Tribunal will notify the parties of the date and time it will take place, giving **14 days notice** from the date on which notice is sent unless the parties agree to a shorter timescale.

If within 5 days of the date of the notice either party provides the Tribunal with exceptional reasons as to why it cannot make the appointed date, or arrange representation for that date, then another date may be appointed which will be within 7 days of the first date. No party will be permitted to reject two dates/times.

Case Management Conferences will normally take place by telephone conference.

#### **6.6.2 Skeleton arguments**

Skeleton arguments are not required prior to a Case Management Conference but parties should be prepared to deal with all matters relevant to the future management of the case.

### 6.6.3 Decision and directions

The Hearing Officer will give directions at the Case Management Conference with regards to the future conduct of the case. Directions will be confirmed with a confirmatory letter to both parties.

## 6.7 Procedural Hearing

Where procedural disagreements arise, whether between the parties or between the Tribunal and a party/parties, and where a party/parties are not content to accept the Tribunal's preliminary view on the matter, a Procedural Hearing may be requested to resolve the issue. Such a hearing will normally deal with matters arising during the pleadings stage (before the parties have filed evidence). Examples of matters which are resolved at such a hearing are the admissibility of pleadings and the striking out of grounds. This is not an exhaustive list.

### 6.7.1 Appointment of the date and location

Where a Procedural Hearing is due to be held, the Tribunal will notify the parties of the date and time it will take place, giving **14 days notice** from the date on which notice is sent.

If within 5 days of the date of the notice either party provides the Hearings Clerk with exceptional reasons as to why it cannot make the appointed date, or arrange representation for that date, then another date may be appointed which will be within 7 days of the first date. No party will be permitted to reject two dates/times.

Procedural Hearings and Case Management Conferences will normally take place via telephone conference.

### 6.7.2 Skeleton arguments

Skeleton arguments are not normally required prior to a procedural hearing.

Where skeleton arguments are required, or filed, they must be received by the Tribunal by **14:00** two working days before the hearing, regardless of the start time of the hearing. For example, for any hearing due to take place on a Thursday, the skeleton arguments must be filed by 14:00 the previous Tuesday. As with all other correspondence, a copy must also be sent to the other party. If the parties wish to arrange a simultaneous exchange, then they should contact each other to arrange this.

### 6.7.3 The decision

Decisions on procedural matters will often be given at the hearing itself and will be followed with a letter to both parties confirming the decision and reasons. **Parties should note that, in accordance with rule 70, any decision made after a procedural hearing which does not terminate the proceedings or make an**

**award of costs can only be appealed independently of the final substantive decision with the leave of the Tribunal.**

## **6.8 Substantive (Main) Hearing**

Once the periods for the parties to file evidence have been concluded, either party may request the appointment of a main hearing to make oral submissions to the Hearing Officer on substantive matters. Further, in cases of invalidation based on relative grounds, the Hearing Officer may direct that the parties attend a hearing.

### **6.8.1 Appointment of the date and location**

At the conclusion of the evidence periods, the parties will be provided with a period of 14 days from the date of the Tribunal's letter to notify the Tribunal if they wish to be heard and, in the event that a hearing is requested, the Tribunal will appoint a time and date.

When the date for the Main Hearing is decided, the Tribunal will send notice to the parties of the date and time it will take place, giving **at least 14 days notice** from the date on which notice is sent unless otherwise agreed.

Any request made by party/parties to postpone or rearrange an appointed date for a Main Hearing must be made within a reasonable time period and be supported by full and precise reasons. In the case of a request to rearrange, the Tribunal would expect the parties to agree a list of other dates suitable to both parties which can be put forward for the consideration of the Hearing Officer.

**PARTIES SHOULD BE AWARE THAT WHETHER AN APPOINTED DATE CAN BE CHANGED OR POSTPONED IS ULTIMATELY AT THE DISCRETION OF THE HEARING OFFICER. THIS APPLIES TO ALL TYPES OF HEARINGS AND CMCs.**

Main Hearings will normally take place via video conference with the Hearing Officer sitting in the Newport Office and the parties sitting in the London Office. The parties can also elect to attend the hearing in person at the Newport Office. However, if cross-examination is to take place, the hearing will normally be in person and will take place either in London or Newport.

### **6.8.2 Skeleton arguments**

Parties with legally qualified representatives are required to submit skeleton arguments in advance of a Substantive Hearing. Where parties intend to rely on authorities (other precedent cases) then details of these should be included within the skeleton arguments.

Parties who do not have a legally qualified representative are not required to provide skeleton arguments, although they may do so if they wish.

Where skeleton arguments are required, or filed, they must be received by the Tribunal by **14:00** two working days before the hearing, regardless of the start time of the hearing. For example, for any hearing due to take place on a Thursday, the

skeleton arguments must be filed by 14:00 on the Tuesday before. As with all other correspondence, a copy must also be sent to the other party. If the parties wish to arrange a simultaneous exchange, then they should contact each other to arrange this.

### **6.8.3 Cross-examination**

*Section 69 of the Trade Marks Act 1994*  
*Rule 65 of the Trade Marks Rules 2008*

Where a party wishes to cross-examine any witness on his written evidence, the request to cross-examine must be made at the earliest opportunity (preferably at the same time as the request to appoint a Main Hearing) to ensure reasonable notice is given.

If a request to cross-examine is received, the Tribunal will need to be satisfied that it is appropriate in all the circumstances. To ensure that the Tribunal has the necessary information on which to base his decision and to ensure the effective conduct of proceedings, all parties making a request for cross-examination should:

- Make the request at the earliest opportunity
- Give the name of the witness they wish to cross-examine
- Give reasons why cross-examination of each witness is requested
- Set out the specific issues to which cross-examination would, if allowed, be directed
- Explain the relevance of those issues to the matters to be decided
- Give an estimate of the time any cross-examination is expected to take
- Copy the request to any other party to the proceedings

For clarification, as regards bullet-point 4 above, the Tribunal does not expect parties to provide a list of the questions to be asked.

The Hearing Officer responsible for the case will then issue directions indicating whether cross-examination is to be permitted and, if so, setting out the scope for its conduct (this may form the subject of a Case Management Conference prior to the Main Hearing).

If cross examination takes place, the witness will be sworn in and his written statement will be taken as his evidence in chief - assuming he is not *only* giving oral evidence. General legal principles of cross examination will apply, such as:

- Cross-examination questions can be leading, re-examination cannot be

- There is nothing to stop a witness being questioned on relevant matters put in evidence by the other side's witnesses, even though the person being cross-examined had said nothing in his own written evidence about the matters in question
- New documents can be introduced which challenge the credibility of a witness
- Admission of new evidence will be limited

This is not an exhaustive list.

As a rule, persons will usually be required to attend the hearing in person if they are to be cross-examined however by using a video conference facility it might be possible to cross - examine persons without requiring their attendance at the hearing. This applies in particular to persons outside the UK, but there are a number of factors to consider. For guidance refer to Civil Procedure Rules, Part 32 Evidence, Practice Direction Annex 3.

When used for cross examination or the taking of oral evidence, the objective should be to make the video conference facility session as close as possible to the usual practice at a hearing. To gain the maximum benefit, several differences have to be taken into account.

Some matters, which are taken for granted when cross examination or oral evidence is undertaken in the conventional way, have a different dimension when it is undertaken by video conference facility: for example, the administration of the oath, ensuring that the witness understands who is at the local site and what their various roles are, the raising of any objections to the evidence and the use of documents. This is further complicated when the witness under examination is a foreign national giving their evidence from outside the UK.

Whilst it should not be presumed that all foreign governments are willing to allow their nationals or others within their jurisdiction to be examined before a Tribunal in England or Wales by means of a video conference facility, the Tribunal does not require inquiries to be made if the witness is located in either the European Economic Area or a British Overseas Territory.

*In all other cases, enquiries should be directed to the Foreign and Commonwealth Office (International Legal Matters Unit, Consular Division) with a view to ensuring that the country from which the evidence is to be taken raises no objection to it at a diplomatic level. The party who is directed to be responsible for arranging the attendance of the witness will be required to make all necessary inquiries about this well in advance of the hearing and must be able to inform the Tribunal what those inquiries were and of their outcome. In cases where appropriate inquiries have been made but no response received, the Tribunal will proceed on the basis that no objections are being raised.*

If there is any doubt about this, enquiries should be directed to the Foreign and Commonwealth Office (International Legal Matters Unit, Consular Division) with a view to ensuring that the country from which the evidence is to be taken raises no objection to it at a diplomatic level. The party who is directed to be responsible for

arranging the attendance of the witness will be required to make all necessary inquiries about this well in advance of the hearing and must be able to inform the Tribunal what those inquiries were and of their outcome.

Time zone differences need to be considered when a witness abroad is to be examined in England or Wales by video conference facility. The convenience of the witness, the parties, their representatives and the Hearing Officer must all be taken into account. The cost of the use of a commercial studio is usually greater outside normal business hours. There is also the issue of the capability of the witness to understand proceedings in English and respond accurately to questioning, or whether this might require a translator to act with the witness.

#### **6.8.4 The decision**

At the completion of the parties' submissions at a hearing, the Hearing Officer may give their decision straightaway or may reserve it for later issue. In other cases, the Hearing Officer may suspend their decision pending a subsequent event, such as registration of a material earlier right. There is generally a tendency to reserve Main Hearing decisions.

Following the Hearing, the Hearing Officer will issue a decision which will include full reasons in support of that decision. This decision can be appealed either to the Appointed Person or to the High Court. Please see the 'Appeals' section for details on how to appeal against the decision at section 7.

#### **6.8.5 The role of the Hearing Officer after the Hearing**

Once the Hearing Officer has given their decision in writing and provided a full statement of reasons for that decision, they become *'functus officio'*, that is, their role is complete and they can take no further action in the matter adjudicated upon.

Queries or explanations in relation to the decision reached cannot be entertained and must be pursued through appeal mechanisms. Likewise, it is not possible to pursue substantive issues through channels such as office complaints procedures, (although a complaint about the handling of the case may be considered).

The Hearing Officer may however issue a supplementary decision to clarify his original intention or to correct clerical errors or to deal with costs.

#### **6.9 Abatement**

The common law principle of abatement would apply where the Tribunal has issued a decision which, had it known of circumstances completely disposing of the issue (e.g. an assignment of the mark in suit to an applicant for revocation) it would not have issued it. In such circumstances the Appointed Persons have held that they have the power to set aside the Tribunal's decision.

#### **6.10 Withdrawal of the action after the Tribunal's decision**

Once a decision has been issued by the Tribunal it is not possible for a party to withdraw an action e.g. as a result of settlement, thus 'setting aside' or nullifying the effect of the Tribunal's decision. Parties must instead apply to the Court or Appointed Person to obtain a consent order.

## **7. APPEALS**

*Section 76 and 77 of the Trade Marks Act 1994*  
*Rules 71, 72 and 73 of the Trade Marks Rules 2008*

Any decision made by the Tribunal under the Act ('decision' includes an exercise of discretion) can be appealed. An appeal seeks to have the Tribunal's decision reversed, set aside or varied. A party who files an appeal will become the 'appellant' in the ensuing appeal and the other party becomes the 'respondent' to that appeal. If both parties file appeals, this will give rise to cross-appeals in which each party becomes the appellant in relation to their own appeal and the respondent in relation to the appeal of the other party.

There are two possible routes of appeal which are:

- To the 'Appointed Person' (a person appointed by the Lord Chancellor to hear and decide appeals, and who meets the eligibility set out in the Act) or
- To the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland

If a decision of the Tribunal is appealed, the implementation of the decision will be suspended until the appeal process has been concluded.<sup>51</sup>

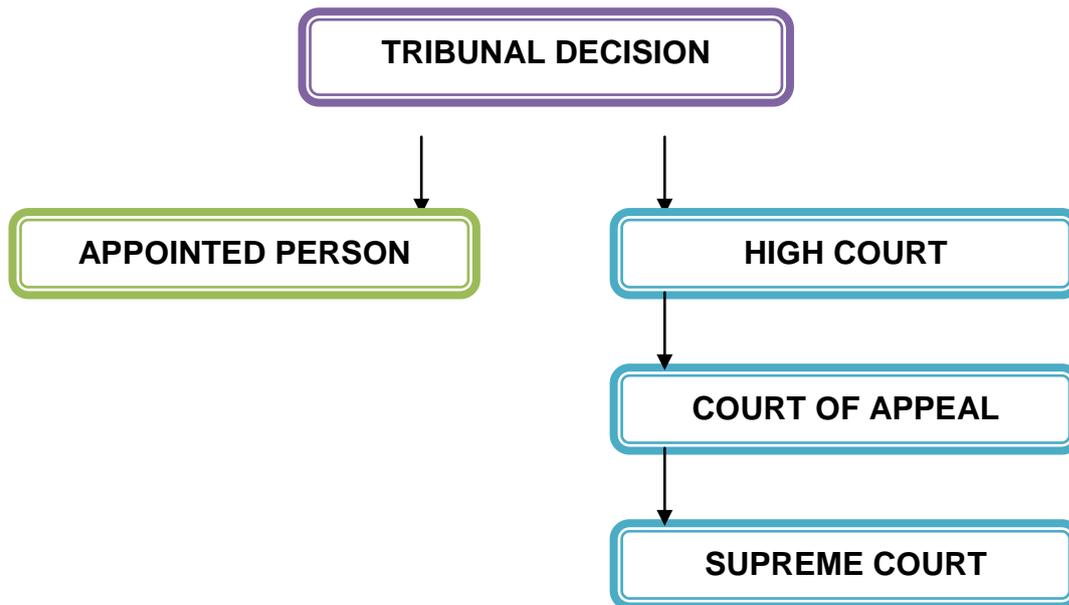
### **7.1 Appeal routes**

The route of appeal is a matter for the parties to decide. However, relevant factors that parties may wish to consider are the costs involved and length of time the appeal may take. An appeal to the Court can be a long and costly process whereas an appeal to the Appointed Person is a relatively inexpensive process.

The decision of the Appointed Person is final: it cannot be appealed to any higher body. Conversely, the decision of the High Court may be further appealed to the Court of Appeal, The Supreme Court and, ultimately, the Court of Justice of the European Union (CJEU).

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<sup>51</sup> *POINT FOUR Trade Mark* BL O/373/02



## 7.2 How to appeal to the Court

If a party wishes to appeal to the Court, rather than to the Appointed Person, the procedure involved is set out in the detailed rules of procedure applicable to the court. Please refer to the Civil Procedure Rules (Part 52 for Appeals here

[http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice\\_directions/pd\\_part52.htm](http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_part52.htm) and Part 63 here [http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice\\_directions/pd\\_part63.htm](http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_part63.htm) which relates to Patents and other Intellectual Property claims)

## 7.3 How to appeal to the Appointed Person

*Rule 71 of the Trade Marks Rules 2008*

*Rule 71(1A) of The Trade Marks (Fast Track Opposition) (Amendment) Rules 2013*

Notice of appeal to the Appointed Person must be filed with the Tribunal on a TM55P within **28 days**, beginning immediately after the date of the Tribunal's decision which is the subject of that appeal. The TM55P must include the appellant's statement of grounds of appeal. It must specify whether, and in which respects, the appellant wishes the Appointed Person to reverse, set aside or vary the Tribunal's decision.

There is a £250 fee required to file a notice of appeal to the Appointed Person.

### 7.3.1 Extension of the period for filing an appeal to the Appointed Person

The period for filing an appeal may be extended, by the filing of a TM9 which must be accompanied by a fee. However, parties should note that strong and compelling reasons are required to support such a request.<sup>52</sup>

Each request for an extension of time will be considered on its own merits.

### **7.3.2 After a party files a notice of appeal**

The Tribunal will send the notice of appeal and statement to the Appointed Person and to the respondent. Treasury Solicitors are responsible for the arrangement of appeals before the Appointed Person.

### **7.3.3 The respondent**

If the respondent is content with the Hearing Officer's decision they need do nothing in response to the notice of appeal.

If, on the other hand, the respondent to an appeal wishes the Tribunal's decision to be upheld in its totality, **but for additional or different reasons from those given in the decision**, then it should file a respondent's notice with the Tribunal setting out their reasons. The respondent's notice must be filed within **21 days** beginning immediately after the date on which the notice of appeal and statement was sent to the respondent. The notice must specify any grounds on which the respondent considers the original decision should be maintained where these differ from or are additional to the grounds given by the Tribunal in the original decision.

The Registrar will then send a copy of the respondent's notice to the Appointed Person and a copy to the appellant.

### **7.3.4 Referral of an appeal to the Court after an appeal has been filed to the Appointed Person**

#### *Rule 72 of the Trade Marks Rules 2008*

Within 28 days of the date on which the notice of appeal is sent to the respondent by the Tribunal, either the Tribunal or any party to the original proceedings may request that the Appointed Person refer the appeal to the Court.

If the Tribunal makes the request, a copy shall be sent to the parties to the proceedings.

If one of the parties makes the request, they must send it to the Tribunal who will then send it to the other party and to the Appointed Person.

Within a further 28 days (from the date that the Tribunal sent a copy of the request to the party/parties), any party who is sent a copy of the request can make

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<sup>52</sup> *Whiteline Windows Ltd v Brugmann Frisoplast GmbH BL O/120/99*

representations as to whether the appeal should be referred to the Court. The Appointed Person will then decide whether to agree or decline the request to refer.

It should be noted that, even if the Tribunal and the parties have not requested referral to the Court, the Appointed Person may still refer the matter if it appears to them that a point of general legal importance is involved. In such circumstances, the Appointed Person will send notice to the Registrar and to every party to the proceedings that the matter should be referred to the Court.

Where the Appointed Person does not refer the matter to the Court, they will determine the matter and his decision will be final.

### **7.3.5 Appointment of the Oral Hearing before the Appointed Person**

*Rule 73 of the Trade Marks Rules 2008*

Where the Appointed Person does not refer the matter to the Court, they will send written notice to the Tribunal and every party to the proceedings, of the time and place which has been appointed for the oral hearing of the appeal. Notice will be sent **at least 14 days** before the oral hearing is due to take place.

Any party to an appeal may decide not to attend the oral hearing and may make written representations instead. If all parties take this option, the Appointed Person may determine the case on the basis of any written representations and the hearing may be cancelled.

The decision of the Appointed Person will be sent, with a statement of reasons for the decision, to the Tribunal and to each person who was a party to the appeal.

## **8. INTERNATIONAL REGISTRATIONS**

*The Trade Marks (International Registration) Order 2008*  
*The Trade Marks Rules 2008*

### **8.1 Legislation governing International Registrations (UK)**

The detailed rules governing International Registrations (UK) are covered by *both* the Trade Marks Rules 2008 and a Statutory Order, The Trade Marks (International Registration) Order 2008 (the Order). Precisely how the two pieces of legislation interrelate is made clear in the Order. A brief explanation of the Madrid Protocol governing international registration is required before examination in detail as to how the Tribunal, in inter partes proceedings, handles these cases.

### **8.2 The Madrid Protocol**

The Protocol allows a proprietor of, or an applicant for, a national registration to apply through their national office for registration of a national mark in the International Register of the International Bureau of the World Intellectual Property Organisation (WIPO). Protection can be sought in any country party to the Protocol. The designated country is not bound to grant protection and could refuse it on the

grounds which would apply under the International Convention for the Protection of Industrial Property (Cmnd 4431). However, if no notice of refusal has been sent to the International Bureau, States are required to accord the same protection to an international registration designating their territory as they would a national registration. The detailed rules on international registration are set out in the Common Regulations adopted under the Protocol but certain matters have nevertheless been made subject to national provisions - the Act, Rules and the Order.

An international registration designating the UK is referred to as an International Registration (UK).

### **8.3 Opposition to an International Registration (UK)**

*Rules 12, 17, 18, 19, 20 and 21 of the Trade Marks Rules 2008*

The Order states which specific rules do not apply to International Registrations (UK). With regard to opposition, these are to be treated in the same way as a national application, as provided for in rule 17 of the Rules. However, within 4 months from the date of publication, the Tribunal must send a notice of refusal to the International Bureau.

In addition to sending the notice of refusal to the International Bureau, the Tribunal will serve the notice of opposition to the holder's address for service. The holder has two months from the date that the notice of opposition is served to them within which to file a TM8, under rule 18 of the Trade Marks Rules 2008, together with an address for service in the United Kingdom, another EEA state or the Channel Islands. The consequence of failure to file an address for service is set out in rule 12 of the Rules. The Tribunal will not examine the pleadings until both the statement and counterstatement have been received.

Once the TM8 is filed and scrutiny of the pleadings has been completed by the Registry, the remaining stages of the proceedings are governed by rules 19, 20 and 21 of the Trade Marks Rules 2008.

### **8.4 Revocation or declaration of invalidity of an International Registration (UK)**

*Rules 12, 38, 39, 40, 41, 42, 43 and 45 of the Trade Marks Rules 2008*

These proceedings are covered by the Order in exactly the same way as are opposed International Registrations (UK), i.e. the relevant rules from the Trade Marks Rules 2008 apply to these proceedings. Particular attention should be paid to the provisions of an address for service in the EEA.

### **8.5 Rectification of an International Registration (UK)**

An International Registration (UK) is only protected in the UK; the actual registration is held and maintained by the International Bureau. Therefore there can be no actions for rectification of the registration before the Tribunal; any action for the correction of errors which would normally fall under the heading of rectification will need to be raised with the International Bureau.

However, where an international registration is based on a UK application or registration any rectification action taken during the period of dependency, normally the first five years of the international registration, will impact on that registration and the International Bureau, will need to be informed by the Tribunal.

## **9. GLOSSARY OF TERMS**

### **Abatement:**

A common law principle which applies where the Tribunal has issued a decision which had it known of circumstances completely disposing of the dispute (e.g. an assignment of the mark in suit to an applicant for revocation) it would not have issued.

### **Absolute grounds:**

These are grounds for objecting to a trade mark arising from the trade mark itself.

### **Acquiescence:**

Describes a period of 5 years where the owner of an earlier right has known about the use of a registered trade Mark by another but taken no action to prevent that use. This usually results in a loss of certain rights associated with ownership of a registered trade mark.

### **Address for service:**

An address within the UK, EEA or Channel Islands which must be filed by all parties to proceedings and to which all correspondence relating to proceedings will be sent by the Tribunal.

### **Affidavit:**

Formal written statement testifying on oath that a specified fact or account is true. Countersigned (usually with an official seal) by a witness of juridical authority, affidavits may be used as evidence in court and tribunal proceedings

### **Appellant:**

A person who makes an appeal to a Court or other authorised body with the jurisdiction to hear appeals.

### **Appellate bodies:**

Other Tribunals/Courts with the jurisdiction to hear an appeal from a decision of a lower Tribunal/Court

### **Appointed Person:**

A senior independent intellectual property lawyer appointed to hear appeals from decisions of the IPO. The Appointed Person offers a cost effective alternative to appealing to the courts.

### **Assignment:**

The document used to transfer a trade mark or other intellectual property right from one party to another. Assignment of registered trademarks should be promptly recorded at the IPO.

**Bad faith:**

Conduct before the IPO or in relation to a trade mark that indicates behaviour or practices that is questionable. It covers obvious conduct like dishonesty but can be more subtle and cover conduct that might be generally considered sharp practice.

**Bona fide:**

This relates to good faith and implies that in certain dealings with trade marks a party acts without any knowledge or information which is contrary to or undermines their position. i.e. without fraud, collusion or participation in wrongdoing.

**Case Management Conference (CMC):**

In accordance with rule 62(4) the Tribunal may, at any time, direct that the parties attend a Case Management Conference. This will be conducted by a Hearing Officer and will, as a general rule, result in directions being given in respect of the timetable and future conduct of the proceedings.

**Cooling-off period:**

A period allowed in opposition proceedings before the Tribunal, within which parties may negotiate a settlement.

**Earlier right:**

This is a term used to describe a pre-existing right that may form a barrier to subsequent trade mark application.

**Earlier trade mark:**

This is a term used to describe a pre-existing trade mark which may form a barrier to a subsequent trade mark application. These trademarks may be Domestic, Community trademarks and/or International trade marks.

**EEA:**

European Economic Area, a free-trade zone created in 1994, composed of the states of the European Union together with Iceland, Norway, and Liechtenstein.

**Ex parte:**

Refers to administrative proceedings involving only one party, e.g. between the applicant for registration and the Registrar.

**Functus Officio:**

Describing a person who has discharged his duty and whose office or authority in a particular matter is at an end. Once a judgment has been given, the HO is *functus officio* : he has no power to revisit his decision.

**Hearing:**

An open attendance before a Hearing Officer at the Tribunal, which is normally open to the public.

**Hearing Officer:**

A senior official of the Tribunal responsible for conducting hearings and making decisions on proceedings pending before the IPO.

**Inter alia:**

[*Latin: Among other things*]

Used, primarily, to introduce a non-exhaustive list.

**Inter Partes:**

[*Between the parties*]

Is used to refer to legal proceedings of an adversarial nature between two or more parties, e.g. in opposition proceedings between the application for registration and the opponent.

**Invalidity/invalid:**

A decision that a registered trade mark should not have been granted due to grounds that subsisted at the time of the grant of the application. Once declared invalid, such a trade mark will be deemed never to have been registered.

**IPO:**

The Intellectual Property Office.

**Joint hearing:**

A hearing, on preliminary matters, prior to the parties being in formal proceedings. (Once parties are in formal proceedings this becomes known as a Procedural Hearing).

**Licensee:**

The party authorised by the owner to use the trade mark or other intellectual property rights.

**Madrid Agreement:**

A procedure for obtaining an International registration through WIPO.

**Madrid Protocol:**

A procedure for obtaining an International Registration through WIPO.

**OHIM (sometimes referred to as OAMI):**

This is the EU's Office for Harmonisation of the Internal Market and is responsible for the registration of Community trademarks and Community designs.

**Opponent:**

The party objecting to an applicant's application for a trade mark.

**Opposition:**

The procedure where a third party may formally object to an application for registration of a trade mark.

**Notification date:**

The date on which the Tribunal serves proceedings on the other side.

**Passing off:**

A cause of action that seeks to prevent unregistered trademarks with a sufficient goodwill from being misappropriated by a third party.

**Pleadings:**

Is an alternative, technical term for statements and counter-statements. Pleadings serve a simple function by identifying the issues between the parties which may later be the subject of evidence.

**Prima facie:**

[*Latin: On the first appearance.*]

In common parlance the term *prima facie* is used to describe the apparent nature of something upon initial observation.

**Preliminary view:**

Issued by the Tribunal, to the parties, to indicate its view on a particular matter, for example, refusal of an extension of time or a view that consolidation is appropriate. A period is given for the parties to contest such a decision.

**Procedural Hearing:**

IA hearing held in respect of preliminary matters between two or more parties which need to be resolved prior to the substantive hearing.

**Publication:**

All trade mark applications and registrable transactions are published in the Trade Mark Journal.

**Quasi-judicial:**

Refers to a decision made by an administrative tribunal or government official which resembles a judicial function in that it involves deciding a dispute and ascertaining relevant facts and law.

**Register:**

The record kept by the IPO of all registered trademarks and registrable transactions.

**Register of Trade Mark Attorneys:**

The official register of professionals entitled to use the designation trade mark attorney, entry to which is subject to passing rigorous examinations in trade mark law and practice and associated intellectual property rights.

**Relative grounds:**

Grounds for objecting to a trade mark application or applying for a declaration of invalidity due to the existence of earlier trademarks or rights.

**Respondent:**

The defending party to an appeal.

**Revocation/revoke:**

An action to remove a registered trade mark for certain reasons that have arisen since the trade mark was registered and include that it has not been used for a period of 5 years since its registration and that it is misleading or become the common name for the goods or services for which it is registered.

**Skeleton argument:**

A document prepared by a party (or its legal representative) that sets out the basis of the party's argument. These should always be copied to all other parties to the proceedings and should be filed no later than 14.00 two days prior to the hearing date.

**Statutory Declaration:**

A document used to provide the evidence of a party in relation to proceedings before the IPO and authenticated before a notary public or other qualified person.

**Specification:**

Another name for the classification of goods or services covered by a trade mark.

**Substantive Hearing:**

The main hearing to determine the outcome of proceedings.

**Supranational law:**

Is a form of international law, based on the limitation of the rights of sovereign nations between one another. Members transcend national boundaries or interests to share in the decision-making and vote on issues pertaining to the wider grouping.

**Surrender:**

A voluntary step the owner of a registered trade mark may take to either remove his trade mark registration in full or in relation to certain goods or services in the specification. Often occurs when a registered trade mark is threatened with revocation.

**Trade Mark Attorney:**

A professional intellectual property practitioner specialising in trade mark law and practice who is entered on the Register of Trade Mark Attorneys.

**Tribunal:**

Refers to the Registrar, Hearing Officers and the Tribunal's other officers.

**Unregistered trade mark:**

A trade mark which denotes the goods or services of a particular undertaking but is not registered. Such unregistered trademarks may be used to prevent others from using the same or confusing trademarks under passing off.

**WIPO:**

The World Intellectual Property Organisation based in Geneva which administers the Madrid Protocol and Madrid Agreement for the international registration of trade marks.

**Witness Statement:**

This is a document used to provide the evidence of a party in relation to proceedings before the IPO. It does not need to be authenticated by a notary public.