

Technical Bulletin – October 2013

1. Wording of disclaimers

A disclaimer's purpose is to make clear to third parties that independent use of descriptive/non-distinctive elements would not infringe the registered trade mark. Under the 1994 Act, disclaimers are no longer requested by the Registrar as rights conferred by a registration exist in the totality of the mark. Nonetheless, section 13 of the Act still provides applicants with the right to voluntarily disclaim specified elements within their marks. When necessary, we should reject unclearly worded disclaimers and propose alternatives to the applicant.

Here is an example:

“No exclusivity is claimed in respect of the word”

In this case, the text above should have been rejected in favour of the following:

“Registration of this mark shall give no rights to the exclusive use of the word”

Although at first sight the wording may appear the same in effect, the first version is inherently vaguer as it is unclear exactly what form of ‘exclusivity’ is not being claimed. The second version makes the scope and context of the disclaimer plain, and such wording should be adopted in all cases.

2. Use of the word ‘Organic’ and derivatives: effect upon section 3(3)(b) (deceptiveness)

[MARK REDACTED]

The stylisation in this mark provides sufficient distinctive character to make the mark as a whole acceptable under Section 3(1). However, the mark sends a clear message that indicates that the goods are organic. Whilst it is acknowledged that the mark does not consist of the full word ‘organic’ it so strongly alludes to the goods being organic that the average consumer is likely to be deceived if the goods are not in fact, organic, in nature. Therefore a section 3(3)(b) objection and appropriate limitation would have been appropriate. If a message about the, e.g. organic nature of the goods is so obvious, the fact that the actual word ‘organic’ is used is of no consequence.

3. Signs that are simply too banal or simplistic to function as trade marks

[MARK REDACTED]

This is often a very difficult call to make for examiners. Are there signs, usually shapes or very simple geometric devices, which are too simplistic or banal ever to function as a trade mark? There is case law, under section 3(1)(b) or its European equivalent, which supports a 'yes' to the theoretical question above. OHIM Board of Appeal Case R-860/2012-5, for example, states at paras 9 and 10:

"9. According to the case-law, a sign which is excessively simple and is constituted by a basic, geometric figure, such as a circle, a line, a rectangle or a conventional pentagon, is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use (see judgments of 12 September 2007, T-304/05, 'Representation of a pentagon', par. 22, and of 29 September 2009, T-139/08, 'Half a Smiley smile', par. 26).

10. That being so, a finding that a mark has distinctive character within the meaning of Article 7(1)(b) CTMR is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark distinguish the goods and services from those of other undertakings (see judgment of 16 September 2004, C-329/02, 'SAT.2', par. 41 and judgment of 9 September 2010, C-265/09 P, 'α', par. 38)."

The point of this discussion is to alert examiners to possible backing and strategy for such an objection to be made. But it must be stressed that such an objection should be used sparingly, and not without the advice of a PEO or Training Section. It is, in other words, something of a 'nuclear' option.

So, when exactly is a mark too banal to function? The OHIM Board of Appeal case refers to simple geometric figures but the principle can be extended. One of the tests for excessive banality or simplicity may be, e.g. that the sign has no 'concept' at all about it, that is to say, could it be conceived of as something else, in addition to or rather than, just a geometrical shape?

The example above may be said to meet such an initial test, but many examiners would naturally be cautious about taking an objection given, especially, what has already been accepted. We are not saying the above example should inevitably have faced a banality type objection but it may have at least prompted some further 'digging' by the examiner. The 'digging' takes the form of consulting colleagues and especially taking a look at the applicant's website, assuming it has one of course.

If an objection is made, it is best, as a strategy, to simply say the sign is too simplistic or banal to function as a trade mark. If this can be supported by reference to the applicant's own use on, e.g. its own website, where plainly the sign is not functioning, then do that. If not, rule 62 can always be invoked to get the applicant to show its use. If examiners know for a fact the sign is not functioning on its own as a TM and can show it, APs will find such evidence hard to ignore if the matter goes to appeal. Examiners should also exercise caution in making the additional claim that the sign is, e.g. merely 'decorative' or a 'border', without backing for that assertion. Such backing can come from, e.g. the applicant's website or relevant trade practice. Be aware that being classed as 'decorative' or a 'border', may not, in and of itself (as with the issue of being a 'promotional statement') necessarily render it devoid of distinctive character.

On a second point of strategy, do not get over analytical as to the goods and services. If you are saying that such a sign is 'devoid' for certain goods or services, in the very nature of the sign, it is unlikely to be less devoid for others. In other words, take a robust blanket objection across the board.

4. Case Summary: BL O-386-13 'Cardiff Airport and 'Belfast International Airport'

This was an appeal to the Appointed Person (AP) in relation to Section 3(1)(c) of the Act and interpreting case law and practice related to geographical names and descriptions. Professor Annand, acting as the AP, upheld the Registrar's decision to partially refuse registration for services in Class 39 in respect of the marks 'CARDIFF AIRPORT' and 'BELFAST INTERNATIONAL AIRPORT'.

The marks were applied for in relation to a wide variety of services in Classes 35, 36, 37, 38, 39, 42, 43 and 45. We accepted the marks on absolute grounds for most services, however in line with our 'AIRPORT' practice which is referred to in the Addendum, the marks were refused registration at hearing in respect of;

Transport; travel arrangements; transport services; passenger transport by road or rail; taxi services, taxi booking and information services, car parking, car parking booking and information services; advisory and information services relating to travel; booking or reservation of seats/tickets for travel; car parking.

The section 3(1)(c) objection was based on the premise that the signs used in respect of those services set out above, would merely serve to designate the destination of the transport services, or their geographical origin. We all know of taxi services or car parking services, for example, which are almost entirely dedicated to serving an airport, but which may have no 'official' connection with the airport authorities. Such traders would have been undoubtedly, and potentially adversely, affected by this registration.

Grounds for appeal to the AP were that the applicants sought to register the signs to prevent consumer confusion between, e.g. official and unofficial car parks serving the airport. The AP dismissed this fact as being irrelevant to whether the public would perceive the signs as designations of origin, rather than a characteristic of the services concerned.

Other grounds for appeal were based on 'equal treatment' because other 'airport' marks had been accepted for registration. Also, the fact that there is an indiscriminate line between 'transport and car parking services' in Class 39 and other services which were prima facie accepted. As far as any 'indiscriminate line' argument was concerned this did not, however, in and of itself, persuade the AP to overturn the whole decision. With regard to 'equal treatment' argument, the AP reviewed the precedents and concluded that 3 of the marks involved different considerations. The decision refers to useful case law for examiners in respect of earlier rights and also refers to the fact that each case must be examined on its merits and therefore limited significance must be attached to precedents. It may be noted, however, that Professor Annand was, like some of her fellow AP's, at least prepared to look at, rather than dismiss out of hand, the alleged comparable marks.

The AP's decision made several references to the 'need to keep free' and also referred to "*the Registry's frontline role in preventing the granting of undue monopolies.*" These are important considerations in assessing the distinctiveness of marks which may serve in trade to designate a characteristic of the goods or services. It is clear now that all APs and the courts take this view and this is very reassuring in terms of our role.

In her decision, Professor Annand suggested that the mark may be also objectionable for other services, such as 'car rental services and hotel services', but did not make any decision in this respect (as it was not argued on appeal) and for now, our 'airport practice' remains unchanged. In her conclusion, Ruth Annand confirmed that in the absence of evidence of acquired distinctiveness the trade marks were excluded from registration for the said transport and car parking etc. services under Section 3(1)(c) and 3(1)(b) of the Act.

This helpful decision re-affirms our practice in respect of 'airport' marks and it is also a useful decision which provides guidance in respect of 'equal treatment', 'precedents' and the 'need to keep free'.

TRADE MARKS EXAMINATION TECHNICAL BULLETIN NOVEMBER 2013

1. Applications for colour *per se* and the use of related 'mark descriptions'

We already know from the Court of Justice of the European Union's decision in *Libertel* that single colours *per se* can function as trade marks (see Case C-104/01). We also know from both *Heidelberger* and our own wider experience that applications consisting of one or more specific colours 'applied to the packaging of the goods' can also be acceptable (see Case C-49/02).

In these latter cases, mark descriptions and/or images are sometimes added to help clarify the parameters of the application (e.g. "*the mark consists of the colour Red Pantone 456 applied to the outer surface of a petrol forecourt livery as shown in the representation attached*"). And in the case of applications for colour *per se*, mark descriptions are similarly filed, although often with much less detail (e.g. "*the mark consists of the colour Orange Pantone 789*").

But what happens when an application is made for a colour *per se*, and the usual colour 'swatch' is accompanied by a form of description which *implies* (rather than categorically defines) how the colour is intended to be used? This issue came to light in a recent decision of the Court of Appeal in [Case \[2013\] EWCA Civ 1174](#) between Nestle and Cadbury. The original application had been made by Cadbury for a specific shade of purple, and the usual colour swatch was accompanied by the following description:

“The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods”.

Nestlé’s lawyers argued that this description’s reference to a particular shade of purple being only the *predominant* (as opposed to the one and only) colour failed the *Sieckmann* criteria for signs to be *inter alia* clear and precise. Nestle had no issue with the mark description as far as it applied to the use of purple as the whole visible surface; its objections only related to where the colour constituted the *predominant* colour of the packaging. This argument was summed up in paragraph 34 of the decision where it was alleged by Nestle that:

“...the use of the word ‘predominant’ introduced into the verbal description of the mark elements of vagueness and subjectivity that did not satisfy the requirements of precision, clarity and objectivity.”

The Court of Appeal agreed with Nestle, and overturned the High Court’s earlier decision to allow Cadbury’s description. The Court believed that the description’s use of the word ‘predominantly’ introduced an element of configuration which went beyond colour *per se*. And given that the reference to configuration (i.e. predominant application of colour) was not sufficiently precise, the sign did not meet the *Sieckmann* requirements. The Court summed up its view in paragraph 50 by stating:

“The use of the word “predominant” opens the door to a multitude of different visual forms as a result of its implied reference to other colours and other visual material not displayed or described in the application and over which the colour purple may predominate. It is an application for the registration of a shade of colour “plus” other material, not of just an unchanging application of a single colour, as in Libertel.”

So what does this mean for us? Firstly, in terms of graphical representation, conventional claims to single (and multiple) colours *per se* will continue to be deemed acceptable providing that a suitable Pantone (or other recognised colour classification) reference is provided. This means that an application for, say, the colour purple *per se*, accompanied by the mark description *“The mark consists of the colour purple (Pantone 2685C)”* will continue to be accepted. Equally, an application for colour(s) paired with a specific description referring to the configuration or application of that colour will continue to be acceptable - so an application for the colour yellow, accompanied by *both* the mark description *“The mark consists of the colour yellow (Pantone 5375T) applied to the outer visible service of a power tool as shown in the attached representation”* and an image showing application of the said colour configuration will also be acceptable.

However, we should exercise caution when dealing with any application for colour *per se* (or colour applied to the product or the packaging) where the accompanying mark description uses words such as ‘predominantly’, ‘significantly’, ‘mostly’ or any other imprecise term intended to denote the ‘amount’ of colour used on the product. Any mark description which seeks to indicate in less than clear terms how the colour is to be applied should be subject to an objection under section 3(1)(a) - on the grounds that it falls foul of section 1(1), being something which is *less* than a clearly defined and/or represented sign.

2. National Flags (and elements thereof) incorporated into composite trade marks

When assessing composite marks (i.e. those which include more than one element) examiners are reminded to consider not just overall distinctiveness under section 3(1), but also to consider if any of the elements shown in the mark could also be protected symbols.

National flags of Paris Convention countries are protected under section 57(1) of the Act, and that protection applies irrespective of whether or not the flag appears on the 6ter database. The protection afforded to national flags is very broad - it prohibits the use of such flags as trade marks *per se*, and it prohibits their use as elements within composite signs. In all cases, that prohibition applies regardless of what goods and/or services are being claimed. The trade mark need not be an exact reproduction of the flag - where it is likely to be perceived by the relevant public as imitating such a symbol then it is also prohibited.

[MARK REDACTED]

The first example above is a composite mark where, in addition to the prominent word [REDACTION], it also clearly depicts two national flags. Although the two flags are not visible in their entirety, they are both heraldically standard depictions and would be seen as imitating the national flags of the UK and the US.

UK national flags such as the Union Jack are specifically *excluded* from coverage of section 57 by section 55(1) (b). UK national flags are only open to objection under section 4(2) (a) if their use is likely to be *misleading* and/or *grossly offensive*. However, the Stars and Stripes - being the national flag of the USA - *is* covered by section 57, and so an objection under sections 3(5) and 4(3) would be appropriate. The fact that part of the US flag is obscured from view is not determinative.

[MARK REDACTED]

In the second example shown above, the sign includes a generic flag 'shape' symbol, where the top half comprises of the upper part of [REDACTION], and the bottom half comprises of [REDACTION]. Although the two flags are not 'complete' representations, their use in the mark would be seen as imitating the national flags and so an objection under section 3(5) and section 4(3) would be appropriate. In both cases, the objection can be overcome by the applicant supplying consent to use and register the emblem from the relevant national body.

3. Section 3(3)(b) and assessing deceptiveness (general reminder)

Although the issue of deceptiveness has been covered in previous technical bulletins, related discussions at some recent QSC meetings suggest that a further refresher would be useful to examiners.

Objections are to be raised under section 3(3)(b) in those cases where, on the basis of the message conveyed by the mark, consumers are likely to be deceived as to the nature, quality or geographical origin of the goods. This does not mean that we should raise objections simply because the mark does not correspond exactly to the goods or services (or where it corresponds to *more* than what is listed in the specification). To repeat the tried and tested example, we

should not raise an objection against a mark containing the words 'Strawberry Jam' where it is applied for in respect of jams *at large*. In this case, (and notwithstanding the fact that deception may well occur if such a mark was used on, say, blackcurrant jam) we assume the producer has no intention to use the mark on anything other than strawberry jam. To do so would be so commercially pointless, and so in this type of scenario we adopt a 'hands off' approach.

However, if the mark indicates a desirable quality and the goods or services *do not* comply with that desirable quality, then (i) there is the real possibility that an unscrupulous trader might seek to exploit the scenario, (ii) there is a real likelihood that the consumer's decision to purchase would be based on an expectation that the goods possess that 'desirable quality', and (iii) deception would most likely occur. In such cases, we should be taking an objection. To illustrate: watches produced in Switzerland have a reputation for superior quality, and so if a trade mark intended for use in respect of watches indicates Swiss origin, then the consumer's decision to purchase may well be based on that indication. To avoid deception and a section 3(3)(b), the specification should be limited to goods produced in Switzerland.

[MARKS REDACTED]

The QSC committee recently identified the above marks to be deceptive under section 3(3)(b) of the Act as they clearly signify British origin via inclusion of the wording [REDACTION] and the stylised Union Jack as a background. It was noted in the June 2012 Technical Bulletin that UK now enjoys a quality-based reputation for home-grown goods (see [REDACTION]). As a result, a section 3(3)(b) objection should have been taken against class 31, with the limitation 'all of the aforesaid goods being produce of the UK' being proposed as a suitable means of overcoming the objection.

[MARK REDACTED]

Similarly, in the above case, the public would be deceived if the jewellery being sold under the trade mark did *not* contain diamonds. A section 3(3)(b) objection should have been raised and the term 'jewellery' limited to 'jewellery comprising or containing diamonds'.

4. Deceptive marks applied for in respect of services

Practice in respect of deceptive marks, such as marks containing the word 'organic' has to date only related to use on goods. A recent case raised discussion as to whether the practice should be extended to, for example, the retailing of goods, because a service *per se* cannot be organic. The mark below was the subject of the discussion.

[MARK AND SPECIFICATION OF GOODS AND SERVICES REDACTED]

After much deliberation, it was concluded that it must follow that if goods themselves must be restricted to organic, then the retailing of such goods must be restricted also. When the average consumer is confronted with this mark in relation to the *sale* of 'beauty products, toiletries', there is an explicit expectation that those goods either individually, or contained within a hamper, are organic in nature. As the mark contains the word 'organic', it indicates to the average consumer that the applicant simply retails organic goods. In future, a deceptiveness objection should be raised under section 3(3)(b) against these kind of marks which can be overcome in the usual

manner. A suitable limitation to the specification would be *'Retail store services connected with the sale of organic beauty products and organic toiletries.'*

The same principle will apply to other services. For example, if we receive an application for the mark 'Marks and Spencer's Organic Baking' [NOTE: FICTITIOUS MARK] in Class 43 in respect of 'Services for providing food and drink', the application would face an objection under section 3(3)(b). This could be overcome by amending the specification to 'Services for providing organic food and drink'. In deciding whether to raise a deceptiveness objection against certain services, examiners will need to consider whether the *end product* of the service results in goods which could feasibly be organic.

5. Geographical: [MARK REDACTED] and other 'unofficial' place names

The primary question with this type of mark is, would the mark be recognised as a geographical name in the first place? This may not be as straightforward as it seems where, for example, the name is of a former London Metropolitan Borough which has long since ceased being such a Borough. In this case, dictionary research had cast doubt on the word [REDACTION] as being recognised as a modern Metropolitan Borough, and from that it was concluded that the location no longer exists.

That said, [REDACTION] is still undeniably recognised by the average consumer as an area of London with, for example, its own tube station. So, even if the precise administrative framework or boundaries of [REDACTION] were, or are, unclear, or have changed over the years, the name [REDACTION] lives on in the minds of consumers as an area of London around the tube station of the same name. As such, there could be a 'need to keep free' certain terms, and an objection under section 3(1)(c) cannot be ruled out.

The lesson from this example is that sometimes dictionary references do not tell the whole picture in terms of whether a geographical name would be recognised as such by the average consumer. The dictionary can be a starting point, but a bit more digging is called for in terms of consumer recognition. In this case, the search terms, [REDACTION] plus 'the relevant services' may have been more revealing.

6. Handling agents - general advice

In a recent case involving a borderline trade mark, the examiner responsible openly disclosed the fact that discussions on the mark's suitability for acceptance had taken place between the examiner and (unidentified) senior officers. This led to a protracted exchange in which the agent insisted that the identity of the senior officer be disclosed, so that a decision could be made on the suitability of an *ex parte* hearing request. This request for a name was suitably refused, although some resource on the part of the examiner and the hearing officer was exercised in reaching that point.

Notwithstanding the fact that discussions between the examiner and colleagues (whether senior or not) should and do take place, examiners are reminded that - in terms of official correspondence sent to the applicant or agent (including any telephone calls) - you have responsibility for the decision made. This is confirmed in section 74(3) of the Act which states that:

“Anything which the registrar is or may be authorised or required to do under this section may be done on his behalf by a duly authorised officer.”

And in those rare cases where agents appear to cross the line of professionalism - particularly over the phone - it is imperative that examiners record as much detail as possible i.e. when the call took place (the date and the time); the name of the agent; a summary of the issue discussed; and reference to any unprofessional behaviour.

In the past, and only on very rare occasions, the Registrar has written to senior partners to highlight unprofessional behaviour. We can and will do this again if justified, but any case we present will always be much stronger if supported with detail.