Trade Marks Registry

WORK MANUAL

CHAPTER 10

SEARCHING AND COMPARISON OF TRADE MARKS

Trade Marks Registry
The Patent Office

This manual is intended for the guidance and instruction of the staff in the Trade Marks Registry. Its terms in no way fetter the discretion given to the Registrar under the Trade Marks Act 1938. All cases dealt with by the Registry will be decided under the Act on their own facts and within the guidance of the Courts and the Registrar's discretion, where appropriate.

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SECTION 1

CHAPTER 10

INTRODUCTION

10-1 In addition to the report which must be made on the registrability of the mark applied for (see Chapter 9) the examiner is required to make a report of a search for conflicting trade marks already registered or pending in the registry. To implement the provisions of Section 12 of the Act, Rule 31 requires that a search shall be made in connection with every application for the registration of a trade mark, for the purpose of ascertaining whether there are on record in respect of the same goods or goods of the same description any registered or pending marks which are the same as the application mark or so nearly resembling it as to be likely to deceive or cause confusion. Particulars of any such conflicting marks found in the search and recorded in the names of persons or firms other than the applicant are entered by the examiner on the report sheet (ER2) headed "SECTION 12 REPORT FOR APPLICATION NO.". The examiner is required to enter on the report sheet the numbers of the classes of goods (in Schedule III and IV) in which the search is made and the words (including phonetics) and/or devices searched.

10-2 The particulars of closely similar marks to the mark applied for which are found to be recorded in the name of the applicant are entered on a separate yellow association report so that they may be associated in accordance with the provisions of Section 23(2) if and when the application mark is registered (see paragraph 10-112 below).

10-3 For applications in certain classes of goods it is necessary to extend the search beyond conflicting marks recorded for the same goods or goods of the same description (see paragraph 10-85 below re: "Danger to Health").

INDEXES

10-4 To enable the searches for conflicting marks to be made registered and pending trade marks are entered in indexes which distinguish in class order the word marks, device marks and other categories of marks such as letters and numerals.

10-5 The current classification system (Schedule 4 of the Trade Marks Rules) classifies goods into one of 34 classes.

For marks registered before 1938 a separate classification system (Schedule 3 of the Trade Marks Rules), classifies goods into one of 50 classes.

10-6 Goods are so classified that any specified item will always fall into one particular class only; however there may be goods of the same description in another class or classes. (See Chapter 25 of this work manual for a detailed description of the indexes).

REFUSED COTTON MARKS

10-9 The collection of refused cotton marks covers applications made but refused in relation to cotton piece goods, cotton yarns and threads and some cotton goods little removed from piece goods, eg cotton sheets, towels and handkerchiefs. Many of these marks consisted of a device of an animal, bird, human figure, flower etc., making an appeal to the eye and therefore easily recognized in foreign markets such as in Africa and Asia where the literacy of purchasers was low at the turn of the century. They were used with small or negligible differences by many traders because of their appeal to buyers overseas and the practice was tacitly accepted by the trade. But it followed that such devices were not inherently distinctive and all applications relating to the cotton goods referred to above were considered with reference to a common cotton marks list in addition to the general requirements of the Act and Rules. The common cotton marks list was largely compiled as the result of an examination of the marks which were in use in the cotton industry in or about 1875.

10-10 If the device appeared on the common cotton marks list and the application was not supported by adequate evidence of factual distinctiveness (probably limited to cotton goods for a particular territory abroad) the application was refused. Modified forms of common devices were considered on their merits.

10-11 In considering applications for trade marks in relation to these cotton goods the Registrar, or the Keeper of the Manchester Branch, was able to consult the Trade and Merchandise Marks Committee of the Manchester Chamber of Commerce, under Section 39(10) of the Act.

10-12 It will be seen from the above that the common cotton marks list was largely based on old information when conditions in the cotton industry were vastly different, from present day conditions.

10-13 Accordingly it was decided that the common cotton marks list would be cancelled with effect from 1 November, 1966 and notification of this appears in Trade Marks Journal No. 4588 of 3 August, 1966. Further information about the abandonment of the common cotton marks list is given on file I.P.D. 37913.

10-14 The collection of refused marks was put on a statutory basis by the Trade Marks Rules, 1912, made under the Trade Marks Act, 1905, when provision was made for marks in the collection to be part of the search material. Retention in the collection after 31 December, 1912, was dependant on the payment of a continuance fee and a further fee has been payable each fourteen years since then. No additions to the collection were possible after 26 July, 1938, the date when the present Act came into operation.

10-15 The maintenance of the collection is a statutory requirement under Section 39(8) of the Trade Marks Act, 1938, and Rules 102 to 104 which continue the position under earlier legislation. Under the sub-section refused marks, as there defined, are to be treated for the purposes of Section 12(1) and 12(2), but for no other purpose, as if they had been registered trade marks.

10-16 Details of the collection are housed at the Manchester Branch. Additionally details of refused cotton marks are incorporated into the Schedule III Indexes maintained in the London Office.

10-17 Particulars of the marks are contained in (a) the alphabetical index of word marks, (b) the "terminal" index and (c) the devices index in exactly the same way as registered marks. Changes in the collection are notified to the registry each week by the Manchester Branch and these alterations are noted in the indexes. The notifications largely relate to refused marks in respect of which the continuance fee (which is similar to the renewal fee for registered marks) has not been paid. In such cases it is necessary for the records to be amended by removing the slips from the word indexes or by stamping "Discontinued" in the device index. Changes consequent upon assignment, alteration of address etc., also require recording in the indexes.

10-18 It is essential to have regard to the limited effect of the collection of refused marks. Marks in it are equivalent to registered marks for Section 12 purposes only, and for nothing else. It follows that association under Section 23 cannot arise and that the usual steps relating to assignment, changes of name, description, and address (and the corresponding fees) are not applicable.

10-19 Nevertheless changes in ownership and address take place and it is necessary that such changes are recorded (without fee) in the appropriate indexes, files etc., of the collection at the Manchester Branch and the records in the London office. There is no formal provision for this but without doing so it would not be possible to comply with Rule 104 which requires the Registrar to send notices to the last known owner at his last known address. When changes in the ownership etc., of registered marks are advertised in the Journal no mention is made of any refused mark involved in the same change, and they are not shown in the Form TM No 16 etc., concerned.

10-20 There have been a few instances where limitation of the specifications of refused marks have taken place to enable applications for registration to proceed and Forms TM No 20 (with fee) have been obtained for the purpose although it is debatable whether this procedure is provided for under the Act or Rules. Consent has sometimes been accepted from the owners of refused marks though it is not the practice, as a general rule, to ask for this. In recent instances the applications have been advertised "By Consent" in the usual way. There is nothing specifically in the present Act or Rules to enable refused marks to be cancelled from the list.

10-21 Currently in 1985 there are 56 marks remaining in the collection. A complete listing of these is at Annex B of this chapter.

CROSS SEARCH LIST

10-22 The cross search list sets out the classes in both Schedule 3 and 4 in which searches must be made according to the class number of goods applied for since goods of the same description are not necessarily confined to a single class. The list also indicates whether the search in other classes is to be of a general nature or for specified goods. It must be emphasised, however, that the list of goods indicated are not necessarily exhaustive and in the end conflict of goods may be tested in the Courts. There is a supplementary cross search list used to identify marks in respect of goods which are likely to be harmful to the public if consumed through confusion over the marks. See paragraph 10-85 on Danger to Health. No decision that would enlarge the scope of the cross search list should be made without the prior approval of the Assistant Registrar or his deputy.

SEARCHING MARKS FOR JOINT APPLICANTS

10-23 Particular care should be taken when searching joint applicant marks; any mark found which meets the usual criteria (in respect of the mark itself and goods) and is registered in the name of only one of the parties to the joint application must be treated as a citation.

SEARCHING DEFENSIVE MARKS

10-24 Applications to register defensive marks are searched under Section 12 in the same way as ordinary applications. The normal association considerations apply but in addition, a defensive mark is associated with its "parent" mark even though the goods might be different (Section 27(3)). One defensive mark and another in the same ownership are only associated if the respective goods are the same or of the same description even though the defensive marks have a common "parent". Ordinary marks (as distinct from defensive marks) found during the search must be cited if the goods and marks are the same - even if they are in the same ownership as the defensive application. They remain as cites until the clash of goods with the defensive application is resolved. (See Chapter 22 of this work manual for full details of defensive marks).

SEARCHING CERTIFICATION TRADE MARKS

10-25 For the purposes of Section 12 and Section 23 (association) applications for certification trade marks are searched in exactly the same way as applications for ordinary trade marks. (See also Chapter 23 of this work manual).

ARTICLE 6 ter OF THE INTERNATIONAL CONVENTION

10-26 Any search made by examiners must include the special 'Article 6 ter' indexes. Any devices or words etc found during the search of the indexes which have been afforded protection under Article 6 ter of the International Convention should not be entered on the search report. Instead, examiners, should enter the details under dictionary and other references on the report sheet and raise a Rule 17 and Section 11 objection as set out in Chapter 9 of this work manual.

BRITISH STANDARDS INSTITUTE (BSI)

10-27 By agreement between the Registrar and the British Standards Institute the registry carries out a search of any proposed common names for pesticides in order to check if they conflict with any registered or pending trade marks or additionally if they conflict with any marks protected under article 6 ter of the international convention. The result of the search is notified to the secretary of the appropriate BSI Technical Committee. Corres file 63045 provides full details.

BRITISH PHARMACOPOEIA COMMISSION (BPC)

10-28 By agreement between the Registrar and the BPC the registry carries out a search in Class 5 of any proposed British approved names for pharmaceuticals in order to see if they conflict with any registered or pending trade marks, previously notified approved names, or any marks protected under article 6 ter of the International Convention. Corres file 63131 and IPCD file 41523 provide full details.

MANCHESTER BRANCH

10-29 Only indexes and public enquiry points are maintained at the Manchester branch. All applications filed in Manchester are passed to London for search and examination where they are dealt with in every way as though they were applications filed in London.

[10-30 to 10-38]

SECTION 2

SEARCH PROCEDURE

10-39 To ensure that all classes which are likely to have similar goods or goods of the same description in them are searched, a cross search list is provided, as mentioned in paragraph 10-22 above.

To identify from the cross search list which other classes need to be searched, an examiner must compare the specification of goods of the new application with the list of similar goods to be found in other classes. Where the specification of goods of the new application could include goods which are considered to be goods of the same description in another class or classes, those classes must be listed on the examination report sheet and searched.

It is generally the specification on the form TM2 that is taken to compile the X-search list. If however there is a letter on the file from the applicant or his agent agreeing to a limitation of the specification as requested by classification, then this is the specification which should be used as the basis of the X-search. This is particularly important as regards "class claims" which are often edited drastically - sometimes to a single item.

WORD MARKS

10-40 When searching it is necessary to look in each class in which the search is to be made, to see whether the identical mark is already registered. A searcher might be able to offer a reasonable explanation as to why he failed to cite a mark which only resembles the mark under examination, but failure to cite an identical mark is inexcusable.

Having satisfied himself as to the position regarding identical word marks, the searcher then looks for marks which resemble the mark under examination and which are registered in respect of the same goods or description of goods remembering that it is essential to search in the indexes for both registered and pending marks. In carrying out a search the examiner must bear in mind the similarity in sound between certain letters eg the letter "K" and the hard "C", the letter "S" and the soft "C", the letter "F" and the letters "PH", the letter "J" and the soft "G", and so on. A search in respect of a word beginning or ending with one such letter(s) must be extended amongst the words with the similar sounding letters(s) where the likely pronunciation of the word makes this necessary. Examples are:

PHONETICS

K	=	Hard C
S	=	Soft C
F	=	PH
J	=	Soft G
I (i)	=	Y
ZEPH	=	ZEF
ix	=	(ic (ics)

ox	=	(oc (ocs (ocks
ack	=	ac ak
Uro	=	Euro
Cort	=	(Kort (Court (Caught

10-41 A mark consisting of a word or words which, in effect, describe a particular device mark must be regarded as likely to be confused with that device and vice versa. For example, the words "Red Indian" would have to be cited against a representation of a red indian and in the case of such words or devices, the search must always extend to their pictorial or verbal equivalents (see the Red Star case 11 RPC 142).

When making a search in respect of a mark consisting of a foreign word or words, the searcher must also consider the equivalent English word or words. The search need however only cover nearly identical phonetic or visual equivalents of foreign words, with greater attention paid to words in languages likely to be encountered in this country (eg West European) than those unlikely to be met (eg Tibetan).

DEVICE MARKS

10-42 So far as device marks are concerned, it is essential for the searcher to learn the indexing system as soon as possible. It is necessary, in every case of a device mark, to look through the collection of representations of pending marks as well as the index of registered marks.

For full details of the indexes and a list of the various headings and subheadings used to index device marks see the annexes to chapter 25 of this work manual.

[10-43 to 10-52]

SECTION 3

COMPARISON OF MARKS

10-53 No set of precise rules as to when or when not to cite can be set down. The question whether one trade mark is so similar to another that public confusion is likely to arise if both marks appear on the market in relation to the same goods or goods of the same description, is a matter for individual commonsense judgement, which the searcher needs to exercise in carrying out his duties. Nevertheless, over the years the courts have laid down certain principles to be borne in mind, and these are referred to below.

To start with it must be assumed that the marks will be used normally and fairly in respect of all the goods for which registration is sought. Additionally the onus of satisfying the Registrar that confusion will not arise is on the applicant.

10-54 The Pianotist case (23 RPC 774) provides a number of basic principles which must be considered.

1. APPEARANCE: You must compare the appearance of the two marks.

2. SOUND: You must compare the sound of the two marks.

3. GOODS: You must consider the goods to which the mark is to be applied. For instance the purchaser of an expensive new car is likely to take more care over his purchase than the purchaser of a cheap pair of socks and thus the purchaser of the car is less likely to be deceived or confused than the purchaser of the socks.

4. CUSTOMER: You must consider the kind of customer who is likely to buy the goods. The more knowledgeable or specialised in a particular trade the purchaser is then the less likely that purchaser is to be deceived or confused.

5. SURROUNDING CIRCUMSTANCES: All the surrounding circumstances must be considered and this includes the previous factors plus any other relevant factors which become known.

   Further principles which in effect extend and expand on the first five are:

6. The question whether one mark resembles another mark, within the meaning of section 12, should not be decided as the result of a meticulous comparison of the two marks side by side, letter by letter or syllable by syllable.

7. FIRST IMPRESSION AND IMPERFECT RECOLLECTION: Aristoc V Rysta (62 RPC 72) provides a useful guide to this principle.

8. SIMILARITY OF THE BEGINNINGS of word marks is generally more important than similarity of endings because of the tendency which most people have of slurring the ends of words or of dropping their voices at the ends of words [see the Tripcastroid case 42 RC 204].

9. MARKS MUST BE COMPARED AS WHOLES: that is to say, marks should not be split up or dissected when being compared for the purposes of section 12 (see the case of Erectiko v Erector - 52 RPC 151).

10. DISTINGUISHING OR ESSENTIAL FEATURES: However where device marks which may have a number of elements including words, are being compared it is important to identify the "essential feature" or "features" of the mark. The following short extract from the judgement of Sir Wilford Greene M R in the Saville PERFUMERY (58 RPC 147) case gives useful comment:

"In the present case, for example, the evidence makes it clear that traders who have to deal with a very large number of marks used in the trade in which they are interested, do not, in practice, and indeed cannot be expected to, carry in their heads the details of any particular mark, while the class of customer among the public which buys the goods does not interest itself in such details. In such cases the mark comes to be remembered by some feature in it which strikes the eye and fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing features, sometimes as the essential feature, of the mark. I do not pause to examine these appellations since the idea conveyed is free from ambiguity. In deciding whether or not a feature is of this class, not only ocular examination, but the evidence of what happens in practice in the particular trade is admissible".

Another useful comment on "essential features" is to be found in the following extract from the judgement of Mr Justice Lloyd-Jacob in the NOTEK case, (1951 RPC page 273):

A trade mark is infringed if a person other than the registered proprietor or authorised user uses, in relation to goods covered by the registration, one or more of the trade mark's essential particulars. The identification of an essential feature depends partly upon the Court's own judgement and partly upon the burden of the evidence that is placed before the Court. As Lord Radcliffe observed in de Cordova v Vick Chemical Coy (1951) 68 RPC 103 at 106: "In most persons the eye is not an accurate recorder of visual detail and marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole".

11. CONTEXTUAL CONFUSION: The possibility of contextual confusion must be taken into account. That is to say, in comparing two word marks, it is necessary to consider them in the context of verbal orders for goods ordered under these marks.

12. A mark consisting of a word or words which, in effect, described a particular device mark must be regarded as likely to be confused with that device and vice versa. For example, the words "Red Indian" would have to be cited against a representation of a red indian and in the case of such words or devices, the search must always extend to their pictorial or verbal equivalents [see the Red Star case (11 RPC 142)].

13. ENGLISH AND FOREIGN EQUIVALENTS: The Golden Fan case [13 RPC 295] gives judicial support to the view that foreign words and their English equivalents may be confusingly similar. Current practice is not to apply this too rigidly and the following examples illustrate current practice and show that the foreign equivalent must be reasonably close either visually and/or phonetically to be in conflict.

The following words would be in conflict under Section 12:

ENKLE	(German)	=	ANKLE
PROMESSE	(French)	=	PROMISE
OUI	(French)	=	YES
RASTLOS	(German)	=	RESTLESS
FREGATE	(French)	=	FRIGATE

The following words would not be in conflict under Section 12:

DOM	(German)	=	CATHEDRAL
CHIEN	(French)	=	DOG
TIENDA	(Spanish)	=	SHOP
CONEJO	(Spanish)	=	RABBIT

There may be occasional instances where the meaning of the foreign equivalent is thought to be so well known that (despite lack of visual and/or phonetic similarity) it would be in conflict under Section 12. OUI or YES is an example of this.

14. PLURALISED WORDS: It is well-known that trade marks are often used by themselves when ordering goods, ie without any specific mention of the goods as such. For example, a person will usually ask for "a box of Swan Vestas", rather than "a box of Swan Vesta matches". In such cases, a person ordering a quantity of goods under the trade mark will often naturally do so by simply adding an "s" to the trade mark itself. Therefore, it is necessary, when comparing word marks, to allow for the possibility that the marks themselves may in practice be pluralised and to consider whether this process would have the effect of enhancing the likelihood of confusion between the marks. The degree of likelihood that a mark will be used in this manner depends to a large extent on the nature of the goods concerned.

15. WORDS "talk" in trade marks. Thus, if a mark consists of a device in combination with a distinctive word (ie a word of a trade mark nature), it is most likely that it is by the word that the public will normally order goods under the mark. Therefore, where two marks resemble each other to the extent that they each contain a similar device, the overall resemblance between them will generally be lessened if they bear words of a trade mark nature which are entirely different from each other.

16. When comparing word marks, attention should be paid to the length of the words in assessing the effect of any differences between them. It is obvious, for example, that a difference of a single letter in long words is likely to detract very little from their over-all resemblance, whereas a single-letter difference between two three-letter words may make the words completely different from each other.

17. Where a mark which, on its own, would be in conflict under Section 12, the addition of a "House" mark does not necessarily remove the conflict. An example of this is the BULOVA ACCUTRON case (1969 RPC 102).

18. FAMILY OF MARKS: Where a number of similar marks in the same ownership incorporate an identical element then the view is taken that if someone also applies for registration of a mark incorporating that element, the public will assume that it is an addition to the family of marks and be confused or deceived if that is not the case. The minimum number of marks which constitutes a series or family of marks is 3.

A useful comment on this practice is to be found in the following extract from the judgement of the Assistant Registrar in the BECK KOLLER Case (64 RPC 76):

"When an application for registration is before the Registrar it frequently happens that the search for conflicting marks reveals several marks having some characteristic feature in common with the mark of the application, which marks may stand on the register in the name of one proprietor only, or in the name of several different proprietors. At this stage, when the matter is one between the applicant and the Registrar, the latter generally has before him no evidence as to whether the registered marks are in actual use or not, but in forming an opinion under Section 12 as to whether or not confusion or deception is likely to arise, he is bound, I think, in the absence of evidence to presume that prima facie, some at least of the registrations have been effected bona fide by persons who at the date of their respective applications were using or proposed in the near future to use their marks. If, therefore all the marks were owned by one proprietor, the Registrar would presume that the latter was using a "Series" of marks and judge the conflict between

the applicants' mark and each of the proprietor's marks with this consideration in mind. Of course, if the registration merely consisted of one and the same word registered separately in respect of several articles to be found in a single class of the trade marks schedules, the Registrar would in general regard all these registrations as but the equivalent of a single registration covering all the items, for they would not constitute a "series" as now under discussion. On the other hand, if the registered marks found were owned by several different proprietors, this would be a circumstance which might considerably assist the applicant who would be in a position to submit that the common characteristic was one well recognised in marks in use in the particular trade. In short, when the Registrar comes to compare the applicant's mark with the registered marks, using the principles laid down in the "Pianotist" case (23 RPC 774), the presence of marks on the register other than the one with which the comparison is being made is regarded as one of the surrounding circumstances which he is required to take into account".

COMPARISON OF GOODS

10-55 1. Apart from a comparison of the marks (when examining an application for conflict under Section 12 of the Trade Marks Act) the other question is whether the goods stated in the application under examination are the same goods; goods of the same description or different goods.

2. A record of decisions on "goods of the same description" is kept and this is called the "Comparison Of Goods Index - 'COGI'". It is however only a guide and what was thought to be in conflict thirty years ago may not be today.

3. It is essential to consider the whole of the specification of each mark. If only one part of the first specification consists of goods of the same description as one part of the second it is enough to found an objection.

4. The standard test for deciding if goods are of the same description is that laid down in Jellinek's application (63 RPC 59). The nature and purpose of the respective goods must be considered in a practical, businesslike way and not as a scientist or academic might consider

them. Consideration must be given to whether goods meet at any one point in the distribution chain, ie manufacturing, wholesaling and retailing; the criteria is not that the goods should share the same channel of trade in its entirety from manufacturer to consumer.

5. The Court's guidance is that consideration should be given under three headings:-

- Nature of goods
- Purpose of goods
- Channels of trade of the goods

In practice, if it is considered that the respective goods coincide in respect of two headings then this is sufficient to justify a finding that the goods are of the same description. (See the Floradix case 1974 RPC 583).

6. It is doubtful whether given goods are goods of the same description merely because they pass through the same channels of trade.

7. Channels of trade can be broken down into three elements although not all goods will necessarily have all three.

(a) producer/manufacturer
(b) wholesaler (if any)
(c) retailer (if any)

The channels of trade are considered to be the same if two sets of goods meet at any point in their channels of trade. For instance if it is common for both X goods and Y goods to be made by the same firm, or retailed by the same shop the goods are said to have the same channels of trade.

Difficulties may be encountered when dealing with goods sold in departmental stores or supermarkets. In the case of a department store the channels of trade for both X goods and Y goods would be the same if they were sold in the same department or over the same counter.

In the case of a supermarket the channels of trade of both X goods and Y goods would be the same if the two sets of goods were commonly displayed or grouped together.

At examination stage you may not know what the channels of trade are for any particular set of goods although in many instances common sense and general knowledge will help you.

8. The Daiquiri Rum Case (1969 RPC 600) (concerning amongst other things whether rum was the same as, of the same description as, or different to, rum cocktails) gives support to the way the Law has developed in deciding the question of conflict of goods.

Lord Reid in his judgement in this case gives a useful interpretation to the words "the same goods" and "goods of the same description".

Additionally Lord Wilberforce in his judgement in the same case gives a useful commentary on the same topic.

PRACTICE ON CONFLICTING CO-PENDING TRADE MARKS [SECTION 12(3)]

10-56 In view of the terms of Section 12(3) all conflicting co-pending marks are required to be cited. Until 9 April 1984 each co-pending application was cited against the other. From 9 April 1984 onwards however, the only citation is of first-filed marks against later marks, on the basis that the former have, prima facie, the prior right, and processing of the first-filed mark will continue uninterrupted. Applications filed on the same day will be cross-cited. The owners of the first mark will not be advised in the first instance of the existence of the later application. The onus is upon the later applicants to advise the registry of any claim they may have to sole ownership of the mark or to the prior right and to establish this claim through evidence. Failing this some alternative means of avoiding a conflict will need to be found by them, eg limitation of specification or modification of the mark.

10-57 In deciding which co-pending application has the first filing date, claims to priority by virtue of an International Convention filing should only be taken into account if the Convention claim has been proven. If, initially, an application is accorded priority by virtue of the International Convention date and subsequently that date is surrendered for, eg a wider specification, then the Section 12(3) conflict must be re-assessed.

10-58 The citation of the first filed application against the later filed application should be made in the form of a search report attached to the objection letter using the standard paragraphs (TP/NE) as necessary. Particulars of the mark to be cited should be entered on the Section 12 report sheet and the file for the earlier application obtained. There are separate report sheets for

1 Pending <u>but unadvertised</u> marks (report sheet headed paragraph 31)

and 2 Pending <u>but advertised</u> marks (report sheet headed paragraph 32)

In order to include the appropriate paragraphs in the search report the examiner will need to consider the status of the earlier application, in particular:

(a) whether it has been accepted or is being advertised before acceptance and;

(b) whether the later applicant is already aware of it and has lodged opposition or is seeking an extension of time for doing so. This application should then be given priority for the issue of the Official objection letter.

10-59 If standard paragraph 31 is used the entries under the column "Class and date filed" should additionally state:

(i) Not yet advertised.

(ii) To be advertised in Journal No ..... (This information will of course be obtained from the file of the first application; (ii) will only be used when Journal Section have already earmarked the cited application for advertisement in a particular Journal.

10-60 The date to be regarded as the date of acceptance for Advertised before Acceptance (ABA) cases is the date on which the case is noted "accepted" by the appropriate SEO, and in all other cases it is the date of the proof meeting at which the case was accepted.

10-61 If an application has been accepted and is likely to have been placed on the register by the time the official objection letter will be issued, the principal or senior principal should be consulted before any letter is sent to

either party. The mere fact that a fee paid Form TM10 has been lodged does not, however, mean that the application must be registered.

10-62 In all cases, a "Special Note" should be added to the file of the first application indicating the numbers of later filed applications against which it has been cited and requesting that they be brought forward for determination (if still outstanding) upon registration, refusal, etc of the first application.

10-63 Any challenge by the later applicants to the earlier application will normally be on one of two grounds:

1. That the later applicants have the prior right by virtue of prior use of the mark in this country;

2. There is a dispute as to ownership of the mark.

In either case, the only detail that should be transmitted to the applicant is the date from which the later filed application is claiming use from. Any other information eg turnover is confidential information and should never be transmitted to a third party. If further information is required the parties should be encouraged to liaise with one another. Further action depends upon the stage the earlier application has reached.

10-64 If the earlier application has not been advertised the earlier applicants should be allowed 2 months to respond to the challenge (eg by themselves claiming priority of use). At this stage progress of the earlier application should be stopped and the later application raised as a cross cite against it. Neither will be allowed to proceed until it has been established which has the prior claim. The side with the earlier priority claim, once this is known, should be invited to prove the claim in a statutory declaration. Normally the applicants with the proven priority date will be allowed to proceed to advertisement on notice to the other applicants whose application wil be put into suspense until the opposition period has expired. If they do not file an opposition and no other proposals are forthcoming then their application will be removed from record. If there is a dispute as to ownership of the mark the matter should be brought to an interlocutory Hearing.

If the later applicants merely ask for the earlier application to be suspended while they consider their position, the request should be refused, and the applicants informed that no action is being taken to halt the earlier application.

10-65 If the earlier filed application has been advertised the advertised applicants should be told that the later applicants' letter is being treated as a request for an extension of the opposition period and their observations are invited. Again further progress of the earlier application to registration should be stopped. If the earlier applicants agree to an extension of the opposition period (eg to allow negotiation between the parties) the normal procedure should be followed by Law Section (see Chapter 26 of this work manual). If the earlier applicants object to an extension then an interlocutory Hearing should be appointed.

A challenge by the second applicants to an earlier application must be dealt with very promptly to avoid the first application slipping through to acceptance or registration in the face of a valid challenge from the later applicants.

If the second applicants do not challenge the first application but ask to be suspended pending the outcome of the first-filed application, this may be agreed if it can be justified, eg the first application faces serious objections which do not affect the second.

EX-PARTE HEARINGS ON SECTION 12(3) CONFLICT

10-66 Subject to the right of either party to ask for a joint hearing, conflicts under Section 12(3) are usually dealt with at ex-parte hearings where the possibility of both applications proceeding on "Cross Notice" or "Cross Consent" is considered. "Cross Notice" is now only imposed in rare instances. See paragraph 10-170 for details of consent procedures.

JOINT HEARINGS ON SECTION 12(3) CONFLICT

10-67 If it is not possible to resolve the conflict as in paragraph 10-66, or if, the marks are too close for consent a joint hearing will probably be necessary and the papers should be referred to one of the Principals or Senior Principal to consider if a joint hearing is requested. If the parties cannot reach agreement in a manner approved by the Registrar, the manner of proceeding will depend on the facts of the case. If both marks are unused, the earlier application will be allowed to proceed to advertisement on agreement to send a copy of the advertisement of their Mark to the later applicant (which will be suspended) to await the outcome of any opposition proceedings which may ensue. If opposition does not take place and the first applicants mark proceeds to registration the later mark will normally be refused. A similar procedure will be followed when one

applicant claims and proves use earlier than the other applicants filing date and the other cannot prove use, then it will be the used mark that will proceed. If, however, both applicants claim and prove substantial use, both applications may be advertised before acceptance on cross notices, thus leaving the matter to opposition proceedings. If no opposition results the Registrar may refuse to proceed with either and may refer both parties to the court, as provided by Section 12(3). The case may, however, arise where on substantial use on both sides and not absolutely identical marks or goods, it may be possible to proceed with both under Section 12(2), (for details of S12(2) procedures see paragraph 10-192 onwards) each party giving "Notice" to the other (for details of notice procedures see paragraph 10-190).

REFUSAL UNTIL RIGHTS ARE DETERMINED BY THE COURT

10-68 The above procedure should result in most cases being settled within the registry, but where the parties' equities are dubious, eg where both parties claim to be the proprietor of the same mark or the evidence, if any, does not make clear who the real owner is, the Registrar may exercise his discretion to refuse to proceed with either application until the applicants' rights have been determined by the court.

The following is an example of the form in which an order, refusing to proceed under Section 12(3), should be made:

ORDER UNDER SECTION 12(3) TRADE MARKS ACT 1938

APPLICATION NO BY

APPLICATION NO BY

After hearing the parties, under the powers conferred by Section 12(3) of the Trade Marks Act 1938 I hereby refuse to proceed with either of the above applications for registration until the rights of the Applicants have been either determined by the Court or settled in a manner approved by the Registrar of Trade Marks. Should no such determination or settlement be reached within 6 months from the date hereof, both applications will be removed from the

record of pending applications, subject, however, to the right of either party to apply within that period for an extension thereof.

Dated this day of 19

Acting for the Registrar,
the Comptroller-General

CONFLICT WITH A REFUSED APPLICATION STILL ON RECORD

10-69 The following procedure should be adopted for dealing with the conflict of a pending mark against a mark which has been refused either ex parte or as a result of opposition proceedings and where either the statutory period in which to appeal against the refusal has not expired or an appeal has not been finally determined.

10-70 The action to be taken by the examiner is to cite in the normal way but he/she should consider the stage reached by the refused application and write to the parties on the lines indicated below. The letters should be tailored to fit the particular circumstances and in case of doubt the principal or senior principal should be consulted.

10-71 The applicants for the later application should be informed of the particulars of the refused application and of the fact of its refusal. They should also be informed that in the event of a successful appeal against the Registrar's refusal an objection under Section 12(3) will be formally raised against the present application. To avoid delay, the applicants may wish to offer amendments which avoid the potential objection. If so, these should be considered in the usual way. If, however, the potential conflict cannot be overcome in this way, the later application will be suspended, if it is not withdrawn, pending the final determination of the earlier application.

10-72 Should, at the time of examination of the later application, the period for lodging notice of appeal against the refusal be close to termination, it might be desirable to "mark time" until the period expires so as to avoid an unnecessary citation, but this is, of course, a matter for individual judgement. Where no citation is made because the

appeal period has expired the file for the refused application should be specially noted that no late extension is to be allowed. If in such a case a late extension is nevertheless allowed by the court, the later applicant (or his agent) should immediately be advised by telephone, confirmed by letter and suspended to await the outcome of the appeal.

10-73 Any subsequent correspondence should be co-ordinated so that account is always taken of the latest information regarding the status of the refused application.

[10-74 to 10-84]

SECTION 4 - DANGER TO HEALTH

EXTENSION OF CROSS-SEARCHING

10-85 By directions of the Board of Trade to the Registrar (which are mandatory) (see Annex A) the cross search in respect of certain goods was extended to include marks which are likely to cause danger to the public owing to confusion over the suitability of goods for internal consumption. This direction resulted from parliamentary questions to the President of the Board of Trade about the danger to health because of the appearance in the same shops of a liquid cleaning agent marked "SUNDROPS" and a soft drink marked "SUN-DROP". Both these marks are registered. As a result of the TREETOP case [details of which are contained on IPCD file 080/71] it was decided as a matter of practice to extend the search for "Danger" marks to beers and cider. The supplementary cross search list is incorporated in the main Cross Search List (see paragraph 10-22 above).

REGISTRARS' DISCRETION IN DANGER CASES

10-86 It is desirable that the Registrar should do as much as possible to avoid the "Sundrop" incident arising again although it is not thought that, as a general rule, the Trade Marks Act, 1938, allows marks to be refused merely on the ground of the possibility of confusion of this kind. Where a particularly bad case is concerned, however, eg where the same mark is sought for a soft drink and a disinfectant, there is no reason why we should not refuse to proceed under the Registrar's discretion (see the Jardex/Jardox Case 63 RPC 19). Current practice however is to inform the applicant if any such marks are found. This does not constitute a formal objection by the Registrar and

the onus is on the applicant to decide whether to proceed with the application.

Regardless of whether the registration is secured, the applicant is advised to take appropriate steps to minimise the potential dangers. For example, by suitable packaging and labelling of the goods.

NOTATION OF DANGER CITATIONS

10-87 Conflicting marks which show up as a result of the extended search will be marked on a separate form specially for danger cites. Citations made solely on danger grounds, viz where the respective specifications contain neither the same goods nor goods of the same description, should be restricted to identical or closely resembling marks, ie where, had goods of the same description been involved, either the registered mark is owned by the applicant and would have been required to be associated under Section 23 or the registered mark is owned by another proprietor and would have led to refusal of the application or to a requirement that a letter of "consent" be filed. In any case of doubt the citation should be made. Where an objection arises under section 12 as well as on danger grounds the normal criteria for citation should be applied and the search report noted "+D" in red.

10-88 The Official letter conveying the results of the examination and search in these cases should include paragraph 34 from TP/NE adapted as necessary to fit the circumstances of the case:

> "The search of the Register has revealed the following confusingly similar [registered Mark(s)] [and pending Marks] [and Marks which have been accepted] [and Marks which have been advertised before acceptance*] where it is considered that there is a substantial risk that the Marks are likely to confuse the public as to the suitability of any goods for internal consumption. This should be borne in mind by the Applicant in deciding whether to proceed with his/her application. Whether or not registration of his/her Mark is secured he/she should consider taking appropriate steps, eg by the mode of sale of the goods and their get-up and packaging, to minimise the danger.
>
> This matter is drawn to your/your clients' attention from a public interest point of view and is not a formal objection. The Registrar does not propose to take any further action in the matter."

10-89 Where the same goods or goods of the same description are involved but the registered mark is owned by the applicant, the procedure will depend on whether or not association of the marks under Section 23 is required. If it is not, the danger objection will not be raised because it is considered that the particular marks are not sufficiently similar. If it is, the association report should be noted "+D" in red and a written warning of the danger, based on the example in paragraph 10-88 above, should be included in the letter requiring association.

INHERENT DANGER IN CERTAIN CLASSES

10-90 All this must not detract from the care which must be taken in dealing with citations, which are true Section 12 objections, in classes where the danger over mistaken goods is very real indeed, for example, in Class 5 where all pharmaceutical preparations, disinfectants, and insecticides are all regarded as goods of the same description.

[10-91 to 10-102]

SECTION 5 - COMPLETION OF SEARCH REPORT

INFORMATION TO BE INCLUDED ON SEARCH REPORT

10-103 The search report which has individual sheets for recording Section 12(1), 12(3) and danger citations separately, indicates all of the details of resembling marks which are required to be noted therein, ie the application number of the mark, the number of the Trade Marks Journal and page of that journal in which the mark was advertised, and the goods in respect of which the mark is registered. If the mark in question is registered in respect of "All goods included in Class (No.)" this may be indicated by writing the single word "Class" in the "Goods" column. Experience will indicate other abbreviations which can be used in stating the specifications of goods of cited marks, but when an abbreviation is attempted, it must be remembered that it is essential to state specifications with absolute clarity as to their meaning and scope.

10-104 If the cited mark is a pending device mark then two photocopies of the mark should be attached to the form, one attached by glue the other by pin. This is so that a representation can be attached to the official letter advising of the 12(3) objection.

10-105 If the cited mark is a word mark, the word should be written plainly in the left-hand column of the search report, followed by 'a' or the word "alone" if the index indicates that the word is "alone" (ie is registered by itself without other matter). This detail is important from the point of view of those who have to make the final decision as to whether the objection based on the cited mark is to be upheld.

10-106 If any part of a cited mark is disclaimed the fact should be clearly indicated, by underlining the disclaimed word(s) and marking with a 'D' in black.

10-107 Some applications are, for a variety of reasons, amended after advertisement and this is indicated in the indexes by the following note: "Appln amd after advt Jnl No .....".

The examiner should refer to the relevant journal in order to ascertain what the amendment was and if it affects the citability of the mark. For instance an amended specification may in one case make no difference in relation to the application being searched and the mark will still be deemed citable, in another instance the amendment may be such as to mean the mark is no longer a cite.

The search slip should be noted as apropriate so that other examiners do not have to investigate the position each time a search is carried out.

When an application has been amended after advertisement and is still deemed to be a cite, details of the journal reference(s) containing the amendment should be noted on the report sheet.

10-108 The name of the present proprietor of the cited mark should be entered in the right-hand column of the search report, together with a note of the number of the Trade Marks Journal containing the advertisement of any change in the proprietorship of the mark or in the name or address of the proprietors. This is indicated when the entry of the cited mark in the main index bears any of the following notes: "ASSIGNED J.0000" or "NAME ALTERED J.0000" or "ADDRESS ALTERED J.0000". When the index entry bears either of the first two of these notes, examiners should refer to the relevant Journal(s) in order to find the name of the current proprietor of the cited mark which should be noted on the search report.

10-109 In the "Goods" column on the search report, a note should also be made, in addition to, and just below, the original specification, of any partial cancellation of the cited registration indicated in the index, together with the

number of the Trade Marks Journal in which the cancellation was advertised, for example, "Cancelled for nuts, bolts and like J.0000".

10-110 The following information should be written immediately below the numbered particulars of the cited mark in the search report:

(a) If the cited mark is shown in the index as having proceeded "By Consent", the note "Consent", followed by the number, Trade Marks Journal and page of the consenting mark, should be entered.

If the registration which has given the consent to the cited mark is not itself to be raised as a cite against the application a note to this effect should be made eg 'off record' etc.

(b) If the cited mark is shown in the index as having been "advertised before acceptance", the note "A.B.A." should be entered.

(c) If the cited mark is shown in the index as having proceeded under Section 12(2), the note "Sec. 12(2)" should be entered.

(d) If the entry in the index shows that a memorandum has been entered in the register in connection with the cited mark (the Index would bear the note "Memo. entered J.0000"), a note to that effect should be included in the search report with the other particulars of the cited mark.

(e) If the index has been stamped "RECTIFICATION" Law Section should be consulted. The number of the file should be entered and a note made as to the possible length of time proceedings might take.

PENDING APPLICATIONS

10-111 When pending applications have to be cited it is necessary to identify which of two categories they fall into:

I Not yet advertised or about to be advertised;

II Advertised.

Separate sheets are provided for recording details of marks falling into each of Categories I and II above. If the mark

falls into category I, ER2 incorporating paragraph 31 of the typists paragraphs should be completed, additionally the column "Class and date filed" should state either:

(a) Not yet advertised;

or

(b) To be advertised in Journal No .....

(b) above will only be used when journal section have already earmarked the cited application for advertisement in a particular journal.

If the mark falls into category II above ER2 incorporating paragraph 32 should be completed.

ASSOCIATED MARKS (SECTION 23)

GENERAL

10-112 Examiners should note on the yellow association report, identical or similar marks which are pending or registered in respect of the same goods or description of goods in the name of the applicant for the mark under examination. The new mark and any similar pending marks, if they proceed, must be recorded as "associated" marks under the terms of Section 23(2) with those already registered. Under Section 23(1), "associated" trade marks can be assigned or transmitted only together and not separately, the effect of this in short being to prevent similar marks, used in relation to similar goods, being recorded in the names of different persons with resulting confusion of the public. Two matters call for consideration (a) whether the respective specifications contain identical goods or goods of the same description, and (b) whether the marks are identical or so nearly resemble each other as to be likely to deceive or cause confusion if used by another proprietor. Both factors must be present before association can be properly required under the section. So far as (b) is concerned, it seems that association has been requested too readily in the past and a useful approach is to consider whether, if the two marks were in different ownerships, a fatal objection would arise using the criteria applied under Section 12(1). In this connection marks which could proceed only on consent must be treated as fatal. So far as (a) is concerned the guide is the cross search list (but see also paragraph 10-114 for association under Section 17(2)) and the Comparison Of Goods Index (COGI). For full details of COGI see chapter 25 of this work manual. Unless the respective goods, or some of them in the two applications are plainly of the same description, the question of whether

or not to require association should be referred to a hearing officer. This will usually be the SEO in charge of the examination unit.

10-113 Where there is a discrepancy between the address stated in the application and that recorded for the existing registered mark or marks to be associated, the association report should be noted "Address differs" in the right-hand margin alongside the particulars of the mark or marks. In quoting marks for association it is not necessary to note in detail all the similar registered marks for the same goods or goods of the same description. It is generally sufficient to note in detail only the earliest (the oldest mark in the class (the master mark) to which all others refer), the nearest (ie the identical or most closely resembling mark) and the latest. A note should be added below "and others associated" if such is the case. All pending marks requiring association should be noted on the association report.

10-114 Where a mark is proceeding to advertisement on the basis of equities provided by previously registered marks, details of the mark which provides the equities are shown in the journal advertisement. Where there is only one mark to be associated there is no doubt what is to be shown as associated in the journal advertisment. However where there are a number of registered marks to be associated, the mark or marks which are shown in the journal advertisement (to be associated with .....) are those which provide the justification for acceptance of the application. The mark which provides the justification is not always the earliest one and EXAMINERS MUST indicate which mark(s) provide justification for acceptance, by bracketting the appropriate mark or marks on the association report. It should not normally be necessary to bracket more than two marks. Where groups of companion marks (identical marks in different Classes filed at the same time) are being searched it is sometimes necessary to ask for the association of some of them in classes not normally covered in the cross search. This is done where the goods are considered to be closely related and because the marks are identical. Association in these cases is asked for by reason of special circumstances under the provisions of Section 17(2) of the Trade Marks Act.

10-115 The leading associated mark must be bracketted in all instances and not just where equities are a pre-requisite. The criteria for determining the lead association marks is as follows:

1. If there is only one identical mark then that is the lead mark

2. If all associated marks are identical (or all not identical) then go by the closest specification of goods

3. Where there are both pending and registered marks a pending mark will never be the leading associated mark

ASSOCIATION OF JOINT-VENTURE APPLICATIONS

10-116 Association in such cases is dealt with as follows: If, assuming that the application had been made in the name only of one of the applicants, association would have been proper with a mark or marks on the register or about to be registered in the name of that applicant, then such association is required in the case of the joint-venture application, and is advertised as indicated below. If the joint-venture mark is registered, the appropriate entries are made in the association register. Undertakings where appropriate are advertised in lieu of the customary "To be associated with &c."; these undertakings form part of the application and registration and are worded as follows:

A.B. undertakes that his rights in this Mark and in (the registered) Mark No. ..... (when registered shall be assigned or transmitted as a whole and not separately.

C.D. undertakes that his rights (as above).

There may, of course, also be ordinary association (where marks and goods require it) with other joint-adventure marks of the same plural proprietors.

10-117 The examiner should in all cases where association of marks is required stamp "ASSOCIATE" in red at the top of the outside of the file cover.

AGREEMENT TO ASSOCIATION

10-118 The applicant is advised in the examination report letter that if the application proceeds he will have to agree to any association requests and also, where necessary, to take steps to record his new address in the register in connection with the registered marks in question. A standard paragraph in the typists paragraphs for the proceed letter is normally used to request agreement to association requirements.

[10-119 to 10-127]

SECTION 7 - ACTION ON COMPLETION OF SEARCH REPORT

10-128 Action at this stage depends on the examiner's view of the mark under Sections 9 and 10 and whether the application is one of a group of COMP marks. There are four possible routes:

1. If accept Part A or Part B, file is routed direct to the appropriate examination unit SEO for approval before despatch of examination and search reports to applicant or agent.

2. If application is one of a group of COMP marks the file(s) is passed to the appropriate examination unit HEO for a quality check (HEO will pass to SEO if application falls into Category I above).

3. If objections under both Section 9 and 10 are raised (whether other objections or not) and application is not a COMP mark the examiner arranges for examination and search reports to be typed and despatched to applicant or agent without any further approval needed.

4. Until the examination unit HEO is satisfied with a new trainee's work all trainee casework should be cleared by the unit HEO before issue of the examination report.

[10-129 to 10-133]

SECTION 8

SEARCH PROCEDURE FOR APPLICATIONS TO RESTORE AND RENEW LAPSED REGISTRATIONS

10-134 As soon as Form TM 13 is placed on the relevant trade mark file the file should be minuted "Search to date" and passed to the appropriate examination unit. The search should be made in the same way as a search under Rule 31 except that:

(i) The collection of refused marks kept under rule 102 should not be included.

(ii) The Schedule III Register should not be included.

(iii) The search should be confined to the list of pending applications when the Form TM 13 is dated less than 1 year from the date of the expiry of the registration for which restoration is sought.

10-135 If the search reveals no conflict, the file for the application to restore will be returned with a note to that effect to the HEO in registration section to consider the case in accordance with the procedures laid down in chapter 29 of this work manual.

10-136 If the search reveals any conflict, the relevant details should be entered on the report sheet for the conflicting application and the relevant files attached to that for the application to restore. All the files should then be sent to the principal, via the SEO who should add any comments, who will direct the subsequent handling of the application to restore.

10-137 In considering an application to restore a lapsed registration where a conflicting application by another proprietor is pending it must be remembered that the latter would be adversely affected by any exercise of the discretion given by Rule 68 so as to allow restoration. He would thus be entitled to a hearing under Rule 116. An application to restore should not be refused without offering the former registered proprietor a hearing. Cases involving a conflicting application to register are therefore likely to require a joint hearing to be appointed which should be taken at principal level or above. It is not possible to set out fixed guidelines for these cases, but relevant factors will always include the degree of resemblance of the marks and whether the applicant for rstoration has used his mark on all the goods of his registration within the 2 years preceding its removal (see Section 20(4) proviso).

10-138 There is no right of appeal against a decision to allow or refuse an application to restore, since that is purely a discretionary matter. An applicant for registration who is faced with a fatal citation under Section 12(1) through the operation of Section 20(4) has a right of appeal under Section 17 in the usual way.

10-139 If an application to restore is refused (likely to be rare) for whatever reason, the appropriate examination unit will be instructed to note the relevant index slip "Application to restore refused". This notation should also be made on the citation on the report sheet of any pending application dealt with under paragraph 10-136 or 10-137 above.

10-140 Whenever a citation is made under Section 12(1) where the cited mark remains on the indexes because of ection 20(4) the file for the expired mark should be obtained and prominently noted that it has been cited against a pending application, full details of which should be given. Should a Form TM 13 be filed subsequently, the request for a search under paragraph 10-134 above should include a note drawing the examiner's attention to the existing conflict. On conclusion of the search, whether or not any further conflict is found, the files should be referred to the principal to consider.

10-141 Since registered user entries are part of the register of trade marks they stand or fall with the entry in the proprietor's name. Where restoration of a lapsed registration is to be allowed the RU entry may also be restored without any separate application having to be made by the registered user, and the file should be passed to RU section to restore the RU sheet to the live register and to notify the registered user of the reinstatement. Any request by such a user to make representations in support of an application to restore and renew a lapsed registration should be submitted to the assistant registrar or his deputy.

[10-142 to 10-153]

SECTION 9 - OVERCOMING SECTION 12 OBJECTIONS

10-154 There are a number of ways of resolving objections raised under Section 12. These are as follows:

1. Amendment of applicant's specification (see paragraph 10-155)
2. Amendment of applicant's mark (see paragraph 10-161)
3. Consent (see paragraph 10-170)
4. Notice (see paragraph 10-190)
5. Honest concurrent user (Section 12(2)) (see paragraph 10-192)
6. Rectification of the register to remove or part cancel an existing mark or marks (see paragraph 10-199)
7. Voluntary cancellation/part cancellation (see paragraph 10-200)

8. Acquire conflicting mark (assignment) (see paragraph 10-201)

9. Expiry (see paragraph 10-202)

Where objections are raised under Section 12(3) (pending applications) all the above may apply plus additionally.

10. Proof of first use (see paragraph 10-220)

AMENDMENT OF SPECIFICATION OF APPLICANT'S MARK

10-155 An applicant may amend the specification to avoid a conflict with the cited mark as set out in the following paragraphs.

10-156 EXCLUSION: The applicant may exclude from the specification of goods of his application, goods in respect of which the cited mark is registered and goods of the same description.

There are a number of rules for the acceptance of exclusion clauses and the following should be read in conjunction with the section in Chapter 7 of the work manual dealing with exclusion clauses.

I If the clash of goods involves 'same goods' then any exclusion clause should normally include ".... and goods of the same description....". (but see IV below).

II If the clash of goods only involves 'goods of the same description' and not 'same goods' and if such "goods of the same description" are in the same class to that of the application, then the specific goods involved should be excluded but without the addition of "and goods of the same description".

III If the clash is in respect of "goods of the same description" in a different class then it is not possible to utilise the term "but not including goods of the same description as ...." because there is no base to work from and the resultant specification would be too vague.

In such an instance a positive approach will be needed ie. by amendment of the specification to spell out precisely what goods are intended to be covered by the registration, if necessary listing all the goods individually.

IV Where there is conflict involving 'same goods' but the conflict of marks is not considered too severe, it may be possible to allow an exclusion clause merely excluding specific goods without reference to 'goods of the same description'.

V A specification is not acceptable if it is not possible to clearly identify what goods are covered by it, and this must be borne in mind when deciding what exclusions are acceptable.

10-157 LIMITATION: The applicant may limit the specification of goods in his application to goods which are not 'goods of the same description' as the goods covered by the cited (conflicting) mark.

For example if an application with a specification of 'Computers, computer programmes; cameras' had cited against it as an objection a mark with a specification reading 'cameras', it is clear that the only conflict is in 'cameras' as there is no overlap of goods of the same description as cameras on the one hand and computers and computer programmes on the other. The objection could be overcome by the applicant agreeing to delete cameras from his specification.

10-158 The applicant may limit the specification of goods in his application to goods for sale in markets other than those specified in the cited (conflicting) mark. However, division of the UK between one registration and another in the names of different applicants is not generally allowed, except where the applicant is able to invoke the provisions of Section 12(2).

For example the following two specifications are not in conflict, although had the first not included the qualification "...., all being for export to and sale in Puerto Rico" then it would have been a valid objection against the second.

1. Industrial oils and greases (other than edible oils and fats and essential oils), lubricants, fuels, motor spirit and illuminants, all being for export to and sale in Puerto Rico

2. Industrial oils and greases (other than edible oils or fats or essential oils); lubricants; fuels and illuminants; but not including any of the aforesaid goods for export or "none being for export".

[10-159 to 10-160]

AMENDMENT OF APPLICANT'S MARK

10-161 It is occasionally possible to avoid conflict by a modification of the applicant's mark.

1. Suppose an application for the mark KLEIN and DEVICE had cited as an objection against it the mark KLEIN. The objection could be overcome by removing the word KLEIN and allowing the application to proceed for the device only.

2. Amendment of a word mark should not normally exceed the alteration of two letters or the removal or addition of one letter.

3. The alteration of the initial letter of a word is not acceptable.

4. The removal of a whole word in a composite word/device mark is generally acceptable.

5. The addition of an equity (house mark) to a mark may overcome a weak citation by making the amended mark as a totality, dissimilar enough for the citation to be waived.

6. Major amendments which would necessitate an additional search to that already done should not be allowed.

[10-162 to 10-169]

CONSENT - INTRODUCTION

10-170 This method of overcoming an objection depends upon the owner of the cited mark giving 'consent' for the mark applied for to proceed to advertisement and registration. This normally happens if the owner of the cited mark is not concerned that the registration of the proposed mark will adversely affect his business. Essentially consent is looked upon as evidence from the trade that despite appearances to the contrary the facts of trade are such that it is unlikely that there will be confusion.

10-171 In overcoming conflict the Registrar may be more willing to look at the possibility of consent where specialised goods are involved and where he has little or no experience of the areas of trade involved. Clearly in relation to normal consumer fields the Registrar is able to judge the reaction of the purchasing public so the question of consent in these cases is more likely to be considered in relation to the closeness of the marks, the breadth of specifications, involved etc.

10-172 The Registrar cannot impose a condition of consent. This was made clear in the Velva-Glo case, 1961 RPC 255 particularly at page 261 line 5 to page 262 line 12 and in the LinPac case, 1973 RPC 661, particularly at page 666 lines 1-46.

Consent is not a condition and should not be referred to as such in verbal or written communications. Rather the applicant or his agent should be informed that if the consent of the owner of the cited mark is forthcoming the view taken as to the likelihood of confusion will be reconsidered.

In the case of a Section 12(3) conflict the same principle applies. The Registrar does not impose a condition of cross consent; but is able of course to invite the parties to see if they can agree to exchange consents with a view to enabling both marks to be entered on the register. If however, agreement cannot be reached, then prima facie, the applicant with the prior right would be entitled to have his application proceed in the face of the later application(s).

If consent is forthcoming it is a circumstance which an examiner or hearing officer can take into account, amongst other things, in deciding whether there is a likelihood of deception or confusion occurring.

CONSENT-WHEN ACCEPTABLE

10-173 Whether or not consent is acceptable to overcome an objection is a matter of judgement and experience but the following basic rules apply:

1. Only section HEO's and above are authorised to waive an objection because 'consent' has or will be supplied although examiners may recommend consent.

2. Consent is not acceptable when identical marks are involved.

3. Consent will not overcome an objection where the marks are phonetically or visually identical.

4. As a general rule the closer the marks are (assuming the goods to be the same or of the same description) the less likely will it be that consent will overcome the objection. However it is extremely unlikely that the proprietor of a mark which he is using in respect of specific goods would give his consent to the registration of another mark for the same goods or goods of the same description if he thought that confusion would arise between the two marks and thus damage his own business.

   Apart from the marks, consideration should also be given to the type of goods. For example are they goods of a sort purchased over a shop counter with little thought (a bag of sweets) or are they goods for which considerable thought goes into the purchase process, for instance computers. In the latter case because considerable care is taken in deciding upon specific goods, confusion between marks may be less likely and consent more readily acceptable.

5. A further factor which may be taken into account in considering whether consent may be appropriate is when the owner of the cited mark has a very broad specification and the mark applied for has a very narrow specification.

In such cases if the owner is willing to grant consent to the registration of the mark applied for then it can be assumed that the registered mark is not used in connection with all the goods contained in the broad specification. Another possibility is that the trading conditions in relation to the specific goods are such that confusion is unlikely between the marks and hence the owners consent is given.

6. Consent of the owner of a cited mark cannot be accepted if there is thought to be a tangible real risk of danger to health arising by reason of confusion through the existence of two very similar registered trade marks where one (or both) of the specifications is in Class 5 and contains goods for human consumption (this applies to virtually all Class 5 goods with the exception of "material for bandaging; material for stopping teeth; and dental wax).

7. If an applicant files a letter of consent without having been asked to do so, consideration must still be given to whether or not it overcomes the objection, particularly in the light of the preceding rules.

FORMAT AND CONTENT OF CONSENT

10-174 To begin with, the mark applied for must be properly identified in the letter of consent. That is to say, if the mark is a word mark, the letter should state in terms that consent is given to the "registration of the word 'So-and-so'" ..... If the mark consists of or contains a device of some kind, a representation of the mark should be affixed to the letter of consent and be initialled, for purposes of identification, by the signatory to the letter. Secondly, it must be explicit in the terms of the letter that consent is given to the registration of the proposed mark. It is not sufficient if the letter states that consent is given to the use of the mark. Provided the letter clearly comes from the registered proprietor (e.g. as indicated by the letter head) the status of the signatory of the letter need not be stated, it being assumed that the registered proprietor controls the issue of letters in his name.

10-175 Letters of consent should not contain conditions regarding the use of the proposed mark since the registry may not know if those conditions have been met, or could be met. Any such conditions must be made the subject of separate correspondence between the parties. The applicants should be informed to that effect, and should be asked to furnish a fresh letter of consent which is unconditional in its terms, in any case where the original letter offends in this respect.

10-176 If a letter of consent states that consent is given to the registration of the proposed mark in respect of a narrower specification of goods than that stated in the application, the applicant must be requested to reduce the specification of goods on the application to those consented to.

10-177 If a letter of consent is signed by a person or firm other than the registered proprietor of the prior mark, but claiming to be the present proprietor of that mark, the applicant should be informed that further action on his application must be suspended to await the registration of the person or firm concerned as subsequent proprietor of the prior mark. Provided the Registrar is supplied with documentary evidence or is otherwise convinced that the beneficial claim to ownership is genuine then even if the signatory to the letter of consent refuses to take steps to register himself as the proprietor the Registrar may proceed with the pending application on the basis that notice of advertisement is sent to the registered owners of the cited mark. In such a case the mark is not advertised as "by consent".

10-178 On dealing with a normal case and having satisfied himself on the foregoing lines that the letter of consent is in order, the examiner concerned should stamp "By Consent" on the outside of the file cover and on the application form. He should also note prominently in pencil on the minute sheet in the application file, "Consent ... (followed by the application number of the prior mark)...".

PAYMENT FOR CONSENT

10-179 The Registrar does not investigate or accept responsibility for the terms under which a registered proprietor is prepared to give his consent except where the applicant or his agent complains that the owner of the cited mark is demanding a sum of money which could be said to extend far beyond the amount which might reasonably be expected to cover any expenses for professional services.

10-180 It is not unreasonable for the owner of a registered mark to ask those seeking his consent to the registration of their application to pay the professional expenses incurred in considering the matter, but if the sum sought appears to be grossly in excess of these and the owner is taking the opportunity to make some money by giving his consent, consideration may be given to allowing the application to proceed on condition of "notice of advertisement". Of course in taking such action the Registrar must be satisfied that the registered proprietor is prepared to give his consent and is thus not concerned that the proposed registration will adversely affect his business. It must also be clear that if consent has been filed the Registrar would have accepted it as overcoming the section 12 objection. Copies of the correspondence between the two parties should be seen in order to determine this.

10-181 The assessment of reasonable expenses will obviously depend upon the circumstances of each case and it can be expected, for example, that if an address for service in the UK has to approach a registered proprietor overseas through foreign agencies, etc the costs incurred will be higher than in a case where a registered proprietor in this country needs only to consult, or be consulted by, his local professional advisors.

10-182 Where a Section 12(3) position subsists different considerations apply. The possibility of the exchange of cross-consents by the parties may be a solution, to enable both applications to proceed; but if the prior applicant puts forward a package of conditions under which he is prepared to give his consent, and the later applicant is unable to accept one or all of them, there is no justification for the Registrar ignoring the likelihood of confusion between the marks and allowing the later application to proceed on 'Notice', especially if the marks are very close visually and phonetically and cover conflicting goods. Neither would the Registrar be justified in adopting this course if the prior applicant refused to entertain giving his consent. In the LinPac Case (1973 RPC 661) Mr Douglas Falconer QC in his decision indicated that he was not convinced that the Registrar should investigate and accept responsibility for the terms upon which consent is given.

10-183 A recent case (1983) concerning payment for a letter of consent involved a UK registered proprietor who was approached through his trade mark agent located in the same town. The sum sought was £1000 and was deemed to be far too high given that the current scale of legal fees was about £50 per hour. A condition of notice was imposed in lieu of a letter of consent.

Cases such as the above should be referred to the hearing officer concerned or in the event that no hearing has taken place the section SEO, for a final decision.

[10-184 to 10-189]

NOTICE

10-190 This is a condition that is occasionally imposed by the Registrar. The provision of 'notice' to overcome an objection raised under Section 12 is at the Registrar's discretion.

In effect the applicant, or the agent acting for the applicant, must send a copy of the Trade Marks Journal advertising the proposed mark together with a letter of Notice, to the registered proprietor (or the address for service if a foreign proprietor) of the cited mark. In this way the owners are informed of the proposed mark and have the opportunity to lodge a formal notice of opposition to the application if they so wish.

This method effectively puts the responsibility for opposing an application upon the owner of the registered mark. This is in contrast to the other methods of overcoming objections which are all based upon decisions made within the registry. As 'Notice' is not required by the act or rules it should be used sparingly.

In the majority of cases notice should not need to be imposed because in the main a decision should be made to either maintain or waive an objection (possibly after amendment of the specification or mark).

Notice should be used in the following circumstances:

1. When an application is proceeding under the provision of Section 12(2).

2. When an application is proceeding because of priority over another pending application.

3. In particular cases when dealing with citations in Class 5, it may be appropriate to consider the possibility of notice because of the danger which could arise if the marks were confused. This applies only in respect of conflicts where if they occurred in other classes the citations would probably be waived.

When notice is considered appropriate the agent or applicant must provide written confirmation that notice will be sent to the owner of the cited conflicting mark, although it is not necessary for a copy of the actual letter of 'Notice' to be sent to the registry. Where such a condition has been imposed confirmation must be given on the Form TM No 10 (which accompanies the registration fee) that the said condition has been complied with.

10-191 The following is a style of letter which will satisfy the registrar's requirements as to notice.

> "We enclose herewith a copy of Trade Marks Journal No ..... showing on page ..... thereof the advertisement of the Trade Mark Application No ... in the name of (our clients) .....
>
> The Journal is sent by the direction of the Registrar of Trade Marks in order that you may have an opportunity of lodging formal Notice of Opposition to the Application if so advised, but we are instructed to state that this is not to be regarded as an invitation to oppose.
>
> Your attention is also directed to the Notice as to "Opposition" appearing amongst the official Notices at the commencement of the Journal.
>
> This Notice concerns (your) Trade Mark No .....
>
> Yours faithfully,"

Where a letter of Notice is to be sent it should be sent as soon as possible after publication of the journal of advertisement of the applicants mark to enable an opposition to be lodged if required, within the four week period allowed.

HONEST CONCURRENT USE

10-192 In some circumstances it is possible to overcome an objection based upon a cited mark if 'honest concurrent use' can be demonstrated. By this is meant that the conflicting marks have been used honestly in connection with the goods in the respective specifications. Although confusion would normally be expected from the similarity of the marks it is assumed that they have become so well known and readily identified with the goods that the public has become used to differentiating between them.

10-193 Evidence may be filed for the purpose of establishing honest concurrent use of the mark under the provisions of Section 12(2) in order to justify a

registration otherwise prohibited by Section 12(1). It is usual to expect that the applicant shall have used his mark for a period of at least seven years prior to the date of application before the benefits of Section 12(2) can be invoked. If the Section 12 conflict covers several sets of goods for which the dates of first use differ, the journal advertisement must indicate this, viz "Use claimed from the year ..... in respect of [goods] and from the year ..... in respect of [other goods] Section 12(2)".

10-194 While the period of seven years is not sacrosanct it is important to ensure that any lessening of the "customary yardstick" of seven years use is allowed only when the reasons are very strong and defensible. (See the reference to "a considerable amount of concurrent user" - Maeder's case, 33 RPC, 82, lines 5-6). However in dealing with cases in which Section 12(2) is invoked all the facts have to be taken into account. Very heavy use and advertising would be a factor in allowing a shorter period of concurrent use. (The shortest period of concurrent use on which any application has proceeded is 2½ years - the "Granada" application (1979 RPC 303)). The goods also must be taken into account; possibly the sale of one nuclear power station would be sufficient for Section 12(2) to be invoked, for a registration for such installations. As Lord Justice Romer said in Pirie's case (1932) 49 RPC 195 (Court of Appeal) - appeal to the House of Lords being dismissed subsequently - "Every case under the section must be determined on its own merits. I do not doubt that in exercising his discretion, the Registrar must in each case take into consideration the extent of the concurrent user, extent in time and extent in quantity. He must also, of course, take into consideration the degree of deception that will result from a registration of the applicant's mark. He must also consider most carefully whether in the circumstances he ought to impose any and what conditions and limitations, and so forth. All those matters are matters with which the officials in the office are peculiarly fitted to deal, and where the Registrar has exercised his discretion in the matter, the Court should be very slow to interfere".

10-195 The evidence required to substantiate a claim for proceeding under Section 12(2) is similar to that required where distinctiveness is being proved under Sections 9 and 10 except that evidence from independent sources is not needed (except in borderline cases and in the rather rare cases in which it may be thought necessary to expect the kind of "picking out" evidence that is customary in some factual distinctiveness cases) and the applicant is not normally required to provide evidence in the form of copies of invoices or lists of principal towns and cities where the goods have been sold. The declarant's statement that the

mark has been used in relation to the goods throughout a certain area is accepted at its face value, provided it is consistent with the other facts shown in the evidence.

10-196 It is important to note that in practice no application is permitted to proceed under the provisions of Section 12(2) if a position of "triple identity" exists (see the LION case, 57 RPC 248), that is to say:

1. Where the mark aplied for and the cited mark are identical

2. The goods are identical

and 3. The areas of trade are identical

The reasoning for this is that in such circumstances confusion would be certain and the Registrar in effect declines to exercise his discretion to proceed under Section 12(2). Nonetheless there is no statutory bar to the registration of identical marks for identical goods. A "triple identity" conflict can sometimes be overcome in the following ways:-

(a) If the cited mark and the mark applied for are identical and the former is registered in respect of a specification of goods which covers or includes the goods for which concurrent user is claimed, then, provided that a satisfactory case has been made out for the purpose of Section 12(2), the cited registration can be avoided if the proprietor thereof cancels it in respect of the goods for which the applicant's user is shown (ie it need not be cancelled also in respect of goods of the same description as the stated goods).

(b) If the mark applied for has been used over only a part of the United Kingdom, then the application may be allowed to proceed under Section 12(2), provided that a satisfactory case of use has been made out, and that the application and the cited registration are restricted to goods for sale in mutually exclusive areas with a "no man's land" between them. Thus, an application may be allowed to proceed, for example, under Section 12(2) if it is limited to goods "for sale in England except in the Counties of Cumbria and Northumberland" provided that the cited registration is cancelled except in respect of goods for sale in Scotland. The Counties of Cumbria and Northumberland would in this case represent the "no man's land". The question

whether the applicant or the cited registration should exclude the "no man's land" is a matter for arrangement between the owners of the marks. There is no general "yardstick" to establish a minimum extent of "no man's land". The extent of the "no man's land" may be determined by the extent of advertising (regional/national TV for example).

10-197 When the applicant in a Section 12(2) case is considered to have justified, by his declaration, his claim to honest concurrent use of his mark (the honesty of the adoption and use of the mark being taken for granted at this stage, unless the evidence shows that the mark may have been wrongly represented in use as being already registered), the applicant is informed that the application can proceed under Section 12(2) on his giving a written undertaking to send due notice in the customary form by registered post or recorded delivery service to the registered proprietors of the cited mark, of the advertisement of the application in the Trade Marks Journal. Such notice is unnecessary, however, if the proprietor of the cited mark has agreed to part cancellation of his registration either as to goods or to area in order to facilitate registration of the application, or if the cited mark has expired but is still on record. The file cover is stamped "Section 12(2)" with addition, where appropriate, of the words "Special Circumstances", or "Use and other Special Circumstances", and the wording of the necessary legend for advertisement in the Trade Marks Journal is indicated boldly on the summary of evidence form.

10-198 It is possible on sufficient evidence (see the ORTHO application, 850888) to apply the provisions of Section 12(2) even in Class 5 where there could be a question of possible danger to public health arising from the registration of identical or confusingly similar trade marks.

RECTIFICATION PROCEEDINGS

10-199 Essentially rectification means a CORRECTION or amendment of the register.

For example if a mark has not been used for a continuous period of five years or more this could constitute grounds for rectification of the register. This would be very useful to an applicant for a new registration if he could prove that the cited mark has not been so used. If non-use was proved an action for rectification might be successful and the register rectified by removal of the mark not in use. Removal of a cited mark from the register would remove a barrier to the registration of the applicants mark.

The rules governing rectification actions are complex and full details are set out in chapter 26 of this work manual.

VOLUNTARY CANCELLATION OR PART CANCELLATION

10-200 A Section 12 objection may be overcome if the applicant can persuade the registered proprietor of the conflicting mark to cancel or part cancel his registrations, so that no conflict of goods is involved. (N.B. It is normally necessary to ensure that goods of the same description are cancelled as well as any identical goods) - see also paragraph 10-156. Cancellation/part cancellation are dealt with in detail in chapter 29 of this manual.

ASSIGNMENT

10-201 If the applicant can buy the conflicting mark and have it assigned to him so that both the application mark and the conflicting mark are registered in the same name this will overcome any Section 12 objection. The assignment documents should be filed and checked to be in order before formal acceptance of the marks under application. Assignment is dealt with, in detail, in Chapter 30 of this manual.

An alternative to assigning the conflicting mark is to assign the mark applied for. This route needs careful handling because there is no provision to register assignments of pending marks and registration of a pending mark in different ownership to a conflicting registered mark is (apart from exceptional circumstances - see paragraph 10-192) barred by Section 12.

To avoid this situation the formal registration of the mark must be simultaneous with the formal registration of the name of the subsequent proprietor on assignment. This simultaneous registration and assignment is known within the registry as "SIMTIM". No other reason exists for "SIMTIM" and the procedure should not be used to "hurry things up" merely because an application is to be assigned later.

EXPIRY OF MARKS

10-202 Expired trade marks (that is those on which a renewal fee has not been paid) are held under Section 20(4) of the act to be registered trade marks (for Section 12 purposes only) for a period of 1 year from the date of removal from the register. Index slips are not removed and any marks so found which are held to constitute an objection remain as objections (unless some other method of overcoming them is found) until the period of 1 year has passed.

Any applications which have Section 12 objections raised against them and on which it is subsequently found that the mark forming the objection has expired, must wait the passing of the one year period from date of expiry (laid down in Section 20(4) before proceeding to advertisment).

Normally applications may be suspended pending the expiry of the Section 20(4) period but suspensions should not be allowed if the Section 20(4) period has not begun to run (see the RUNNER decision 1978 RPC 402 in which a suspension was refused).

[10-203 to 10-219]

PROOF OF FIRST USE

10-220 Where objection arises because of another pending mark [Section 12(3)] the applicant who applied first should proceed unless the later applicant claims use prior to the date of application by the first filer. If that happens the first filer is given the opportunity to say if he has used his mark prior to the date of first use of the second applicant. The applicant with first use will then be required to prove his claim and if proved will be allowed to proceed on a condition that notice of advertisment is sent to the other party. If disputes arise a joint hearing may be necessary to resolve matters. (See also paragraphs 10-56 to 10-68).

Chapter 12 provides full details on evidence cases and additionally paragraphs 10-192 to 10-198 of this chapter set down the requirements for cases proceeding under the provisions of Section 12(2) [Honest concurrent user].

[10-221 to end]

ANNEX A

TRADE MARKS ACT 1938

DIRECTIONS BY THE BOARD OF TRADE

TO THE COMPTROLLER GENERAL OF

PATENTS DESIGNS AND TRADE MARKS

WHEREAS The Comptroller General of Patents, Designs and Trade Marks is required by sub-section (2) of section 62 of the Patents and Designs Act, 1907 to act under the superintendence and direction of the Board of Trade:

And whereas under subsection (4) of section 1 of the Trade Marks Act, 1938 a register of Trade Marks (hereinafter referred to as "The Register") is kept under the control and management of the said Comptroller (hereinafter referred to as "The Registrar"):

Now, therefore, the Board of Trade hereby directs as follows:

When an application for the registration of a Trade Mark in respect of goods described in the Schedule hereto is made to the Registrar he shall cause a Search to be made in the Register:

(a) In the case of an application in respect of goods described in Part I of the said Schedule hereto, for any Mark registered or for which registration is pending in respect of goods described in Part II of the said Schedule identical with or so nearly resembling the Mark to which the application relates as to be likely to confuse the public as to the suitability of any goods for internal consumption;

(b) in the case of an application in respect of goods described in Part II of the said Schedule hereto, for any Mark registered or for which registration is pending in respect of goods described in Part I of the Schedule identical with or so nearly resembling the Mark to which the application relates as to be likely to confuse the public as to the suitability of any goods for internal consumption;

and if the Search discloses the registration of any such Mark, the Registrar shall bring the matter to the notice of the person making the application for registration of the Trade Mark.

DATED this third day of August, 1961

(signed) JOHN LECKIE

Secretary of the

BOARD of TRADE

SCHEDULE

PART I

Chemical products used in photography, agriculture and horticulture. Bleaching preparations and other substances for laundry use, cleaning and toilet preparations in liquid form, pharmaceutical, veterinary and sanitary substances, disinfectants, weed-killers and insect and vermin killers.

PART II

Meat extracts, milk and dairy products, honey and treacle, non-alcoholic drinks.

ANNEX B

COLLECTION OF REFUSED COTTON MARKS AT JUNE 1985

NUMBER	CLASS	REMINDER DATE	EXPIRY DATE	OWNERS
113482	23	AUG 1985	06 JAN 86	THOMAS WHITTLES LIMITED
141080	24	SEP 1985	20 FEB 86	PATONS & BALDWINS LTD
113728	23	NOV 1985	18 APL 86	HOVIS LIMITED
141298	24	DEC 1985	17 MAY 86	VIYELLA INTERNATIONAL LTD
122826	24	JAN 1986	14 JUN 86	M CHAPMAN & SONS TEXTILES LTD
122845	23	FEB 1986	30 JUL 86	COMPAGNIE FRANCAIS LTD
113994	23	MAR 1986	06 AUG 86	THOMAS WHITTLES LTD
141612	24	APL 1986	24 SEP 86	JOHN HAWKINS & SONS LTD
142157	24	JAN 1987	12 JUN 87	BAXTER BROS & COMPANY LTD
142423	24	MAY 1987	23 OCT 87	JEREMIAH ROTHERHAM & CO LTD
142600	24	AUG 1987	16 JAN 88	ROBERT SORENSON & CO LTD
123699	24	SEP 1987	18 FEB 88	JOHN BROWN & SONS LTD
142644	25	SEP 1987	05 FEB 88	SPENCE BRYSON & CO LTD
123855	23	NOV 1987	19 APL 88	WATSON & CO (LEEK) LTD
142882	24	DEC 1987	27 MAY 88	SPARROW HARDWICK & CO LTD
115810	23	JUL 1988	16 DEC 88	THOMAS WHITTLES LTD
143203	25	JUL 1988	17 DEC 88	R T SALTER (1961) LTD
143548	23	APL 1989	15 SEP 89	W S GODBER LTD
143549	23	APL 1989	15 SEP 89	W S GODBER LTD
143550	23	APL 1989	15 SEP 89	W S GODBER LTD
143551	23	APL 1989	15 SEP 89	W S GODBER LTD
125191	23	MAY 1989	30 SEP 89	A J WORTHINGTON & CO LTD
116738	24	JUL 1989	14 DEC 89	LIBERTY & CO LTD
125347	23	AUG 1989	08 DEC 89	WATSON & CO (LEEK) LTD
125785	23	NOV 1989	17 APL 90	WATSON & CO (LEEK) LTD
144054	24	FEB 1990	13 JUL 90	SIR JACOB BEHRENS & SONS
144331	24	AUG 1990	15 JAN 91	TOOTAL LTD
144401	24	OCT 1990	02 MAR 91	C & V HOME FURNISHINGS LTD
143957	24	DEC 1990	12 MAY 91	GREAT UNIVERSAL STORES LTD

NUMBER	CLASS	REMINDER DATE	EXPIRY DATE	OWNERS
143958	25	DEC 1990	12 MAY 91	GREAT UNIVERSAL STORES LTD
144626	24	FEB 1991	31 JUL 91	DORCAS LTD
144690	24	APL 1991	16 SEP 91	GOODALL SANFORD INC
128011	24	MAY 1991	06 OCT 91	C V HOME FURNISHINGS LTD
144945	23	OCT 1991	31 MAR 92	WILKINSON WARBURTON LTD
144946	24	OCT 1991	31 MAR 92	WILKINSON WARBURTON LTD
144947	25	OCT 1991	31 MAR 92	WILKINSON WARBURTON LTD
129787	24	JUL 1992	07 DEC 92	HASLAMS LTD
145269	24	AUG 1992	09 JAN 93	TOOTAL LTD
145347	24	SEP 1992	23 FEB 93	WM E REES & CO LTD
119108	23	NOV 1992	07 APL 93	ACKERMAN GOGGINGEN
119227	24	DEC 1992	22 MAY 93	PATERSON ZOCHONIS CO LTD
130928	24	APL 1993	17 OCT 93	PATERSON ZOCHONIS CO LTD
119405	24	JUL 1993	09 DEC 93	DEANS RAG BOOK CO LTD
146056	24	JAN 1994	20 JUL 94	COMPAGNIE FRANCAISE
146057	25	JAN 1994	20 JUL 94	COMPAGNIE FRANCAISE
146058	24	JAN 1994	20 JUL 94	COMPAGNIE FRANCAISE
134326	24	MAY 1995	18 NOV 95	VIYELLA INTERNATIONAL LTD
90301	23	NOV 1995	27 MAY 96	THE SINGER COMPANY LTD
78280	23	JAN 1997	13 JUL 96	THE SINGER COMPANY LTD
136056	24	JAN 1996	24 JUL 96	WILKINSON WARBURTON LTD
121292	24	NOV 1997	03 MAY 97	NAC INTERNATIONAL LTD
138794	23	OCT 1997	13 MAR 97	OXLEY THREADS LTD
139399	24	APL 1998	01 SEP 98	BENSON & HEDGES LTD
121292	24	NOV 1996	03 MAY 97	NAC INTERNATIONAL LTD
138794	23	OCT 1997	13 MAR 98	OXLEY THREADS LTD
139399	24	APL 1997	01 SEP 98	BROWNE & HOLLINGSWORTH LTD