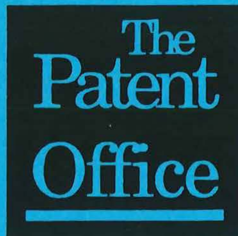


Trade Marks Registry

WORK MANUAL

CHAPTER 9

EXAMINATION OF A TRADE OR SERVICE MARK FOR REGISTRABILITY

Crown Copyright 1989

dti
the department for Enterprise

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.

Chapter 9 - Examination of a trade or service mark for registrability

TABLE OF CONTENTS

Part 1 - General

Introduction 9-1 to 9-4

Representation of mark 9-5

Form of trade mark 9-6

Manchester register 9-7

Sheffield register 9-8
Certification marks 9-9
Defensive marks 9-10
Series of marks 9-11 to 9-12
[spare block 9-13 to 9-21]
Definition of a trade or service mark 9-22 to 9-29
Packaging 9-30
Slogans 9-31
[spare block 9-32 to 9-40]

Precedents 9-41
Difference between Part A and Part B 9-42 to 9-45
Registration in Part A of the register 9-46
Registration in Part B of the register 9-47
Acceptability in Part B 9-48 to 9-49
Consideration of sections 5 and 8 in support of registrability 9-50
Marks comprising multiple features 9-51 to 9-52
Prima facie examination 9-53
[spare block 9-54 to 9-60]

Part 2 - Consideration of the mark under Sections 9 and 10

Introduction 9-61
Name of company, individual or firm [Section 9(1)(a)] 9-62
Signature [Section 9(1)(b)] 9-63 to 9-67
[spare block 9-68]
Invented words [Section 9(1)(c)] 9-69 to 9-71
Hybrid words 9-72
Marks held not to be invented words 9-73
[spare block 9-74 to 9-83]

Geographical names, surnames, laudatory and descriptive words, (Section 9(1)(d))

Introduction	9-84
Geographical names	9-85 to 9-103
Registrability of geographical names	9-86
Previous registrations	9-87
Submission of evidence in support of applications for geographical names	9-88
Names whose only significance is geographical	9-89
Geographical names used fancifully	9-90
Names of very small geographical locations	9-91
Names of other geographical locations	9-92
Names of rivers, seas, deserts, etc	9-93
Geographical names with well-known other meanings	9-94 to 9-96
Natural produce	9-97
Geographical names - similar and phonetically close	9-98
Names of streets, roads and districts	9-99
"Company towns"	9-100
County names in the USA	9-101
Differences between trade marks and service marks	9-102
General	9-103
[spare block	9-104 to 9-122]
Surnames and personal names	9-123 to 9-136
Surnames alone	9-124
Surnames - rare but well known	9-125
Surnames - with other well known meanings	9-126
Surnames - phonetic equivalents of	9-127(a)
Surnames - phonetic equivalents with well known other meanings	9-127(b)
Double surnames with other meanings	9-128
Double surnames with no other meaning	9-129
Full names (ie forename and surname together)	9-130
Invented names	9-131
Forename(s) and surname combined or coalesced	9-132
Surnames combined with the name of the goods	9-133
Surnames combined with a word descriptive of a characteristic of the goods	9-134
Surnames on evidence	9-135
Foreign surnames	9-136
[spare block	9-137 to 9-156]
Descriptive and laudatory words - reference to the character or	9-157 to 9-159

quality of the goods	
Name of new product	9-160 to 9-163
[spare block	9-164 to 9-173]
Mis-spellings of words	9-174 to 9-175
Phonetic equivalents of unregistrable marks	9-176 to 9-178
Foreign words	9-179
Observations on descriptiveness of word marks	9-180
MINI, MAXI and MASTER marks	9-181
UNI-, MONO- and POLY- marks	9-182
MULTI marks	9-183
[spare block	9-184 to 9-201]
Section 9(1)(e) - introduction	9-202
Distinctiveness - a pre-requisite for 9(1)(a) to (d) as well as 9(1)(e)	9-203
Examples of distinctive and non-distinctive marks	9-204
numerals	9-205
letter marks	9-206
combinations of letter and numeral marks	9-207
phonetics of letter marks	9-208
four letter marks	9-209
three letter marks	9-210
two letter marks	9-211
two groups of letters in upper case hyphenated	9-212
three letters - monograms	9-213
two letters - monograms	9-214
single letter marks	9-215 to 9-218
[spare block	9-219 to 9-230]
Device marks	9-231 to 9-257
Mere representations of the goods	9-231
Representations of flowers, shrubs and trees	9-232
Devices of human figures	9-233
Devices of women's heads	9-234
Feminine proper names	9-235
Devices of machines or of parts of such machines	9-236
Devices indicative of the origin or source of the goods	9-237
Pastoral scenes	9-238
Star devices	9-239
Plain geometrical figures	9-240
Devices of a spot	9-241
Fancy borders	9-242
Patterns or backgrounds	9-243
Patterns on the goods themselves	9-244
Devices of impressed seals	9-245
Devices of persons using the goods	9-246
Devices of containers for the	9-247 to 9-248

goods
Devices of bunches of grapes and vine leaves 9-249
Thistle devices 9-250
Devices of road signs 9-251
Device as part of the goods 9-252
Marks depicted in colour 9-253 to 9-257
[spare block 9-258 to 9-270]

Part 3 - Pharmaceutical names 9-271 to 9-272
[spare block 9-273 to 9-280]

Part 4 - Section 11
Section 11- deception - introduction 9-281 to 9-282
inherent deceptiveness 9-283 to 9-293
contrary to law or morality 9-294
scandalous design 9-295
surname alien to applicant 9-296
foreign words as the name of an estate 9-297
designations of cognac, armagnac and calvados 9-298
Section 11 invoked in opposition 9-299
overcoming Section 11 objections - qualification of specification 9-300
overcoming Section 11 objections - limitation of specification 9-301
insurmountable Section 11 objection 9-302
"safe" marks 9-303 to 9-304
overcoming Section 11 objections - imposition of a condition 9-305 to 9-309
[spare block 9-310 to 9-330]

Part 5 - Section 14 - disclaimers

General 9-331 to 9-339
Marks proceeding on evidence of use 9-340 to 9-342
Separate disclaimers 9-343
Effect of disclaimers on composite word/device marks 9-344
Marks acceptable in Part A with disclaimers 9-345
Marks acceptable in Part B with disclaimers 9-346
Marks unacceptable even with

disclaimers	9-347
Hyphenated words and disclaimers	9-348 to 9-350
[spare block	9-351 to 9-360]

Part 6 - Marks requiring particular consideration

Rule 15 - Marks subject to statutory restriction	9-361 to 9-369
General	9-361
Crosses, crescents and other emblems	9-362 to 9-364
Trade mark effect of Section 6 of Geneva Convention Act 1957	9-365
The Geneva Cross and similar emblems	9-366 to 9-367
The Royal Arms and similar emblems	9-368
The word 'Anzac'	9-369
Rule 16 - Marks requiring particular consideration	9-370 to 9-378
General	9-370
The Royal Crown	9-371 to 9-372
The word 'Royal'	9-373 to 9-374
National flags	9-375 to 9-378
Non-trade mark matter	9-379
Matter to be justified or removed	9-380
[spare block	9-381 to 9-390]

Part 7 - International Convention

Marks protected under Article 6 ter of the International Convention	9-391 to 9-397
introduction	9-391 to 9-393
list of flags	9-394
Journal notice of protected emblems	9-395
records of protected emblems	9-396
refusal of protected emblems as trade marks or parts thereof	9-397
Marks consisting of or containing the words MAPLE LEAF	9-398
[spare block	9-399 to 9-420]

Part 8 - Heraldry

Marks consisting of or containing coats of arms or heraldic crests	9-421 to 9-422
Observations by Garter King or Lyon King	9-423

Objections to coats of arms, crests etc 9-424
[spare block 9-425 to 9-440]

Part 9 - Miscellaneous

Portraits in a mark 9-441
Buildings in a mark 9-442
Marks in foreign characters or in a foreign language. 9-443

Translation and transliteration clauses 9-444 to 9-447

Phonetic spelling of letters 9-448
[spare block 9-449 to 9-479]

Marks comprising a number of separate panels 9-480

Blank panels or large areas of blank spaces 9-481 to 9-483

Castrol type condition 9-484

Line border requirements 9-485
[spare block 9-486 to 9-499]

Part 10 - Evidence of use

General 9-500 to 9-502
- special circumstances 9-503 to 9-506
- limitations of special circumstances procedure 9-507
- "creeping" equities 9-508
[spare block 9-509 to 9-529]

Part 11 - Amendments (submissions)

General 9-530
Amendments not filed simultaneously 9-531
Consideration of amended mark 9-532 to 9-535

Amendment after advertisement 9-536
Representations of amended marks 9-537
Amendment by overpasting 9-538
[spare block 9-539 to 9-559]

<u>Part 12 - Registrar's preliminary Opinion</u> 9-560 to 9-562

[spare block 9-563]

Repayment of fees following Registrar's preliminary advice 9-564 to 9-565
Retention of forms 9-566
[spare block 9-567 to end]

APPENDICES

Appendices A and B
Section 11 - limitation of goods as to materials

Appendices C and D
Section 11 - limitation of goods as to intended use

Appendices E and F
Section 11 - limitation as to geographical origin

Appendix G
Disclaimers of ordinary representation of the goods

Appendix H
Disclaimers of other non-distinctive devices

Appendix J
Disclaimers of prominent letters

Appendix K
Disclaimers of separated or out-of-the-ordinary letters

Appendices L and M
Disclaimers of place names

Appendix N
Standard Conditions and Clauses

EXAMINATION OF A TRADE OR SERVICE MARK FOR REGISTRABILITY

Part 1 - General

Introduction

9-1 A trade mark is the means by which a manufacturer, or merchant, identifies his goods, to the exclusion of all others, to the purchasing public. A service mark identifies the services of one particular provider of services. In other words, when the public ask for goods or services by means of a particular mark, they can be assured of getting goods or services of the same origin, whether they know the name of the manufacturer, or merchant, or service-provider, or not. The trade or service mark is thus an important means of identification - in fact, it is often the only means of identification of the goods or services from a particular source. The value of marks to those who own them, and in another sense to the buying public, is therefore obvious. Trade and service mark rights are something which people in business are prepared to go to great lengths to obtain and preserve.

9-2 Formal acceptance of an application is reserved for the Registrar, normally acting through his Acceptance Committee, but as an initial step examiners are required to prepare a report on whether the mark applied for appears to qualify for acceptance within the requirements of the Trade Marks Act 1938 (as amended) and the Trade Marks and Service Marks Rules 1986. The examination is directed firstly to considering whether the mark is one of the types of mark protected by the Act and then to considering the qualities of the mark itself, applying the criteria of distinctiveness under Section 9 (for Part A) and Section 10 (for Part B, if the mark does not qualify for Part A) and of prohibited matter under Sections 11 and 15(3) of the Act. Account has to be taken of the words, devices and other representations specifically referred to in Rules 15-18 inclusive which require special consideration and in some cases are not allowed to comprise or form part of marks accepted for registration.

9-3 The practice of the Registry in examining trade marks for registrability has developed over the years from the interpretation put on the statutory provisions in cases decided by the Registrar and the Courts. The fundamental principles are well established from the leading cases and will be indicated in the paragraphs which follow. A fuller treatment of certain aspects which are peculiar to service marks can be found in Chapter 11 of this Work Manual. It is important that examiners understand these basic principles and apply them in testing every mark under examination, each of which has to be carefully considered on

its own merits, having regard to the specification of goods or services claimed.

9-4 The onus always rests with an agent or applicant to convince examiners that a mark is suitable for acceptance and may thus obtain the statutory monopoly which is sought. Whilst it is not the Registrar's job to suggest ways of overcoming objections, Registry staff should try to be helpful and constructive wherever possible, and where there is a relatively straightforward course of action which could enable a mark to be accepted examiners are encouraged to make this known to the applicant/agent. The lack of such suggestions should not, of course, be taken to mean that the application is without hope!

Representation of the mark

9-5 All details of the mark must be clear and legible before examination of the mark is undertaken. If a feature, letter or word is so small or indistinct as to cause doubt about what is being examined, the applicant must be asked to furnish a larger and clearer representation before the examination can proceed. All representations in an application must agree exactly with each other and should be of a durable nature. Photographic representations which are liable to fade, and those in pencil, which are liable to become effaced, are not acceptable. Where the representations are too large for the space reserved for the mark on the application forms they may be folded but must first be mounted upon linen or other suitable material and affixed in the space (Rules 24, 25, 27 and 28). A three dimensional representation of the mark is not prohibited, see Sobrefina's Application 1974 RPC 674.

Form of Mark

9-6 A trade mark may take the form of a device (ie a symbol), brand, heading, label, ticket, name, signature, word, letter, numeral, and even colour applied to the goods, or any combination of these forms. This list is not exhaustive. Nonetheless it has been generally accepted over the last 100 years that "get-up" eg packaging, does not constitute a trade mark.

Manchester register

9-7 Applications filed at the Manchester Branch of the Trade Marks Registry are passed to the main Registry for examination where they are dealt with in every way as though they were applications filed at the main Registry.

Sheffield register

9-8 Applications received from the Cutlers' Company in Sheffield are dealt with in the examination units in every way as though they were applications filed at the Registry. Section 38 and the Second Schedule of the Act and Rules 95 to 100 govern the procedure for dealing with applications and other matters for Sheffield marks.

Certification marks

9-9 In order to qualify for registration as a certification trade mark, a mark must be "adapted to distinguish" (see Section 37 of the Act). In deciding whether a certification trade mark is "adapted to distinguish" the Registrar judges the mark along the lines laid down under Section 9, although in practice the benefit of any doubt in borderline cases of distinctiveness is given to the applicant. Chapter 23 of this work manual provides full details of practice in relation to certification marks.

Defensive marks

9-10 In order to qualify for registration as a defensive mark, a trade mark must consist of an invented word or invented words (see Section 27 of the Act). Although Section 27 does not say so in terms, the test of "invention" applied in such a case is that laid down in Section 9(1)(c) - see paragraph 9-69. Chapter 22 of this work manual provides full details of practice in relation to defensive marks.

Series of marks

9-11 Where an applicant claims registration of a "series" of marks on one application under Section 21(2) of the Act, the claim that the marks constitute a series is valid only if the trade mark feature (or features) is essentially the same. The differences between the marks which can be allowed are those stated in sub-section 2 of Section 21. For example, an applicant may validly claim registration as a "series" of a number of canned fruit and vegetable labels if the trade mark feature is the same in each label, the only variations as between labels being that they each carry, say, the name and an ordinary representation of a different kind of fruit or vegetable. The latter would be, in the words of the sub-section, "other matter of a non-distinctive character which does not substantially affect the identity of the trade mark".

9-12 It is always difficult to maintain consistency in deciding what differences in marks claimed to be a series - whether words or devices - are acceptable and what are not.

The best guide is the Act itself. The essential elements of Section 21(2) are that the marks must "[resemble] each other in the material particulars thereof" and may differ only in respect of

(a) statement of the goods/services, or

(b) statements of number, price, quality, or names of places, or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the mark, or

(d) colour.

In other words, whatever differences there may be, the marks must still <u>resemble each other in their main features</u>, and the features which differ must be ones which <u>do not substantially affect the identity of the mark</u>.

It is easier to agree that there is a "resemblance in material particulars" in the case of purely device marks than in the case of word marks, where one letter may make a very substantial difference.

[9-13 to 9-21]

Definition of a trade or service mark

9-22 When first considering an application, examiners should determine whether the mark applied for is intended to be used as a "trade mark" as defined in Section 68 of the Act, or, in the case of a "service mark", as defined in Section 1(7) of the Trade Marks (Amendment) Act 1984 (as amended). Unless there is anything in the wording of the mark or in the particulars inserted by the applicant in the application form which might clearly indicate the contrary, it may be assumed that use of the mark as a trade or service mark is contemplated by the applicant.

9-23 The name of an applicant company may cast doubt on whether or not the mark is to be used as a trade mark [eg John Smith (Insurance Agents) plc]. In these circumstances the Registrar is placed on enquiry and the applicant should be asked to explain how he intends to trade in goods under the mark applied for and to confirm that he intends to use the mark within the terms of Section 68 of the Trade Marks Act 1938. A statement merely that he intends to use the mark in the course of trade or business is not sufficient. Similarly, with an application for a service mark, examiners need to be satisfied that the applicant is offering a genuine service, for money or money's worth, and not, for example, merely trading in goods, or offering a 'free' service which is peripheral to his main business activity (eg a retailer offering free advice on purchases).

9-24 In cases where the applicant is domiciled abroad and desires registration in this country only as a pre-requisite to registration in a territory which follows United Kingdom law and practice in these matters, he is allowed to express his specification in the terms "(Goods) for sale in (name of territory)". He is required however, to give an assurance that he seeks registration here merely as a pre-requisite to registration in the territory concerned, and is warned that the registration here might be held to be invalid if attacked under Section 26 of the Act.

9-25 The provision of a service often includes the supply of goods eg a hotel supplies food and a bank supplies cheque books but this does not of itself qualify the mark as a trade mark. Appeals against the Registrar's refusal of applications for the registration of marks by Visa International (application numbers 1094333 and 1171514) in respect of credit cards and travellers' cheques were recently allowed by the Court. The decision was made on the facts of the particular cases - where there was evidence that Visa exercised very close control over the manufacture of the cards and cheques and charged their customers (eg banks) for them albeit as part of wider financial services such as clearing house functions. Visa International had no

dealings with the ultimate users of the cards and cheques.

9-26 The Court held that the relevant question was "does the applicant trade in the goods?": if he does then the fact that he trades in the goods as part of a service, is no bar to registration. There is nothing new in this test and there is no change to registry practice.

9-27 In applying the test in the Visa case, however, the Judge said "without the goods, (ie the cheques and cards), ... the service is useless. Without the service, the goods are pointless. Cheques are not adjuncts, they are essential articles". Strictly this has no relevance for any other case; the decision was made solely on the facts of the Visa applications. No doubt, though, practitioners will attempt to apply the "essential article" reasoning in other circumstances. Possibly the only goods for which this would be reasonable is food served by restaurants and hotels. The Registrar already allows registration in respect of "take-away" food but not for the same food served over the same counter if eaten in the restaurant. The distinction is a fine one. The Registrar will not in future object to applications by restaurants or hotels for food although an application in Class 42 for 'restaurant services' would be more appropriate nowadays. It will however be necessary to continue to object to applications (by restaurants or hotels) for eg plates, cutlery, towels etc because these are marks of ownership rather than origin.

9-28 Service marks are often applied for under the guise of trade marks in Class 16. For example, use of a mark on a hotel brochure is not trade mark use in relation to "printed matter". An airline operator sells tickets but does not trade in them within the meaning of the Act. Possibly only a printer or paper converter trades in tickets. In such cases the Registrar is put on enquiry and the applicant should be asked to provide a satisfactory assurance that there is a bona fide trade in goods for the purposes of the Act (supplying evidence where appropriate). Similarly, if a firm describing itself as "Laundrymen", for example, intends to use the mark applied for in relation to goods which have been merely laundered or cleaned, this would not be use of the mark as a trade mark within the definition contained in Section 68, since the mark would not be used to indicate the origin of the goods. This specific point was dealt with in the case of Aristoc Ltd. v. Rysta, Ltd. (62 RPC 65). Again, today it may be that such applicants would be entitled to register their marks as service marks rather than trade marks.

9-29 Apart from any query which the applicant's name may raise, the mark itself may necessitate an enquiry as to the applicant's intentions. If the mark includes the word

"Process", for example, it might indicate prima facie that it is intended to be used in relation to a process rather than to particular goods. This would not constitute trade mark use, for a trade mark can be registered only in respect of goods. But if the applicant is able to state in such a case that the mark is intended to be used in relation to goods produced by a process this explanation could be accepted as satisfactory.

Packaging

9-30 While it is generally accepted that packaging may not be registered as a trade mark there is little authority (ie Court decisions) on the point. Sobrefina's application, (1974 RPC 674) for a container (in respect of a beverage) was refused by the High Court. The Registrar refused an application to register the Coca Cola bottle (for cola) as a mark (although a line drawing of a Coca Cola bottle has been allowed for registration) and this decision was confirmed on appeal to the High Court, the Court of Appeal and the House of Lords.

Slogans

9-31 Slogans are usually expressed in laudatory or exhortatory terms, eg "Guinness is Good for You", "Players please", "Have a break" (Have a Kit Kat), "Buy British" and as such are not normally regarded prima facie as constituting registrable trade mark matter, ie as constituting trade marks within the definition of "trade mark" in Section 68. In the first three examples Guinness, Players and Kit Kat would be taken, prima facie, to be the trade mark but not the whole slogan. [See the decision of Mr Justice Whitford in "Have a break" - Opposition No 16241]. Slogans also frequently fall foul of the provisions of Section 9(1)(d) as words having "direct reference to the character or quality of the goods" and 9(1)(e).
Before the Registrar can agree to acceptance of such marks he would normally require evidence to show that the slogan is being used as a trade mark and is recognised by the public as a distinctive trade mark.

[9-32 to 9-40]

Sections 9 and 10 - General

Precedents

9-41 Careful account should be taken of any precedents which may have been found either in the precedent index or during the search for Section 12 purposes. Precedents are used as an indication of past practice to ensure as far as possible consistency of treatment of similar marks for similar goods. (Note: the precedent index was maintained for some years until records of lapsed and rejected marks began to be kept on the Registry's electronic database. It is no longer updated but it remains a useful source of reference.) However, the fact that a particular word was regarded as acceptable or objectionable, say, twenty years ago is not necessarily a reason for accepting or objecting to it now. The usage and meanings of words can change with the passing of time and industry is developing in many new fields. Geographical names can take on a new signification. For example, "North Sea" might have been properly registered for "oils" in 1880 but it certainly would not have been in 1980. Intervening decisions of the Court, or changes in the law, can obviously also affect the attitude of the Registry in regard to particular marks. Possible changes such as these should therefore be taken into account in assessing a precedent bearing on the mark under examination. Departure from precedent should be decided upon only after consideration of all relevant circumstances including the goods to be covered by the application. Particular care should be exercised where the mark previously applied for was considered at a hearing. If a statement of grounds of refusal has been issued previously on an identical mark for the same specification, the new application should not be accepted prima facie for registration. Examiners should pay particular attention, during the search, to marks having similar features to the mark under examination. This will indicate the practice regarding certain characteristics of marks eg prefixes, suffixes, devices etc. The observations made during the search will be a good indication as to whether or not a check of the precedent index is necessary. Experience alone can help the examiner to determine this point. At the end of the day, each mark must be judged on its own merits in relation to the goods applied for, with precedents being only one of the factors considered in making a final decision.

Difference between Part A and Part B of the Register

9-42 There are quite different criteria for acceptance prima facie of marks in Part A and Part B and these are set out in Sections 9 and 10 of the Act. See also the WELDMESH case (1965 RPC 590).

9-43 The definition for Part A - adapted to distinguish - means that the mark has some intrinsic quality which makes it unique (distinctive) in relation to the goods. The Part B criterion - capable of distinguishing - implies a mark lacking, in some degree, this intrinsic quality and, for practical purposes, is a less stringent test.

9-44 The difference between the effect of registration in Part A and Part B of the register is defined in Section 5(2). A further distinction between marks registered in Part A and in Part B is made in Section 13, by which registrations in Part B never become conclusive as to validity.

9-45 In legal terms, a mark registered in Part A is, after a period of seven years, deemed to be valid in all respects, whereas a Part B registration, while still affording a proprietor exlusive use to the rights of a mark, does not have the same protection since it never becomes absolute in that it may be expunged from the register by the Courts as the result of legal proceedings. [See Section 13 of the Trade Marks Act, 1938].

<u>Registration in Part A of the Register</u>

9-46 Section 9 of the Act defines what may be registered in Part A of the register (except as a defensive mark or as a certification trade mark). In other words, it defines the various characteristics which ordinarily render a mark registrable. An overriding principle for trade mark registration in Part A is that the mark must be distinctive in accordance with Section 9(1), 9(2) and 9(3). Otherwise, it fails in its purpose, which is to distinguish the goods of the person owning it from the similar goods of other persons. The Courts have emphasised this principle in a number of reported cases and it is a factor to be borne in mind at all times. It can be inferred from the words "any <u>other</u> <u>distinctive</u> mark" in section 9(1)(e) that the types of marks described in 9(1)(a) to (d) must also be "distinctive". Therefore, if there is good ground for holding that a mark, even although apparently fulfilling any one or more of the requirements of paragraphs (a), (b), (c) and (d) of Section 9(1), is nevertheless not "distinctive", then that mark is not registrable in Part A. Thus a signature qualifies for registration under Section 9(1)(b) but only if it is distinctive; if it is written in perfect copperplate script then it would be, prima facie, non-distinctive and would fail. (See, for example, the Fanfold case - 45 RPC, page 325; the Barry Artist case 1978 RPC 703; the Livron case - 54 RPC page 161; and the Scotchlite case - 65 RPC page 229, at page 179 lines 21 to 26 and page 232, lines 13 to 27 and 41 to 43). Additionally it is important to note that Section 9(1) begins "In order

for a trade mark ... to be registrable"; thus even though a mark meets the requirements of Section 9 it may, still be refused, under Section 17(2), in the Registrar's discretion. This discretion must be exercised judicially.

Registration in Part B of the Register

9-47 Section 10 of the Act sets down the qualifications required of a trade mark in order to be registrable in Part B of the register. It will be noted that, whereas Section 9(1) specifies the characteristics required in a mark in order that it may qualify for registration in Part A of the register, Section 10 requires only that a mark shall be "capable of distinguishing" the goods of the applicant. The tribunal (ie the Registrar or, on appeal, the Secretary of State or the Court) is thus given a wide discretion to decide what may be regarded as "capable of distinguishing" in this sense. It is clear from its very existence that Section 10 is intended to provide a less stringent test of registrability than is provided by Section 9. Assistance on the interpretation of "capable of distinguishing" is given in the Torq-Set case, 1959 RPC 344; the Weldmesh case, 1966 RPC 220 at page 227, lines 36 to 49; the Pussikin case 72 RPC 36 and in the Smitsvonk Case 72 RPC 117.

Acceptability in Part B

9-48 In practice, in deciding whether a mark is inherently acceptable for registration in Part B (ie is capable of distinguishing the applicant's goods from the goods of other traders), the Registrar bears in mind the principle that all traders should be at liberty to describe their goods in the ordinary words of the language, or to attach their names to their goods, or to use upon their goods words indicative of the place from which the goods originated, without fear of trespassing upon the rights of the proprietors of registered trade marks. Thus, in determining whether a trade mark is "capable of distinguishing", the Registrar takes into account the extent to which registration of the mark under examination would be likely to interfere with or restrict the legitimate rights of other traders. He also takes account of the extent to which the mark under examination is likely to be confused with ordinary descriptions which can legitimately be used by other traders, for, if such confusion is likely, it is obvious that the mark cannot be inherently capable of distinguishing the applicant's goods. The less likely the possibility of such interference or confusion, the greater the extent to which the mark will be "capable of distinguishing" the applicant's goods.

9-49 In word marks, the main question posed is whether other traders might legitimately wish to use the word(s) or

phrase or ones similar to them. If the answer is in the affirmative, then the mark would not be acceptable even in Part B. (See the VERVE case, 1958 RPC 3).

9-50 Consideration of Sections 5 and 8 in support of registrability

Occasionally agents and counsel urge that the Registrar take into account the safeguards for other traders enshrined in Sections 5 and 8 when considering acceptability in Part B of borderline (and worse) marks. Reference is made to the Sheen and Perfection cases. The Courts in these two cases certainly appear to be drawing comfort from Section 8 but in fact they are arguing that because Section 8 (or its equivalent prior to 1938) exists it proves that descriptive words may be registered if the circumstances justify it and consequently that if descriptive words were barred absolutely then there would be no need for Section 8.

There is no doubt whatever that the savings provisos of Section 5 and Section 8 may not be argued in support of registrability. The House of Lords has given definitive judgements in Glastonburys, Yorkshire and York against Section 8 and the appeal decision in the LOOKING GOOD case (application No 1160124) applies the same principle to Section 5.

The tests for registrability under Sections 9 and 10 remain as those set out in those sections of the Act alone, in the light of the classic judgements of Solio, Charm, Smitsvonk, Torq-Set, etc etc.

Mark Comprising Multiple Features

9-51 When examining a mark which consists of a number of features, one must look at the mark and form a judgement as to whether any one feature, owing either to its relative size or position, is so outstanding that the mark may be said to consist substantially of that feature, with other relatively subordinate features added to it. This applies particularly to marks which include words of a trade mark character in combination with a device or devices of some kind, because words "talk" in trade marks, especially if the device element is an abstract design. The inherent acceptability of this type of mark depends upon the relative impact of the word(s) against the device. For a fuller treatment of this subject, see paragraphs 9-344 to 9-347.

9-52 Some combinations of non-distinctive elements can be distinctive if a new idea is thereby formed, (see paragraph 9-241 and also the Diamond T Case, (38 RPC 373), mentioned at paragraph 9-343).

Prima Facie Examination

9-53 All marks propounded for registration in Part A of the register are examined under Sections 9(1) and 10, in the first instance, without reference to whether the applicant has claimed, or may claim, that the mark has become distinctive by reason of use or other circumstances (Section 9(3)). At this stage marks are examined purely on a prima facie basis. If evidence of use is filed with the application, which is rare, it should be considered after the initial examination has been carried out. Applications for Part B registration are, of course, examined under Section 10 criteria only.

[9-54 to 9-60]

PART 2 - CONSIDERATION OF THE MARK UNDER SECTIONS 9 AND 10

9-61 The following paragraphs set out the considerations which have to be taken into account when examining marks for acceptability under Sections 9 and/or 10 of the Act.

Name of Company, Individual or Firm (Section 9(1)(a))

9-62 Any name of a company, individual or firm is registrable as a mark in Part A if it is represented in a special or particular manner - under Section 9(1)(a). The distinctiveness of such a mark will reside in the special or particular manner. It is not sufficient, therefore, that the name is represented only slightly out of the ordinary, or is shown, say, in ordinary type on a somewhat fancy background (see Fanfold case, 45 RPC pages 199 and 325). The name must be presented in such a way that it, or something similar, could not be arrived at honestly by anybody else (see the ROBIN HOOD case, 69 RPC 125, in which the words "Robin Hood" had to be disclaimed). A name of a company or firm which is not represented in a special or particular manner may, nevertheless, be registrable in Part A under Section 9(1)(d) if the essential element(s) of the name possesses the distinctiveness required for Part A. For example, the word TIFFANY is registrable in Part A being a very rare surname; TIFFANY & CO or TIFFANY & CO LTD are likewise registrable in Part A under Section 9(1)(d) being "words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname" - and, of course, is distinctive because the word TIFFANY is distinctive. On the same basis, the name of a company or firm, the essential element(s) of which is registrable in Part B, is also registrable in Part B.

Where the company name consists of multiple surnames, the principles in 9-129 et seq should be applied in the first instance. If the surnames alone would be registrable (with or without disclaimers as appropriate) the addition of "Ltd" or "& Co" will not prevent it being accepted under Section 9(1)(d). Where a company name consisting of surnames, geographical names or descriptive words is present in a mark but is clearly there only as an identifying feature rather than as part of the trade mark, it need not be disclaimed provided it is not prominent. Where it is prominent, any non-distinctive name-elements should be disclaimed.

See also paragraph 9-130 regarding the possibility of accepting individuals' names under Section 9(1)(d) of the Act.

Signature (Section 9(1)(b))

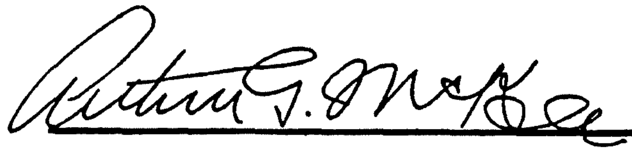
9-63 A signature for the purposes of Section 9(1)(b) should be the usual signature which the person or firm concerned uses (or used) in the business in question, for example, on letters. In doubtful cases it may be necessary to ask for evidence to support the claim of ownership. In order to qualify under this heading a signature must be that of the applicant or some predecessor in business. If the signature is that of someone else the consent of the person concerned to use of his/her name is required and, depending on the circumstances of the case, it can only qualify for Part A if it is in a form which enables it to be considered under 9(1)(a), (See also paragraph 9-62) or if it satisfies section 9(1)(d) (See also paragraph 9-130).

9-64 A signature should, in the absence of very special circumstances, include a surname. If it agrees with the name given in the application form, either because the Christian name or names and the surname are written in full or the Christian names are represented by initials preceding the surname and is in the same form, it can, in general, be accepted. But a signature must be distinctive and a name shown in copperplate form is not acceptable as the latter would fall within the prohibition of Section 9(1)(e) as being non-distinctive. [See Barry Artist 1978 RPC 703]

9-65 If a surname is submitted standing alone, or if the alleged signature includes a title such as "Dr" or "Mr", "Mrs" etc, evidence should be required that what is submitted is in fact the ordinary signature of the applicant as used in his business, and such evidence can in general, take the form of a statutory declaration supported, if possible, in doubtful cases by exhibits showing that the alleged signature has in fact been used in the ordinary course of business.

9-66 The signature of a personal name or of personal names may be used by a firm or company as a trading style under which the applicant or applicants have a bona fide right to trade. A signature is defined in the shorter Oxford English Dictionary as "the name of a person written with his or her own hand ...". Thus handwritten names of partnerships and trading styles such as "The Excellent Tea Company", or "The London Stout Company" are excluded (see the notice in Trade Marks Journal No 927 of 1st January, 1896). Likewise the name of a limited company or other corporation is not distinctive if written in normal script (see 32 RPC pages 454 and 455) (but see paragraphs 9-62 and 9-130 regarding the possible acceptance of such marks under section 9(1)(d).

9-67 Where a mark consists of a signature <u>and</u> the name in block capitals, then a disclaimer of the name is required. The following (in respect of application number 1030631) is an example (advertised in Journal 5938 on page 306) of the form of words that the disclaimer should take in such cases.



ARTHUR G McKEE

Registration of this Trade Mark shall give no right to the exclusive use of the words and letter "Arthur G. McKee" *except in the form of the signature appearing in the Mark.*

[9-68]

Invented word (Section 9(1)(c))

9-69 In considering whether a mark consists of an "invented" word within the meaning of Section 9(1)(c), it is necessary to consider only the word itself, without reference to the goods concerned in the case under examination. The fact that a word mark suggests a meaning in relation to the goods does not militate against its being held to be an "invented" word (see the Solio case - 15 RPC page 485, lines 51-53). It should not, however, convey an obvious meaning to the ordinary person in this country.

9-70 The purpose of "invention" in the sense intended in this context is to arrive at a word which as Lord Shand said in the Solio case 15 RPC page 487, "is clearly and substantially different from any word in ordinary or common use". The Solio case remains the keystone of trade mark case law with regard to "invention", and its main dicta, apart from the one quoted above, may be summarised in the following examples of what do not constitute "invented" words:-

(a) Combinations of ordinary words (eg "Cheapandgood"), even though such combinations may not have been in use before (page 485):

(b) Mis-spellings of known words (page 483);

(c) Foreign equivalents of English words (page 485);

(d) Words which consist of ordinary words with some trifling addition or trifling variation (page 487);

(e) Ordinary words with a diminutive or short and meaningless syllable added to them (page 487).

9-71 While on the one hand the fact that a word may be found in the vocabulary of a foreign language does not, in itself, preclude it from being an invented word, so on the other hand a foreign word is not an invented word merely because it is not current in the English tongue. This was quoted with approval by Lord Radcliffe in the Vaporub case 68 RPC 108. The principle was also endorsed by Lord Tomlin in the Consolette case (48 RPC page 313), lines 24 to 40. A word in a remote foreign language (eg Tibetan) might qualify as an invented word but a word in languages commonly encountered in this country eg Western European, Indian, etc would not. Neither is an English word invented simply because it does not appear in an English dictionary (see the HEAVENLY case 1967 RPC 306, and the Auto-analyser case 1970 RPC 201). The Consolette case furnishes an

example of a word consisting of a known term combined with the diminutive suffix "ette", and which was held not to be invented. The word "Oomphies" (ie a combination of the known word "oomph" with the diminutive suffix "ies") was held by the Court not to be an "invented" word (64 RPC page 31, lines 10 to 20), although held to qualify for registration on other grounds.

Hybrid words

9-72 In the Parlograph case (31 RPC page 265, lines 27 to 36), there is authority for treating a hybrid word (ie one composed of roots from different languages) as an invented word. There are, however, certain reservations in the judgement as to foreign words well known in this country. The French word "bon" meaning 'good' may be quoted as an example of a foreign word well known here, and it has been the practice of the Registrar not to accept, as invented words, words such as BONTOY for toys, BONCHOCS for chocolates, and so on.

Marks held not to be invented words

9-73 The following are references to other decided cases bearing on the question of "invention" in relation to different types of marks held not to be invented:-

Absorbine (= Absorbing) 21 RPC pages 97 and 755;

Arsenoid (made up of a "perfectly common chemical word with a common suffix added to it") 33 RPC 285;

Eanco (= E and Co) 37 RPC 134;

Orlwoola (= All-wool-a or All-woolly) 26 RPC pages 683 and 850;

Panoram (= Panoramic) 20 RPC 349;

Uneeda (= You need a) 18 RPC 170 and 19 RPC 281;

Scotchlite (= Scotch light) 65 RPC 230;

Pussikin (= pussy kin) 72 RPC 36;

Electrix (= electrics) 1959 RPC 283 (House of Lords Judgement).

Yourt (= yogurt) Opposition No 16511 (application No 1111816)

Some examples of invented words are:

SOLIO

KODAK

WHISQUEUR (whiskey liqueur)

PERSPEX

FORMICA

TWIX

VASELINE

ASPRO

AMSTRAD

ASDA

CANDA

JONELLE

[9-74 to 9-83]

Geographical names, surnames, laudatory and descriptive words

(Section 9(1)(d)) - Introduction

9-84 Section 9(1)(d) allows for registration of marks consisting of:

> "a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname."

The underlying purpose of disallowing registration of geographical names, surnames, or descriptive words, at any rate as new (ie unused) trade marks, is to prevent anyone from obtaining a monopoly in words which others may legitimately desire to use in the course of trade (see the W & G case - 30 RPC page 671, line 48, to page 672, line 9). All traders should be free to state on their goods the place of manufacture or origin of those goods and be free to use their own names in relation to their goods. Furthermore, the use of ordinary words of the language should be open to traders in describing or extolling the merits of their goods. Registration (and resulting monopoly) of such words would place difficulties in the way of other traders in the exercise of their legitimate rights, and Section 9(1)(d) is intended to prevent this.

9-85 Geographical names

The registration of major geographical place names as trade marks for goods (see Chapter 11 in relation to service marks) is barred absolutely - reference the Liverpool, Yorkshire and York decisions - and even in the case of less well known names the Courts and the Registry have been reluctant to encroach upon the freedom of traders (present and future) to use place names for their original purpose ie to indicate geographical origin. That said, however, registration of geographical names of lesser significance is not forbidden by the Act, particularly if evidence of factual distinctiveness is filed in support of the application. However, when considering evidence of factual distinctiveness, one must also consider whether the mark has any inherent distinctiveness and whether or not the location concerned has any reputation for the goods; whether such goods are likely to be produced there, either now or in the future, and whether such goods are likely to be traded in, in the United Kingdom. Obviously the possibility of registration increases if the geographical names are in respect of places outside the United Kingdom, and the more remote and unheard of the location the more likely is registration to be allowed.

9-86 Registrability of geographical names

Traders commonly use place names in their titles or trading styles, or as marks. They do so, frequently, to take advantage of any reputation a country or region or town may enjoy for the manufacture of particular goods, or to trade upon the loyalty of the public in buying goods of their own national or local manufacture. By usage, traders can achieve recognition of place names as being 100% factually distinctive of their goods alone but this is not, of itself, conclusive as to the registrability of the place name as all trade marks must have at least a spark of inherent distinctiveness.

The leading decisions in respect of geographical names as trade marks for goods are:

Magnolia 14 RPC 621
Liverpool Cables 46 RPC 99
Glastonburys 55 RPC 253
Yorkshire 71 RPC 150
Tijuana Smalls 1973 RPC 453
York 1984 RPC 231

There have, as yet, been no decisions of the Courts in respect of geographical names as service marks, but the practice in this area is outlined in Chapter 11, (paras 11-36 to 11-37)

9-87 Previous registrations

Some place names, eg AVON, BEDFORD, etc. have been registered in the past, but in the light of subsequently decided cases are considered to be quite unregistrable now. In future no objections need be taken to applications by the owners of such marks for new marks which consist of the "equity" plus an additional element (which may be disclaimable and/or subject to a Section 11 limitation) provided the "equity" is presented identically or almost identically to the original registration and provided there is no extension whatever of the goods covered by the existing registration(s). If a place name is now considered unregistrable, no extension of the earlier registered rights should be allowed by reason of "special circumstances".

9-88 Submission of Evidence in Support of Applications for Geographical names

It should be borne in mind that it is always open to applicants to submit evidence of factual distinctiveness and, equally important, to provide more detailed information about a location and its connection, if any, with the goods for which registration is sought, so as to show that the

mark is inherently distinctive in relation to those goods. Clearly, the size of the location is important but other information may be relevant such as (a) the export of goods to the United Kingdom from the area concerned; (b) whether the name is registered in the country of origin or (c) whether the industry concerned came first and the geographical name was derived from the industry. Another relevant factor could be the width of the specification because, clearly the more restricted the specifiction, the less is the likelihood that other traders would require the name as an indication of origin for their goods.

By way of example where the Registry dealt with a recent application in respect of cheese, the applicants provided evidence from the Milk Marketing Board that commercial cheese manufacture was unlikely in the village concerned since there was no surplus milk in the surrounding area for that purpose and it was unlikely that there would be surplus milk in the foreseeable future. (The MMB will not normally permit milk to be used for the production of cheese unless there is a surplus of milk in that area.) Additionally, evidence from the local authority showed that small "farmhouse" production was unlikely. In another application for coats, an exhaustive planning development survey by the local authority showed no past or existing industry in a moorland village and little possibility of future industry because of its remoteness.

Much of the above relates to evidence of inherent distinctiveness but the availability of evidence of factual distinctiveness is also a factor which can be taken into account in deciding whether or not acceptance is possible provided the mark possesses a modicum of inherent distinctiveness. Factual distinctiveness on its own is not conclusive as regards registrability of geographical names of major cities or towns.

The onus is upon the applicant in each case to satisfy the Registrar as to the acceptability of his mark. Absolute certainty will be unattainable in the vast majority of cases, but if the available evidence leaves the examiner with substantial doubts the application must be rejected.

9-89 <u>Names whose only signification is geographical</u>

Geographical names which cannot fail to have a geographical meaning for a substantial number of people in this country, for the goods claimed, are not acceptable at all in Part A or in Part B prima facie, and may indeed prove to be "a priori" unregistrable even if supported by extensive evidence of use. For example, evidence showed that YORK was 100 per cent factually distinctive in relation to trailers but it was held to be inherently non-distinctive and not to

be a registrable mark. Similarly the geographical name WITNEY was held to be unregistrable for furniture but it was conceded that it might prove acceptable for ocean going liners as others would be unlikely to require it in relation to such goods.

9-90 Geographical names used fancifully

There are geographical names which cannot, on any reasonable basis, have a geographical meaning for the goods claimed, eg NORTH POLE for bananas. Additionally, there are words with geographical meanings so obscure (eg a minute hamlet in, say, outer Mongolia) that those meanings may be disregarded. The registration of such words would hardly be likely to place any practical difficulty in the way of other traders stating the origin of their goods, since the goods concerned would not be likely to emanate from such places or districts. Although literally geographical, use of this category of words is taken to be use in a fanciful way and they may be accepted in Part A.

9-91 Names of very small geographical locations

Under the de minimis principle, geographical names of places with populations lower than 2,000 in the United Kingdom and 50,000 overseas where the goods are not natural produce and the place has no reputation in the goods may be accepted for registration in Part B. In such cases it is thought that the likelihood of traders wishing to use such place names in relation to their goods is so remote that it can be ignored.

9-92 Names of other geographical locations

Apart from de minimis cases, geographical names of places in the UK or overseas, provided they are not considered now or in the future to be likely sites for manufacture of the goods claimed for sale in the United Kingdom, may be accepted in Part B, provided they are supported by strong evidence of factual distinctiveness. Information about the location in question will also normally be required before a decision can be reached as to the mark's registrability (see paragraph 9-86). Resort should be had to gazetteers for information about geographical names and the products of the places named. Examiners must take a view of the likelihood of future association between the place named and the goods specified. The test should be: "Is it a reasonable possibility that the goods could be made at the place in question and sold in the UK, now or in the future?". Obviously, much greater caution is required in respect of locations in the UK than in, say, South America, and in respect of easily made, easily transportable goods than, say, heavy and/or bulky goods. If the gazetteers indicate existing manufacture of a variety of different products in

the place concerned, then care will need to be exercised in considering acceptance.

Some foreign geographical names have become known in this country by reason of their being used as trade marks (HITACHI being an example). Had it not been for the extensive reputation of the names as trade marks, the places concerned would still be virtually unknown. In such cases, examiners should not be unduly influenced by the fact that the name is well-known as a trademark, but should weigh up the merits of the mark using the normal criteria for geographical names and ignoring, as far as possible, the fact that they happen to know the name because of its use as a trade mark.

9-93 Names of Rivers, Seas, Deserts etc.

Names of rivers, seas, lakes, mountains, etc are usually accepted prima facie in Part B for goods which are not directly relevant. Thus, names of rivers, seas and lakes, would not be acceptable as marks for fish and boats and the names of mountains and deserts would not be acceptable as marks for agricultural produce. Some rivers flow through heavily industrialised areas and they would not be acceptable even in Part B; eg "Tyne made" is a common expression. See also the Dan River case, 1962 RPC 157. As regards oceans, the practice is to accept "Atlantic" and "Pacific" prima facie in Part A for goods which are not directly relevant. In the case of Deserts, care needs to be exercised as the development of desert areas for agricultural or industrial use has increased significantly in recent years. However for a wide range of heavy and sophisticated goods acceptance in Pt A or Pt B is likely to be possible though the circumstances of each application must be considered. Again reputation is a factor to be taken into account, and "Sahara" would not be acceptable for dates, or "Kalahari" for diamonds.

Some examples of accepted marks are listed below:

SAHARA

Cl 3 - B 908,200 (J L 4653/1658) - Perfumes; non-medicated toilet preparations; cosmetics; etc

Cl 20 - B 1,228,026 (J L 5590/2827) - Furniture

CL 30 - B 1,156,401 (J L 5425/2032) - Baked foods

CL 32 - B 1,001,179 (J L 4957/1683) - Non-alcoholic drinks and fruit juices.

GOBI

CL 25 - B 1,013,807 (J L 5002/1251) - Footwear

9-94 Geographical names with well known other meanings

Where a word has both a geographical signification and another well-known signification, the examiner is not required to decide which one of them is its "ordinary signification". This was decided in the CANNON case (1980 RPC 519) when the Court of Appeal acknowledged that a word may possess more than one "ordinary signification". Thus, objection will normally be taken against a geographical name even though it possesses other non-objectionable meanings. Nonetheless, an examiner is not prohibited from deciding, without evidence, that when a word has an exceedingly common (non objectionable) meaning and is also the name of an exceedingly remote geographical location, the former is its only ordinary signification (see the MAGNOLIA case 14 RPC 621). It should, however always be remembered that when a place is sufficiently large and/or is relevant for the goods in question (eg York, which is also a cricketing term) then its geographical meaning can **never** be displaced as **one** of its ordinary significations even if it is 100% factually distinctive as a trade mark.

In between these two extremes of the scale there is room for a finding that a place name is not likely to be required, in the UK market, to indicate geographical origin, and therefore has some element of inherent capacity to distinguish. In these circumstances strong evidence of factual distinctiveness may then justify registration.

A geographical name which is acceptable prima facie in Part B may be allowed in Part A if it is shown to be very strongly factually distinctive.

9-95 In practice the following guidelines should be followed in respect of geographical names with well known other meanings:

(a) Places with populations lower than 5,000 in the United Kingdom and which have another very common and non-objectionable meaning which completely outweighs the geographical significance - accept Part B in absence of evidence as to the ordinary signification(s) of the word. In the case of overseas names the location is quite often more important than size. In the case of industrialised areas such as the USA, Japan and Europe 100,000 population size is a reasonable measure while in the case

of names in China or South America, names with populations up to 250,000 could be considered.

(b) If formal evidence is filed (eg a properly conducted survey showing that the geographical meaning of the word is not one of its ordinary significations in this country), then the above population limits may be disregarded, and acceptance may not necessarily be limited to Part B.

(c) Falling between (a) and (b) are place names with other meanings which have been registered many times in the past and which, by precedent, provide an indication as to their ordinary signification.

Examples are:

MARK	SIZE AND LOCATION	ACCEPT
MONARCH	2,000 USA	Part A
AURORA	50,000 in USA	Part B
FALCON	200,000 in South America	Part B

9-96 The following examples illustrate the application of the considerations set down in 9.95 above.

(a) Sierra

County in New Mexico, USA: population 7,189. Evidence filed showing that the county consisted of a 30 mile wide wooded valley part of which was a national park. Industry - timber, logging, and a small gold mine. Court of Appeal held that Part A registration was valid for motor cars. Sierra has own meaning (ie range of mountains).

(b) Central

Department in S Paraguay: population 163,000. Evidence showed that area was low-lying and swampy. Its climate was humid and unsuited to film making. Allowed prima facie in Part B for films prepared for exhibition. It has also come to the Registrar's attention that there is an area in Scotland called "Central Region". However, in view of well known non-geographical meanings for "central" it has been decided that we should continue to accept in Part B of the Register, for goods (although "central" is

considered objectionable for many types of services).

(c) Beer

Village in Devon: population 1,266. Industry - tourism, fishing and lacemaking. Application for soaps, perfumes, cosmetics etc. Objected to under Sections 9 and 10 since (leaving aside the fact that some goods of this type may actually contain beer)these goods may well be sold as holiday gifts etc and nobody should have a monopoly in the name as a mark. (May be acceptable in Part B for some goods, eg computers, but probably not computer programmes).

(d) Blanc de Mer

Mer is a commune of 5,000 population, near Blois, on the extreme edge of the Loire Valley wine-growing region. Application for wine. The mark, in translation, means "White Wine from Mer" (even though it was claimed to translate as "White Wine from the Sea" - sea being the more common meaning of the word "mer"). Mark objected to under Sections 9 and 10 and Statement of Grounds written. The Hearing Officer's decision was upheld on appeal to the Board of Trade. The fact that no-one makes wine commercially in Mer at present does not mean that no-one will wish to do so in future, and it could be offered for sale in the UK market.

9-97 Natural Produce

Generally objection should be taken to all place names in respect of natural produce (eg food, wines, timber, minerals). In each case, details of location, population, activities, etc have to be considered carefully. In effect, a finding that it is extremely unlikely that a place name will be required, in the UK market, to indicate geographical origin, is a finding that the name has an inherent capacity to distinguish. Foreign geographical names are more likely to find acceptance under this heading provided they have no reputation for the goods concerned.

9-98 Geographical names - similar and phonetically close

In addition to geographical names as such the Registrar sometimes has to consider applications for marks which closely resemble geographical names. For such marks to be

acceptable, there must be a visual or phonetic difference between the mark applied for and the geographical name concerned and even then they are normally only accepted in Part B. The following are examples of such marks accepted in the recent past:

SHILTERN	1049371 5077/2730
EXTER	B1047750 5088/440
TREIST	B1006124 5086/338
JAMOCA	1058040 5165/1691
SEVEN VALLEY	B1077722 5250/620
TEXIS	B1060022 5216/1740

It may also be possible to accept a geographical mark by splitting into two words. See for example MAYFAIR which was accepted as MAY FAIR because of its well known other meaning.

9-99 The names of streets, roads and districts

These are generally acceptable in Part B if the name is not associated with the goods in any way. For example, BOND STREET would not be acceptable for clothing, nor OXFORD STREET for a wide range of consumer goods.

Well-known names of foreign streets, roads etc are similarly dealt with: FIFTH AVENUE would be almost on a par with BOND STREET for fashions, and WALL STREET would be objectionable for services connected with stocks/shares or investments.

The names of districts of larger towns and cities may not always correspond with precise geographical areas or administrative units, eg 'Swiss Cottage', 'Billingsgate', 'Covent Garden', but in many instances may be well-known for particular goods or services. Thus BILLINGSGATE would not be acceptable for fish, nor COVENT GARDEN for fruit and vegetables.

9-100 "Company towns"

In a few instances applicants are able to show that they established their business at a particular location and that subsequently a town grew up around the business and adopted the same name. Any reputation which the town now has in respect of the products concerned originates from the business. In such cases prima facie acceptance is normally possible, at least in Part B of the Register. If supported also by evidence of factual distinctiveness then Part A may be a possibility, depending on the circumstances.

9-101 County names in the USA

Many otherwise unobjectionable words appear to have been adopted as county names in the USA. Evidence has been filed in several cases showing that:

(a) In formal or legal usage, the word "county" is never omitted, ie "County of Liberty" or "Liberty County", is never abbreviated to "Liberty".

(b) The US county denotes only an administrative area and is not used in postal addresses. It does not have the geographical connotations and allegiances of eg a British county. In the US a person or firm is likely to identify with a town or state and not with a county.

Therefore a geographical objection should not normally be taken on the ground that a word is the name of a county in the USA.

9-102 Differences between Trade Marks and Service Marks

The Registrar takes the view that there is a significant difference between the use of geographical names as service marks, as opposed to trade marks, and that there is much more scope for acceptance in relation to services. This subject is dealt with in full in Chapter 11, paragraphs 11-36 to 11-37, and 11-39 to 11-40.

9-103 General

It is quite clear from the foregoing that it is often a matter of fine judgement whether or not to accept geographical names for registration, and it cannot be overstated that the mark must be considered in relation to the goods (or services) and all the surrounding circumstances must be taken into account. Acceptance of a word in the past is not a conclusive argument that it should be accepted again, and vice versa.

[9-104 to 9-122]

Surnames and Personal Names - Introduction

9-123 The Registrar's practice concerning the registration of personal names has been revised to take account of acceptance by the Secretary of State's Appeal Tribunal that personal names (ie fornames and surnames) might be accepted under Section 9(1)(d) if they are distinctive, even though they do not qualify under Section 9(1)(a) or (b). This is on the basis that full names (ie forename(s) and surname) are not simply surnames and are therefore not excluded by the wording of Section 9(1)(d). Additionally the Registrar has reviewed his practice in relation to surnames under the 'de minimis' principle established in the CIBA case and in relation to double and multiple surname marks.

Personal name and surname marks will, therefore, in future be treated on the following basis:

Surnames alone

9-124 Words which are simply common surnames, eg Jones, Brown are not acceptable, prima facie, in Part A of the register. However, some surnames may be so uncommon that their "ordinary significance" to the public generally is that of invented words, and such surnames may be accepted on the de minimis principle which was established in the CIBA case (1983 RPC 75) and which is now applied as follows:

(a) Marks may be accepted in Part A if they appear as surnames not more than 15 times in the London Telephone Directory and not more than 30 times in any relevant foreign telephone directory;

(b) Marks may be accepted in Part B if they appear as surnames not more than 30 times in the London Telephone Directory and not more than 50 times in any relevant foreign telephone directory.

Surnames - rare but well-known

9-125 Conversely some surnames are very uncommon and appear hardly at all in directories, and yet are well known eg HEARST and CRIPPEN. Thus to the public their "ordinary significance" is that of surnames and they are debarred from acceptance in Part A by Section 9(1)(d). However, they may be accepted in Part B (within the limits of paragraph 9-124 above).

Surnames - with other well-known meanings

9-126 Surnames with truly well-known other meanings, eg SWALLOW, CANNON, are treated more liberally. They may be accepted for registration under the principles set down in the SWALLOW case (64 RPC 92) which were approved by the Court of Appeal in the CANNON case (1980 RPC 519) as follows:-

(a) Marks may be accepted in Part A if they appear as a surname not more than 50 times in the London Telephone Directory and/or not more than 100 times in any relevant foreign directory. (In effect this amounts to a prima facie conclusion that the "other well known" meaning is the "ordinary signification" of the word).

(b) Marks may be accepted in Part B if they appear as surnames not more than 100 times in the London Telephone Diretory and/or not more than 200 times in any relevant foreign telephone directory.

Note: "Truly well-known other meaning" signifies a meaning which is immediately known to the man in the street and requires no recourse to supporting books of reference.

9-127 (a) Surname - phonetic equivalents of

Generally these are treated as the surnames themselves eg the appearances of GOLDWIN in a directory will be added to the appearances of GOLDWYN. If the mark in question has a well known other meaning eg HEART (equivalent of HART), HAWK (equivalent of HAWKE), LION (equivalent of LYON), it can normally be accepted in Part B. Where such a name appears with a device depicting the word, the surname signification is less strong but even here it should only proceed in Part B. If it is doubtful whether a word is the phonetic equivalent of a surname, eg BLISS (90 times in the London Telephone Directory) and BLIS, then acceptance in Part B is normally appropriate. There is a long line of authority culminating in the ELECTRIX case (1959 RPC 283) establishing that the phonetic equivalent of an objectionable word is itself objectionable. However, it should be noted that in the CRAG case (69 RPC 306) (Crag nil times in the London telephone directory and having its own meaning: Cragg 25 times) CRAG was allowed in Part A on the argument that it was unlikely that a person called Cragg would enter the trade in qestion, and use his own name as a trade mark. CRAG appears inconsistent with ELECTRIX but the latter, being a House of Lords decision, is of greater authority.

(b) Surnames - phonetic equivalents with well known other meanings

As distinct from (a) above the fact that the phonetic equivalent of a word may have a well known other meaning does not assist. Such words must be considered within the limits set out in paragraph 9-124. Words such as HAWKE, SPRATT and LYON have no signification other than as surnames and if they fall outside the limits of paragraph 9-124 they can only be accepted on the filing of evidence of acquired distinctiveness.

Double surnames with other meanings

9-128 Marks composed of two surnames may be accepted in Part A if in combination they convey a clear signification going beyond the surnames themselves, eg BLACK KNIGHT, OCEAN GOLD or LONG LEA, and the mark as a totality therefore becomes distinctive (Diamond T case 38 RPC 373). Part B may be considered if the signification is not so clear eg BROOKS BIRD or TOWNS BAKER

Double and Multiple Surname Marks with no other meaning

9-129 Generally the signification of surnames cannot be avoided where they appear in combination and if this is clearly the case because the names are well known as surnames their acceptance is barred prima facie by the wording of 9(1)(d). It may be, of course, that if the surnames are very rare, particularly if they are foreign names, the surname signification is not immediately apparent. If that is the case, acceptance under (A)(i) below may be possible.

In the case of marks consisting of three or more surnames, acceptance should be possible in Part A on disclaimer or in Part B with or without disclaimer depending on the commonness of the surnames in question. It is considered that where a mark consists of three or more names being used in combination, the likelihood of such a combination being required by others is so remote that marks of this nature can be accepted in Part B with separate disclaimers even if they are very common.

The guidelines for double and multiple surname marks have therefore been revised and are now as follows:

A. Double Surname Marks

i. Accept in Part A without disclaimer on de : If the surnames occur not more than 15

	minimis principles (Note, however comments above and paragraph 9-125)		times in the London Telephone Directory and/or not more than 30 times in any relevant foreign directories.
ii.	Accept Part A with separate disclaimers or in Part B without disclaimer	:	If both surnames appear more than 15 times but not more than 50 times in the London Telephone Directory (or more than 30 times but not more than 100 times in any relevant foreign directories)
iii.	Accept Part B with disclaimer of the more common name	:	If one surname occurs not more than 50 times in the London Telephone Directory (and not more than 100 times in any relevant foreign directories) but the other is more common.
iv.	Accept in Part B with separate disclaimers	:	If both surnames occur more than 50 times but not more than 100 times in any relevant telephone directories.
v.	Object under Sections 9 & 10	:	If both surnames appear more than 100 times in any relevant telephone directories.

In other cases, marks may consist of surnames falling into different categories from those outlined above. Whether such marks are acceptable will depend on individual circumstances bearing in mind the likelihood of the two names being used in combination for the goods or services at issue.

B. Three or more surname marks

i.	Accept in Part A with separate disclaimers	:	If the surnames appear not more than

	or Part B without disclaimer	50 times in any relevant telephone directories.
ii.	Accept in Part B with separate disclaimers	: Even if the surnames are very common.

Full names (ie forename and surname together)

9-130 (a) These may be accepted in Part A under Section 9(1)(a) if represented in a special or particular manner (see paragraph 9-62). They may also be accepted if presented in signature form under Section 9(1)(b) provided the signature is that of the applicant or a predecessor in business (see paragraph 9-63). If presented in an ordinary typeface they may also be accepted under Section 9(1)(d) if the surname appears not more than 50 times (whether or not it has another meaning) in the London Telephone Directory and/or 100 times in any relevant foreign telephone directory. The forename normally qualifies under Section 9(1)(d) and there is no prohibition on the whole name (forename plus surname), provided it is distinctive within the limits bove. In these circumstances however, the surname significance is still present, especially as it is preceded by a forename. The surname element is debarred from prima facie acceptance by the wording of 9(1)(d) and thus should be disclaimed in Part A. Within the above limits personal names may be accepted in Part B without disclaimer as there is no statutory restriction on the acceptance of surnames under Section 10. If the forename is particularly unusual, eg Augustus or Theodore, the mark as a whole becomes that much more distinctive and the above limits may be exceeded in cases where it is thought appropriate, weighing the commonness of the forename against that of the surname.

(b) Personal names may be accepted in Part B if the surname elements appear as surnames not more than 100 times in the London Telephone Directory and/or not more than 200 times in any relevant foreign directory, provided the surname elements of the marks are disclaimed. The final sentence under (a) above may also apply here.

(c) If the surname exceeds the limit set down above, objection is normally taken on the grounds that the mark is not distinctive as a whole and is not capable of distinguishing.

(d) Marks which consist of initials and surnames may be accepted in Part B, without disclaimer, within the de minimis limits set down in paragraph 9-124(b).
(e) In the case of applications for personal names in classes 3 and 25 where female forenames are considered

non-distinctive for such goods as cosmetics and ladies clothing and in Class 42 where forenames generally are non-distinctive for such services as hairdressing, it will be necessary to disclaim these elements. This means that within the limits set out in (a) above, acceptance should be on the basis of separate disclaimers of the surname and forename in Part A and disclaimer of the forename in Part B. Within the limits set down under (b) above acceptance should be on the basis of separate disclaimers.

(f) If the whole personal name has another well known meaning eg JENNY WREN which is the nursery name of a bird (WREN being a fairly common surname), such marks may be accepted in part A on disclaimer of the surname element. This is in line with the practice on double surnames with other meanings set out in paragraph 9-128. In classes 3, 25 and 42 where forenames may be considered non-distinctive for certain goods and services, separate disclaimers of the forename and surname will be required.

Invented Names

9-131 A mark may be presented as a name but if the surname does not appear in the relevant telephone directories the mark may be accepted in Part A (see JOE PALOOKA, journal 5512 page 1134.

Forename(s) and surname combined or coalesced

9-132 If the surname element can be distinguished then acceptance should be on the same basis as set down under paragraph 9-130 except of course there will be no need for a disclaimer as the surname is not a separate element. This means acceptance in Part A if the surname element appears less than 50 times in the London Telephone Directory and/or 100 times in any relevant foreign telephone directory and in Part B if the surname appears less than 100 times in the London Telephone Directory and/or 200 times in any relevant foreign telephone directory.

Surnames combined with the name of the goods

9-133 It is clear from Court decisions that surnames combined with the name of the goods do not qualify as invented and are therefore unlikely to be distinctive (see SIMPLUG 1957 RPC 173). Such marks are not acceptable in Part A or Part B unless the surname part of the mark is sufficiently rare to qualify under paragraph 9-124.

Surnames combined with word descriptive of a characteristic of the goods

9-134 Generally such marks may be accepted in Part A if

the descriptive word has no direct reference, or Part B if the descriptive connotation is not very direct, eg REEDMAG accept Part A; REEDLITE accept Part B; REEDCOATED object: all for paper.

Surnames - on evidence

9-135 Court decisions over many years show that all surnames may be registered on sufficient evidence of use - even such common surnames as SMITH or JONES. Thus all names must have some inherent capacity to distinguish and the justification for this view is that surnames are indeed intended to distinguish one person from another even though the distinctive element in common surnames is very small. They can thus be distinguished from geographical names which do not distinguish in any way other than in a geographical capacity. As regards the consideration of evidence of user, the length of the period of user, the value of goods/services sold and advertising expenditure are the normal measurements, but it is not possible to set down specific guidelines. Generally, if a surname is rare then only a modicum of user over a relatively short period is required, whereas for acceptance of a very common surname such as SMITH in Part A 100% factual distinctiveness shown by evidence of very good user plus evidence from independent witnesses would be required. In other words, the usual "evidence" criteria must apply, which is: "How strong is the prima facie objection?" and "what is the extent of evidence of user filed?".

Foreign surnames

9-136 It may be found in respect of some foreign countries (eg Japan per P G O'Neills Japanese Names) that a mark is a surname in that country but the exact incidence of surnames is not known, perhaps because a suitable local telephone directory is not available. In such instances a prima facie objection under both Sections 9 and 10 should be raised, taking into account any existing equities and precedents. Such surname objections may be waived upon proof that the surname signification fits the Registrar's criteria for Part A or Part B as set out in the preceding paragraphs, but it is for the applicant or his agent to establish these facts to the Registrar's satisfaction.

[9-137 to 9-156]

Descriptive and laudatory words - Reference to the character or quality of the goods

9-157 It has been held that words which are ordinary descriptive words or combinations thereof (or mis-spelling of such words or combinations) and have a direct and very close or very direct and close reference to the character or quality of the goods are not inherently capable of distinguishing (see the Verve case 1958 RPC 3 and the Rotolok case, 1968 RPC 227) and should therefore be objected to under both Sections 9 and 10. In applying the terms of Section 9(1)(d) to words of a descriptive character (ie which have "direct reference to the character or quality of the goods"), it is necessary, whilst formulating any reasonable objections to the registration of a word on the ground that it is descriptive of the goods, to guard against over astuteness in finding objections. The "reference" to the goods must be "direct", ie reasonably plain to see on a first impression. A mark is not objectionable under this head if it merely contains what has been called by the Court a "covert and skilful allusion" to the goods. The test to be applied in deciding this question in respect of any particular mark has been stated in a number of reported cases, probably most clearly in the Charm case (45 RPC page 426, lines 20 to 23 and 35 to 39). In that case it was emphasised that the mark must be considered in relation to the goods concerned, the question then being "What are the public, seeing the mark in conjunction with the goods, likely to think the mark means"? If the answer is that the public are likely to perceive that the mark describes some characteristic of the goods, or conveys a laudatory meaning in respect of the goods, then it can reasonably be contended that the mark is directly descriptive of the goods. See for example the SCOTCHLITE case (65 RPC 229), the BUSMASTER case (70 RPC 141) and the MINIGROOVE case (72 RPC 183). While it is possible to be too astute in finding objections, it is also possible to pose too narrowly the question whether a mark has direct reference to the character or quality of the goods. In the Erectform case (21 RPC 212), for example, it was argued that the goods concerned (corsets) could not themselves have an erect form, or be erect in form. The Court held nevertheless that the word in question had direct reference to the character or quality of the goods because it described the effect which the goods would have upon a person who used them.

9-158 Some words, although they have a 'direct reference' to the goods [in the sense of Section 9(1)(d)] are nevertheless not totally descriptive, and moreover are not likely to be words which other traders in similar goods would legitimately desire to use for ordinary descriptive purposes. Such words may be considered for registration in Part B of the register.

9-159 Another category involves <u>words which simply describe the get-up of goods, or of the labels attached to them</u>. Such words are not regarded as inherently "distinctive". Thus the words "Gold Cap", "Red Cap" or "Golden Seal" are considered to be both descriptive and non-distinctive in respect, for example, of wines and spirits, because it is quite a common practice for wine or whisky bottles to be furnished with a cap or seal coloured gold or red, or for that matter any other colour. For example also, the words "Black and White", being a common description of the colouring of labels which are simply printed in black on a white ground, are not regarded as inherently "distinctive".

<u>Name of new product</u>

9-160 The question of whether the name of a new product is distinctive was considered by the Court of Appeal in McCain International v Birds Eye Foods 1981 RPC 69. McCain International obtained an injunction against Birds Eye Foods for passing off and the latter appealed to the Court of Appeal. In January 1979 McCain launched chips on the market which were cooked for consumption not by frying but by baking in an oven or by grilling. Their sales material referred to them as McCain Oven Chips and stressed that they were a new product. Subsequently, other suppliers marketed "oven ready chips", and the defendants wished to call theirs "Birds Eye Oven Chips". There was no risk of confusion by any similarity of packaging and the case rested on whether the words "oven chips" were associated solely with one manufacturer (no other had in fact used it) on the product. The Court of Appeal discharged the injunction. Templeman L J said:

> "Mr Harman, in a very forceful and if I may say so, very attractive argument, submitted that 'oven chips' is a fancy name and not a phrase in common use in the English language, so that it will be associated with one particular manufacturer and not with a product. He said it is a novel phrase - and that is true; it has never been used before - that also is true. He castigated the phrase as an ungrammatical aggregate of two English nouns and said that it was nonsensical without an explanation. But in my judgment the words 'oven chips' grammatical or not, constitute an expression which is an ingenious and apt description of the contents, namely, potato chips prepared for cooking in the oven; and although the consumer may not have been aware, and could not have been aware of what the expression meant until oven chips came on to the market, once they had come on the market he could

recognise a name which is apt and appropriate to describe a product rather than a manufacturer, the product being potato chips prepared for cooking in the oven. The fact that the name 'oven chips' does not indicate that the chips may also be grilled is neither here nor there. The name does inform the consumer of what is inside the package so that he may know what he is purchasing".

9-161 In his decision Templeman L J referred to earlier cases where plaintiffs had failed to establish a monopoly to such expressions as "flaked oatmeal", (15 RPC 57); "cellular" for clothing, (16 RPC 397); "slip-on" for coats, (26 RPC 393); and "malted milk", (33 RPC 108) where Horlicks' user of the term for 25 years without competition from anybody else did not avail them. He added that if a product is novel its name must be novel, but the manufacturer is not entitled to a monopoly of the name if it is a descriptive name.

9-162 The same sort of point was also considered by the House of Lords in SHREDDED WHEAT (57 RPC 137), where the House ordered its removal from the register - there could be no evidence of the acquisition of a secondary meaning in the absence of rival producers of the same article.

9-163 Arising out of the McCAIN OVEN CHIPS case the following points may usefully be noted:-

(a) that where a descriptive name is applied to a new product by the sole supplier of that product, and yet is such an apt name to describe the product that it quickly becomes generic as the name of those goods, that name cannot easily acquire distinctiveness.

(b) the applicants had consistently sold their product under the name McCAIN OVEN CHIPS. There was strong evidence that the name OVEN CHIPS was descriptive of the product and the name McCAIN indicated origin of the product.

(c) the name "OVEN CHIPS" was an ingenious and apt description of the product. Although the consumer could not have been aware of what the expression meant until the product came to market; once on the market the name 'OVEN CHIPS' would inform the consumer of the nature of the product.

(d) that while a descriptive term may acquire a secondary meaning, the period in the present case was far too short for such a secondary meaning to have been acquired, particularly in view of the plaintiffs' constant reference to their product as "McCain Oven Chips".

(e) that where a person introduces a new product to the market, gives it a name descriptive of the product and has a monopoly, whether legal or de facto, in that product, he cannot claim a monopoly in the name. He can only require that other persons who make the same product distinguish their products by appropriate means. The defendants had done this by making it clear that their products came from Country Fair and Birds Eye respectively.

(f) that the true distinction between a descriptive name and a fancy name is that between a name which is descriptive of the product and a name which is distinctive of the manufacturer (see also the AUTO ANALYSER case 1970 RPC 201).

[9-164 to 9-173]

Mis-spelling of Words

9-174 Marks which have been held not to be "invented" under Section 9(1)(c) because, for example, they consist of mis-spellings of known words or because they differ from known words only to a trifling extent, must be considered under Section 9(1)(d) as though they consisted in fact of those known words (see the Scotchlite case, 65 RPC page 234, lines 9 to 27). The word BORAXE, for example, should be considered under Section 9(1)(d) as though it consisted in fact of the known word "borax" and should be objected to as having direct reference to the character or quality of the goods if the latter consist of borax or borax compounds or derivatives of borax and so on. The word FYNPOWDA would be considered as though it were in fact the words "fine powder" of which it is an obvious mis-spelling.

9-175 It often follows that, if a mark is open to objection under Section 9(1)(d) because of its descriptiveness in relation to the goods, an objection will also arise under Section 11 of the Act if the propounded specification does not contain an appropriate restriction, and attention must always be paid to this point, which is developed later in this chapter.

Phonetic equivalents of unregistrable marks

9-176 It was established in the Electrix Case (1954 RPC 23) that the phonetic equivalent of an unregistrable word is itself unregistrable, but the phonetic similarity must be very close before the prohibition bites (see the reference to 'EXXATE' in paragraph 9-208).

9-177 The question of phonetic similarity was further considered by the Court of Appeal in the NERIT/MERIT case, (1982 FSR 72). In that case the mark NERIT had been registered as a "ghost" mark for cigarettes in order to protect the owner's use of MERIT and to prevent others using MERIT. Two of the appeal judges (Lawton L J and Shaw L J) held that the word NERIT was inherently capable of distinguishing. Shaw L J implied that it might even be adapted to distinguish. Brightman L J however, took the opposite and minority view that words that are virtually the same phonetically are just as unacceptable as the exact phonetic equivalents. In the course of his judgment Brightman L J said:

> "I accept that 'Nerit' is not phonetically the exact equivalent of 'Merit' if the word is enuciated with special clarity. If the words are in the least slurred or even spoken without particular clarity, they are phonetically

indistinguishable. I rely on the evidence of my own ears. There were innumerable occasions during the course of the argument when it was quite impossible for the Bench to tell, save by the context, whether counsel was enunciating 'Merit' or 'Nerit'. The scarcely audible difference between 'Merit' and 'Nerit' is not in my view sufficient to dispel the confusion which the choice of the word was deliberately intended to bring about, and to confer on 'Nerit' the badge of distinctiveness which the word 'Merit' is not qualified to wear. It all depends how carefully you speak. Some would regard 'witch', associated with broomsticks, as the phonetic equivalent of the adjectival 'which'. Others would not. The same approach (ie virtual phonetic resemblance is just as unacceptable as exact phonetic resemblance) was adopted, and I think rightly adopted, by the Registrar when an application was made to register the mark 'Ombrella' in relation to an umbrella-like curtain for a shower bath; see Ombrella trade mark (1974 RPC 683). The learned judge [Mr Justice Balcombe] took the view that as the word 'Nerit' was not the precise phonetic equivalent of 'Merit', therefore it was capable of becoming in course of time distinctive of the goods to which it was applied, (being the test under Section 10 of the Act for registrability in Part B of the register). I venture to doubt whether precise phonetic equivalence is necessary in order to disqualify the ghost mark. See In re Garrett's Application, (1916) 1 Chancery, 436, at page 433, Lord Cozens-Hardy, Master of the Rolls, said this,

> 'A trade mark appeals to the ear as well as to the eye. This has often been laid down .... If the letters O.G. could not be registered it seems to me that the word 'Ogee' ought not to be registered. [Note: Ogee has its own meaning] So if M.T. ought not to be registered, the word 'empty' ought to be refused.

The phonetic resemblance between the letters M.T. and the adjective 'empty' if properly articulated, is not exact. Nor, in my opinion, if there is found to be a practical, although not a precise, phonetic resemblance, would the day be saved for the ghost mark by effecting a change in spelling so as to alter the visual impact. Otherwise in Electrix Ltd v Electrolux Ltd the House of Lords would not, I think, have decided that as 'Electrics' was inherently incapable of

registration, so the word 'Electrix' was also unregistrable, both under Part A and under Part B, despite the difference in visual impact.
See also the second example quoted from Lord Cozens-Hardy's judgment, (the letters M.T. and the adjective 'empty') where the visual impact would be totally different. His judgment was quoted with approval by the House of Lords in the Electrix case: see page 729. I would therefore decide the second issue in favour of the respondents. I respectfully differ from the learned judge, who considered that the defendants could only succeed on this issue if the phonetic resemblance was exact".

9-178 Brightman L J appears to have considered the issue of phonetic resemblance in much greater depth than the other two judges and accordingly carries weight. He was enunciating a principle; the fact that the other two judges took a different view in the particular circumstances of NERIT/MERIT does not substantially detract from the principle. Where, therefore, the phonetic resemblance between a propounded mark and an unregistrable word is very close, it should not be accepted prima facie either in Part A or Part B (see also the Ombrella case 1974 RPC 683).

Foreign Words

9-179 Words in foreign languages sometimes appear in trade marks and normally their meaning should be checked in the various foreign language dictionaries available in the examination units. If a definition cannot be found but the examiner is suspicious that the word could be meaningful for the goods, then the departmental translation service should be consulted. It should be noted, however, that Latin or archaic Greek words are not made the basis of objections under Section 9(1)(d) unless they are words or phrases of the well-known type which most people have become acquainted with as a matter of general knowledge. (See also paragraphs 9-70 and 9-71).

There may be some languages such as Tibetan known only to relatively few people in this country. If this is so it might, in normal circumstances, be possible to argue that such words (even if found to be descriptive or laudatory) should be regarded as invented words and so should qualify for registration under Section 9(1)(c), or at least under Section 10. This argument cannot be sustained however where the laudatory or descriptive meaning of such a word has been drawn to the attention of the purchasing public (perhaps through advertising material) and is thus well known. See for example the statement of grounds issued on the TENBA case (application No 1129387).

Observations on descriptiveness of word marks

9-180 Observations in the following Reported Cases are useful in considering the descriptiveness of words submitted for registration:-

(a) In the Heavenly case (1967 RPC 306) it was observed that the Registrar was entitled to rely on his general knowledge of the use of language, because dictionaries could not always be up to date. It would be wrong to allow words to be registered as trade marks if they were in current use in a way which disqualified them from registration even though such meanings had not yet found their way into dictionaries.

(b) In the Hold and Draw case (1964 RPC page 145 line 30 to line 48), G W Tookey QC, for the Board of Trade, said:

> "When the Registrar is confronted with an application for registration of words such as HOLD AND DRAW in relation to coin freed apparatus, he is immediately put upon enquiry as to whether the words have a reference to the character or quality of the goods, because the words themselves convey a strong implication that they represent something other than a purely fanciful phrase. That being so, I consider that the Registrar is entitled and indeed bound to seek by any means at his disposal, whether there is in fact a direct connection between the trade mark and the character or quality of the goods upon which the mark is intended to be used. It has to be remembered that the onus is always upon the applicants to satisfy the Registrar that the mark which is propounded is suitable for registration and an applicant cannot expect to get an advantage merely because he has claimed registration in respect of such a wide specification of goods that to some extent it veils from the Registrar the precise character of the goods upon which the applicant intends to use the mark in commerce. If the Registrar reasonably suspects that the trade mark has a direct reference to the character or quality of the goods upon which it is intended to be used, then in my view the Registrar is bound to give effect to such suspicions and to refuse to register unless and until he is provided with such additional information as

will enable those suspicions to be dispelled".

MINI, MAXI and MASTER marks

9-181 So far as Section 9(1)(d) is concerned, it is necessary to mention three particular kinds of word mark which may not appear at first sight to be open to objection but which have nevertheless been consistently objected to by the Registrar in appropriate circumstances. One of these groups consists of words beginning with the prefix "Mini". Owing to the development in the language of the use of this prefix to indicate something small (eg indicated by the "MINI" car), it is the practice to object to words consisting of the prefix "Mini", combined with the name of the goods or of some feature of the goods. Thus, the word "Minigroove" was refused registration in respect of long-playing gramophone records (ie records having smaller grooves than the short-playing type (72 RPC 183)). The second group consists of marks containing the word MAXI. In recent years MAXI has (on the analogy of MINI = small) come into common use as meaning "large", "great" or "much" and we must now regard it as having that meaning. In particular MAXI + "name of goods" (eg MAXICHIPS for potato chips or MAXI + the name of some quality or function to which size or degree is relevant (eg MAXICOVER for paint) will normally be objected to both in Part A and Part B. There may be a few cases where MINI or MAXI is not too descriptive ie where the concept of size or degree is not directly relevant eg MAXISAND, for sand; such a Mark may be accepted prima facie in Part A.

The third group consists of words ending in "Master" ie where that word is preceded by the name of the goods or by some word which gives a descriptive or laudatory meaning to the word as a whole (see the Busmaster case - (70 RPC 141) - and the Earthmaster case - (1956 RPC 73)). Furthermore, the frequency with which traders used to adopt "MASTER" marks is in itself an indication of non-distinctiveness.

Nowadays it is considered that 'MASTER' is somewhat quaint as a descriptive term and it is no longer a word which is likely to be used in decribing goods. When it is used in a mark, therefore, a more lenient line can be taken from that suggested in older reported cases such as those mentioned above. The practice is now as follows:-

(a) MASTER + name of the goods/services (eg MASTERBIKE, MASTERCLEAN). In this context, the word is most likely to suggest a laudatory meaning (an exceptionally fine bicycle, an exceptionally good cleaning service) and objections should be taken under both Sections 9 and 10.

(b) Name of the goods/services + MASTER (eg BIKEMASTER, CLEANMASTER). Switching the order of the words does indicate a little inventiveness but these marks still have some laudatory connotations. Although slightly better than the those described in (a) above they should still be refused in Part A ("because they consist of the name of the goods (services) and the laudatory word MASTER, conjoined, being descriptive of and non-distinctive for eg bicycles (cleaning services) of outstanding quality") but are acceptable in Part B.

(c) Characteristic of the goods/services + MASTER (eg SWINGMASTER for golf clubs, SHIFTMASTER for excavating machines, SLEEPMASTER for mattresses). No sensible objection can be raised to such marks under Section 9 and they should therefore be accepted in Part A.

<u>UNI-, MONO- and POLY- marks</u>

9-182 As prefixes, UNI- means "consisting of, relating to, or having only one", MONO- means "one" or "single" and POLY- means "more than one, many or much" (Collins' Dictionary). It follows that in many cases, marks containing these prefixes will be somewhat descriptive, or at least suggestive, of a characteristic of the goods/services; for example, MONOGRIP for tools (single-handed operation) or UNIMIX for dry-mixed building aggregates (only one mix, with water, required) or UNICORE for cables (having a single core), are all readily understandable and would attract an objection under Section 9. However, they are not the most apt words for describing the goods and it is unlikely that they would be used in a descriptive way in everyday speech. Such marks are, therefore considered "capable of distinguishing ..." and acceptable in Part B. Where the added element has a less direct reference to a characteristic of the goods/services (eg MONOFIX for tools, or UNICOVE for cove adhesive, or UNIFLEX for cables) such marks will be acceptable in Part A.

When used alone, UNI, MONO, and POLY will often be acceptable in Part A. Similarly, when combined with the name of the goods/services, they may well be unobjectionable - for instance, UNIBANKING for banking services, MONOBIT or POLYBIT for drill bits.

Examiners should also be aware that some of these "prefixes" have become adjectives in their own right, by common usage,

and will be very descriptive/non-distinctive in relation to some goods eg MONO has come to mean "monochrome" in relation to TV sets/VDUs and "monophonic" in relation to music-reproducing equipment; POLY is now virtually generic for "polythene" or for "polyester" content in fabrics.

MULTI marks

9-183 Following the "MULTILIGHT" case ([1978] RPC 601), "MULTI-" marks require careful consideration. It was held in that case that "multilight" was totally lacking in any inherent distinctiveness for light fittings which comprised two or more lights. No amount of factual distinctiveness could overcome the fundamental lack of inherent distinctiveness. By this reasoning, MULTI- plus a descriptive element will not be acceptable in Part A or Part B in the following types of marks:

(a) where the goods comprise a plurality of features, as opposed to one, eg MULTILIGHT light fittings, MULTIPOCKET hold-alls, MULTICARB engines, MULTIBLADE razors, MULTILENS cameras.

(b) where the goods serve more than one purpose, eg MULTIFABRIC cleaners or dyes, MULTIBLADE sharpening devices (for more than one type of blade).

(c) where the goods perform more than one action at a time, eg MULTIPUNCH hole-punches, MULTISTITCH paper-stitching machines.

Where the added element is less clearly descriptive, marks may be acceptable in Part B, eg MULTICLENS cleaning services, MULTIWIPE cleaning materials.

On its own, or combined with the name of the goods/services, MULTI- may well be acceptable in Part A. eg MULTIPENSION pension services (whereas MULTICHOICE pension services would be objectionable - pension schemes offering alternative benefits) or MULTI cables (whereas MULTICORE would be objectionable).

Section 11 should also be considered where appropriate, bearing in mind especially the possibility of deception when the mark "reads into" the goods or services, eg "MULTI" may seem a harmless mark in relation to stitching (stapling) machines but in the context "MULTI stitching machines" it could be deceptive if the machines were not capable of performing more than one stitching (stapling) action at a time.
[9-184 to 9-201]

Section 9(1)(e) - introduction

9-202 Apart from the types of mark specifically defined in paragraphs (a), (b), (c) and (d) of Section 9(1), other forms of mark which, if they can be held to be "distinctive" as defined in Section 9(2), are registrable under paragraph (e) of Section 9(1). Typically these are marks consisting of letters and/or numerals and device marks of all kinds, for example, of animals, birds, buildings, ships, human figures, geometrical figures etc. A glance at the search indexes shows the limitless variety of forms which device trade marks have taken. Letters and numerals are dealt with in paragraph 9-205 onwards and device marks in paragraph 9-231 onwards.

Distinctiveness - a prerequisite for 9(1)(a) to (d) as well as 9(1)(e)

9-203 A word mark which is not acceptable under any of the paragraphs (a) to (d) of Section 9(1) cannot be considered a "distinctive" mark within the meaning of Section 9(1)(e) unless its distinctiveness is proved by evidence of use; and where it is necessary to take objection to a mark under Section 9(1), paragraphs (a), (b), (c) or (d), the objection is also taken automatically under Section 9(1)(e). Moreover it does not follow that if a mark qualifies under Sections 9(1)(a)-(d) it will necessarily be accepted, as it may still not be distinctive [see paragraph 9-46]. The words "The" or "Any" for example are wholly non-distinctive and are unregistrable. The decision whether or not a trade mark is adapted to distinguish in this sense depends upon the answer to the question, "Does this trade mark consist of, or is it likely to be confused with any matter which other traders commonly use or should be legitimately free to use in describing or ornamenting or getting-up their goods in the ordinary course of trade, and without fear of trespassing on the rights of the proprietors of a registered trade mark?". If there are good grounds for answering that question in the affirmative, then the trade mark under examination is not, prima facie, "adapted to distinguish" the applicant's goods (see the observations of Lord Parker in the W & G case - (30 RPC page 671, line 32, to page 672, line 9)).

Examples of distinctive and non-distinctive marks

9-204 It is impossible to set down an extensive list of examples of words or devices which, may or may not qualify as being distinctive marks under Section 9(1) (e) or capable of distinguishing under Section 10 because it is impossible to visualise all the reasons or circumstances which may give rise to objections under this head. Each case must be considered on its merits. The following paragraphs

demonstrate the more common types of mark or matter which will fall to be considered under Section 9(1)(e) or Section 10 in determining whether prima facie they are "distinctive" or "non-distinctive" and the considerations which need to be taken into account when examining a mark from this point of view. In the following examples "distinctive" relates to both Parts A and B unless stated otherwise.

Numerals

9-205 Marks which consist simply of numerals or their equivalent expressed in words are not acceptable, prima facie in either Part A or Part B because they are frequently used to indicate model numbers, catalogue reference numbers etc.

Letter marks

9-206 Marks which consist simply of a single letter or of two or three letters and are not pronounceable, are not acceptable prima facie because of the common use of initial letters by traders in general in marking their goods and for other purposes in trade (see the W & G case - 30 RPC 661). However, when a letter or letters have some additional features added (other than borders or decorative features of a non-distinctive character), so as to create a combined device, then the presence of the letter or letters will not prevent a finding of distinctiveness, but in general the exclusive use of letter(s) will need to be disclaimed. (See Ford-Werke AG - (72 RPC 196)). It is wrong to note the name of an applicant and then deduce in the mark initial letters of the applicant's name. The mark should be considered on its own merits. The following extract from the judgement of Lloyd-Jacob J in the Ford-Werke case referred to above sets out the Registrar's practice in relation to monograms.

> "Whilst it is plain that in each case the Hearing Officer cannot avoid (and, so far as I know, never seeks to avoid) the ultimate responsibility of deciding on the presence or absence of such distinctiveness as the type of application requires for its acceptance, rules of practice are in operation in the Trade Marks Registry to facilitate his task; and the Registrar, by his Counsel, has informed the Court of those which are relevant to the cited applications.
>
> They are as follows: (1) Monograms, if of three or more letters, are prima facie considered to be adapted to distinguish; and, if of two letters, are prima facie considered capable of distinguishing. Capacity to distinguish may also be inferred if two letters not monogrammed, and therefore showing a

definite sequential order, are so run together as to involve an elision of part of one of the letters. (2) If to a letter or letters some additional features are added (other than borders or decorative features of non-distinctive character), so as to create a combined device, the presence of such letter or letters will not prevent a finding of distinctiveness, but in general their exclusive use will need to be disclaimed. (3) If to some other integer a letter is introduced in a manner which does not plainly identify it as such letter, the combination may be adapted to distinguish, although the exclusive use of the letter may need to be disclaimed. (4) A combination of non-distinctive integers, one of which consists of one or two letters, may in the totality possess distinctiveness, although disclaimer may be required of some or all of the component parts.

It is into the second of these four categories that the mark here in suit would have to fall if it were to claim the benefit of consonance with Office practice. Once the conclusion is reached that the features additional to the letters are of no distinctive significance and that, together with the letters, they form no combined device but merely accentuate the letter feature the exclusion of this mark from the category is unavoidable. I have heard no argument on the propriety of these categories and I am far from certain that, in expressing them in my own language, I have accurately delimited them. It suffices for present purposes to say that I can see no objection to the system of practice directions as at present operating in the Trade Marks Registry, nor any prima facie reason for questioning the four rules of practice to which I have referred".

9-207 <u>Combinations of letter and numeral marks</u>

Letters and numerals are themselves non-distinctive, but there comes a point when a sufficient combination of non-distinctive letters and numerals may be considered at least capable of distinguishing in Part B. The sort of mark which can be accepted in Part B is NA22H or 22NH7 where the numeral (or letter) component is both preceded and followed by letters or numerals. The reason for accepting such marks is that they are unusual combinations and are unlikely to be required by traders for references in catalogues and the like.

Examples of unacceptable marks are CGP10 or KP140 as these

are merely letters plus numeral marks. An argument that the last element is a letter 'O' would not be acceptable.

The division between acceptable and unacceptable combinations is arbitrary but as a matter of practice it is intended to impart a degree of uniformity and there should be no departure from practice without good reason.

9-208 Phonetics of letter marks

Marks which consist of the obvious phonetic equivalent, or of a mere spelling-out, of letters (eg "Ellandgee") are likewise not acceptable prima facie (see the Ogee case 33 RPC 117). In much the same category are word marks which consist of a spelling-out of initial letters with a phonetic equivalent of "and Co" added. The Registrar refused, for example, to register the word "Eanco" because it was phonetically the same as "E and Co", the applicant's initials. The refusal was upheld by the Court on appeal (see 37 RPC 134).

However, in the 'EXXATE' case the High Court ordered registration in Part A despite the Registrar's objection that the word was merely the phonetic rendering of 'X8'. The judge was not satisfied that the word was necessarily the phonetic equivalent of the letter and the numeral and he did not think that the business community, on hearing the word, would understand it to be a reference to 'X8'. Furthermore, the registration of the word would not embarrass other traders who wished to use 'X8' as a product reference, etc.

It will be seen that this constitutes a much more liberated approach then some of the earlier cases. In the light of this, the following guidelines have now been adopted:-

> A "phonetic" objection should be raised only where there is no reasonble doubt that the word sought to be registered would be understood by the public to refer to a non-distinctive number, letter or both. In practice, therefore:
>
> (a) If it is reasonably certain that a word will not be seen as a phonetic representation of letters eg SIVE (ie CV) or IDE (ie ID) - accept in Part A
>
> (b) If it is doubtful, eg ELEX (could be LX or EE-LEX), EFFEMEX (could be FMX or EFFI-MEX) or EFFANDES (could be "F and S" or "F-ANDES") - accept in Part B.
>
> (c) If there is no reasonable doubt that a word

- would be seen as a representation of letters eg ELLANDGEE -object Part A and B.

Four letter marks

9-209 Marks which consist of known words which have no reference to the goods/services are, of course, acceptable in Part A. If the four letters form an invented word which is clearly pronounceable (eg TOCS, YOCA) the mark will similarly be acceptable in Part A. If the mark is not pronounceable (eg QXWV or PTCR) or there is serious doubt whether the public would attempt to pronounce it (eg QWEV or XOTH) it will be acceptable in Part B at best, prima facie.

Three letter marks

9-210 These marks were previously only accepted in Part A if they were either (a) well known dictionary words (CAT, MET, NOD etc) or (b) if they were pronounceable and represented in upper and lower case (Mep, Piv, etc).

Following a change of practice in 1989 three-letter marks, if clearly pronounceable, are acceptable in Part A, whether or not shown in upper and lower case. MEP and PIV would now qualify in Part A, for instance, as would LIF, WAC, FAL, SYL etc. Totally unpronounceable three letter marks XTC, ITP, MLK, etc) are not acceptable in Part A or Part B, prima facie.

On the borderline are the sorts of combinations of letters which the general public might see as invented words, even though their pronunciation is difficult or unclear eg OXS, AOT, ROH, YRA. In some such cases, use of upper and lower case lettering may assist, eg Roh, Yra, but if this is thought necesary then the mark does not qualify for more than Part B registration. It is doubtful whether even Oxs or Aot would really appear as words to the public and in such cases of doubt the examiner would be justified in raising objections under sections 9 and 10.

In considering such cases, it is helpful to compare the invented "word" with known words: if there is a similarity, the public are much more likely to attempt a pronunciation. If "Oh!" is pronounceable, why not "Roh!", for instance? If "Era", why not "Yra"? But "A" is seldom followed by "O" and almost never in a short word, and pronunciation of "Aot" is therefore strained; similarly "X" is almost never followed immediately by "S", and pronounceability of "Oxs" is therefore only a matter of speculation.

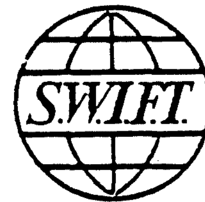
Considerations to be taken into account when considering acceptance or objection to such three-letter marks are:-

(a) In all cases, if the letters are followed each by a full stop (even though otherwise they might constitute a well-known word, eg C.A.T.) we should object as letters. The objection might be overcome in some cases by the removal of the stops and the closing up of the letters provided the resulting words in such cases are free from other objections.

Where the "punctuation" marks separating the letters have a device-like appearance rather than mere punctuation, or where the punctuation marks are so insignificant in size that the letters give the overall impression of being a word, it may be possible to treat the mark as a word, rather than letters. For example

S·L·I·M
CORPORATION

1,299,638
J1.5760 P.893



B1,213,193
J1.5746 P.3000

(b) If the letters (without stops) are pronounceable as a word, but are well-known to the public as letters, we may have to object to such a mark, even if it is amended to show it is a word. Examples of this are R.A.F., O.A.P., I.B.A., M.O.T., V.I.P., E.E.C.

(c) A mark consisting of an elision of three letters will usually be accepted in Part B unless it clearly has a device look about it (as a 3 letter monogram does because the order of the letters is masked) or if it qualifies as described above eg as a well known word or pronounceable letters presented in upper and lower case. See paragraph 9-213 in respect of 3 letter monograms.

Two letter marks

9-211 These were previously only accepted in Part B at best, prima facie, and then only if shown in upper and lower case, regardless of whether they were well known dictionary words. Thus HE, SO and OT were unacceptable but He, So and Ot were acceptable in Part B.

Following the change of practice mentioned in para 9-210, two-letter marks are now accepted in Part B, whether or not shown in upper and lower case, and whether or not they are dictionary words, so long as they are clearly pronounceable. HE, SO and OT would now qualify for Part B, therefore, as would IM, TU, FO etc. If the pronunciation is difficult or doubtful, eg XO, IY, AO, YR, objections should be raised under sections 9 and 10 prima facie. It is doubtful whether such marks would benefit from being presented as Xo, Iy, Ao, Yr, but each mark must of course be considered on its own particular merits.

Two groups of letters in upper case, hyphenated

9-212 When a mark consists solely of two groups of three letters hyphenated they may be accepted in Part A prima facie when both parts are easily pronounceable, whether or not either part is a word, but no reference to the goods or other objection can be based on either part separately or in combination. Marks not meeting this test will usually be acceptable only in Part B at the most, but it is not possible to set out a rule of thumb, nor would that be desirable since the cardinal rule that every mark must be judged on its own merits must never be lost sight of. Objections to Part A will be more easily maintained where the hyphenated version is offered as an amendment to a six-letter mark which is not found to be acceptable in either Part A or Part B of the register. While the list below will indicate some of the matters to be taken into account it is not intended to be exhaustive. One may, for example, find that a six-letter mark acceptable only in Part B could be considered for Part A on amendment to a hyphenated version.

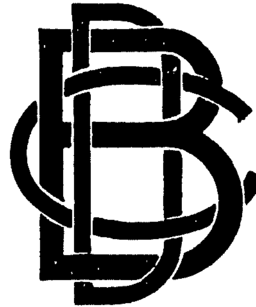
MARK	GOODS		DISCLAIM	COMMENTS
XYZ-XYZ	any goods	Acc B	The letters 'XYZ'	Two groups of mere letters.
XYZ-ABC	any goods	Acc B	Disclaim each group separately	Two groups of mere letters.
XYZ-PEN	pens	Obj A/B		Mere letters + the goods.
POL-PEN	pens	Acc A		Pronounceable and reads through, therefore Part A.
XYZ-PEN	fencing	Acc B	Disclaim separately the letters "XYZ" and the word "PEN"	Mere letters + reference to goods; cannot be 'read'.

MARK	GOODS		DISCLAIM	COMMENTS
POL-PEN	fencing	Acc A		Can be 'read' so no need for disclaimer.
XYZ-PEN	fertiliser	Acc B	The letters XYZ	No reference to goods but cannot be 'read'; presented as letters.
POL-PEN	fertiliser	Acc A		Reads through, no reference to the goods.
CAR-PET	carpets	Obj A/B		Combination = the goods.
SLO-GRO	plant growth inhibitors	Obj A/B		Combination = direct reference.
LON-DON	any goods	Obj A/B		Combination = geographical; phonetics barely altered.
ASK-ERN	any goods	Acc B		As above but sound and look altered.
MIL-TON	any goods	Obj A/B		Combination = common surname; phonetics barely altered.
HIG-HAM	any goods	Acc B		As above; sound and look altered; too close visually for Part A.

In considering the degree, if any, of reference to the goods one should not be over astute. The mark SED-DIF, for example, is acceptable in Part A for 'slides for the differential examination of sediments'. The necessity of taking an objection under Section 11 should be borne in mind in appropriate cases as should the possible need for disclaimers for reasons other than mere letters, and the effect of such a disclaimer on any acceptance in Part A. See paragraphs 9-348 et seq for further guidance concerning the need for disclaimers in these types of mark.

Three letters - monograms

9-213 Marks consisting of three or more letters formed into a monogram (by which is meant letters which have been intertwined) are accepted as registrable in Part A of the register. The mere placing of the letters one upon the other, without intertwining, does not necessarily produce a monogram. An example of the practice is application No 654091 which was advertised in Journal 3669 on Page 608:

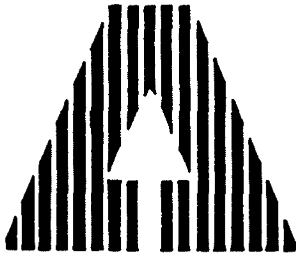


Two letters - monograms

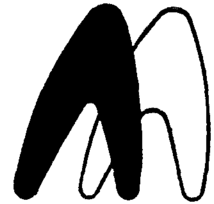
9-214 Monograms composed of only two letters are not regarded as sufficiently distinctive for registration (prima facie) under Section 9, but are considered to be acceptable for registration in Part B of the register. An example of the practice is application No B1132208 which was advertised in Journal 5416 on Page 1466:

Single Letter Marks

9-215 Single letter marks propounded for registration are notoriously lacking in inherent distinctiveness. Such marks are rarely accepted prima facie in Part A and then only if the overwhelming impression is that of a device. A disclaimer of the letter will normally not be required because the device impression must be well away from the letter. See, for example:



and



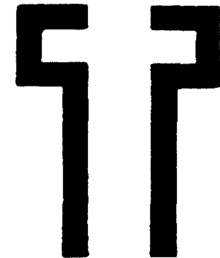
No 991333
Journal 4934 Page 544

No 989750
Journal 4934 Page 560

9-216 Where the mark gives the impression of a letter but not clearly defined then such marks will probably be acceptable in Part B on disclaimer of "a letter". Some examples are given below:

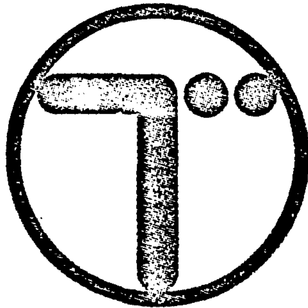
Registration of this Trade Mark shall give no right to the exclusive use of a letter "K".

No B1033605
Journal 5294 Page 318



Registration of this Trade Mark shall give no right to the exclusive use of a letter "T".

No B1133509
Journal 5427 Page 2133

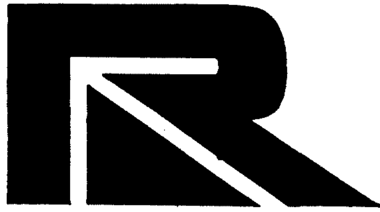


Registration of this Trade Mark shall give no right to the exclusive use of a letter "T".

No B1134861
Journal 5427 Page 2134

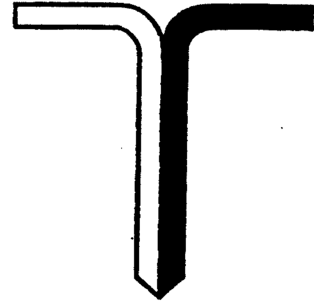
Registration of this Mark shall give no right to the exclusive use of a letter "G".

No B1273677
Journal 5703 Page 294



Registration of this Trade Mark shall give no right to the exclusive use of a letter "R".

No B972008
Journal 4877 Page 299



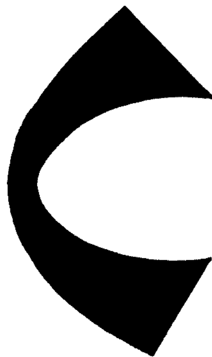
Registration of this Trade Mark shall give no right to the exclusive use of a letter "T".

No B982215
Journal 4934 Page 546

9-217 Where the overall impression is of a letter represented in an existing fount or in a manner such that other letters of the alphabet could be envisaged in the same "fount" then such marks are not acceptable in either Part A or Part B prima facie. Such marks require the benefit of user before they can proceed to registration - even in Part B. See, for example:

No B982431
Journal 4971 Page 2364 and

No B941031
Journal 5031 Page 174



Advertised before acceptance. Section 18 (1) (*proviso*).

Advertised before acceptance by reason of use and special circumstances. Section 18 (1) (*proviso*).

9-218 The Assistant Registrar, in his decision on application No 1075597 (1982 RPC 145) for a single letter mark in the form of a lower case 'd' with an elongated serif bounded by a broken circular border gives a very good exposition on the practice in relation to single letter marks and the points to consider in relation to such marks.

When dealing with letter marks 'The Encyclopaedia of Type Faces' by Jaspert, Berry & Johnson (published by Blandford) is a useful reference book. However, the fact that a particular style cannot be found in that Encyclopaedia does not, of itself, prove that the style of lettering is distinctive or invented: each case must be considered on its own merits and if the overwhelming impression is that of a

simple letter, the mark will not be acceptable without satisfactory evidence of use.

Lettering styles may be the subject of copyright and in particular cases (eg if the letters are very original) it may be necessary to investigate the position further.

[9-219 to 9-230]

Device marks

9-231 Mere representations of the goods claimed in the application are not "distinctive". Straightforward representations of motor cars, for example, cannot be "distinctive" of one particular manufacturer's make of cars, because all manufacturers of, or dealers in, cars should be free to use, and often do use, illustrations of cars in advertising their own goods. This principle applies also to representations of people connected with the relevant goods or services, for example, devices of chefs are not generally distinctive for food-stuffs or restaurant services, nor mechanics for car repair services. Fanciful representations may possess a measure of distinctiveness and at least be capable of distinguishing (for Part B), on a suitable disclaimer.

9-232 Representations of flowers, shrubs and trees are commonly used in the perfumery trade in labels and advertisements and for this reason are not regarded as "distinctive" in respect of perfumes or perfumed goods or in respect of similar medicated goods in Class 5.

9-233 Devices of human figures are not "distinctive" in respect of clothing, because such devices are commonly used by all and sundry for purposes of illustration in advertisements of those goods. This applies where the devices are more or less ordinary representations of men and women or children standing or sitting and in ordinary dress. If the figure is shown in some unusual way, eg doing a high-kicking act or with arms tied in a knot, the device could well be regarded as distinctive because of the unusual posture of the figure. The sketch of a female figure for clothing (opposite) was refused in Pantino Inc's application, (1966 RPC 527). Figures shown in silhouette or naked (assuming they are not offensive) can normally be accepted in Part B.

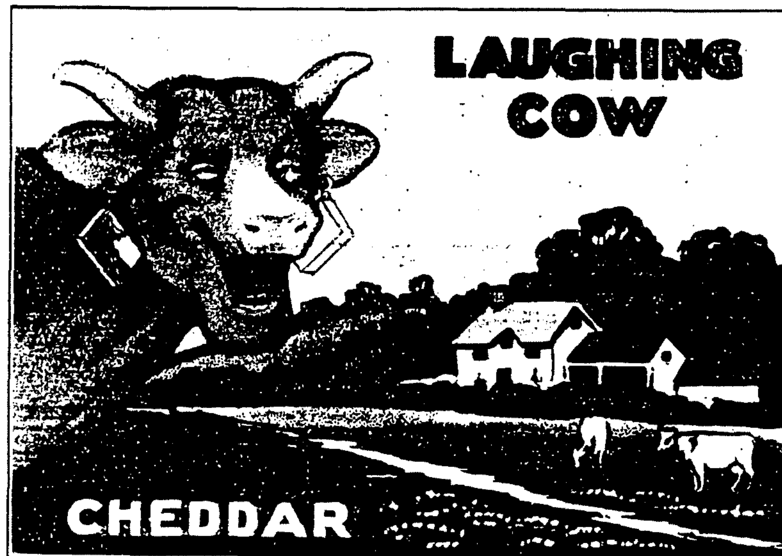
9-234 Devices of women's heads are commonly used for advertising purposes in the perfumery trade, and especially for hair-waving preparations and hairdressing and beautician's services. They are therefore not regarded as "distinctive" in Class 3 or in respect of similar medicated goods in Class 5, or hairdressing or beautician's services in Class 42.

9-235 Feminine proper names are commonly used by traders in the perfumery, women's hairdressing and clothing trades and, therefore, are not regarded as distinctive or capable of distinguishing any one person's goods in those trades or

in respect of medicated goods in Class 5 similar to perfumery. Corres file number 54766 gives the background to registry practice with regard to the common use of feminine proper names in relation to articles of women's clothing. This does not, however, apply to footwear (ie boots, shoes, slippers, sandals, etc). Babies' items such as napkins etc also fall outside the prohibition.

9-236 Devices of machines, or of parts of such machines are not acceptable in respect of goods which they themselves manufacture. A fanciful combination of such devices may however be capable of distinguishing (for Part B) on a suitable disclaimer.

9-237 Devices indicative of the origin or source of the goods are not acceptable in Parts A or B. Thus devices of animals are not "distinctive" in respect of leather, skins or hides; devices of cows are not "distinctive" in respect of milk (in any form), butter, cheese or other dairy products; devices of trees are not "distinctive" in respect of timber; and so on. These are examples only, and obviously do not exhaust all the possible objections to a mark under this head. It is a matter of judgment and discretion, and the foregoing relates to ordinary or conventional representations of the devices in question. Thus, while an ordinary representation of a cow would be objected to as not "distinctive" in respect of, say, milk, entirely different considerations would arise if the cow were shown in some fanciful manner, eg doing a hornpipe or laughing, see for example:



No 514553
Journal 2746 Page 1747

A fanciful device of this kind would clearly be "distinctive", since it would be entirely out of the ordinary. Within this category some devices may be acceptable in Part B depending on the degree of innovation shown.

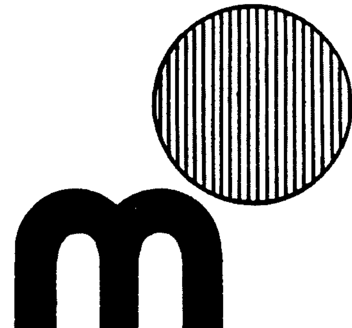
9-238 Pastoral scenes, that is to say, commonplace scenes of cows grazing in a field, are not acceptable in respect of dairy products, for the reason that they are commonly used in the trade as mere decorative matter on butter wrappers, condensed milk labels, and so on.

9-239 Star devices are in common use in the tobacco and spirit (whisky, brandy etc) trades and so are not distinctive of those goods.

9-240 Plain geometrical figures, ie triangles, squares and other four-sided figures (including diamonds), circles, eclipses and so on, are not acceptable because they are commonly used as mere borders or outlines in trade marks. Geometrical figures having ten or more sides are similarly regarded because they are too nearly like mere circles. Figures having from five to nine sides are considered to be acceptable either (a) if they are made solid or (b) if they are coloured and shown in combination with words describing them and also limited to the particular colour in which they are shown. Thus, a pentagonal device shown in the colour red and combined with the words "Red Pentagon", and limited to the colour red, would be regarded as a "distinctive" mark within the meaning of Section 9(1)(e). (See the Pentagon case, (1964 RPC 138)). Some borderline marks with some degree of innovation may be acceptable in Part B.

9-241 Devices consisting merely of a spot (ie a circle filled in with a single colour) are not regarded as sufficiently "distinctive" for registration in Part A of the register; but if words descriptive of the spot (eg "Blue Spot", "Red Spot"), are added to the device of a spot, and if the applicant is willing to limit the mark, including the spot, to the colour named (see paragraph 9-253), the resulting mark is regarded as acceptable for registration in Part B.

However, the combination of a relatively non-distinctive spot (or other geometrical figure) with another relatively non-distinctive element can produce a mark which has, overall, a capacity to distinguish and may therefore be acceptable in Part B with each element separately disclaimed,



Registration of this Trade Mark shall give no right to the exclusive use, separately, of the letter "M" and the device of a red spot.

(B1161708 Journal 5519 Page 1543)

9-242 Fancy borders are not considered to constitute "distinctive" marks, or to lend any element of distinctiveness to the mark in a case where the matter within the fancy border is itself not "distinctive" (see the Benz case - 30 RPC 177) - and the Statement of Grounds on application No 1124424.

9-243 Simple or commonly used patterns or backgrounds, which traders in general should be free to adopt for commonplace ornamentation purposes in their labels, are not considered to be acceptable.

Tartan patterns or backgrounds are regarded as being in this category of non-distinctive marks, and require careful consideration.

Whilst tartans are not protected by law (unless the designer registers them as a Registered Design) it is Scottish custom that anyone belonging to a particular clan has the right to use that clan's tartan. Trade/service mark rights cannot, therefore, be granted in respect of known tartan patterns, as such designs are in common use and therefore non-distinctive for trade/service mark purposes. There can be no objection to registration of a pattern which, although it resembles a tartan in style, is not in fact a recognised tartan but merely an invented pattern, provided it meets the normal test of distinctiveness. Particular care is required because the essential element of a tartan is the colour scheme and there may be variations in the way the actual stripes, etc are put together. Therefore, the fact that a precise replica of the pattern cannot be found in the relevant reference books does not necessarily mean that the pattern will not be recognised as a particular tartan. The Registry holds a copy of an encyclopaedia of tartan patterns but in cases of doubt, examiners should seek the advice of the Tartan Society.

9-244 Devices which are likely to be used as patterns on the goods themselves and words describing such devices are not regarded as acceptable in respect of those goods, eg flower devices or the words "WILD ROSE" in relation to textile piece goods, chinaware etc. If objections are raised to eg textile piece goods, decorated with flowers these could be overcome by excluding from the specification "textile piece goods decorated with flowers".

9-245 Devices of impressed seals are regarded as "non-distinctive" unless they contain matter of a "distinctive" character which of itself enables the mark to be accepted as a whole in either Part A or Part B.

9-246 <u>Ordinary conventional representations of persons using the goods concerned</u> are not acceptable, eg an ordinary picture or drawing of a man in the act of painting is not considered to be "distinctive" in respect of paints or of paint brushes. Similarly, a representation of a woman engaged in knitting is "non-distinctive" in respect of knitting yarns.

9-247 <u>Devices of containers for the goods concerned</u> are not acceptable in respect of those goods. For example, a device of a bottle is "non-distinctive" in respect of whisky, and a device of a can is "non-distinctive" in respect of any canned goods. It sometimes happens that the representations accompanying an application will consist of an illustration of a container with the actual trade mark displayed on the container which itself is presented in an ordinary or unfanciful manner. In those cases where the trade mark is acceptable for registration there is no need to disclaim the device of a container as it is inconceivable that anybody would consider that the use of such a device could infringe the registration of the mark. (See also paragraph 9-333 re disclaimers required when the mark is limited to colour). Note that the three-dimensional shape or form of the container itself has been held not to be an appropriate representation of a trade mark for registration purposes (see Sobrefina's application 1974 RPC 672).

9-248 The law in relation to containers was recently tested by the Coca Cola Company who submitted evidence in support of an application to register their bottle for cola drinks. The application was refused by the Registrar and their appeals to the High Court, the Court of Appeal and the House of Lords were also refused. See also paragraph 9-30.

9-249 <u>Devices of bunches of grapes and vine leaves</u> are not considered to be "distinctive" in respect of wines, since such devices are a common feature of wine labels. It is now considered that such devices are so common and non-distinctive that a disclaimer is not required.

9-250 <u>Thistle devices</u> are not acceptable in respect of goods for which Scotland is widely famed (eg whisky), for the reason that such devices are commonly used by traders in their labels and the like for the purpose of indicating the Scottish origin of the goods. If the goods do not originate in Scotland an objection under Section 11 would also arise.

9-251 <u>Devices of road signs officially adopted by the Department of Transport</u> are objected to in the first place

as not being "distinctive" and as open to objection under Section 11. This objection is usually waived if the applicant can furnish the written consent of the Department of Transport to the registration of his mark, unless the goods concerned are motor vehicles or other goods directly connected with the roads or road traffic.

Device as Part of the Goods

9-252 Insignia which appear on badges are not considered prima facie to constitute trade marks in respect of the badges themselves, for the reason that such insignia are part of the badges, whereas a trade mark should be something apart from, or additional to, the goods concerned. That of course is the prima facie position and it may be that if evidence could be filed showing proper trade mark use the position would be different. The AA badge has been accepted for registration and the dome lead device proved acceptable in the matter of James Application (3 RPC 340) where it was proved that the dome device was imprinted as a trade mark on lead sold in various shapes. The Capsule Case (1976 RPC 20) was rather different in that colour was the distinctive element which was applied to the whole surface of the goods. Also accepted, on evidence of factual distinctiveness, was a radiator device for motor cars (see Rolls Royce - Application No 1,034,118).

Marks depicted in colours

9-253 In cases where the mark is depicted in colours, the provisions of Section 16 of the Act must be taken into account in deciding whether or not the mark is acceptable. It might be that the mark, although otherwise not a "distinctive" one, could nevertheless be held to be distinctive or capable of distinguishing if it were limited to the particular colours in which it is shown in the application. For example, if the mark consisted simply of a circle filled in with a single colour, it would not be distinctive. If, on the other hand, the circle were divided into halves, with each half displayed in a different colour, the result would probably be that the mark could be accepted for registration in Part B because the combination or arrangement of colours was itself capable of distinguishing and provided that the applicant agreed to insert in the application form a clause in the following terms:-

"The mark, here depicted in heraldic shading, is limited to the colour(s) .... (specify the names of the colours) as shown in the representation on the form of application".

Segments in different colours may be distinctive even without naming particular colours provided that the presence

of more than two colours is indicated by half tones in the camera ready copy for the black and white advertisement in the Trade Marks Journal.

9-254 A clause in the above terms is required to be inserted in all cases where it has been decided to accept the mark on the basis that it is "distinctive" because of the particular combination of colours in which it is shown.

9-255 If a mark consisted simply of matter which was not "distinctive" in itself, acceptance would not normally be justified if the non-distinctive matter were simply printed in a colour or colours different from the colour of the background.

9-256 Where an applicant wishes to limit his mark to colour and the colour limitation is not a formal requirement of the Registrar it is not necessary to provide camera ready copy in heraldic shading for the advertisement. The colours must however, be depicted in half tones and the colour limitation clause should read as follows: "The mark is limited to the colours .... as shown in the representation on the form of appplication".

9-257 Sometimes a mark is depicted in colour on the form of application. If the mark qualifies for registration regardless of its colour then no colour limit is required. Black and white representations are not required for the file although the advertisement in the Journal must show the mark in black and white depicting the various colours in different half tones.

[9-258 to 9-270]

Part 3 - Pharmaceutical Names

9-271 Non-proprietary names for pharmaceutical and veterinary substances and pesticides, which are "approved" by the British Pharmacopoeia Commission (BPC), the Pharmaceutical Society of Great Britain and the British Standards Institution (BSI), are recorded in the internal search indexes both forward and terminal (the latter being asterisked) for Class 5 so that they can be picked up as ground for objection under Sections 9, 10 and 11. This is because "approved names" must be regarded as generic descriptions, the use of which should be free to all traders in the goods concerned. Any proposed trade mark which is identical to, or confusable with, an approved name is therefore "not invented, descriptive, non-distinctive, and likely to deceive or cause confusion". The objection does not arise under Section 12 and the proper place for particulars of any such name, disclosed by searching, is on the examination report sheet, not the search sheet. Objection is not normally taken to a trade mark for a name proposed for "approval" in the interval between informing the relevant body that it is not in conflict with existing registrations, and its actual approval. It is for the interested body to keep that interval as short as possible, to watch the Journal advertising trade marks for opposition, and (if necessary) either to oppose registration, or to abandon their own proposed name.

9-272 Registry practice for pharmaceutical name indexing is as follows:-

(a) The proposed name is submitted by the BPC or BSI to the Registry for search;

(b) After searching, the result is reported in writing to the body concerned;

(c) The body notifies the Registry when the name is actually "approved";

(d) The name is inserted in the Search databases.

The relevant files are as follows:-

CORRES 62801 - Veterinary Approved Names.

CORRES 63045 - BSI Names for Pesticides.

CORRES 63131 - BPC Approved Names.

[9-273 to 9-280]

Part 4 - Section 11 - Deception - Introduction

9-281 Section 11 of the Act provides as follows:-

"It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of it being likely to deceive or cause confusion, or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design".

9-282 This Section embraces a wide range of objections. In practice, however, at the ex parte examination stage by far the most important aspect is that of inherent deceptiveness, or otherwise, of the mark in relation to the claimed goods.

Inherent deceptiveness

9-283 When examining a mark for the purposes of Section 11 it should be borne in mind that whilst each application in the final event must be considered upon its own merits, examination staff should concentrate particularly on the underlying principles and on the liberal supply of examples in the appendices, as follows:

- In respect of material from which the goods are made - Appendices A and B.

- In respect of the intended use - Appendices C and D.

- In respect of the geographical origin - Appendices E and F.

9-284 The prohibitions under Section 11 of the Act are very widely expressed. On the other hand, the Trade Descriptions Act 1968 and the Hallmarking Act 1973 are specific statutes designed to protect the public from false descriptions of goods. Whilst registered proprietors of trade marks are liable to penalties under these Acts, nevertheless it remains the Registrar's responsibility under Section 11 of the Trade Marks Act to ensure that marks which are unlawful under particular statutes are not accepted for registration.

9-285 Normally, the Registrar is not competent to judge whether or not a mark offends under the Trade Descriptions Act, etc. It is possible indeed that many of the marks objected to under Section 11 in the past would not offend the particular statutes. It is against this background, that objections under Section 11 are raised only when the

mark contains a direct and unequivocal reference to the goods, and the mark would undoubtedly be deceptive if used on goods (within the claimed specification) which could not meet the explicit promise of the mark.

9-286 The criteria in deciding whether or not to raise an objection under Section 11 is that the descriptive element:-

(a) must be a word or words or device which form a separate integer in a mark or are so presented in a mark as to be clearly understood to be descriptive

and

(b) could reasonably be expected to influence the public's interest in the goods.

See the following cases: Royal McBee 1961 RPC 84; BALI 1969 RPC 472; GE 1973 RPC 297; and CHINA THERM 1980 FSR 21.

9-287 The words must be the actual descriptive words (or mis-spelt words phonetically identical to such words) and will not normally be combining form words or abbreviations. For example, in Class 32 in respect of non-alcoholic drinks the mark PEPSI LEMON would be objected to under Section 11 if the mark is claimed for drinks which do not contain or are not flavoured with lemon, but the marks LEMANDA and LEM-SIP would not be objected to under Section 11 of the Act. Similarly, in Class 5 (pharmaceuticals) abbreviations such as CAP or TAB (capsules or tablets) would not these days give rise to an objection under Section 11.

9-288 Where a descriptive element forms part of an invented word, or of some other word which is acceptable under Sections 9 or 10 of the Act, the position of this element in the word will normally be decisive in whether or not a Section 11 objection should be raised. For example where the descriptive element appears at the end of the word, use of the mark in conjunction with the generic name of the goods will tend to be descriptive of the goods. Thus, CHEFSTEEL (for shelves, worktops, sink units, etc) could, when used in ordering the goods, be understood to indicate CHEF steel shelves, etc and would thus be deceptive if used in relation to shelves, etc other than those made from steel. On the other hand the mark STEELMASTER (for hammers) would not read into the goods with the same descriptiveness.

9-289 Deception only occurs when a descriptive word is interpreted to indicate a precise specific characteristic of

the goods which is not in fact present in the goods. Some descriptive words are not precise in their meaning when used in relation to certain goods and the likelihood of these words causing deception is therefore remote. The word SPORT, for example, in respect of clothing is imprecise today since "sports clothing" can refer not only to attire worn whilst playing sports but also clothing for casual wear. The word STEEL in marks for eg, saws, is also of uncertain significance since it could be interpreted to indicate either the saws are made of steel or are for use in cutting steel. In cases of this nature where a potentially descriptive word is not in fact directly descriptive, objection should not be taken under Section 11 because it must be assumed that prospective purchasers will be put on enquiry and therefore deception will not occur in practice. The cardinal rule is that before raising an objection under Section 11, examination staff must be reasonably sure that a descriptive word in a mark will lead the public to expect a precise characteristic in the goods sold under that mark and that characteristic would be of importance in the selection of the goods. In the latter regard, indications of local geographical origin of the goods will not usually be of importance except where a particular locality has a reputation for the goods concerned eg Paris for clothing, Stoke for pottery, Munich for beer, Northampton for shoes, certain regions for wine, etc. If the indicated locality does not possess a particular reputation for the goods, deception cannot occur since prospective purchasers of the goods will not have any preconceived ideas about the nature of the goods. Where, for example, no Section 11 objection arises is in the case of the mark 'California Vogue' for "baths" firstly because the word California implies no particular type of bath and secondly because no one would be likely to think that relatively cheap bulky objects such as baths would be imported from California. Purchasers may, on the other hand, have expectations about goods manufactured or produced in certain countries, and where the names or devices indicative of countries or well known towns appear in marks and the specification of the application is not limited to goods originating from the relevant country an objection under Section 11 will invariably be raised. Such objections can be overcome by a condition of registration. It is to be noted that a place name conjoined to another word is no longer a place name.

The following are the standard wordings used for such a condition:

(a) It is a condition of registration that the mark shall be used in relation only to goods the produce of .....

NOTE: For use in respect of food and beverages and basic (unmanufactured) raw materials.

(b) It is a condition of registration that the mark shall be used in relation only to goods manufactured in .....

NOTE 1. For use in respect of manufactured goods.
2. Where only one item appears in the specification, refer to the item by name (eg wines) rather than use the general term "goods"

9-290 An indication of origin must be direct, and therefore objection should not be raised under Section 11 on the basis that a mark is, or appears to be, a word or words in a foreign language.

9-291 In the majority of cases, descriptiveness or misdescriptiveness arises in respect of the materials from which the goods are made, the purpose for which they are intended, or their place of origin. Examples of the types of marks which should or should not be objected to under Section 11 are appended as follows:

In respect of the <u>material</u> from which the goods are made - Appendices A and B

In respect of the <u>intended use</u> - Appendices C and D

In respect of the <u>Geographical origin</u> - Appendices E and F

9-292 Objections under Section 11 can of course arise in respect of characteristics other than those listed above. For example, marks used in relation to books, magazines, etc might indicate the subject matter of the book. In those cases where a mark is or could be used as the title of a book, etc eg MODERN KNITTING, POULTRY WORLD, then real deception could occur unless the books, etc sold under the mark are limited appropriately. Device marks for such goods should rarely be objected to under this Section since in use they are less likely to be understood to be descriptive indicators, the titles of the publication being relied upon for this purpose.

9-293 These general rules will cover most cases in which a decision has to be taken on whether or not to raise an objection under Section 11 because of the descriptiveness or misdescriptiveness of the mark. But in all such cases the decision will rest on the same basic principles - the descriptive element in the mark applied for must be clear and direct and in respect of a particular characteristic of goods which would influence a purchaser to choose those goods.

Contrary to law or morality

9-294 Objection should properly be taken in the exercise of discretion under Section 17 to any mark which is likely to be offensive to religious susceptibilities or to public taste, but sometimes the dividing line between offensive marks and marks which strictly could be said to be "contary to morality" is a fine one. (See the Hallelujah case (1976) RPC 605). In such cases objection may be taken under Sections 11 and 17. Objection to a mark such as "Commit Murder" falls squarely under Section 11. What is "contrary to morality" must be decided in the context of current attitudes. Marks which would have been refused summarily in the 1930's may well be accepted without comment nowadays. In practice, very few applications attract objections on this score today.

Scandalous design

9-295 Much of what is said immediately above applies here. In current practice, no objection is raised to fairly inexplicit outline drawings or photographs of nude figures; objection should be raised against explicit full frontal nudes and offensive (scandalous) back views.

Surnames alien to applicant

9-296 Where a mark consists of or incorporates a surname which differs from that of the applicants for registration no objection under Section 11 should be taken unless the name already has a reputation connected with the goods concerned, as, for example, Jack Nicklaus for golf clubs. The objection, when taken, will be under Section 11 on the grounds that use of the name by the applicants would be confusing or deceptive as to the origin of the goods because of the existing reputation of the name, and should be taken whether or not there is an existing registration citable under Section 12(1).

Foreign words as the name of an estate

9-297 Marks applied for in respect of wines and spirits, and which contain such words as "Chateau", "Clos", "Domaine", etc, have in the past had objections raised under Section 11 on the ground that the public are likely to be deceived as to the origin of the goods unless the applicant is able to declare that he is the proprietor of the estate so named. This practice has now been discontinued but the background may be found on Corres file 38208.

Designations of cognac, armagnac and calvados

9-298 The United Kingdom Government has given the French Government an undertaking (Exchange of Notices Cmnd 6301) to protect the designations "cognac", "armagnac" and "calvados". Staff must ensure that no trade marks bearing these designations are accepted for registration in respect of goods other than those so designated. This restriction will equally apply even if these designations are used with an indication of the true origin eg Japanese cognac, or with the addition of an expression such as "kind", "type", "style" or similar terms.

Section 11 - Invoked in opposition

9-299 Section 11 is sometimes invoked by persons opposing the registration of a trade mark, the plea in such cases being that the use of the mark propounded for registration is "likely to deceive or cause confusion" having regard to its similarity to the opponents' mark or name which they have been using to a significant degree up to the time of the application for registration. This aspect of the Section does not, however, arise in the course of the ordinary ex parte examination of a mark. It is put forward in opposition proceedings and needs to be supported by evidence.

Overcoming Section 11 objections - qualification of specification

9-300 Where an objection arises under Section 11 the "cure" for the objection can quite often be the addition of a mere qualifying phrase to the specification of goods as applied for. For example, the mark EKTACOLOR applied for in respect of photographic chemicals, would attract an objection under Section 11 on the grounds that it would be likely to deceive if used upon photographic chemicals generally. The objection would be overcome however, if the qualifying phrase "for use in colour photography" was added to the specification of goods. In this type of situation, examiners should indicate in the examination report how the objection can be overcome.

Overcoming Section 11 objections - limitation of specification

9-301 Sometimes a Section 11 objection (if the sole objection to the mark) can be met only by a definite limitation of the goods, as distinct from the mere addition of a qualification of the specification on the lines indicated above. For example, if application was made for

the word EVETOY in respect of all the goods included in Class 28, the mark would be open to objection under Section 11 unless the application was limited to "Toys" per se.

Insurmountable Section 11 objections

9-302 There is the type of case where the objection under Section 11 arises and for which there is no remedy, for example, the word ORLWOOLA applied for in respect of cotton goods would be obviously objectionable and no amendment of the specification could remedy the defect. Objection under Section 11 also arises where the term "Safe" appears in the mark which could lead purchasers to believe that the goods so marked were safe to use in any circumstances, or, in other words, that the mark was indicating a guarantee of safety. Such an objection is particularly relevant to pharmaceuticals (Class 5) which might be thought safe to use in any circumstances (see the Vitasafe case, 1963 RPC 256).

"Safe" Marks

9-303 In all cases where there is a danger to the health or the safety of the public through deception resulting from an element in a trade mark, it is important that an objection under Section 11 be identified and raised.

9-304 It is normal practice to allow the presence of the word SAFE in marks where such marks are for use in relation to goods which are normally described as "... safe" or "safety ..." goods, eg safety helmets, safety glasses etc. This practice has latterly been extended somewhat, and, provided there is no danger to public health the word SAFE may appear in marks for goods which comply with BSI standards and the like and where the applicants agree, in appropriate circumstances to submit to a condition of registration that the goods conform to appropriate standard(s) and that the appropriate standard(s) will always be published in conjunction with the mark eg in advertising and in trade literature. This will ensure that the public are warned in which sense the word SAFE is being used. Without it, different members of the public might make different assumptions and thereby be deceived eg in the case of containers for pharmaceuticals SAFE could imply preserved in good condition for many years, or pilfer proof, or tamper proof, or child proof. In some instances there may be a whole host of BSI standards which could apply, covering a wide range of goods in a specification: in such cases it may be more appropriate to refer, in the condition of registration, simply to "the British Standards Institution Safety Standards in force for the time being in relation to

any of the goods specified". Otherwise, where practicable, the actual BS code numbers should be stipulated in the wording of the condition.

Such conditions should be required only where there is a clear and obvious possibility of danger to public health or safety arising from a possible misunderstanding of the mark. Where goods or services cannot reasonably be understood to involve such safety considerations, or where the mark has only an indirect meaning (eg SAFEWAY for a range of grocery products, or INTERSAFE for delivery services) it is impracticable and unrealistic to attempt to define the safety standards applicable and this aspect can be ignored.

The following example (No 1149588 advertised in Journal 5526 on page 2019) shows the form of words to be used, where a condition can be agreed to:

It is a condition of registration that the Mark shall be used in relation only to goods that conform with British Standards Institution Safety Standards for faceshields, spectacles, goggles, welding helmets, welding shields—BS679 or BS2092, filter masks and respirators—BS2091, airhoods, sandblasting hoods and ventilating suits—BS4667, firesuits—BS1547, ear muffs and ear plugs—BS5108, caps—BS5240, work clothing—BS2563 and 4679, shoes and boots—BS953 and 1870, gloves—BS697 and 1651, belts—BS1397, catchnets—BS3913, devices for the prevention of falling—BS5062, electrode holders BS638, or any standard or regulation which may replace those standards and that the applicable safety standard or safety regulation shall be indicated to the public in conjunction with the Mark.

1,149,588. Faceshields, spectacles, goggles, welding helmets, welding shields; filter masks, respirators, air hoods, and sand-blasting hoods, all being breathing apparatus, none for use in artificial respiration; ventilated suits and fire suits; ear muffs, ear plugs (other than for protection of the hearing); caps, workclothing, shoes, boots, gloves, belts for wear; catchnets; devices for the prevention of falling; holders for use with welding electrodes; all being safety clothing or safety appliances for protection against accident, injury or fire.

In most instances the only words that will change from the above example are those affecting the number(s) and names of the appropriate standards and the goods to which they relate.

<u>Overcoming Section 11 objections - imposition of a condition</u>

9-305 It is clear from the authorities that a trade mark should not be registered for a wider claim of goods than those for which it is used or proposed to be used. In the case of Ducker's Trade Mark (45 RPC, page 402 at lines 15-18) Lord Hanworth said that "the words 'proposed to be used' mean a real intention to use, not a mere problematical intention, not an uncertain or indeterminate possibility, but it means a resolved or settled purpose which has been reached at the time when the mark is to be registered". It is therefore contrary to the intention of the Act to allow

an application to proceed on a condition, from the terms of which it is clear that the applicants cannot use the mark on some category of goods in the specification. The Registrar may take unilateral action under Section 33 to have the mark expunged if the condition is not observed.

9-306 In cases where Section 11 objections are properly taken, the Registrar is often pressed by agents to impose, instead of a limitation of goods, a condition of registration. The reason for this alternative is that a condition gives the owner of the trade mark wider infringement rights than a limitation of goods. A condition, however, whilst taking care of the Section 11 objection, undermines the concept of the Ducker's decision referred to above if goods are left in the specification on which use of the mark is clearly not intended.

Where a condition is appropriate

9-307 The most common legitimate use of a condition instead of a limitation of the specification is where the mark indicates geographical origin of the goods. For example, PILOFRENCH for wine, indicating goods of French origin. The objection could be met by a condition that the mark shall be used in relation only to goods the produce of France, since all types of wine eg red, white, sweet, dry, sparkling, may be made in France.

Where a condition is not appropriate

9-308 In contrast, PROSTEEL in respect of "all goods included in Class 6" should not be made the subject of a condition since it could not possibly be used eg in respect of non-ferrous metal ingots which, by their very nature, could not consist of, or contain, steel. Similarly examination staff should not impose a condition for eg PROSCREW for fasteners at large since the mark obviously cannot be used without deception on eg nails or staples. However, a condition is appropriate in respect of PROSTEEL for a specification for "screws".

9-309 One of the leading cases dealing with Section 11 objections is the China-Therm case (1980 FSR Page 21) in which Mr Justice Whitford stated "---- that in relation to articles made of plastic of the kind the subject of the application for registration, the use of these words (CHINA THERM) in this association is going to misdescribe the character or quality of the goods; people are likely to think that goods advertised as CHINA-THERM in the way of cups or containers of any sort are likely to be made of china; and the mere fact that they could be so advertised so that it is made plain that they are not made of china or that upon receipt, in the event of an order being placed

under a misapprehension, it would be ascertained that they were not made of china cannot save the position so far as the applicants are concerned".

[9-310 to 9-330]

Part 5 - Section 14 - disclaimers

9-331 Where a distinctive mark includes within it an element or elements which by themselves are non-distinctive, the Registrar may require the non-distinctive matter to be disclaimed. The purpose of these disclaimers is to make clear to the general public the rights existing in a trade mark registration (Rule 36). Disclaimers can thus serve to assure those not expert at estimating the bounds of infringement rights that if they want to use descriptive and non-distinctive matter, their use is not restrained by registration of that disclaimed matter as part of a particular trade mark. Examples are as follows:-

- Those marks embodying ordinary representations of the goods or devices of ordinary representations of containers within which they are sold - Appendix G.

- Those embodying devices in common use in relation to the respective goods ie non distinctive devices - Appendix H.

- Those embodying individual outsized letters - Appendix J.

- Those embodying separated or out of the ordinary letters - Appendix K.

- Those embodying geographical place names - Appendices L and M.

9-332 Under United Kingdom law, infringement rights go wider than the exact form in which the mark is registered. They extend to deceptively resembling marks. Thus any part of a mark which is merely descriptive or non-distinctive matter may be required to be disclaimed in order to protect the rights of others to use the descriptive or non-distinctive matter without fear of infringement action. In these cases the disclaimer is expressed in the following terms: "Registration of this Trade Mark shall give no right to the exclusive use of <u>the</u> word ....", or of course alternatively "<u>the</u> device", or "<u>the</u> letter", etc. The intention is to disclaim the non-distinctive element actually in the mark. In the cases of elements which are sufficiently distinctive for registration purposes yet clearly derived from non-distinctive matter, eg a representation of the goods or a letter or letters of the alphabet, a disclaimer can ensure that registration rights are limited to the form of the device, etc, in the mark. In such cases the disclaimer is of "<u>a</u> device" or "letter(s)", not "<u>the</u> device" or "<u>the</u> letter(s)". The intention here is

to restrict infringement rights to the particular form of the mark and of course to confusingly similar forms while leaving the ordinary form for use by others. (See Dunhill's application 1982 RPC 145 and Bagots Hutton, 1915 32 RPC 346).

In a composite mark of eg devices of sweets which are themselves non-distinctive but which make up a distinctive whole, the disclaimer should be of "the devices of sweets". If the combination of devices is also non-distinctive as a whole then the disclaimer is of "the device of sweets". (See Tavener Rutledge 1959 RPC 83).

9-333 Whilst the purpose of disclaimers is to inform the public that the Registrar does not intend infringement rights to reside in a particular part or parts of a mark, clearly some parts of marks are so obviously descriptive or non-distinctive that it is superfluous for the Registrar to spell this out by means of disclaimers. For this reason it has been a firm practice for many years not to require a disclaimer in respect of the name of the goods or an unregistrable laudatory epithet such as "good", "best", "super", etc. There are also other descriptive and non-distinctive words and devices which are just as obviously non-distinctive as the aforesaid, and which do not need to be disclaimed. However one exception to this rule is when a mark is specifically limited to colour a disclaimer will be required of any prominent non-distinctive elements of the mark which would not normally be disclaimed eg cartons or containers. The reasoning behind this being that the designation of specific colours to such non-distinctive elements distinguishes them from elements not so marked giving the impression that rights to the non-distinctive element are held in the coloured form. An example of the sort of disclaimer required is as follows: "Registration of this trade mark shall give no right to the exclusive use of the device of [a carton] coloured [yellow and black]". It should be noted that when an obviously unregistrable word forms part of a non-distinctive phrase the whole phrase should be disclaimed eg disclaim "super six" and not just "six" since disclaimer of the latter word may give rise to doubts as to the status of "super".

(a) If the name of the goods is obviously lacking in distinctiveness so also must be an ordinary pictorial representation of them or of their conventional containers and they need not be disclaimed. Examples of unnecessary disclaimers for devices of the goods and containers are shown in Appendix G.

(b) Words which directly characterise the goods by, for example, describing their nature or purpose

will undoubtedly be understood as such and need not be disclaimed. The underlined words in the following examples fall into this category - SKI CONE (for ice creams, etc), LAVAZZA EXPRESSO (for coffee, etc. adapted for use in expresso machines), THE BUCHANAN BLEND (for whisky), ENERGY MUSIC (for goods in Class 16 relating to music), INTERCRAFT CABINET RANGE (for office furniture incorporating cabinets), POLYCELL READY MIX (for ready to use adhesives), CONDER POLLUTION CONTROL (for installations and apparatus for water supply and sanitary purposes), TRAIL SNACK (for food mixtures in Class 29), MINT SYMPHONIES (goods in Class 30 flavoured with mint), SHARWOOD'S TANDOORI (cooking essences, sauces, etc for use in the preparation, flavouring or dressing of tandoori).

(c) In respect of certain goods, some devices are in common use, either in trade marks or general promotional material, and these are clearly not associated with any one particular trader. Where such devices appear in a mark in an ordinary and unfanciful manner, it is inconceivable that anybody would consider the use of such devices could infringe the registration of the mark. Examples of such devices are bottles and glasses in respect of drinks in Classes 32 and 33, cooking utensils and tableware in respect of related foodstuffs, plants and flowers for agricultural or horticultural products, test tubes, flasks and the like for chemicals and pharmaceuticals, vine leaves and grapes for wines and spirit beverages and flame devices for fuels (see Appendix H). Where such devices appearing in marks are in fact out of the ordinary they should be disclaimed and the extent to which they are out of the ordinary will determine the form of the disclaimer. If this extent is insufficient to be clearly distinctive, no infringement rights should be given but if it is sufficient to create distinctiveness, infringement rights should be limited to the device in that distinctive form (see paragraph 9-332).

9-334 It is well established that mere letters of the alphabet are entirely lacking in distinctiveness since it is common for traders to use them as abbreviations of their names or for cataloguing or categorising their goods. Similarly, numerals are used for the latter purposes. Therefore, where letters or numerals appear in a mark in conjunction with a distinctive word or words by way of classification or category identification, and the essential distinctiveness of the mark lies in the word or words,

consideration should be given to the need to disclaim the letters/numerals. The following rules should normally be applied:

(a) Numerals (alone) or up to three unpronounceable letters (alone) following the distinctive part of the mark, eg DEPIL 88, ALUDROX MH, BINAB T, LOBAB XYZ - no need to disclaim the letters/numerals.

(b) Combination of letter(s) and numerals(s) following the distinctive element, eg ROCKET WD-40, DEPIL 8MH, - disclaim the letters/numerals.

(c) Two or three pronounceable letters following the distinctive element, eg BINAB OS, ROCKET MIV: 'OS' is an acceptable Part B mark alone, and 'MIV' is an acceptable Part A mark (see 9-210 and 211). No disclaimer of 'MIV' is therefore required; but for Part A 'BINAB OS' would have to be subject to disclaimer of 'OS', in Part B no disclaimer would be necessary.

(d) Where letters/numerals as in (a) or (b) above appear as the first element of a mark eg P3-almecolor, HP-5 DRIV-FORM or JLW COMPUTRON, or where they appear solely in combination with a device, disclaimers to them are required since they could be claimed or understood to be an essential feature of the marks.

9-335 Where a letter or some of the letters in a word mark are given added prominence in size, a disclaimer of the letter(s) is required only in the cases where the prominence is likely to be understood to be an essential part of the mark. In other words, if the overall effect of the mark is no more than that of the word or words themselves, no disclaimer is necessary. But if the effect of the exaggerated letter(s) is to create a word(s) plus letter(s) mark, a disclaimer of the non-distinctive letter(s) is required. See the examples in Appendix J. Similarly, in marks consisting of letters or words where some of the letters are separated or highlighted in some other way but nevertheless form an integral part of the mark's identity, that is to say the mark will undoubtedly be known and recognised by the totality of the letters in it and not by its separate parts, the registration will not be subject to any disclaimers. Examples of such marks are given in Appendix K.

9-336 It has been the practice in the past to disclaim a missing letter when a device appears in lieu of that letter in a word mark. The purpose of this was to indicate the mark has been treated as a word mark and not merely a combination of letters and the device. Such disclaimers do not serve any other purpose since the letter does not exist for infringement rights to be claimed in it. If the registry understands such marks to be essentially word marks it is reasonable to assume the majority of the public will also see them as such and no disclaimer is therefore necessary. If, however, the device in such cases is non-distinctive in the context of an application, a disclaimer of the device may be necessary: but if it is a mere representation of the goods, paragraph 9-333(a) above will apply.

9-337 Unregistrable geographical place names which appear in marks and which, by reason of their position or prominence therein, will undoubtedly be understood to be indications of the location of manufacture or of the owner and not of trade mark significance need not be disclaimed - examples of such marks appear in Appendix L. But where such a place name is, or might be interpreted to be, an essential part of a mark as in CALIFORNIA VOGUE, ACAPULCO JOE, MAXIM'S DE PARIS or as in the examples in Appendix M, they must be disclaimed.

9-338 Marks which contain words which are not distinctive by themselves but are combined with other words to form a recognisable corporate unity which is distinctive when used in relation to the goods of an application, should not attract a disclaimer of the non-distinctive word since the essential character of the mark lies in the combination of words. The underlined words in these examples have been unnecessarily disclaimed in the past - <u>HIT</u> & RUN, <u>SIX</u> GLENS, <u>LORD</u> OF THE RINGS, KISS AND <u>MAKE UP</u>, <u>BIRDS</u> OF PARADISE and MILL <u>HOUSE</u>. It must be emphasised, however, that the combination of words must form a sensible and recognisable whole to avoid a disclaimer of the non-distinctive word.

9-339 <u>Disclaimers will therefore be required of the following</u>:-

(a) a prima facie non-distinctive element, but one which is not a priori unregistrable by itself, appearing in a composite mark in a manner which might be interpreted as of trade mark significance (except where that element in combination with another creates a unified corporate distinctive whole (see paragraph 9-338) or where that element is lost in the overall identity of the mark (see paragraphs

9-335 and 338);

(b) a mis-spelt non-distinctive word, to ensure the mis-spelling is not understood to be a registrable or distinctive feature;

(c) a slightly unusual representation of a totally non-distinctive device (eg of the goods or their containers) requires a disclaimer to <u>the</u> device and a distinctive device which is clearly derived from a non-distinctive device requires a disclaimer to <u>a</u> device to limit the infringement rights;

(d) a distinctive device which is clearly derived from a letter or letters of the alphabet, except where this is a monogram or consists of elided letters, should carry a disclaimer to <u>a</u> letter or letters to limit the infringement rights;

(e) a geographical place name or adjectival form of that place name which does not fall within the de minimis rules or is clearly not non-trade mark matter as defined in paragraph 9-337.

9-340 <u>Disclaimers on applications proceeding by virtue of distinctiveness acquired through use</u>

Marks coming under this heading form a separate category in respect of disclaimers. If a mark contains an element which is a priori unregistrable, eg obvious laudatory epithets and geographical place names forming an essential part of a mark, doubts may arise about the status of that element if the application proceeds on the basis of acquired distinctiveness. A disclaimer of that element is required in order to make clear that the registered proprietor of the mark has no exclusive right to it other than in the particular mark. However, there is still some matter which must be regarded as being totally non-distinctive and not the exclusive property of any one trader, eg the names of goods, ordinary pictorial representations of goods and commonly used containers for them, and words commonly used in descriptions of goods (such as ELECTRIC in the mark LEWIS ELECTRIC for electrical goods, HOMES in the mark LIFE STYLE HOMES for dwelling houses, CONTROL in the mark JOHNSON CONTROL for control apparatus and instruments and KIT in the mark ADVENTURE KIT for toys and playthings, all sold in kit form). Disclaimers of these are therefore unnecessary.

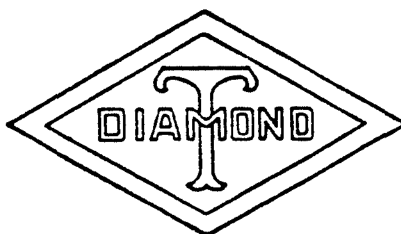
9-341 Those applications for marks which contain

mis-spelt words which are phonetically identical to the name of the goods or to a word totally descriptive of the goods, as the word ROOTA in BIO ROOTA (for rooting compounds) must be subject to a disclaimer of that word.

9-342 Where a device of any container of the goods appears in a mark of an "evidence" case and the device is no different from an ordinary representation of a container, clearly no rights in the device can be claimed from a registration and a disclaimer is unnecessary. If, however, the device is a representation of an out of the ordinary container a disclaimer to a device of a container should be entered on the register to limit any infringement rights likely to stem from the device in the mark.

9-343 Separate disclaimers

Occasionally a mark may consist of a number of features all of which are, individually, objectionable or non-distinctive, but which together form a distinctive combination of features. In such a case all the elements may need to be disclaimed separately. See the Diamond T case (38 RPC 373):



in which disclaimers of a diamond shaped border, the word "Diamond" and the letter "T" were required. Current Registry practice for the wording of a disclaimer of this sort (using the above example) should be as follows:

> Registration of this mark shall give no right to the exclusive use, separately, of a diamond shaped border, the word "Diamond" and the letter "T".

EFFECT OF DISCLAIMERS ON COMPOSITE WORD/DEVICE MARKS

9-344 Composite word/device marks containing disclaimed word elements need to be carefully considered before reaching a decision on whether the mark as a whole, taking into account the disclaimed elements, is acceptable in Part A, or in Part B, or is unacceptable.

The Registrar has in the past taken the view that when one or more words needed to be disclaimed in a composite word/device mark, the effect was, almost invariably, to relegate the whole mark to Part B at best. The higher judicial authorities have not, on the whole, shared this view and it is not uncommon for them to direct registration of a mark in Part A even when it is subject to disclaimer of fairly prominent non-distinctive matter (see, for example, the "Mackenzie" case, 1967 RPC 268).

The practice has therefore been revised and is now as follows:

Marks acceptable in Part A with disclaimers

9-345 Where the disclaimed element is relatively small, so that the distinctive element is still predominant, not just in mere physical size but in its overall visual impact, the mark may be accepted in Part A. As a rough guide, the following factors should be considered, but cannot be applied rigidly - the decision on any particular mark is always a subjective one:

i. the distinctive element should be the one which catches the eye first and holds the attention. Thus it helps if it is placed above, or to the left of, the disclaimed element(s) but this is not conclusive in itself.

ii. the disclaimed element(s) should not be too large in relation to the rest of the mark - as a rough guide, the physical length of any disclaimed words should not exceed the width of the device, but the height and boldness of the lettering need to be taken into account: "Britain feels better for it" in small lettering is far less prominent than a shorter word like "NATIONAL" or "GOLD" expanded to fill the same space.

iii. the more obviously non-distinctive the disclaimed element is, the less damaging it may be to the mark as a whole, because the public would be expected to realise that no trade or service mark rights would exist in very common words or phrases, eg "24 hours", "International", "Colour".

iv. where the distinctive element is a well-known mark, ie a "household name", or where it is a mark which has been registered on the basis of strong acquired distinctiveness through

extensive use, it may be considered more capable of supporting a composite mark containing a relatively large or prominent amount of disclaimed material, because the public are familiar with that part of the mark already and it will necessarily catch their attention all the more.

v. whether the distinctive element is particularly striking.

Marks acceptable in Part B with disclaimers

9-346 Where the disclaimed element is more prominent than as outlined in 9-345 it may be difficult to decide whether the mark is acceptable in Part B or whether it should be rejected altogether. As a rough guide, the following factors may preclude acceptance in Part A whilst still allowing acceptance in Part B:

i. the disclaimed element is placed above, or to the left of, the distinctive element and has a visual impact almost equally as strong as that of the non-disclaimed elements.

ii. the disclaimed element, even though positioned below or after the non-disclaimed element is visually very prominent and tends to attract the attention equally.

iii. the disclaimed element does not consist purely of descriptive or non-distinctive words and there is a danger that it may be seen by the public as trade or service mark material in itself, eg mis-spelled words or elided words.

iv. (obviously) the non-disclaimed element is, in itself, not particularly strong.

Marks unacceptable even with disclaimers

9-347 Where the disclaimed element is visually overpowering and draws the attention right away from the non-disclaimed elements, objections should normally be raised under sections 9 and 10. There may, however, be some instances (like those mentioned in 9-345 (iii) above) where such an element may, because of its obvious non-distinctiveness, be almost certain not to be seen as an essential or protected element of the mark and it may still be possible to accept the mark as a totality in Part B.

Hyphenated words and disclaimers

9-348 It is clear that the hyphen's main purpose is to form a word. Any hyphenated word appearing as a trade mark could, therefore, be treated as one word, provided there is no obvious misuse of the hyphen merely to obtain rights in some otherwise disclaimable element. For example, the word OPPORTUNE is one word, and there is no legitimate reason for it to have a hyphen. A music publisher seeking to register OPPOR-TUNE might, therefore, come under some suspicion.

In most other cases a hyphenated word, being by definition one word, need not have any of its components disclaimed.

The mark should be assessed as a totality and if the presence of the hyphen makes little or no difference to pronunciation it will not normally be necessary to ask for a disclaimer unless the mark is presented visually as two clearly differentiated elements. For example, BI-TIX should be treated as though it were BITIX and therefore acceptable in Part A as an invented word. But if the letters "BI" were much more prominent than the rest (eg in heavier type or in a different colour), making the mark effectively two words, the mark would then consist of one Part A element ("TIX") and one Part B element ("BI"); therefore, it could proceed in Part B without disclaimer, whereas in Part A a disclaimer of "BI" should be requested.

9-349 Again, a mark may consist of hyphenated elements which may be unacceptable as separate marks but which, while not reading through as one word in the normal sense, combine to form an acceptable mark within Part A or Part B. In such a case, disclaimer of the separate elements may well be necessary, eg BRI-FON.

9-350 If the hyphen merely links separate, unpronounceable elements such as XYZ-ABC neither of which are acceptable on their own, prima facie, then disclaimer of the separate elements should be requested (see also 9-334).

[9-351 to 9-360]

Part 6 - Marks requiring particular consideration

Rule 15 - Marks subject to statutory restriction

9-361 Rule 15(1) requires the Registrar to refuse an application for any mark on which appears any of the following:

(a) any emblem, designation, design or wording if the use thereof by the applicant would be an offence contrary to section 6 of the Geneva Conventions Act 1957 (use of Red Cross and other emblems), or

(b) the Royal Arms, or Arms so nearly resembling them as to be calculated to deceive, if the use thereof by the applicant would be an offence contrary to section 92(2) of the Patents Act 1949, or

(c) the word "Anzac" if the use thereof by the applicant would be an offence contrary to the "Anzac" (Restriction on Trade Use of Word) Act 1916.

Rule 15(2) gives the Registrar discretion to refuse, or to accept subject to suitable limitation, condition, etc, marks containing items confusingly similar to those covered by Rule 15(1)(a)(b) and (c).

Prohibition on the use of crosses, crescents, and other emblems

9-362 Rule 15(1)(a) prohibits the registration of trade marks consisting of or including the words 'Red Cross' or 'Geneva Cross', and representations of the Geneva and other crosses in red, or of the Swiss Federal Cross in white on a red ground or silver on a red ground, or such representations in a similar colour or colours. This Rule reflects the prohibition on the use of such words and devices now included in the Geneva Convention Act of 1957. The Act also recognised the United Kingdom's obligations to give similar protection to other symbols adopted by Moslem countries for purposes akin to the Red Cross emblem.

9-363 Section 6(1) of the Geneva Conventions Act 1957 provides "it shall not be lawful for any person, without the authority of the Army Council, to use for any purpose whatsoever any of the following emblems or designations, that is to say -

(a) the emblem of a red cross with vertical and horizontal arms of the same length on, and

completely surrounded by, a white ground, or the designation 'Red Cross' or 'Geneva Cross';

(b) the emblem of a red crescent moon on, and completely surrounded by, a white ground, or the designation 'Red Crescent';

(c) the lion emblem in red on, and completely surrounded by, a white ground, that is to say, a lion passing from right to left of, and with its face turned towards the observer, holding erect in its raised right forepaw a scimitar, with, appearing above the lion's back, the upper half of the sun shooting forth rays, or the designation 'Red Lion and Sun'."

9-364 Section 6(2) of the same Act provides it "shall not be lawful for any person without the authority of the Board of Trade (now the Secretary of State), to use for any purpose whatsoever:-

(a) any design consisting of a white or silver cross with vertical and horizontal arms of the same length on, and completely surrounded by, a red ground, being the heraldic emblem of the Swiss Confederation, or any other design so very nearly resembling that design as to be capable of being mistaken for that heraldic emblem;

(b) any design or wording so very nearly resembling any of the emblems or designations specified in the foregoing subsection as to be capable of being mistaken for, or, as the case may be, understood as referring to, one of those emblems."

Insofar as trade marks are concerned, registration requires the authority of the Board of Trade under Section 6(2).

Trade mark effect of Section 6 of Geneva Convention Act 1957

9-365 (a) Devices. The use as a trade or service mark (or as part of a trade or service mark) of the device of an emblem as defined in Section 6 of the Geneva Conventions Act, 1957 or of a device so very closely resembling that emblem as to be likely to be confused with it, is an offence if that use is in the stated colour or colours, or in a colour or colours likely to be confused with them.

(b) Words. The use as a trade or service mark (or as part of a trade or service mark) of the words "Red Cross", "Geneva Cross", "Red Crescent", "Red Lion and Sun" or any words so very nearly resembling those words as to be capable of being understood as referring to a prohibited emblem is an offence.

Practice for carrying out Section 6 of the Geneva Convention Act 1957

9-366 The Geneva Cross

The practice is governed by Section 11 and Rule 15(1)(a) and is as follows:

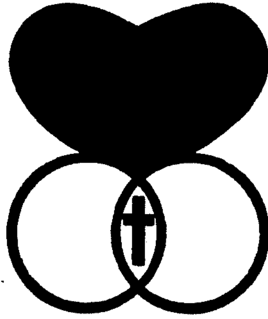
(a) No mark may be accepted if it consists of or features prominently any cross device which is the same shape (or is likely to be confused with the Red Cross or Swiss Federal Cross and is in red or any closely resembling colour, or if the cross device is a separate element and/or highlighted in the mark. If it is part of an overall pattern or is incorporated into a device or is part of a shield device then an objection should not be raised.

(b) A rough guide to decide whether a cross device is similar in shape to the Geneva Cross is that the upright should be vertical and the shaft horizontal so that all four arms appear to be rectangular and of equal length, with the dimensions of the arms being such that their length is no greater than 3 times their width or their width is no greater than 3 times their length. A condition of registration must be imposed to read:-

> "It is a condition of registration that the mark shall not be used with the cross device appearing thereon in red, or in white, or silver on a red ground, or with the cross device or ground in, or of, any similar respective colour or colours."

The condition is unnecessary if the cross device forms a negligible part of a composite Mark.

Examples of marks in which a cross condition is not considered necessary are:



No 1157147
Journal 5512 Page 1132

No B1165469
Journal 5506 Page 694

No 1142728
Journal 5506 Page 684

(c) Marks consisting of or containing the words "Red Cross" or "Geneva Cross" may not be accepted.

(d) If the mark consists of or contains a cross other than those described above, no objection under Rule 15 should be raised nor should a cross condition be imposed. However, the device may be open to objection under other rules or Sections of the Act.

9-367 Sections 11 and 17(2) and rule 17 give sufficient power to refuse the registration of state and International inter-governmental body emblems, and the words or emblems (or any device or words likely to be mistaken for them) mentioned in paragraph 9-363 above. So far as the emblem described in subsection 6(1)(b) of the Convention is concerned, no objection would arise if a crescent moon device appeared in the mark as a subsidiary feature, eg, as part of a general scene or landscape, but if the crescent moon device were given any degree of prominence, so that the mark as a whole would be likely to be confused with, or to resemble, the emblem in question, it will be necessary to consider the propriety of making it a condition of registration to be inserted on the Application Form in the following terms:-

> "It is a condition of registration that the mark shall not be used with the crescent moon device in red or in any similar colour".

<u>Prohibition on the use of the Royal Arms and similar emblems</u>

9-368 Rule 15(1)(b) prevents registration of marks containing the Royal Arms, or Arms which are so close to them as to be calculated to deceive, if their use by the applicant would be an offence under Section 92(2) of the Patents Act 1949. Conventional representations of the Royal Arms are shown below:

The Royal Arms

The Royal Arms as used in Scotland

Section 92(2) of the Patents Act 1949 reads as follows:-

> "(2) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling or profession the Royal Arms (or Arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, then, without prejudice to any proceedings which may be taken against him under section sixty-one of the Trade Marks Act, 1938, he shall be liable on summary conviction to a fine not exceeding twenty pounds:
>
> Provided that this section shall not affect the right, if any, of the proprietor of a trade mark containing such Arms to continue to use that trade mark."

Use of the word 'Anzac'

9-369 Under Rule 15(1)(c) the Registrar must refuse any application for a mark on which the word 'Anzac' appears, if such use of the word would be an offence under the "Anzac" (Restriction on Trade Use of Word) Act 1916. Briefly, such an offence is committed if the word "Anzac" is used in connection with any trade, business or profession, without the authority of a Secretary of State.

Rule 16 - Marks requiring particular consideration

9-370 Rule 16 in effect puts the Registrar on notice that certain words and devices require careful consideration before being accepted as trade marks or as parts of trade marks. The actual wording is "The Registrar shall consider whether to refuse an application "[if any of the stated items appears on a mark]. In practice, such marks should be objected to, prima facie, and it will be for the applicant to convince the Registrar, by any appropriate means, that registration should be allowed.

The wording of Rule 16 is as follows:

> "Marks requiring particular consideration
>
> 16 The Registrar shall consider whether to refuse to accept an application for the registration of a mark on which any of the following appear:-
>
> (a) representations of the Royal crests or armorial bearings or of insignia or

devices so nearly resembling any of them as to be likely to be mistaken for them;

(b) representations of the Royal crown or of the Royal or national flags;

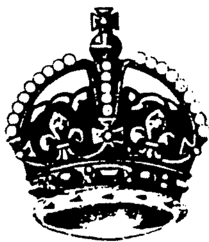
(c) representations of Her Majesty or any member of the Royal Family or any colourable imitation thereof;

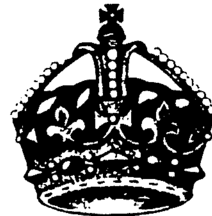
(d) the use of any words, letters or devices in such a manner as to be likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation;

(e) any word or words the false use of which would be capable of being an offence contrary to section 35 of the Registered Designs Act 1949 (false representation of design as registered) or section 110 or 111 of the Patents Act 1977 (unauthorised claim of patent rights or that patent has been applied for);

(f) any word or words suggestive of copyright or similar protection or suggesting that trade mark infringement is a criminal offence."

9-371 So far as (b) is concerned, conventional representations of the Royal crown are shown below for ease of reference:





9-372 In cases where the mark includes a device of the Royal Crown or a closely resembling device, it may be necessary to consult with the Royal Warrant Holders Association as to whether the degree of similarity justifies objecting under Rule 16. The removal of the orb and cross from the top of the crown is usually sufficient to overcome objection.

9-373 Regarding paragraph (d), the dictum of Mr Justice Buckley in the Royal case (1961 RPC 84 at page 92 lines 33-50) suggests that we would not be justified in assuming as a matter of course that the word ROYAL also necessarily implies Royal patronage. The judge took the view that when applied to articles the word "Royal" would convey to the ordinary person the laudatory idea of pre-eminence or excellence in a particular sphere. He based this on the definition of 'Royal' in the Oxford Dictionary. Even so, it may be that for certain goods which might be said to be associated with the Royal Household an objection under Rule 16 would be justified. However, the observations give authority for objecting to "Royal" as a laudatory and descriptive term under Section 9(1)(d) and Section 10 and the question of raising a Rule 16 objection might only arise when the evidence of user is considered.

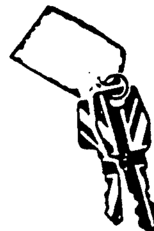
9-374 From the above it follows that we must continue to object <u>prima facie</u> to the word "Royal" alone (and closely similar words, eg "Royale") which should only be registered upon evidence of distinctiveness, as "Royal" for typewriters. Combinations such as "Royal Stag", "Royal Flush", etc, which have a well defined meaning of their own, will continue to be accepted in Part A as in the past. Combinations in which the word "Royal" is carried by another registrable word or device, eg "Rayburn Royal", "Royal Hartex", can be accepted on a disclaimer of the word "Royal". Where, however, the other feature of a "Royal" combination mark is a descriptive word, surname or other unregistrable term or device, the mark as a totality should be objected to, <u>prima facie</u>, under Sections 9 and 10. For example the Registrar could not accept "Royal Foam" for foamed plastics materials or "Royal McLeod" for whisky. Combinations that imply royal patronage should be objected to under Rule 16 and Section 11, apart from other sections of the Act. "Royal Balmoral" would be objectionable on that score, and "Royal Chef" for foodstuffs would probably suggest that the goods were used by the Royal Household Chefs. There are occasions when Royal patronage is granted, for instance by Royal Warrant. In such circumstances an application can proceed only on evidence of user with an appropriate condition. See for example QUEENS OWN, application No 659806 Journal No 3782, page 955. The condition in that case was:-

> "It is a condition of registration that the applicants undertake that if, at any time, they or their successors in title cease to hold the Royal Warrant they or their successors in title will make application forthwith to cancel the registration of this trade mark".

9-375 So far as national flags are concerned (paragraph (b)), in the UK these consist of the Union Jack and the blue, white and red, ensigns. Where a mark consists of, or incorporates, a device of the Union Jack (or ensigns) in the normal colours, or closely resembling colours, then it clearly falls within the scope of Rule 16. So too do representations of the Union Jack (or ensigns) in black and white in a half tone and also in black and white only. Strictly speaking a mark represented in black and white should be assumed to embrace the use of that mark in any two colours and no more (1968 RPC 98 - "of course, one is not confined to the representation of the mark in the application, one can envisage any part of the mark as being in any colour") but a black and white representation of the Union Jack clearly falls within the scope of Rule 16 since it is a "representation".

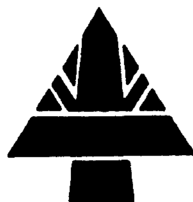
9-376 Under the predecessor to the present Rule 16, there was an absolute prohibition of such flags in marks, but the present Rule merely requires the Registrar to "consider whether to refuse". However, under Article 6 ter of the Paris Convention, the Registrar must refuse to register (inter alia) the flags of other countries of the Union. Paragraphs 9-391 et seq explain this in more detail. In practice, where the flag device is prominent and un-stylised, objection should be raised. In the following examples, the first would be considered unacceptable because of the plain Union Jack present on the key "tag"; if this is removed, as in the second example, the mark is acceptable:-

Unacceptable

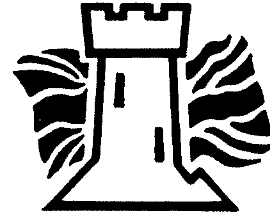


Acceptable

Very stylised representations based on the Union Jack may nowadays be acceptable prima facie in Part A, such as the following:



9-377 Stylised representations forming part of an overall distinctive mark may be accepted in Part A, prima facie, without disclaimer, as in the casesbelow:



Plain representations of the Union Jack or other flags, provided they form a small element of a mark which would in any event be distinctive even without the "flag" element, may remain in marks but should always be disclaimed. Consideration should also be given to the implications of section 11 - for instance the presence of a Union Jack would certainly be taken to indicate British origin, and the specification should be limited to reflect this, and similar action should be taken on other national flags.

9-378 Illustrations of the flags of various nations are to be found in Webster's Dictionary and the "Guide to the Flags of the World", a copy of which is kept in the Training Section library.

Non-trade mark matter

9-379 The Registrar usually takes the view that non-trade mark matter which falls into the categories set out below should be removed from the the mark so that the essential features of the mark are not muddied. Each case must, however, be considered on its medrits;

(a) statements of indications as to the price of the goods, nett weight, ingredients etc;

(b) printers; markings or printers' or artists' names and addresses;

(c) directions as to use of the goods;

This sort of detail is often ephemeral and as such it is in the applicants' own interest to delete it.

Matter to be justified or removed

9-380 If the mark contains such statements as, eg "Established 1871" or "Founded in 1750", or if it includes

representations of exhibition awards or medals, or statements about the award of medals or diplomas, the applicant must be asked to justify such statements, awards, etc by confirming the facts about them in a Statutory Declaration. If the statement is retained in the mark it is not disclaimed since no trade mark rights could possible exist in it. If such features cannot be justified they should be removed.

[9-381 to 9-390]

Part 7 - Marks protected under Article 6 ter of The International Convention - introduction

9-391 Under Article 6 ter of the International Convention for the Protection of Industrial Property, as revised at Lisbon in 1958, the United Kingdom is under an obligation, _inter alia_, to refuse or to invalidate the registration, and to prohibit the utilisation without authorisation by the competent authority, either as trade marks or as elements of trade marks, of:-

(a) the armorial bearings, flags or other State emblems of the countries of the Union, which includes most of the major countries of the world, (and of which a list is held by the Industrial Property and Copyright Department), the official signs and hallmarks indicating control or warranty adopted by them, and all imitations thereof from a heraldic point of view. Emblems of such member states of a Federation such as the Swiss Cantons are regarded as State emblems, but mere national colours, as such, as distinct from those colours when shown in the form of a state flag or other State emblem, are not regarded as entitled to protection. The protection afforded as regards official signs and hallmarks is more limited, since it applies solely in cases where the marks which contain them are to be utilised for the same goods or class of goods;

(b) the armorial bearings, flags, or other emblems, abbreviations or titles of international inter-governmental organisations, of which any country of the Union is a member, unless the use or registration is not of a nature as to suggest to the public that a connection exists between the organisation concerned and the armorial bearings, etc, or is clearly not of a nature to mislead the public as to the existence of a connection between the user and the organisation.

9-392 By the joint effect of sub-paragraphs (5) and (6) of Article 6 ter:-

(a) State flags are prohibited.

(b) Other material in paragraph 9-391, and all material in paragraph 9-392 is prohibited as from two months after its notification to the

Registry for protection through W.I.P.O. and any objection by a country of the Union must be made within 12 months from the receipt of notification.

9-393 Notification of the emblems etc, which a country or international inter-governmental body desires to protect is made through W.I.P.O. and any objection by a country of the Union must be made within 12 months from the receipt of the notification.

List of flags

9-394 Illustrations of the flags of various nations are to be found in Webster's Dictionary and "Guide to the Flags of the World" a copy of which is kept in the training officer's library. See also paragraphs 9-375 to 9-377 on Union Jacks.

Journal notice of protected emblems etc

9-395 Representations of the emblems etc for which protection is sought are not reproduced in the Journal since these are invariably in colour. A notice is nevertheless inserted in the Journal stating where they can be seen.

Records of protected emblems etc

9-396 Material notified under paragraphs 9-391 and 9-392 is deposited in a special record kept in the Science Reference library for consultation by the public. Entries are also made in the appropriate search indexes, both in examination units and in the public search room. Full particulars of such material are also held in the Manchester branch. Examples of material notified are the emblems and titles of the World Health Organisation and the International Olive Oil Council. The procedure for dealing with applications by international inter-governmental bodies is set out in IPCD file number 37714.

Refusal of protected emblems as trade marks or parts thereof

9-397 Under Article 6 ter the Registrar is required to prohibit registration, and for this, Section 11 and Rule 17 together with the Registrar's discretionary powers of refusal are used. As regards marks which resemble a protected emblem the degree of similarity must be very high to justify refusal. Regard must be had to the fact that the question of imitation is one to be determined from an heraldic point of view and that the prohibition of Article 6 ter applies only in the absence of an authorisation by the competent authorities.

Marks consisting of or containing the words MAPLE LEAF

9-398 Marks consisting solely of the words MAPLE LEAF are not acceptable. See application number 581,336 which was refused after correspondence with the Canadian Government. Marks incorporating the device of a maple leaf may be acceptable if:-

(a) the applicant is domiciled in Canada;

(b) the applicant possesses a registration of the mark in Canada covering all the goods applied for;

(c) a condition to use the mark in relation only to goods the produce of Canada is imposed; and

(d) exclusive use of the device of a maple leaf is disclaimed. (See for example application number B995628 which was advertised in Journal No 5134 on Page 109).

All four criteria must be met. Similar considerations apply to other well known national symbols such as the Shamrock for Ireland.

[9-399 to 9-420]

Part 8 - Marks consisting of or including coats of arms or heraldic crests

9-421 Rule 17 requires that where a representation of armorial bearings, insignia, etc etc appears on the mark the Registrar shall consider whether to refuse to accept an application for registration unless the consent of the owner is given. The word "representation" goes wider than an identical reproduction but in practice objection is only taken in respect of identical representations or virtually identical representation. Heraldic devices are probably incorporated in marks to give an up-market impression and it seems likely that the public does not distinguish by the heraldic device even though it may be an essential element of the mark in trade mark terms. In practice the public will probably distinguish by another element - especially a word element. In the following mark the distinguishing feature in the market place will almost certainly be PALL MALL.

The position will be different, of course, if the heraldic device is the only distinguishing feature.

Composite marks incorporting heraldic devices

9-422 (a) If the heraldic device is obviously a fanciful device as in the following mark:

search the Register in the usual way.

(b) If the device appears to be a proper coat of arms or heraldic crest, ask the applicant for the derivation of the device:

i. if the reply is that it is invented or fanciful and is owned by the applicant, accept the assurance at face value and take no further action, in the knowledge that in practice other matter will distinguish,

ii. if the reply is that it is someone's coat of arms etc (other than the applicants') ask for the consent of that person and refuse the application if the consent is not forthcoming.

Marks in which heraldic device is sole distinctive element

9-423 (a) If the heraldic device is obviously fanciful, search the Register in the usual way.

(b) If the device appears to be a proper coat of arms etc refer to the Garter Principal King of Arms (or the Lyon King of Arms in the case of Scottish residents) using the appropriate standard letter for his opinion whether the use of the mark would infringe the rights of any proprietor of arms recorded in his Register:

i. if the advice is that the device as a totality is identical, or very nearly so, to an existing coat of arms, obtain a copy from Debrett's Peerage or Bowtell's Heraldry in Training Section or from the "Kings". If the examiner agrees that the arms are identical or virtually so, then an objection should be taken. Consent of the owner will overcome objection.

ii. if the advice is that eg the top left hand quarter is similar to this, and the bottom right quarter resembles that, take no action.

The Garter King is on record as saying that what might appear to the public as completely different devices may be very similar to the trained heraldic eye. The test the Kings adopt is that of the grant of a new coat of arms, which is not necessarily the same as the trade mark test of confusion.

Objection to coats of arms, crests etc

9-424 The only ground upon which the Registrar is

entitled to object to a mark containing a heraldic emblem is that the emblem is identical to a recorded crest or coat of arms (apart of course from the operation, eg of Rule 16 or of Sections 9 and 12). If Garter King or Lyon King reports, in any particular case, that the emblem in question does <u>not</u> resemble any recorded crest or coat of arms, then there is no bar, so far as the Act is concerned, to the registration of the mark on heraldic grounds. It will often be found, however, that Garter King will express the view that the heraldic emblem "resembles an emblem owned by "so and so" and that the trade mark ought therefore not to be allowed". The fact that it merely <u>resembles</u> (but is not <u>identical</u> to) an emblem owned by "so and so" does not constitute a ground on which the Registrar can validly refuse to register such a trade mark since only the bearings etc themselves are barred. Objection could only be taken to non-identical device marks, which so nearly resemble bearings etc that they would be taken as a "representation" of the bearings.

[9-425 to 9-440]

Part 9 - Miscellaneous

Portraits or personal names in a mark

9-441 Where it proves upon enquiry of the applicant that a mark consists of or includes a representation or name of a living person, or of a person recently deceased, the terms of Rule 18 apply. The written consent of the person, represented or named, should be obtained or in the case of a person recently deceased written consent from that person's legal representatives. If the representation is that of a child, the consent of the parent or guardian should be furnished. In addition, where appropriate, the following statement should be entered by the applicant on the application form "The portrait appearing in the mark is that of ....".

Buildings in a mark

9-442 If a building is depicted in a mark, the applicant should be asked to state whether he owns the building in question and, if he does not, to furnish the written consent of the owner of the building to the registration of the mark. A statement in the following terms is included in the advertisement of the application in the Journal:- "The building represented in the mark is the property of ......" (the applicant, or as the case may be).

If consent is not forthcoming then an objection should be taken in the exercise of discretion under Section 17 and also under Section 11 if appropriate. See the statement of grounds issued in respect of the mark "MANSION HOUSE" under Nos 1088121-2. Similar objections arise to the name of buildings as to pictorial representations of them. This practice applies to all UK buildings in respect of all goods and services but insofar as foreign buildings are concerned, only in respect of tourist films and videos and printed matter and photographs falling within classes 9 and 16, and tourist services within classes 35, 39 and 42. In a composite mark a disclaimer of the name or representation of the building will not obviate the need for consent in the exercise of discretion under Section 17.

Marks in foreign characters or in a foreign language

9-443 In cases where the mark consists of or contains a word or words in foreign characters, or consists of a word or words in a foreign language, the terms of Rule 30 apply. It is essential that the meanings of words of this kind should be known before examination and the departmental translation service may be asked to supply a transliteration and translation of any word or words shown if the meaning of the character or words cannot be found from the dictionaries

available in the Registry.

TRANSLITERATION AND TRANSLATION CLAUSES

9-444 In the interests of consistency the standard wording shown below should always be used unless it is inappropriate, and then a special clause should be drafted to suit the circumstances.

9-445 Marks containing foreign characters

When a mark consists of or contains a word or words in foreign characters eg Chinese, Rule 30(1) does not permit the Registrar any discretion in the requirement for a transliteration and translation clause.

If the foreign characters can be transliterated and do have a meaning the following wording should be used:

(a) if forming only part of a mark:

"The transliteration of the [Chinese] characters appearing in the mark is .... meaning ...."

(b) if the mark consists entirely of foreign characters:

"The transliteration of the [Chinese] characters of which the mark consists is .... meaning ...."

If the foreign characters can be transliterated but have no meaning the following wording should be used:

(a) if forming only part of a mark:

"The transliteration of the [Chinese] characters appearing in the mark is .... which has no meaning"

(b) if the mark consists entirely of foreign characters:

"The transliteration of the [Chinese] characters of which the mark consists is .... which has no meaning"

Finally, if upon transliteration the foreign characters are merely found to be the name of the applicant company, the following wording should be used:

"The transliteration of the foreign characters

appearing in the mark is .... which is the name of the applicant company"

9-446 Foreign words

When a mark consists of or contains foreign words the Registrar has a discretion whether or not he requires a translation clause. In practice, a translation clause should normally be requested unless the foreign words concerned are so well known that their meaning is likely to be understood by the majority of people. The following sets out the standard wordings.

If the mark consists only of a foreign word or words the following wording should be used:

> "The mark consists of a [French] word meaning ...."

If however the word or words form only a part of a mark the following wording should be used:

> "The [French] word appearing in the mark means ...."

In rare instances the word or words may be found to be a transliteration of a word from a language formed of characters. In such instances the following wording should be used:

> "The word appearing in the mark is the transliteration of [Chinese] characters meaning ...."

9-447 No action is taken on marks which contain or consist of hieroglyphics purporting to be foreign characters but which upon examination are found to be fictitious and without meaning.

Phonetic spelling of letters

9-448 In the past examiners have sometimes overlooked the phonetic spelling of letters in foreign calligraphy. An example of this was the mark ΦOTOFORM which was read as being IOTOFORM and the Greek PHOTOFORM aspect was overlooked ("Φ" in Greek represents PH). It will be realised that in this particular case, when the mark was read as IOTOFORM throughout the examination, the Section 9, 10, 11 and 12 objections which would arise under PHOTOFORM could quite easily be missed (and in fact were). Examiners should, therefore make themselves familiar with the Greek and Cyrillic alphabets and make suitable enquiries when foreign characters appear in a mark.
[9-449 to 9-479]

Marks comprising a number of separate panels

9-480 Only those panels which contain matter of a trade mark character should be allowed to remain in the mark. In other words, the applicant should be encouraged to remove any panels which only contain purely commonplace descriptive matter, eg descriptions of the goods or directions for use of the goods.

Blank panels or large areas of blank space

9-481 Following the decision of Mr Justice Whitford in the CASTROL case (1972 RPC 531) the practice of the registry as regards conditions of registration governing the insertion of matter in blank panels and other considerable areas of blank space appearing in trade marks was reviewed. The circumstances of the case before Mr Justice Whitford were that Castrol Limited had applied to register a device mark referred to as a "half flash" mark. The "half flash" device incorporated a large blank white space and the hearing officer had considered that the mark had sufficient visual impact to be acceptable in Part A provided the applicants undertook not to use it with any added matter at all, or in Part B if purely descriptive matter was added to the blank space, the reason being that the addition of this matter would diminish the inherent distinctiveness of the device. The applicants were not prepared to accept either of these alternatives as they wished to introduce one of their word trade marks into the blank space when the mark was in use.

Mr Justice Whitford decided that the addition to the "half flash" of one or other of the applicants' registered trade marks would not wholly destroy the distinctiveness of the device, as the hearing officer had considered it would, and he allowed the appeal subject to transfer of the application to Part B and to a suitable condition being formulated to ensure that the mark was not used with any matter in the blank space other than one or more associated trade marks of the applicants with or without wholly descriptive additions. The requirement that the registered marks to be used in the blank space be "associated" with the device is clearly a condition of registration under Section 17(2) to avoid difficulties upon the assignment of the mark applied for. The requirement cannot come within Section 23(2) as identical or closely resembling marks are not involved. The condition for proceeding is as follows (amended as appropriate if the mark is a service mark):-

"It is a condition of registration that the blank space in the mark shall, when the mark is in use in relation to the goods of the present application, either be left vacant or be occupied only by matter of a wholly descriptive and non-trade mark character or be occupied only by one or more associated marks registered in respect of goods included in the specification of the present application with or without the addition of matter of a wholly descriptive and non-trade mark character."

9-482 The learned Judge acknowledged that the effect of the TIME decision (1961 RPC 381) was binding on the hearing officer and confirmed that the Registrar, in deciding on the merits of a mark, should consider the effect of additional matter inserted in a blank space upon it.

9-483 Following this decision the practice regarding composite marks incorporating an obvious blank panel or a large blank space is as follows:-

(a) The mark applied for must be considered firstly from the point of view of overall distinctiveness whether for Part A or Part B. If, as in the Renold Chains case (1966 RPC 487), the mark comprises essentially a blank space or panel embellished with descriptive or non-distinctive matter so as to clearly provide a surround for whatever is inserted in the blank space then _prima facie_ the mark is objectionable.

(b) If the mark as a totality is inherently distinctive because of the novelty of the get-up or pictorial representation, then critical consideration should be given to whether any blank space condition is necessary. If, for example, the blank space or spaces occur because the wording or other features do not fill up the whole of a panel or because the mark comprises an arrangement of geometric shapes or open symbols, it should be accepted without condition.

(c) Blank space conditions governing the addition of descriptive and non-trade mark matter should be imposed only if there is an obvious blank panel which is clearly intended for or invites the insertion of other matter and plays no part in the overall distinctiveness of the mark. The form of wording of the condition to be inserted on the application form is as follows:-

"It is a condition of registration that the blank space(s) in the mark shall, when the mark is in use be occupied only by matter of a wholly descriptive and non-trade mark character".

(d) In cases other than those at (c) above it should be assumed that the mark applied for will be used substantially as it appears on the TM2. It should be possible to distinguish between those marks which, as presented for registration, possess inherent qualities of distinctiveness and those which do not, eg simple geometric shapes.

(e) Hearing officers or section heads must not impose conditions such as that formulated for the Castrol application unless there is a request from the applicant or his agent for an alternative to the ordinary blank space condition referred to in (c) above. A point to be remembered is that conditions for proceeding are requirements of the Registrar, so hearing officers must not be persuaded into imposing a Castrol-type condition (i) if there is no necessity for one or (ii) unless the circumstances are analogous to those of the Castrol application, ie unless it can be and is shown in evidence that the applicants have customarily and for a reasonable length of time in fact inserted in the blank space registered trade marks of theirs for specifications within that under examination. [Evidence was submitted in the Castrol case at appeal stage to show that they had been using registered marks within the flash device for many years. See (1972) RPC page 538 lines 14 to 34.]

(f) It is normal Registry practice not to ask for a blank space condition when a mark is limited to colour

<u>Castrol-type condition</u>

9-484 If a Castrol-type condition is agreed to by a hearing officer or section head, it will be necessary to identify by specific reference in the association clause in the Trade Marks Journal advertisement the registered mark or marks which may be inserted in the blank space, as shown by the evidence; and to prepare a special sheet in the proprietor's name for entry in the Association Register giving the group of marks associated as a condition under Section 17(2) rather than under Section 23(2) of the Act. If an applicant who has obtained registration of a mark subject to a Castrol-type condition subsequently requests

association with that registration of a new application (presumably for a word mark) which would not normally (ie under Section 23(2)) be associated with it, with a claimed specification of goods no wider than that of the "condition" registration, so that he may insert the mark of the new application in the blank space of the "condition" registration, the request should be submitted for consideration by an officer of Grade 7 level, before it is allowed. The insertion of new later marks in the blank space of the "condition" registration should not be suggested to applicants or agents by hearing officers or others.

Line border requirements

9-485 Where the mark consists of two or more features which are not closely integrated, it may not be clear that a single mark is intended. The applicant should be asked to remedy this by adding a line border surrounding all the features or close up the features to give it entity. A line border should also be asked for in respect of any mark consisting of multipanelled labels or a repetitive pattern.

[9-486 to 9-499]

Part 10 - Evidence of use [See also Chapter 12 of this manual] - General

9-500 All that has been said previously relates in the main to the consideration of new (ie unused) marks for registration in Part A or Part B of the register. All marks are first examined on the basis that they have not been used in relation to the goods concerned prior to the date of application, to see whether they are prima facie acceptable for registration.

9-501 Section 9(3)(b) and Section 10(2)(b) of the Act provide, however, that a mark which is not prima facie acceptable for registration in Part A or Part B of the register, may nevertheless be registered if the applicant can prove that it is distinctive in fact, ie by reason of its use in relation to the goods concerned prior to the date of filing of the application for registration or by reason of "other circumstances". The considerations which arise in dealing with a mark which is claimed to have become distinctive by reason of use are set out in Chapter 12.

9-502 Evidence of use is sometimes filed before an application reaches examination stage. In such cases the evidence should be considered in accordance with the guidance in Chapter 12 after the prima facie examination has been completed and a separate letter should be issued with the examination report.

Special Circumstances

9-503 In regard to marks claimed to be registrable by reason of "other circumstances", it is improper to attempt to set down any hard and fast limits to the "other circumstances" which may be held to justify the Registrar in accepting for advertisement a mark which does not otherwise comply with the requirements of registration, since the Act itself lays down no such limits. The question is an entirely discretionary one for the Registrar. But the following paragraphs give examples of circumstances which are generally regarded as sufficient to justify advertisement before acceptance (ABA) by reason of special circumstances.

Cases where ABA special circumstances can be utilised

9-504 If the applicant has the same mark already registered and his new application is in respect of goods of a very closely similar description to those covered by the existing registration, it is probable that the application may by reason of those circumstances be accepted so far as the requirements of Sections 9 and 10 are concerned. Thus, for example, an existing registration in respect of "jams

and syrups" would be regarded as justifying advertisement of the same mark, in the name of the same proprietor, in respect of marmalade and treacle. This is considered to be a normal progression in trade.

Similarly, where a mark has been registered for services, an application to register the same mark for goods which are closely associated with those services should normally be allowed to proceed ABA by reason of special circumstances, and vice versa. For instance, if a mark is registered for carpet shampoos, it would be reasonable to allow the same mark to proceed "ABA special circumstances" in Class 37 for the hire of carpet shampooing apparatus; or if a mark is registered for veterinary services, to allow an application for veterinary pharmaceuticals to proceed in the same way.

9-505 If the applicant has already registered (by virtue of use) a surname in the possessive case (eg MASON'S) the surname itself (ie MASON) could be regarded as acceptable for advertisement in the name of the same proprietor in respect of the same goods as those covered by the existing registration. The converse is also the case; that is to say, a registration of the surname MASON could be held to justify the advertisement of the word MASON'S in the name of the same proprietor in respect of the same goods as those covered by the existing registration. It may be also that if eg MASON was registered and the new mark was MASON COMPAC (the latter word being disclaimable) then a slight widening of the goods could be allowed under special circumstances.

9-506 In any such cases it is assumed that if the public knows a mark in respect of certain goods it will associate that same mark with the same owner in respect of closely related goods. Similarly the public will make the same connection if a known mark is slightly changed in respect of the same goods.

Limitations of Special Circumstances Procedure

9-507 The special circumstances procedure cannot normally be used where both the mark differs and the range of goods is to be extended. In this context, the addition of a disclaimable element would not necessarily affect the identity of a mark - see paragraph 9-505. A registration of a word in plain block type is regarded as enabling the proprietor to use the same word in other forms of type. However, marks registered in fanciful form do not necessarily give rights for marks in plain block type, and such applications cannot normally be accepted without evidence of actual user, whenever there are prima facie objections to the mark. This is a general principle and each case must be considered on its merits. See the MORNY case (68 RPC 55 + 131); and the W + G case (30 RPC 660). If

the stylisation was only slight in the first instance then special circumstances may be used. If a mark is found on first examination to fail to satisfy the requirements of Sections 9 and 10 it is necessary to pay attention to any existing registrations of similar marks by the same applicant in respect of the same or similar goods and to decide whether any of these justify the acceptance of the mark by reason of "other circumstances" as provided by Section 9(3)(b).

Avoidance of "creeping" equities

9-508 Applications accepted by reason of special circumstances cannot normally be used as the basis of further such acceptances. This is to avoid a "creeping" process being used to obtain, by a succession of such applications, registrations of goods or services far removed from those of the original application in respect of which evidence of use was furnished. Examiners should however, take a realistic approach and should avoid being unduly restrictive.

[9-509 to 9-529]

Part 11 - Amendment of mark applied for (submissions)

General

9-530 In cases where an official objection has been taken to the mark, the Registrar (using the discretion granted by Section 17(2) of the Act) allows the applicant to submit simultaneously up to two proposals for amending it with a view to overcoming the objection. The proposed amended marks are examined in the same manner as the original mark. The criteria to be borne in mind when considering whether an amendment to an application can be allowed are substantially the same as those governing a "series" of marks (see paragraph 9-12). Applying this reasoning to amended marks, the question becomes: "Do the original and the proposed altered mark still resemble each other in the material particulars?", and "Does the proposed alteration substantially affect the identity of the mark?". An application for a single mark cannot be amended to comprise a series of two or more marks. After examination the applications are submitted to the hearing officer concerned (if a hearing has been taken); if no hearing has taken place the decision should be taken by the Unit HEO, in consultation with senior officers where this is considered necessary.

No changes are made in the indexes or computer records at this stage - such changes only being actioned when the application Form TM2 is amended.

Amendments not filed simultaneously

9-531 Subject to a hearing officer's discretion, no more than two proposals for modification of the mark are allowed to be submitted for consideration on any one application and they must be submitted at the same time. An applicant who, after having had one proposal declined, proffers a second, or who, after having had two declined, proffers another, should be informed that a fee-paid request should be made under the provisions of Section 42 of the Act to secure the Registrar's preliminary advice - (see paragraph 9-560) and that any claim to registration of further modified marks needs to be made the subject of fresh and separate (fee-paid) applications to be dealt with on their merits.

Consideration of amended mark

9-532 It is important also to note that the amendment of a word mark, which can be allowed for the purpose of overcoming official objections must be such as not to alter the mark to any material extent since rights in such amended marks are back dated upon registration to the date of application. The amendment should not normally exceed

the alteration of, say, two letters in the word or the addition or removal of one letter. Any amendment exceeding this will necessitate a fresh application. The alteration of the initial letter of a word mark should not be allowed as an amendment of the original mark, because a completely fresh search has to be carried out. Non-distinctive matter can of course be removed by amendment without altering the fundamental registrable feature, even if it means deleting more than the accepted two letter maximum.

9-533 Whether an amended mark can be accepted for registration is a matter for judgment by the examination unit SEO concerned or a hearing officer applying the recognised tests of registrability. Sometimes the change of a single letter may completely alter the appearance and phonetic rendering of the original mark. The insertion of hyphens at the normal syllable breaks, however, is unlikely to do this. Such an amendment or a change of letters which still leaves the amended mark phonetically the same as the original, or almost so, do not enable an amended mark to be accepted. Added to this an amendment should not be accepted if it is substantially different from the original mark and requires a wider search. The examination unit SEO concerned or hearing officers should decide on refusal rather than acceptance if they are in doubt about the registrability of an amended mark. Examiners should normally ask for confirmation that an amended mark will be used exactly in the form in which it is to be registered, to avoid cluttering the register with "ghost marks". [See the Nerit case 1982 FSR 72].

9-534 Agents or applicants sometimes submit an additional mark purporting to be a "House Mark" in order to overcome an official objection regarding the original mark. Where it is found that such a submission is not a "House Mark" no further examination should be made. The submission report sheet should be noted as follows:-

> "The submitted mark constitutes a substantial amendment requiring an entirely new search. If your clients wish to pursue the amended mark it will necessitate a fresh application. Of course you are entitled to a hearing in connection with the original mark as filed which, if required, should be requested within two months from this date".

9-535 Marks purporting to be "house marks" and submitted as additions to overcome objections must be registered, <u>and</u> have been applied for at the same time or prior to, the application under consideration. If, however, the "House Mark" is found to be a pending case with an application date not later than the application under

examination, then the submission sheet should be endorsed

"May be accepted when ...." and on the "House Mark" file a "SPECIAL NOTE" should be attached to the minute sheet stating that "When registered bring forward application number .... for action".

Amendment after advertisement

9-536 For many years the practice was to refuse to amend marks after acceptance except to overcome a new objection taken by the Registrar. This practice resulted from a decision in opposition No 11184 contrasting the power of the Court to allow a modification to a mark under Section 18(10) in opposition proceedings and the omission of any such specific power under Section 18(5). It seems anomalous, however, that the Registrar should have power to modify the mark under Section 17(2) before acceptance and alter after registration under Section 35, but not between acceptance and registration. The current practice is therefore to allow amendment under Section 17(7) after acceptance and advertisement provided:

(a) the circumstances leading to the application to modify are explained, and justify the change

and

(b) the modification does not substantially affect the identity of the mark

and

(c) the altered mark is re-advertised for opposition.

Representations of amended marks

9-537 As a general rule, where a mark is to be amended without the necessity of a fresh application, the applicant is required to file fresh representations of the mark as amended for substitution in the application form. It sometimes happens that the mark is in colours and the applicant is unable to supply or would be put to undue expense in supplying representations of the proposed amended mark in the original colours. In such cases the applicant may effect the amendments in the mark in the way most convenient without altering the identity of the mark. For instance, where a statement of the goods or other printed matter is to be deleted from a coloured label it might be open to question whether the blocking out of the words in ink might not introduce into the amended mark a number of

rectangles or other geometrical devices caused by the ink. It is desirable, therefore, that where possible, the colour of the deleting medium should correspond as far as possible with the background of the matter to be deleted. As an alternative, the deletion might be effected by an over-pasting that is so well done as to be reasonably likely to remain permanent. In such a case, however, the over-pasted material should correspond, so far as possible, in colour with the original background; unless, as in the SYLEX marks (eg No 144962, Journal No 3062, page 1499), it is a question of substituting a different feature, for which purpose only three courses are possible, namely new representations, impressions from the camera ready copy (which will ignore the original colour scheme, if there was one) or secure over-pasting.

Amendment by over-pasting

9-538 Amendment of representations by over-pasting should be permitted only if there are special reasons for it, eg in order to preserve colours (which the substitution of an impression in black and white from the Journal representations would disregard) without expense to the applicant for new colour prints. In these cases acceptance should follow only if the over-pasting is well done, and appears likely to last. Mere drawing of ink line or lines through matter to be deleted, leaving the parts easily decipherable, should be discouraged, and fresh representations or effective blocking out should be requested in all such cases with the possible exception of the case of coloured marks mentioned above. On the other hand, in the case of very small and trivial alterations such as the removal of artists' initials, or the word "Registered", or other details which are small enough to be properly deleted by a mere ink line, the applicant may make his own choice. It will be useful to point out to applicants in appropriate cases that, wherever the mark they propose to use differs from the mark on the register, they run the risk of having to prove, in infringement actions, that the marks are sufficiently near to result in deception, for it sometimes happens that traders do not use these "amended" marks as they appear on the register.

[9-539 to 9-559]

Part 12 - Registrar's preliminary Opinion

9-560 Section 42 of the Act provides that any person may apply for the Registrar's advice as to whether a mark is prima facie acceptable for registration under Sections 9 and 10. Such requests used to be made on form TM 29 (and these are occasionally still received) but it is more usual now for requests to be made by letter or telephone call, via the Patent Office Search and Advisory Service (SAS).

9-561 These requests are dealt with as a matter of priority and passed to the Examination Units responsible for the class(es) of goods or services concerned, where examination takes place in much the same way as for any formal application for registration. The opinion given in all cases is a prima facie one; this is to say, it takes no account of any use of the submitted mark which the applicant may claim to have made. In order to be as helpful as possible the Registrar normally gives an indication of any other objections (eg, under Sections 11, 68 or 21) which would be likely to arise if the mark in question were to be formally applied for. A search for conflicting marks under Section 12 is not carried out.

9-562 Any forms TM 29 still filed at the Manchester Branch are passed to the appropriate examination unit via the SAS as above.

[9-563]

Repayment of fees following the Registrar's preliminary advice (this section should be read in conjunction with chapter 21 of this work manual)

9-564 Any person who files a request for the Registrar's preliminary advice as to the inherent registrability of a trade mark and who, the Registrar having expressed a favourable opinion, then files a formal application for registration of that mark within three months after the Registrar's advice is given, may apply for the repayment to him of the fee paid on the formal application if the Registrar, on reconsideration, then objects to the mark under Section 9 or Section 10 as the case may be (the authority for this is Section 42(3) of the Act). See also paragraph 9-565.

9-565 An applicant who desires the repayment of the application fee in the aforesaid circumstances must give

notice of the withdrawal of his application for registration <u>within two months from the date of the notice of the Registrar's objection</u> (Rule 20).

<u>Retention of forms</u>

9-566 When replies are sent the forms are retained in the examination units and attached to any ensuing application. The examiner is not bound by the advice previously given but must have good grounds, which must be stated, for reaching a different decision.

[9-567 to end]

The specifications of goods of these registrations were limited in order to overcome objections taken under Section 11 in respect of materials from which the goods are made. The descriptive elements are either directly so in the Marks or become directly so when the Marks are used in conjunction with the name of the goods. Objections should continue to be raised in similar cases.

CHEFSTEEL

B1,125,849. Shelves, worktops, sink units, and parts and fittings for all the aforesaid goods; all being of steel; articles fabricated of steel; all included in Class 6. BRANDLING METALS LIMITED, Broadcut, Fareham, Hants, PO16 8ST; Manufacturers and Merchants.—19th December, 1979.

KLEBER VINYLPLUS

Date claimed under International Convention, 22nd December, 1978.

Registration of this Trade Mark shall give no right to the exclusive use of the word "Vinylplus".

B1,110,752. Hoses wholly or substantially wholly of vinyl plastics. PNEUMATIQUES CAOUTCHOUC MANUFACTURE ET PLASTIQUES KLEBER-COLOMBES, (a Societe Anonyme organised under the laws of France), 6 Avenue Kleber, Paris 16e, France; Manufacturers.—8th March, 1979. Address for service is c/o Baron & Warren, 16, Kensington Square, London, W8 5HL. To be Associated with No. B1,037,736 (5085, 273) and another.

DEWFRESH BEEFY BITES

Registration of this Trade Mark shall give no right to the exclusive use of the words "Beefy Bites".

B1,126,906. Beef products for food. J. H. DEWHURST LIMITED, Denmark House, 24-30 West Smithfield, London EC1A 9DL; Manufacturers and Merchants.—15th January, 1980. To be Associated with No. B822,677 (4352, 90).

JACOB'S GOLDENWHEAT

Registration of this Trade Mark shall give no right to the exclusive use of the word "Goldenwheat".

1,101,723. Biscuits (other than biscuits for animals) consisting substantially of wheat products. ASSOCIATED BISCUITS LIMITED, trading as HUNTLEY & PALMERS, and as W. & R. JACOB & CO., (LIVERPOOL), and as PEAK FREAN & CO., 119 Kings Road, Reading; Biscuit Manufacturers.—20th September, 1978. To be Associated with No. 765,821 (4138, 1161) and another.

The specifications of goods of these registrtions were limited in order to overcome objections taken under Section 11 in respect of materials from which the goods are made. The descriptiveness is not sufficiently direct to justify the raising of such objections in future similar cases.

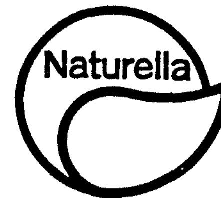
KUM SUNG GOLD STAR

Registration of this Trade Mark shall give no right to the exclusive use of the words "Gold Star".

B1,065,577. Clocks, all having cases made from, or plated with, gold. GOLD STAR COMPANY LIMITED (a Limited Liability Company incorporated under the laws of Korea), 282 Yang Dong, Chung-ku, Seoul, Korea; Manufacturers and Merchants.—12th July, 1976. Address for service is c/o Reddie & Grose, 6, Bream's Buildings, London, EC4A 1HN.

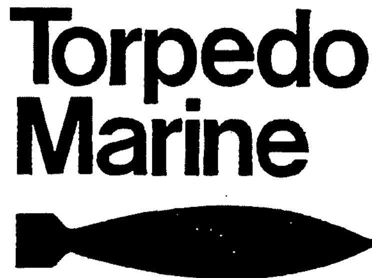
STEELMASTER

B1,013,307. Steel headed hammers being hand tools. THE STANLEY WORKS (a Corporation organised and existing under the laws of the State of Connecticut, United States of America), 195 Lake Street, New Britain, Connecticut 06050, United States of America; Manufacturers and Merchants.—26th June, 1973. Address for service is c/o Marks & Clerk, 57/60, Lincoln's Inn Fields, London, WC2A 3LS.



B1,109,403. Non-alcoholic drinks, all made from fruit and vegetable juices and from nectars; natural syrups for use in making beverages; natural mineral waters; all included in Class 32. NATURELLA SUDSAFT A.G., (an Aktiengesellschaft organised under the laws of the Federal Republic of Germany), Marbacher Strasse 12, D-7057 Winnenden, Federal Republic of Germany; Manufacturers and Merchants.—12th February, 1979. Address for service is c/o Haseltine, Lake & Co., 28 Southampton Buildings, Chancery Lane, London, WC2A 1AT. To be Associated with B880,440 (4569, 386).

The goods of these registrations were limited in respect of their clear intended use. In similar cases in the future objections should be raised under Section 11 if the goods are not likewise limited.



Registration of this Trade Mark shall give no right to the exclusive use of the word "Marine".

1,050,533. Anti-fouling compositions, and paints; all for marine use. BERGER, JENSON & NICHOLSON LIMITED, Berger House, Berkeley Square, London, W.1; Manufacturers. — 6th August, 1975. To be Associated with No. 697,426 (3814, 629).

DYLON KETTLE CLEAN

Registration of this Trade Mark shall give no right to the exclusive use of the words "Kettle Clean".

1,127,103. Cleaning preparations and stain removing preparations, all for use on kettles. MAYBORN PRODUCTS LIMITED, Worsley Bridge Road, Lower Sydenham, London, SE26 5HD; Manufacturers.—17th January, 1980. To be Associated with No. 711,112 (3890, 1163) and others.

BOOTS TWIST & CURL

Registration of this Trade Mark shall give no right to the exclusive use of the words "Twist & Curl".

1,124,022. Hand implements (not being electrically heated) operated by twisting actions, for curling hair. THE BOOTS COMPANY LIMITED, Nottingham NG2 3AA; Manufacturers and Merchants.—15th November, 1979. To be Associated with No. 1,124,023 (5359, 1229).

MARLEY DAMPSEAL

Registration of this Trade Mark shall give no right to the exclusive use of the word "Dampseal".

1,128,224. Non-metallic building materials for use in damp-proof courses. THE MARLEY TILE COMPANY LIMITED, London Road, Riverhead, Sevenoaks, Kent; Manufacturers and Merchants. —6th February, 1980. To be Associated with No. 878,307 (4619, 289) and others.

The goods of these registrations were limited in respect of their intended use. But the indication of use in these cases is either insignificant or insufficiently direct and <u>Marks of this nature should not be objected to under Section 11.</u>

It is a condition of registration that the Mark shall be used in relation only to goods sold to hospitals.

Registration of this Trade Mark shall give no right to the exclusive use of letters "BHP" *and the words* "Hospital Products".

B1,127,897. Surgical, medical and dental instruments and apparatus. THE BOOTS COMPANY LIMITED, Nottingham, NG2 3AA; Manufacturers and Merchants.—31st January, 1980. To be Associated with No. 1,038,402 (5066, 2114) and others.

TRICOOL

B1,116,426. Installations and apparatus included in Class 11, all for the cooling of water for industrial use; and parts and fittings included in Class 11 for all the aforesaid goods. TRICOOL ENGINEERING LIMITED, Newgate Lane, Fareham, Hampshire, PO14 1BP.—25th June, 1979.

LOOMOBILE

B1,085,372. Caravans and trailers (vehicles) for use as toilets, and parts and fittings included in Class 12 for all the aforesaid goods. PORTA-SILO LIMITED, Blue Bridge Lane, York, YO1 4AS; Manufacturers and Merchants.—20th October, 1977.

These registrations were limited in respect of the geographic origin of the goods since this is clearly apparent from the Marks. Applications for Marks of this nature should continue to be objected to under Section 11 unless they are likewise restricted.

Registration of this Trade Mark shall give no right to the exclusive use of the words "Rioja", "Cinicero" *and* "Fuenmayor" *and the device of vine leaves and grapes.*

It is a condition of registration that the Mark shall not be used with the cross device appearing thereon in red, or in white or silver on a red ground or with the cross device and ground in, or of, any other similar respective colour or colours.

It is a condition of registration that the blank space in the Mark shall, when the Mark is in use, be occupied only by matter of a wholly descriptive and non-Trade Mark character.

It is a condition of registration that the Mark shall be used in relation only to wine the produce of the Rioja district of Spain.

1,039,021. Wines. BODEGAS EL MONTECILLO S.A., (a Sociedad Anonima organised under the laws of Spain), Fuenmayor (Logroño), Spain; Manufacturers and Merchants. — 27th November, 1974. Address for service is c/o Redferns, Marlborough Lodge, 14 Farncombe Road, Worthing, West Sussex, BN11 2BT. To be Associated with No. 1,039,017 (5066, 2144). (By Consent.)

Registration of this Trade Mark shall give no right to the exclusive use of the words "Smith's" *and* "American."

It is a condition of registration that the Mark shall be used in relation only to goods manufactured in America.

1,093,167. Overalls, dungarees, jeans being articles of clothing; jackets for men, women and children. BROOKLYN OVERALL CO., INC. (a Corporation organised and existing under the laws of the State of New York, United States of America), 112 Commercial Street, Freeport, Long Island, New York, United States of America; Manufacturers and Merchants.—28th March, 1978. Address for service is c/o Stevens, Hewlett & Perkins, 5, Quality Court, Chancery Lane, London, WC2A 1HZ.

MAXIM'S DE PARIS

Registration of this Trade Mark shall give no right to the exclusive use of the word " Paris ".

It is a condition of registration that the Mark shall be used in relation only to goods manufactured in Paris.

B1,122,219. All goods included in Class 25. MAXIM'S LIMITED, N.E.M. House, 24 Worple Road, Wimbledon, London, SW19 4DD, and 3 Rue Royale, Paris, France; Manufacturers and Merchants.—12th October, 1979. Address for service is c/o J. E. Evans-Jackson & Co., 49, Albert Hall Mansions, Kensington Gore, London, SW7 2AF.

EDEN VALE SOMERSET SOFT

Proceeding under Section 29 (1) (*b*).

Registration of this Trade Mark shall give no right to the exclusive use of the words " Somerset Soft ".

It is a condition of registration that the Mark shall be used in relation only to soft cheese the produce of Somerset.

B1,062,382. Soft cheese. EXPRESS DAIRY COMPANY LIMITED, 430, Victoria Road, South Ruislip, Middlesex, HA4 0HF; a Holding Company.—5th May, 1976. To be Associated with No. B942,031 (4903, 1638) and others.

These registrations were limited in respect of the geographic origin of the goods but the marks do not directly indicate such origin and Section 11 objections on this basis should not be raised against Marks of this nature.

It is a condition of registration that the Mark shall be used only in relation to goods manufactured in Denmark.

1,101,477. Bread, biscuits (other than biscuits for animals), cakes, pastries, farinaceous food pastes, non - medicated confectionery, pralines, chocolates, chocolate articles, marzipan, cocoa, pastes for stuffing for pastry, cake paste, cake powder, breadcrumbs and cake substance for human consumption. FAELLESFORENINGEN FOR DANMARKS BRUGSFORENINGER, (a Co-operative Society incorporated under the laws of Denmark), 65, Roskildevej, DK 2620 Albertslund, Denmark; Manufacturers and Merchants.—14th September, 1978. Address for service is c/o Barker, Brettell & Duncan, 138, Hagley Road, Edgbaston, Birmingham, B16 9PW.

WELSH MOUNTAIN

It is a condition of registration that the Mark shall be used in relation only to goods manufactured in Wales.

1,110,675. Non-medicated toilet preparations; cosmetics; soaps, hair lotions; dentifrices; substances for laundry use; and shoe cleaning preparations. GEORGE CUMMING, Rhufeinfa, Station Road, Caernsws, Powys, Wales; Merchant.—7th March, 1979.

"FRENCH CONNECTION"

It is a condition of registration that the Mark shall be used in relation only to goods manufactured in France.

B1,101,502. Articles included in Class 18 made of leather. THE FRENCH CONNECTION LIMITED, 44, South Molton Street, London, W.1; Manufacturers and Merchants.—14th September, 1978. To be Associated with No. B1,101,505 (5341, 149).

YODERANDES

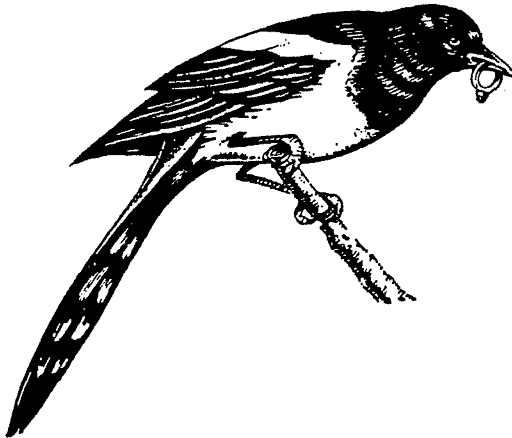
Date claimed under International Convention, 1st April, 1978.

It is a condition of registration that the Mark shall not be used as a varietal name.

It is a condition of registration that the Mark shall be used in relation only to goods grown or produced in the Andes region of Colombia.

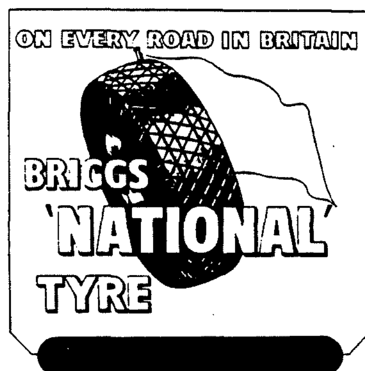
1,100,356. Ornamental live plants; and parts of such plants for propagation purposes; natural flowers and seeds included in Class 31. YODER PLANT TRADING GmbH (a Joint Stock Company organised under the laws of Federal Republic of Germany), Fontenay-Allee 12, 2000 Hamburg 36, Federal Republic of Germany; Growers and Merchants.—18th August, 1978. Address for service is c/o Reginald W. Barker & Co., 13 Charterhouse Square, London, EC1M 6BA. To be Associated with No. 1,098,822 (5263, 1197).

These registrations have disclaimers to the devices of ordinary representations of the goods for which they are registered or devices of ordinary representations of containers within which they are commonly sold. These devices are obviously non-distinctive and need not be disclaimed.



Registration of this Trade Mark shall give no right to the exclusive use of the device of a Ring.

1,128,821. Jewellery comprising gems set in gold and in platinum but not including jewellery in the shape of birds. MAGPIE INSTINCT LIMITED, 63-66 Hatton Garden, London, EC1N 8LE; Jewellery Manufacturers.—16th February, 1980.

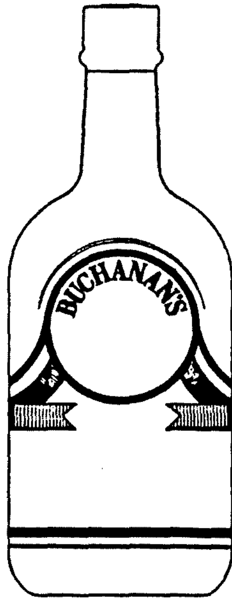


Registration of this Trade Mark shall give no right to the exclusive use of the word " Briggs " *and the device of a tyre.*

722,318. Vehicle tyres wholly or mainly of rubber or synthetic rubber. W. BRIGGS & COMPANY LIMITED, 44, Brazennose Street, Manchester, 2; Merchants.—3rd October, 1953. To be Associated with No. 383,122 (2109, 920).

Registration of this Trade Mark shall give no right to the exclusive use of the device of a nut and bolt.

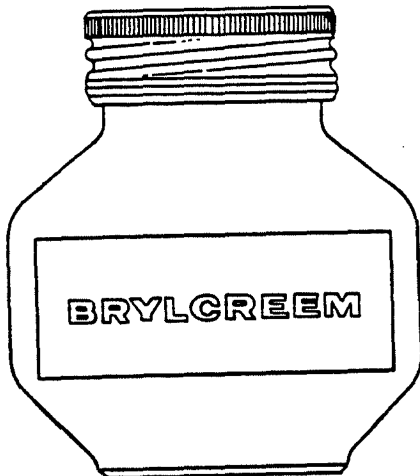
1,088,980. Nuts and bolts, all included in Class 6. W. M. OWLETT & SONS LTD., 15/21 Bourne Road, Bexley, Kent; Wholesale Merchants.—4th January, 1978.



Registration of this Trade Mark shall give no right to the exclusive use of the device of a bottle.

It is a condition of registration that the blank spaces in the Mark shall, when the Mark is in use, be occupied only by matter of a wholly descriptive and non-trade mark character.

B1,062,995. Whisky. JAMES BUCHANAN & COMPANY LIMITED, Devonshire House, Piccadilly, London, W1; Scotch Whisky Distillers and Blenders.—17th May, 1976. To be Associated with No. 297,643 (1600, 1940) and others.



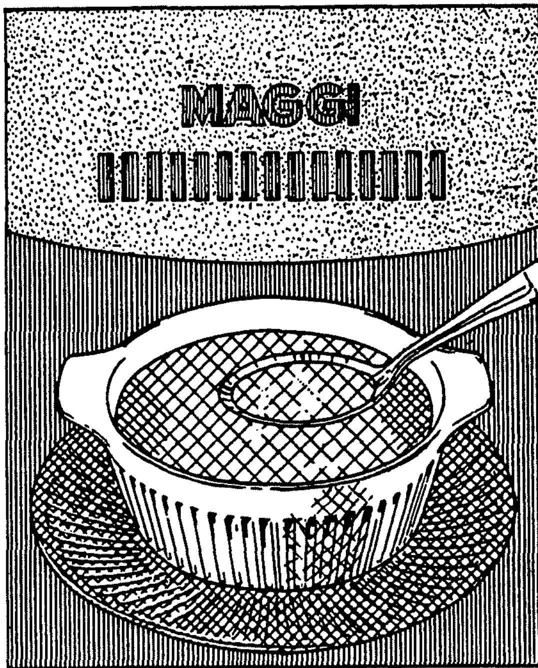
Registration of this Trade Mark shall give no right to the exclusive use of the device of a jar.

B1,097,286. Anti-perspirants, perfumes, non-medicated toilet preparations, cosmetics, dentifrices, shampoos and soaps, all in cream form. BEECHAM GROUP LIMITED, trading as BEECHAM TOILETRY PRODUCTS, Beecham House, Great West Road, Brentford, Middlesex; Manufacturers and Merchants.—16th June, 1978. To be Associated with No. 880,710 (4591, 1217) and others.

Registration of this Trade Mark shall give no right to the exclusive use of the device of a container.

1,095,844. Anti-perspirants, perfumes, non-medicated toilet preparations, cosmetic preparations, dentifrices, shampoos and soaps. BEECHAM GROUP LIMITED, Beecham House, Great West Road, Brentford, Middlesex; Manufacturers and Merchants.—19th May, 1978. To be Associated with Nos. 446,663 (2423, 1997), 1,050,231 (5147, 781) and others.

The disclaimers entered against these registrations are unnecessary since the devices are in common use in relation to the respective goods and therefore obviously non-distinctive. Devices of this nature need not be disclaimed.



Proceeding under Section 29 (1) (b).

Registration of this Trade Mark shall give no right to the exclusive use of the device of a bowl of soup, a spoon and a plate.

The Trade Mark is limited to the colours yellow, red, light brown, silver, white and dark brown as shown in the representation on the form of application.

B1,030,543. Soups and preparations included in Class 29 for making soups, none being for export to, or sale in, that part of the People's Democratic Republic of Yemen, formerly known as Aden. NESTLÉ S.A. (a Corporation organised under the laws of Switzerland), La Tour-de-Peilz, Canton de Vaud, Switzerland; Merchants. —6th June, 1974. Address for service is c/o K. A. C. Westwood, St. George's House, Croydon, Surrey, CR9 1NR. To be Associated with Nos. 468,946 (2536, 2482), 816,510 (4326, 1000) and others.

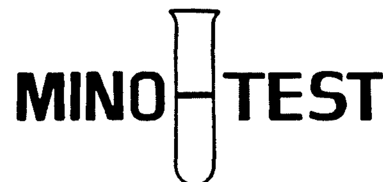
Registration of this Trade Mark shall give no right to the exclusive use of the device of a flower head.

1,087,221. Live plants and natural flowers. BRITISH TELEFLOWER SERVICE LTD., 146, Bournemouth Road, Chandler's Ford, Eastleigh, Hampshire; Merchants.—25th November, 1977.

CARLO ERBA

Registration of this Trade Mark shall give no right to the exclusive use of the device of a test tube.

B893,132. Pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; disinfectants; preparations for killing weeds and destroying vermin. CARLO ERBA SOCIETA PER AZIONI (a Joint Stock Company organised under the laws of Italy), Via Imbonati 24, Milan, Italy; Manufacturers and Merchants.—13th April, 1966. Address for service is c/o J. A. Kemp & Co., 14, South Square, Gray's Inn, London, W.C.1. To be Associated with No. B712,020 (3894, 22) and another.



Registration of this Trade Mark shall give no right to the exclusive use of the device of a test tube.

850,381. Chemical products included in Class 1 for use in laboratory diagnosis. C. F. BOEHRINGER & SOEHNE G.m.b.H. (a Joint Stock Company organised under the laws of Germany), Sandhoferstrasse, Mannheim-Waldhof, Germany; Manufacturers and Merchants.—14th June, 1963. Address for service is c/o Carpmaels & Ransford, 24, Southampton Buildings, Chancery Lane, London, W.C.2.

Registration of this Trade Mark shall give no right to the exclusive use of the devices of vine leaves and grapes.

It is a condition of registration that the blank space in the Mark shall, when the Mark is in use, be occupied only by matter of a wholly descriptive and non-trade mark character.

1,056,584. Wines, spirits (beverages), liqueurs and cocktails. BARCAVE LIMITED, 6, Great James Street, London, W.C.1; Manufacturers and Merchants.—19th December, 1975

Registration of this Trade Mark shall give no right to the exclusive use of the words "Elizabethan Mead" *and the device of a wine glass.*

It is a condition of registration that the blank space in the Mark shall, when the Mark is in use, be occupied only by matter of a wholly descriptive and non-Trade Mark character.

B1,090,864. Mead. LAMB & WATT LIMITED, 200 Great Howard Street, Liverpool, L3 7EL.—11th February, 1978. To be Associated with No. 1,035,277 (5073, 2522).

The prominent letters in these two registrations may well be understood as, or claimed to be, essential elements of the Marks and have properly been disclaimed. Similarly prominent letters in word Marks should continue to be disclaimed.

Registration of this Trade Mark shall give no right to the exclusive use of the letters "CTX".

1,073,055

Registration of this Trade Mark shall give no right to the exclusive use of a letter "G".

B1,059,295.

The disclaimed letters in the following examples are not significant in the identity of the marks which are essentially word marks. Such letters in similar marks need not be disclaimed.

CompuStatic

Registration of this Trade Mark shall give no right to the exclusive use of the letters "C" and "S".

B1,141,688

TeViP

Registration of this Trade Mark shall give no right to the exclusive use of the letters "TVP".

1,023,943

TiGi

Registration of this Trade Mark shall give no right to the exclusive use of the letters "T G".

B1,130,927

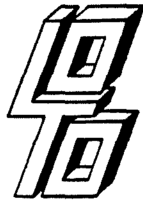
APPENDIX K

The separated or out of the ordinary letters in the following registrations are integral parts of the Marks which will undoubtedly be identified by their totality rather than their separate parts. <u>It is unnecessary to disclaim such letters in Marks of this nature.</u>

Proceeding under Section 29 (1) (*b*).

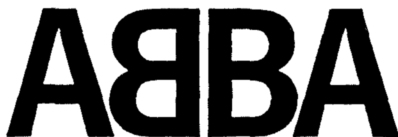
Registration of this Trade Mark shall give no right to the exclusive use of the letters "tc" *and the device of a rotor.*

B1,070,276.



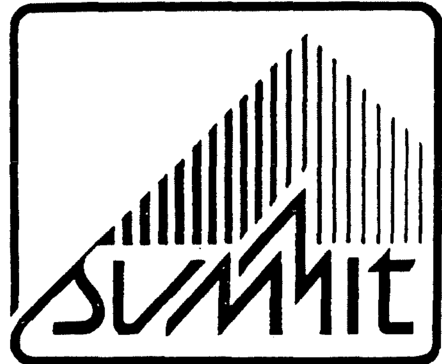
Registration of this Trade Mark shall give no right to the exclusive use of the letters "oo".

B1,116,572.



Registration of this Trade Mark shall give no right to the exclusive use of a letter " B ".

B1,066,247.



Registration of this Trade Mark shall give no right to the exclusive use of a letter " M ".

1,088,922.

Registration of this Trade Mark shall give no right to the exclusive use, separately, of the letters " G ", " A ", " W ", " I " *and* " S ".

1,119,364.

Registration of this Trade Mark shall give no right to the exclusive use of the letters " RN ".

1,066,865.

APPENDIX L

The geographic place names in these registrations are clearly indicative of the location of manufacture or of the proprietor and not of Trade Mark significance. The disclaimers entered against them are therefore not necessary.

Registration of this Trade Mark shall give no right to the exclusive use of the words "Rioja Espana" *and the devices of vine leaves and grapes.*

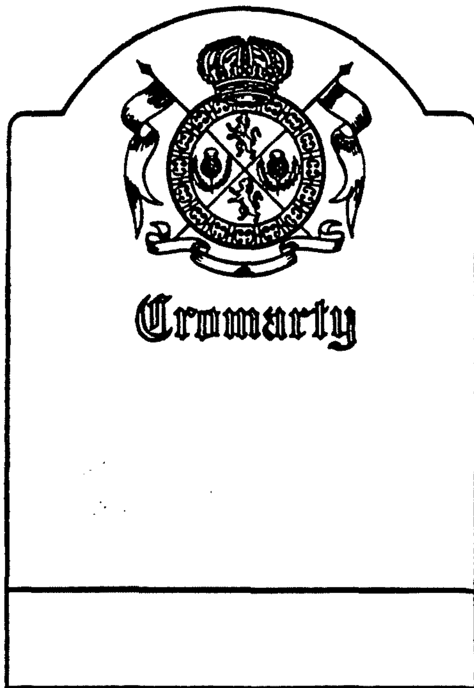
B1,116,529.

Registration of this Trade Mark shall give no right to the exclusive use of the word "London" *and the device of a rose.*

B921,815.

APPENDIX M

The prominent geographic place names in these Marks have properly been disclaimed since in the context of the Marks their significance is more of a Trade Mark nature than of geographic location. Marks of this nature will continue to require a disclaimer in respect of the prominent place name.



Registration of this Trade Mark shall give no right to the exclusive use of the word "Cromarty" *and the devices of thistles.*

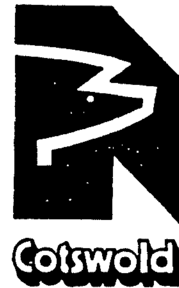
B1,058,148.

Disclaim

Do not disclaim

Registration of this Trade Mark shall give no right to the exclusive use of the words "Rioja", "Cinicero" *and* "Fuenmayor" *and the device of vine leaves and grapes.*

1,039,021.



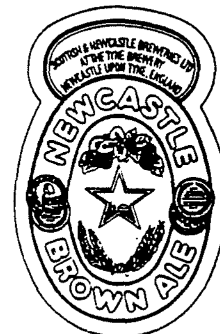
Advertised before acceptance. Section **18 (1)** *(proviso).*

Registration of this Trade Mark shall give no right to the exclusive use of the word "Cotswold".

B1,084,437.

Registration of this Trade Mark shall give no right to the exclusive use of the words "Oakland" *and* "Cigaretten".

1,097,476.



Registration of this Trade Mark shall give no right to the exclusive use of the word "Newcastle".

B1,117,151.

APPENDIX N

TRADE MARK CONDITIONS AND CLAUSES

This appendix is intended as a quick reference aid to the wording of conditions and clauses many of which are frequently used to overcome Official objections. Mention is made of many of these in the text of this chapter of the work manual and where a further explanation is required reference should be made to the appropriate paragraph. However, provided the condition or clause is appropriate to the individual case it is desirable in the interests of consistency that these standard wordings be adopted. Where, however, they do not satisfy an Official objection in a particular case then another condition or clause should be drafted which does.

1. <u>ADVERTISED BEFORE ACCEPTANCE</u>

(a) Advertised before acceptance. Section 18(1) (proviso).

(b) Advertised before acceptance by reason of special circumstances. Section 18(1) (proviso).

(c) Advertised before acceptance by reason of use and special circumstances. Section 18(1) (proviso).

2. <u>SECTION 12(2)</u>

(a) Use claimed from the year 1900. Section 12(2).

(b) Use claimed from the year 1930 in respect of ....; and from the year 1939 in respect of .... Section 12(2).

(c) Proceeding by reason of special circumstances. Section 12(2).

(d) Proceeding by reason of use and special circumstances. Section 12(2).

3. <u>BLANK SPACE(S)</u>

(a) It is a condition of registration that the blank space(s) in the mark shall, when the mark is in use, be occupied only by matter of a wholly descriptive and non-trade or service mark character.

<u>(CASTROL TYPE)</u>

(b) It is a condition of registration that the blank space in the mark shall, when the mark is in use in relation to the goods [services] of the present application, either be left vacant or be occupied only by matter of a wholly descriptive and non-trade or service mark character or be occupied only by one or more associated marks registered in respect of goods [services] included in the specification of the present application with or without the addition of mattter of a wholly descriptive and non-trade [service] mark character.

[NB All the associated marks must be listed in the advertisement in the Trade Marks Journal]

4. BOTTLES, CONTAINERS ETC

Registration of this mark shall give no right to the exclusive use of the device of a bottle coloured ....

[NB If proceeding on evidence of factual distinctiveness or factual capacity to distinguish the disclaimer may require different wording]

5. BOX eg GOLD BOX mark

Registration of this mark shall not prevent any person using a box coloured (gold) or from describing such a box as a (gold) box.

[NB Such marks will probably be proceeding on the basis of acquired distinctiveness ie "Advertised before Acceptance". Section 18(1) proviso]

6. BUILDINGS

The building represented in the mark is the property of .... (the applicant(s) or as the case may be).

7. COLOURS

(a) The mark is limited to the colours .... as shown in the representation on the form of application.

(b) The mark, other than the (portrait) appearing therein, is limited to the colours .... as shown in the representation on the form of application.

(c) The mark, here depicted in heraldic shading, is limited to the colour(s) .... as shown in the representation on the form of application.

NB 1 If a mark is limited to colour it is not normally necessary to have a blank space condition.

2 Where the mark is limited to colour and the advertisement depicts this in heraldic shading 7(c) above should be used. Where the mark is limited to colour but the advertisement does not reflect this, use the words set out at 7(a) above.

8 CRESCENT

It is a condition of registration that the crescent moon device appearing in the mark shall not be used in red or any similar colour.

9 CROSS

(a) FULL It is a condition of registration that the mark shall not be used with the cross device appearing thereon in red, or in white or silver on a red ground, or with the cross device or ground in, or of, any similar respective colour or colours.

[NB Normally used when the cross device is in the same shape as the Red Cross or Swiss Federal Cross or is likely to be confused with them]

(b) LIMITED It is a condition of registration that the cross device appearing in the mark shall not be used in red or any similar colour.

[NB Normally used when the cross device is less likely to be confused with the Red Cross but where the possibility nevertheless exists, eg where the arms of the cross are irregular or distorted]

10 DAIRY

It is a condition of registration that the mark shall be used in relation only to goods which comply with the regulations that are in force from time to time regarding the use of the word "Dairy" in relation to ice cream and ice cream confections.

11 DANGER

(Note: these are included for the sake of completeness but have now been superseded by the new practice of notification only of 'Danger' citations. Conditions of this type must not be used as a way of avoiding potential conflicts under Section 12.)

(a) Medical Practitioner

i. It is a condition of registration that the mark shall be used in relation only to goods supplied on prescription of a registered medical practitioner.

ii. It is a condition of registration that the mark shall be used in relation only to goods supplied to registered medical practitioners.

[NB This condition should only be used in conjunction with a specification for goods not entering the home, eg injectable pharmaceutical preparations for diagnostic purposes and for use by registered pathologists]

(b) Method of Packaging

i. It is a condition of registration that the mark shall be used in relation only to goods sold in containers each holding not less than (5 litres).

ii. It is a condition of registration that the mark shall be used in relation only to goods supplied by the applicants direct to industrial premises.

iii. It is a condition of registration that the mark shall be used in relation only to goods sold in containers each holding not more than (one fluid ounce).

iv. It is a condition of registration that when the mark is used in relation to goods in liquid form, the goods shall be sold only in aerosol containers adapted to dispense their contents by puffing or spraying.

v. It is a condition of registration that the mark shall be used in relation only to goods sold in tablet form.

12 DISCLAIMER

(a) Registration of this mark shall give no right to (insert i. to vii. as appropriate).

i. .... the exclusive use of the letter .....

.... the exclusive use of the device of a ....

[ie When it is intended to disclaim the letter or the device depicted in the mark and all other forms of that letter or that device]

ii. .... the exclusive use of a letter ......

.... the exclusive use of a device of a ....

[ie When it is intended to allow registration rights in respect of the particular letter or device depicted in the mark but in no other confusingly similar form]

iii. .... the exclusive use of the letters ....

.... the exclusive use of the devices of ....

[ie Plural of i.].

Note: When letters are presented or make an impact together, disclaim the letters together, eg "ABC". When presented separately, disclaim the letters eg "A", "B" and "C"]

iv. .... the exclusive use of letters ....

.... the exclusive use of devices of ....

[ie Plural of ii.]

v. .... the exclusive use of the word "....."

vi. .... the exclusive use of the words ("French Fried").

[ie When the words clearly read through as a totality (usually, but not necessarily, on one line).

vii. .... the exclusive use of the words ("French" and "Fried").

[ie 1. When words are presented separately,

and 2. When it is intended to disclaim elements of a mark separately and in combination.]

(b) Registration of this mark shall give no right to the exclusive use, separately, of the words ("Diamond" and "Shamrock").

[ie When it is intended to disclaim elements of a Mark separately but not in combination]

(c) Registration of this mark shall give no right to the exclusive use of the devices of (wrapped sweets).

[ie When it is intended to disclaim individual items

making up a device but not the device as a whole]

(d) Registration of this mark shall give no right to the exclusive use of the device of (wrapped sweets).

[ie When it is intended to disclaim the device of a collection of items as a whole]

(e) Registration of this mark shall give no right to the exclusive use of the word ("International") and the (Cyrillic) characters therefore.

13 GEOGRAPHICAL ORIGIN

(a) It is a condition of registration that the mark shall be used in relation only to goods the produce of ....

[NB For use in respect of food and beverage and basic (unmanufactured) raw materials, and specifications embodying both manufactured and unmanufactured materials.]

(b) It is a condition of registration that the mark shall be used in relation only to goods manufactured in ....

[NB 1. For use in respect of manufactured goods.

2. Where only one item appears in the specification, refer to the item by name rather than use the general term "goods".]

(c) Scotch Whisky

It is a condition of registration that the mark shall, when in use in relation to whisky or to whisky-based liqueurs, be used in relation only to Scotch whisky or to Scotch whisky-based liqueurs.

14 HALLMARK

It is a condition of registration that the mark shall not be applied directly to goods by means of an impression or stamp in the metal or in any metal part thereof, or in combination with any other impression or stamped mark or marks in the manner of a Hallmark.

15 INTERNATIONAL CONVENTION

Date claimed under International Convention, 3 October 1977 (....... (Country)).

[NB The date claimed <u>must not</u> be more than six months prior to the date of application but allowance is made for weekends and public holidays if the final day falls on one of these.]

16 <u>LABEL</u> eg "Black Label" mark.

Registration of this mark shall not prevent the use by other traders of labels in the colour black.

[NB This condition is not required if the words appear in the mark and are disclaimed; ie this condition is likely only in respect of cases proceeding on evidence of factual distinctiveness or factual capacity to distinguish.]

17 <u>LOW TAR CIGARETTES</u>

It is a condition of registration that the mark shall be used in relation only to cigarettes yielding not more than 10 milligrammes of tar per cigarette.

18 <u>METRIC</u>

It is a condition of registration that the mark shall be used in relation only to goods made to metric standards.

19 <u>MUSIC GROUPS</u>

(a) <u>Class 9</u> It is a condition of registration that the mark shall, when in use in relation to (discs and tapes), be used in relation only to such (discs and tapes) comprising pre-recordings performed, written or produced by members of the (Electric Light Orchestra).

(b) <u>Class 16</u> It is a condition of registration that the mark shall, when in use in relation to printed matter, books, printed publications, pictures and photographs, be used in relation only to such goods relating to the (Electric Light Orchestra Group) and shall, when in use in relation to sheet music, be used in relation only to music written by members of the (Electric Light Orchestra Group).

20 <u>PARTNERSHIP</u>

(a) It is a condition of registration that neither (no one) of the applicants shall use the mark except on behalf of both (all) of them.

(b) It is a condition of registration that the mark shall be used in relation only to goods with which both

(all) of the applicants are connected in the course of trade.

21 PORTRAIT

(a) The portrait appearing in the mark is that of ....

(b) The mark consists of a portrait of ....

(c) The portrait appearing in the mark is part of an original painting of which the applicants own the copyright

22 RAF ROUNDEL

(a) It is a condition of registration that the mark shall not be used in any combination of the colours red, white and blue or of any similar respective colours.

(b) It is a condition of registration that the roundel device appearing in the mark shall not be used in any combination of the colours red, white and blue.

23 SAFETY STANDARDS

It is a condition of registration that the mark shall be used in relation only to goods [services] which conform to British Standards Institution Safety Standards ......

(a) ..... for [first goods] - BS 123, [second goods] - BS 234, [third goods] - BS 345 etc (note: where the list of goods is reasonably short)

(b) ...... in force for the time being in relation to any of the goods specified, (note: where it would be impracticable to set out all the goods separately)

or any standard or regulation which may replace those standards and that the applicable safety standard(s) or safety regulation(s) shall be indicated to the public in conjunction with the mark.

24 SEAL

Registration of this mark shall not prevent the use by other traders of seals of the colour ....

25 SERIES

Application under Section 21(2) for a series of (number

in words) marks.

26 TRANSLATION AND TRANSLITERATION

(a) The mark consists of a (French) word meaning ....

(b) The (French) word appearing in the mark means ....

(c) The transliteration of the (Chinese) characters appearing in the mark is .... meaning ....

(d) The transliteration of the (Chinese) characters of which the mark consists is .... meaning ....

(e) The transliteration of the (Chinese) characters of which the mark consists is .... which has no meaning.

(f) The transliteration of the (Chinese) characters appearing in the mark is .... which has no meaning.

(g) The transliteration of the foreign characters appearing in the mark is .... which is the name of the applicant company.

(h) The word appearing in the mark is the transliteration of (Chinese) characters meaning ....

[NB See also (e) under "Disclaimer.]

27 VARIATION CLAUSE

In the term "brown ale", ale is the name of the goods and brown is the description.

(a) In use in relation to goods covered by the specification other than brown ale the mark will be varied by the substitution of the name and description of such goods for the word "brown ale".

[NB 1. For specifications covering a range of goods, eg beer, ale, porter and lager.

2. When the variation clause applies only to the name of the goods or only to the description then the clause should be adapted accordingly, ie "......... varied by the substitution of the name of such goods ....", or "...... varied by the substitution of the description of such goods ....".]

(b) In use in relation to ale other than brown ale the mark will be varied by the substitution of the description of such ale for the word "brown".

[NB For specifications covering only one product.]

28 VARIETAL

(a) It is a condition of registration that the mark shall not be used as a varietal name.

(b) It is a condition of registration that the word(s) appearing in the mark shall not be used as a varietal name.