

## **CHAPTER 20**

# **PRACTICE GUIDE TO THE EXAMINATION OF TRADE & SERVICE MARKS**





FOREWORD .....	I
SOURCES OF REFERENCE .....	II
THE LEGAL FRAMEWORK AND CONSTRAINTS WITHIN WHICH THE PATENT OFFICE OPERATES	III
PATENT HEARING PROCEDURE .....	III
JUDICIAL REVIEW .....	III
PRINCIPLES OF NATURAL JUSTICE .....	III
JUDICIAL PRECEDENT .....	III
HEARING OFFICER DECISIONS .....	III
THE WORK MANUAL .....	IV
<b>A</b>	
ACCEPTANCE: DATE OF .....	A1
ACE .....	A1
ACUMEN .....	A1
ADVANTAGE .....	A1
ADVERTISED BEFORE ACCEPTANCE BY REASON OF FACTUAL DISTINCTIVENESS .....	A1
ADVERTISED BEFORE ACCEPTANCE BY REASON OF SPECIAL CIRCUMSTANCES .....	A2
ADVERTISED BEFORE ACCEPTANCE .....	A4
ALBION .....	A4
ALCOHOLIC COCKTAILS .....	A4
ALCOHOLIC DRINKS .....	A4
ALWAYS .....	A5
AMENDMENT OF MARKS .....	A5
ANGLIA .....	A6
ANIMAL NAMES .....	A6
ANSWER(S) .....	A6
ANZAC .....	A6
APPEALS TO THE SECRETARY OF STATE REGARDING THE REGISTRAR'S DECISION. ....	A6
AQUA .....	A7
ARCADE .....	A7
ARMAGNAC .....	A7
ARTICLE 6 TER .....	A7
ARTICLE 6 TER OF THE INTERNATIONAL CONVENTION .....	A7
ARTICLE 6 TER: HOW PROTECTION IS SOUGHT. ....	A8
ARTICLE 6 TER: AS APPLIED TO THE UK TRADE MARKS ACT .....	A8
ASSOCIATION OF MARKS WITH DIFFERENT ADDRESSES .....	A8
ATLANTIC AND PACIFIC .....	A8
AURORA .....	A9
AVENIR .....	A9
AVON .....	A9
AWARDS/MEDALS .....	A9
<b>B</b>	
BADGES/INSIGNIA .....	B1
BANK CARDS .....	B1
BEEFEATER .....	B1
BEER: IN SPECIFICATIONS .....	B1
BEER: GEOGRAPHICAL NAME .....	B1
BETA .....	B1
BIO .....	B2
BITTER .....	B2
BLANC DE MER .....	B2
BLANK SPACES OR PANELS .....	B2
BLEND .....	B4
BLUSH .....	B4
BORDERS: FANCY .....	B4
BOTTLES .....	B4
BOX: WORD USED IN COMBINATION WITH A COLOUR .....	B4
BREAK .....	B5

BRITANNIA .....	P
BRITANNIC .....	B5
BUDGET .....	B5
BUILDINGS: PICTORIAL REPRESENTATIONS OR NAMES OF .....	B5
BUS SERVICES .....	B6
BY .....	B6
<b>C</b>	
CAD .....	C1
CALEDONIA .....	C1
CALVADOS .....	C1
CAP: CAPSULES .....	C1
CARE .....	C1
CARTOON CHARACTERS .....	C1
CASTROL CONDITION .....	C2
CAT .....	C2
CELL .....	C2
CENTRAL .....	C2
CERA .....	C2
CHANNEL ISLANDS .....	C2
CHARTERMARK .....	C
CHEF .....	C2
CHRISTIAN NAMES .....	C3
CITATION OF MARKS SHOWN AS LAPSED .....	C3
CITIZEN'S CHARTER .....	C3
CITY .....	C4
CLASSIC .....	C4
CLOCKS AND WATCHES .....	C4
CLOS .....	C4
CLUB .....	C4
COCA COLA BOTTLE .....	C4
COCKTAIL NAMES .....	C4
COCKTAILS IN SPECIFICATIONS .....	C5
CODED BANK CARDS .....	C5
COGNAC, ARMAGNAC AND CALVADOS .....	C5
COLOUR: WORD APPEARING IN A MARK. ....	C5
COLOUR: WORD USED IN A MARK FOR PAINT .....	C5
COLOUR: MARKS DEPICTED IN. ....	C6
COLOUR BACKGROUNDS .....	C6
COLOUR LIMIT: REQUESTED BY APPLICANT. ....	C
COLOUR: MARKS NOT LIMITED TO BUT APPLIED FOR IN. ....	C7
COLOUR: NAME OF COLOUR IN A WORD MARK .....	C7
COMMUNITY .....	C7
COMPANY NAMES .....	C7
COMPARISON OF GOODS AND SERVICES .....	C8
COMPARISON OF MARKS .....	C9
COMPARISON OF DEVICE MARKS .....	C11
COMPASS POINTS .....	C15
COMPOSITE MARKS CONTAINING NON-DISTINCTIVE ELEMENTS .....	C15
CONCEPT .....	C23
CONCORDE/CONCORD .....	C23
CONDITIONS: USE TO OVERCOME SECTION 11 OBJECTIONS .....	C24
CONFECTIONERY: SHAPED .....	C24
CONFECTIONERY: NON-MEDICATED .....	C25
CONNECTION(S) .....	C25
CONSENT .....	C25
CONSENT: IN RELATION TO CLASS 5 GOODS .....	C26
CONTAINERS: ALONE .....	C26
CONTAINERS: REPRESENTATION OF CONTAINER PLUS DISTINCTIVE MARK .....	C2

CONTAINERS: LIMITED TO COLOUR .....	C26
CONTAINERS: THREE-DIMENSIONAL .....	C27
CONTAINERS: COCA COLA BOTTLE .....	C27
COOKS .....	C27
COPYRIGHT .....	C27
COUNCIL OF EUROPE .....	C27
COUNTERFEIT .....	C27
COUNTRY .....	C27
CREAM/CREME .....	C28
CRETE .....	C28
CRESCENT MOON .....	C28
CROSSES .....	C28
CRYO .....	C30
CUVE(E) .....	C30
CYRILLIC LETTERS .....	C30
<b>D</b>	
DANDY .....	D1
DANGER CITATIONS .....	D1
DATES .....	D1
DECORATIVE MATTER .....	D1
DELTA .....	D1
DERM .....	D1
DEVICE MARKS: SECTION 11 .....	D1
DEVICES: REPRESENTATIONS OF THE GOODS/SERVICES .....	D2
DIET .....	D2
DISCLAIMER: OF TOTALLY NON-DISTINCTIVE WORDS/DEVICES .....	D2
DISCLAIMERS: APPLIED TO SERIES .....	D3
DISCLAIMERS: EFFECT ON COMPOSITE WORD/DEVICE MARKS .....	D3
DISCLAIMERS: INVOLVING AMPERSANDS OR STROKES .....	D4
DISCLAIMERS: TWO WORD MARKS .....	D5
DISCLAIMERS: TAKEN SEPARATELY .....	D5
DISCLAIMERS: UP TO THREE LETTERS FOLLOWING A MARK .....	D6
DISCLAIMERS: COMPLETION OF THE EXAMINATION REPORT .....	D6
DISCLAIMERS: WORDING OF .....	D6
DOCTOR .....	D8
DOMAINE .....	D8
DOUBLE .....	D8
DREAM .....	D8
DURA .....	D8
<b>E</b>	
ECO .....	E1
ECU .....	E1
EEC .....	E1
EMPIRE MARKS .....	E1
ENVIRO .....	E1
EQUITY: USE OF .....	E2
EQUITY: USE IN RELATION TO SECTION 12 .....	E2
ESTABLISHED .....	E2
ESTATE NAME .....	E3
EURO .....	E3
EUROPEAN COMMUNITY SYMBOLS .....	E3
EUROPEAN ECONOMIC INTEREST GROUPINGS (EEIGS) .....	E7
EVIAN .....	E8
EXPIRY: OF MARKS .....	E8
EXPORT .....	E8
EXTENSIONS OF TIME: GRANTING OF: EX PARTE .....	E8
EXTENSIONS OF TIME: DATE FROM WHICH THEY RUN: EX PARTE .....	E8

EXTRA .....	E7
EXTRA JAM .....	E9
<b>F</b>	
FAMILY OF MARKS .....	F1
FAX .....	F1
FIBRE .....	F1
FILTER .....	F1
FINE/FINEST .....	F1
FINESSE .....	F2
FINLANDIA .....	F2
FINO .....	F2
FLAGS .....	F2
FLAGS: OBJECTIONS UNDER SECTIONS 9, 10 AND 11 .....	F2
FLAGS: SECTION 14 (DISCLAIMERS) .....	F2
FLAGS: APPLICATION OF ARTICLE 6 TER OF THE PARIS CONVENTION .....	F2
FLAGS: EXAMPLES OF REGISTRABLE MARKS .....	F3
FLAGSHIP .....	F4
FLASH DEVICE .....	F4
FLEXI AND FLEX .....	F5
FLOAT .....	F5
FLOWERS, SHRUBS AND TREES .....	F5
FOREIGN CHARACTERS OR WORDS .....	F5
FOREIGN SURNAMES .....	F5
FOREIGN WORDS: ARCHAIC .....	F5
FOREIGN WORDS: OBSCURE .....	F5
FORENAMES .....	F6
FORENAMES: FEMALE .....	F6
FORENAMES: MALE .....	F6
FOREX .....	F6
FREE NEWSPAPERS .....	F6
FULL NAMES .....	F7
FULL NAMES: STATUTORY RESTRICTION .....	F7
FULL NAMES: REPRESENTED IN A SPECIAL OR PARTICULAR MANNER .....	F7
FULL NAMES: PRESENTED AS A SIGNATURE .....	F7
FULL NAMES: IN ORDINARY TYPEFACE .....	F7
FUTURE .....	F8
<b>G</b>	
GARDEN .....	G1
GEM .....	G1
GEOGRAPHICAL NAMES: GENERAL .....	G1
GEOGRAPHICAL NAMES: RELEVANT RPCS .....	G1
GEOGRAPHICAL NAMES: DE MINIMUS PRINCIPLE .....	G1
GEOGRAPHICAL NAMES: DIFFERENCES BETWEEN TRADE MARKS & SERVICE MARKS .....	G2
GEOGRAPHICAL NAMES: REDUNDANT .....	G2
GEOGRAPHICAL NAMES: WELL KNOWN AND IN THE UK .....	G2
GEOGRAPHICAL NAMES: RELATIVELY UNKNOWN (SERVICES) .....	G2
GEOGRAPHICAL NAMES: FOREIGN .....	G3
GEOGRAPHICAL NAMES: NATURAL PRODUCE .....	G3
GEOGRAPHICAL NAMES: COMPANY TOWNS .....	G3
GEOGRAPHICAL NAMES: SPLIT .....	G4
GEOGRAPHICAL NAMES: TWO (OR MORE) COMBINED (SERVICES) .....	G4
GEOGRAPHICAL NAMES: RIVERS, SEAS, LAKES, MOUNTAINS .....	G4
GEOGRAPHICAL NAMES: OCEANS .....	G5
GEOGRAPHICAL NAMES: DESERTS .....	G5
GEOGRAPHICAL NAMES: DISTRICTS STREETS AND ROADS .....	G5
GEOGRAPHICAL NAMES: SIMILAR AND PHONETICALLY CLOSE .....	G6
GEOGRAPHICAL NAMES: WITH OTHER WELL KNOWN MEANINGS .....	G6

GEOGRAPHICAL NAMES: COMBINED WITH OTHER MATTER .....	G7
GEOGRAPHICAL NAMES: PREVIOUS REGISTRATIONS (EQUITIES) .....	G7
GEOGRAPHICAL NAMES: FOR WINES .....	G7
GEOMETRICAL FIGURES: PLAIN .....	G8
GEOMETRICAL FIGURES: SPOTS .....	G8
GEOMETRICAL FIGURES: IN COMBINATION .....	G8
GET-UP .....	G9
GHOST MARKS .....	G9
GLEN .....	G10
GOLD .....	G10
GORBACHEV OR GORBY .....	G10
GRAPES AND VINE LEAVES .....	G10
GREEK OR CYRILLIC LETTERS: ACCEPTABILITY .....	G11
GREEK OR CYRILLIC LETTERS: DISCLAIMERS .....	G12
GREEN .....	G12
GUERNSEY .....	G12
<b>H</b>	
HAZE .....	H1
HEADS: OF WOMEN .....	H1
HEARINGS: EX PARTE .....	H1
HEAVENLY .....	H2
HERALDIC DEVICES: MARKS CONTAINING .....	H2
HERALDIC DEVICES : COMPOSITE MARKS .....	H3
HERALDIC DEVICES: PROCEDURE FOR CONTACTING THE GARTER KING .....	H3
HERALDIC SHADING .....	H4
HIBERNIA .....	H5
HIDE DEVICES .....	H5
HIGH TECH (OR PHONETIC EQUIVALENTS) .....	H5
HIGHLAND .....	H5
HOLOGRAMS .....	H5
HOUSE OF .....	H5
HUMAN FIGURES .....	H6
HYBRID WORDS .....	H6
HYPHENATED WORDS .....	H6
<b>I</b>	
IDEAL .....	I1
IMPERIAL .....	I1
INFRINGEMENT: POSSIBLE DEFENCES .....	I1
INSIGNIA .....	I1
INTER .....	I1
INTERNATIONAL .....	I2
INTERNATIONAL PRIORITY: GENERAL .....	I2
INTERNATIONAL PRIORITY: CASCADING .....	I2
INTERNATIONAL PRIORITY: CERTIFICATE .....	I2
INTERNATIONAL PRIORITY: NON-ASSIGNABILITY OF RIGHTS .....	I3
INTERNATIONAL PRIORITY: THE SIX MONTH PERIOD .....	I3
INTERNATIONAL PRIORITY: LATE CLAIMS .....	I3
INVENTED WORDS: EXAMPLES .....	I4
ISLE OF MAN .....	I5
ISOTONIC .....	I5
<b>J</b>	
JAFFA .....	J1
JERSEY .....	J1
JIFFY .....	J1
JUMBO .....	J1
<b>K</b>	
KINGSIZE .....	K1

KIT .....	K
KITCHEN .....	K1
KRETEK .....	K1
<b>L</b>	
LA .....	L1
LABEL : WORD USED IN COMBINATION WITH A COLOUR .....	L1
LABELS .....	L1
LABELS : DEVICES OF .....	L2
LADY .....	L2
LAND .....	L2
LASER .....	L3
LEDA .....	L3
LETTERS: DISTINCTIVENESS .....	L3
LETTERS: FICTITIOUS .....	L3
LETTERS: NOT PRONOUNCEABLE .....	L3
LETTERS: PLUS ADDITIONAL FEATURES .....	L3
LETTERS: PLUS NUMERALS .....	L4
LETTERS: PHONETIC EQUIVALENT SPELLING OF .....	L4
LETTERS: GROUPS OF FIVE OR MORE .....	L5
LETTERS: GROUPS OF FOUR .....	L5
LETTERS: GROUPS OF THREE .....	L5
LETTERS: GROUPS OF THREE (WELL KNOWN) .....	L6
LETTERS: GROUPS OF THREE AND GROUPS OF TWO .....	L6
LETTERS : GROUPS OF TWO .....	L6
LETTERS: GROUPS OF TWO (WELL KNOWN) .....	L6
LETTERS: PUNCTUATION BETWEEN .....	L6
LETTERS : SPACING OF .....	L7
LETTERS: ELISION OF THREE .....	L7
LETTERS: NON-DISTINCTIVE: COMBINATIONS OF THE SAME LETTER .....	L7
LETTERS: TWO GROUPS IN UPPER CASE, HYPHENATED .....	L7
LETTERS: MONOGRAMS .....	L9
LETTERS: SINGLE .....	L9
LETTERS: SOURCES OF REFERENCE .....	L10
LIFESTYLE .....	L11
LIGHT/LITE .....	L12
LINE BORDER .....	L12
LINK: GENERAL .....	L12
LINK: ALONE .....	L17
LINK: AS A PREFIX OR SUFFIX .....	L13
LINK: PHONETIC EQUIVALENTS .....	L13
LINK: CONSIDERATION UNDER SECTION 12 .....	L13
LIPPINCOTTS GAZETTEER .....	L14
LOGY .....	L14
LOW .....	L14
LOW ALCOHOL DRINKS .....	L14
LUX .....	L14
<b>M</b>	
MACHINES .....	M1
MAESTRO .....	M1
MAGI .....	M1
MAGIC .....	M1
MAGNA .....	M1
MANOR .....	M2
MAPLE LEAF .....	M2
MASTER: GENERAL .....	M2
MASTER: CONSIDERATION OF EVIDENCE OF USE .....	M3
MATE .....	M:

MATIC .....	M4
MATURE: APPLIED TO CHEESE .....	M4
MAXI .....	M4
MEDALS .....	M5
MEDI .....	M5
MEGA .....	M5
MEL .....	M5
MELLOW .....	M5
MICRO .....	M5
MILD: APPLIED TO TOBACCO .....	M5
MILD: APPLIED TO CHEESE .....	M6
MINERAL WATER: RIGHTS OF EXTRACTION .....	M6
MINI .....	M6
MIS-SPELLING OF WORDS .....	M6
MIST .....	M6
MISTER .....	M7
MONO .....	M7
MOSELTALER .....	M7
MOUNTAINS .....	M7
MR .....	M7
MULTI .....	M7
MUSIC GROUP CONDITIONS .....	M8
MUST .....	M8
<b>N</b>	
NAPOLEON .....	N1
NATIONAL FLAGS .....	N1
NATURAL: PARTICULARLY IN CLASS 3 .....	N1
NATURAL PRODUCE .....	N1
NATWEST .....	N2
NEED .....	N2
NEW .....	N2
NEWSPAPERS .....	N2
NEXT .....	N2
NON-ALCOHOLIC DRINKS .....	N2
NON-MEDICATED CONFECTIONERY .....	N3
NON - TRADE MARK MATTER .....	N3
NOVA .....	N3
NOW .....	N3
NUMERALS .....	N3
NUMERALS: 100S .....	N4
<b>O</b>	
OFFENSIVE DESIGNS .....	O1
OLD .....	O1
OLOGY OR -LOGY .....	O1
OLYMPIC SYMBOL (AND WORD): GENERAL .....	O1
OLYMPIC SYMBOL .....	O1
OLYMPIC : WORD .....	O2
OPEN .....	O2
OPTIMA .....	O2
OPTIMUM .....	O2
ORIGINAL(S) .....	O2
<b>P</b>	
PACIFIC .....	P1
PACK, PAC, PAK .....	P1
PAINTINGS: FAMOUS .....	P1
PARA .....	P1
PARCELS .....	P1

PARTNER .....	P
PASTORAL SCENES .....	P2
PATTERNS: DECORATIVE .....	P2
PATTERNS: TARTAN .....	P2
PENDING APPLICATION: TRANSFER FROM SECTION 17 TO SECTION 29(1)(B) AND VICE VERSA (REGISTERED USER) .....	P2
PENGUIN PRACTICE: HISTORY .....	P3
PENGUIN PRACTICE: PRESENT APPLICATION .....	P3
PENGUIN PRACTICE: GOODS/SERVICES AFFECTED .....	P4
PERSONAL ORGANISERS .....	P9
PHARMACEUTICAL NAMES: GENERAL .....	P9
PHARMACEUTICAL NAMES: INDEXING .....	P10
PHONETIC EQUIVALENTS OF UNREGISTRABLE MARKS .....	P10
PLUS .....	P10
POINTER .....	P11
POLY .....	P11
POP GROUPS/MUSICAL PERFORMERS .....	P11
PORTA .....	P11
PORTRAITS .....	P11
PRECINCT .....	P11
PRIMA/PRIMO .....	P11
PRINCIPALLY : AS A CLASSIFICATION TERM .....	P12
PRO .....	P12
PROCHAIN(E) .....	P12
PRODUCE OF .....	P12
PROFILE .....	P12
PROTECTED MATTER .....	P13
PUBLIC HOUSES: NAMES .....	P13
PUNCTUATION MARKS .....	P13
<b>R</b>	
®: SECTION 60 OF THE TRADE MARKS ACT 1938 .....	R1
RAC .....	R1
REDUCED SUGAR .....	R1
REFUNDS OF FEES .....	R1
REGAL .....	R2
REGISTER : DIFFERENCE BETWEEN PARTS A AND B .....	R2
REGISTERED USER: CHANGE OF DURING THE COURSE OF PROSECUTION UNDER SECTION 29 (1)(B) .....	R2
REGISTERED USER : AN EXAMPLE .....	R2
RENTAL OF GOODS .....	R3
REPUTATION .....	R3
RITZ .....	R4
RIVERS .....	R4
ROADS .....	R4
ROAD SIGNS .....	R4
ROSETTES .....	R4
ROYAL: GENERAL .....	R4
ROYAL ARMS AND SIMILAR EMBLEMS .....	R4
ROYAL CROWN .....	R5
ROYAL MAIL .....	R5
ROYAL PORTRAITS .....	R6
ROYAL SOVEREIGN .....	R6
ROYAL: WORD .....	R6
ROYAL WARRANT .....	R7
<b>S</b>	
SAFE .....	S1
SAVOY: GEOGRAPHICAL SIGNIFICATION .....	S2
SCOTCH WHISKY: .....	S

SCOTCH WHISKY ORDER 1990 .....	S2
SCOTTISH REFERENCES .....	S3
SCOTTISH REFERENCES: IN CLASS 33 .....	S3
SEALS: IMPRESSED .....	S3
SERIES MARKS: HISTORY .....	S3
SERIES MARKS: PRESENT DAY USE .....	S3
SERIES MARKS: EXAMPLES .....	S4
SERIES MARKS: EXAMINATION OF .....	S12
SERVICE MARKS: EXAMINATION UNDER SECTIONS 68 AND 1 (7) .....	S12
SHAMROCK: DEVICE .....	S14
SHAPE OR FEATURES OF GOODS: AS TRADE MARKS .....	S14
SHILLING (OR 60/ ) .....	S15
SHOP .....	S15
SIAM .....	S15
SIERRA .....	S15
SIGNATURES: GENERAL .....	S15
SIGNATURE: PLUS THE NAME IN BLOCK CAPITALS .....	S16
SIGNATURE: USE OF THE WORD .....	S16
SILK .....	S16
SKINS: DEVICES OF .....	S16
SKY .....	S16
SLIM OR SLIMLINE .....	S16
SLOGANS .....	S17
SMOKERS ARTICLES .....	S17
SOCIETY .....	S17
SOLO .....	S17
SPRING .....	S18
SPRINGS: OWNERSHIP OF .....	S18
SPORTS CLUBS .....	S18
STARS .....	S18
5 STAR/FIVE STAR .....	S18
STATIONERY .....	S18
STERLING .....	S18
STITCHING: DEVICES OF .....	S19
STREET .....	S19
STUDIO .....	S19
SUPRA .....	S20
SURNAMES: DE MINIMUS PRINCIPLE .....	S20
SURNAMES: RARE BUT WELL KNOWN .....	S20
SURNAMES: FOREIGN, INCIDENCE UNKNOWN .....	S20
SURNAMES: USE IN RESPECT OF LOCAL SERVICES .....	S20
SURNAMES: PHONETIC EQUIVALENTS OF .....	S21
SURNAMES: DOUBLE, WITH OTHER MEANING .....	S21
SURNAMES: DOUBLE AND MULTIPLE IN COMBINATION .....	S22
SURNAMES : WITH FORENAME (NAME OF AN INDIVIDUAL) .....	S22
SURNAMES: COMBINED OR COALESCED WITH FORENAME(S) .....	S23
SURNAMES: PLUS TITLE .....	S23
SURNAMES: COMBINED WITH THE NAME OF THE GOODS .....	S23
SURNAMES: COMBINED WITH A WORD DESCRIPTIVE OF A CHARACTERISTIC OF GOODS .....	S24
SURNAMES: ALIEN TO APPLICANT .....	S24
SWEETS .....	S24
<b>T</b>	
TAB .....	T1
TARTAN .....	T1
TEAM .....	T1
TECH .....	T1
TECHNICAL CITES .....	T1
TEX .....	T1

THERMO (THERM) .....	T
THISTLES .....	T2
THOROUGHbred .....	T2
TITLES .....	T2
TOBACCO: RAW .....	T3
TOBACCO: MANUFACTURED .....	T3
TOBACCO PRODUCTS .....	T3
TODAY .....	T3
TOMORROW .....	T3
TOUJOURS .....	T3
TRADE EVIDENCE .....	T3
TRADING STYLES: GENERAL .....	T4
TRADING STYLES: HANDWRITTEN .....	T4
TRANSLATION AND TRANSLITERATION CLAUSES .....	T4
TREES .....	T5
TROPICAL .....	T5
ULTRA .....	U1
ULTRO .....	U1
UNI .....	U1
UNIVERSITIES: FORMER POLYTECHNICS .....	U
UNIVERSITIES WITHIN THE UK (WHOSE EXCLUSIVE TITLES ARE GRANTED BY ROYAL CHARTER) .....	U2
UNIVERSITIES OUTSIDE THE UK .....	U2
USE: ACCRUING AFTER DATE OF APPLICATION .....	U2
VARIATION CLAUSE .....	V1
VARIETAL NAMES .....	V1
VILLA .....	V2
VINE LEAVES .....	V2
VSOP .....	V2
WARE .....	W1
WEBSTERS DICTIONARY .....	W1
WORLD .....	W1
X: OR EX .....	X1
YES .....	Y1
YOG .....	Y1

## **FOREWORD**

This Guide to Registry practice has been created primarily to help Registry examiners. It consists of information compiled from a variety of sources including Reports of Patent Cases (RPCs), Fleet Street Reports (FSRs), Practice Amendment Circulars (PACs) and minutes from senior officers in the Registry. Registry practice reflects and interprets the current state of the law, but just as the law is always in transition so practice must change to take factors such as fashions and new technology into account. This guide will consequently require regular updating and it is anticipated that a revised edition will be issued yearly.

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

It should be remembered that the practice stated in this Guide should never be applied rigidly. Full consideration must be given to all the relevant factors in any given application as each case must be considered on its own merits. An examiner should not generally disregard practice but the particular circumstances of a case may suggest that a departure from practice would be justified. In this case a senior officer should be consulted.

TRADE MARKS REGISTRY  
JANUARY 1994

## **SOURCES OF REFERENCE**

Reports of Patent Cases (RPCs) relevant to trade marks are selected by Michael Fysh QC in consultation with senior officers in the Registry. Cases are selected for publication because they are considered to illustrate an important point of law or its development. The cases may have been decided at any stage of Judicial procedure; they may have proceeded through the legal system as far as the House of Lords or they may have been the subject of a statement of grounds (SOGs) issued by a Hearing Officer. (See The Legal Framework And Constraints Within Which The Patent Office Operates).

Fleet Street Reports (FSRs) are cases selected by Michael Fysh QC and published individually. It is possible for a case to be the subject of both an RPC and an FSR.

Practice Amendment Circulars (PACs) are notices issued internally for the benefit of Registry Staff. They deal with a wide variety of subjects including major changes in Trade Mark Registry practice. PACs are not available to the general public but major changes in Registry practice are published in the Trade Marks Journal as and when necessary.

## **THE LEGAL FRAMEWORK AND CONSTRAINTS WITHIN WHICH THE PATENT OFFICE OPERATES**

Trade marks are intellectual property, and are a form of personal property. (In Scotland they are called incorporeal moveable property). The Patent Office is the Statutory granting and/or regulatory authority for intellectual property but all disputes relating to property rights must finally be determined by independent judges in Courts of Law.

### **Patent Hearing Procedure**

A Patent Office Hearing is a tribunal and consequently follows tribunal procedure. Tribunals are not courts, they do not formally make up part of the judicial structure, members do not take the oath of judicial office and procedure is often relatively relaxed and informal. Hearings, like all tribunals, are subject to 'Judicial review' and must follow 'Judicial precedent'.

### **Judicial Review**

This is performed by the Queens Bench Divisional Court, which is a powerful and authoritative common law court consisting generally of two High Court Judges presided over by the Lord Chief Justice of England. It normally deals with the complaints of individuals or groups against the State. The function of the Court is to provide a means of ensuring that the principles of 'natural justice' are not infringed; if the court considers that these principles have not been met an order of the court may be issued requiring an inferior tribunal to take a specified action.

### **Principles of Natural Justice**

Broadly stated and interpreted for present purposes;

- 1 No party may act as a judge in his own cause;
- 2 A party must know, in detail, the case or charge he has to answer;
- 3 All interested parties must have an opportunity to be fully heard and/or represented on all relevant matters affecting their interests;
- 4 No decision may be arrived at before the admissible evidence and/or representations have all been fully heard and thoroughly considered;
- 5 The decision must be arrived at in good faith and in accordance with the law and not for some ulterior, albeit well-meaning, motive such as general administrative convenience.

### **Judicial Precedent**

Precedents may be found in 'Reports of Patent Cases' (RPCs) together with the Fleet Street Report (FSRs). Judgements of Courts of Record are binding on all inferior courts and tribunals; judgements of inferior Courts and tribunal decisions (Hearings) are not legally binding but should generally be followed, in comparable circumstances, in the interests of consistency; such decisions may later be altered by means of an appeal to a higher court or by the Judicial review procedure.

### **Hearing Officer Decisions**

All Hearing Officer decisions are of equal status irrespective of the rank of the Hearing Officer; this is because they are technically all Comptroller General's decisions made by officers delegated to act on his

behalf. They are not legally binding unless explicitly approved and adopted by a Court of Record eg the Patents Court. Administratively they are normally binding upon examiners if the same point occurs.

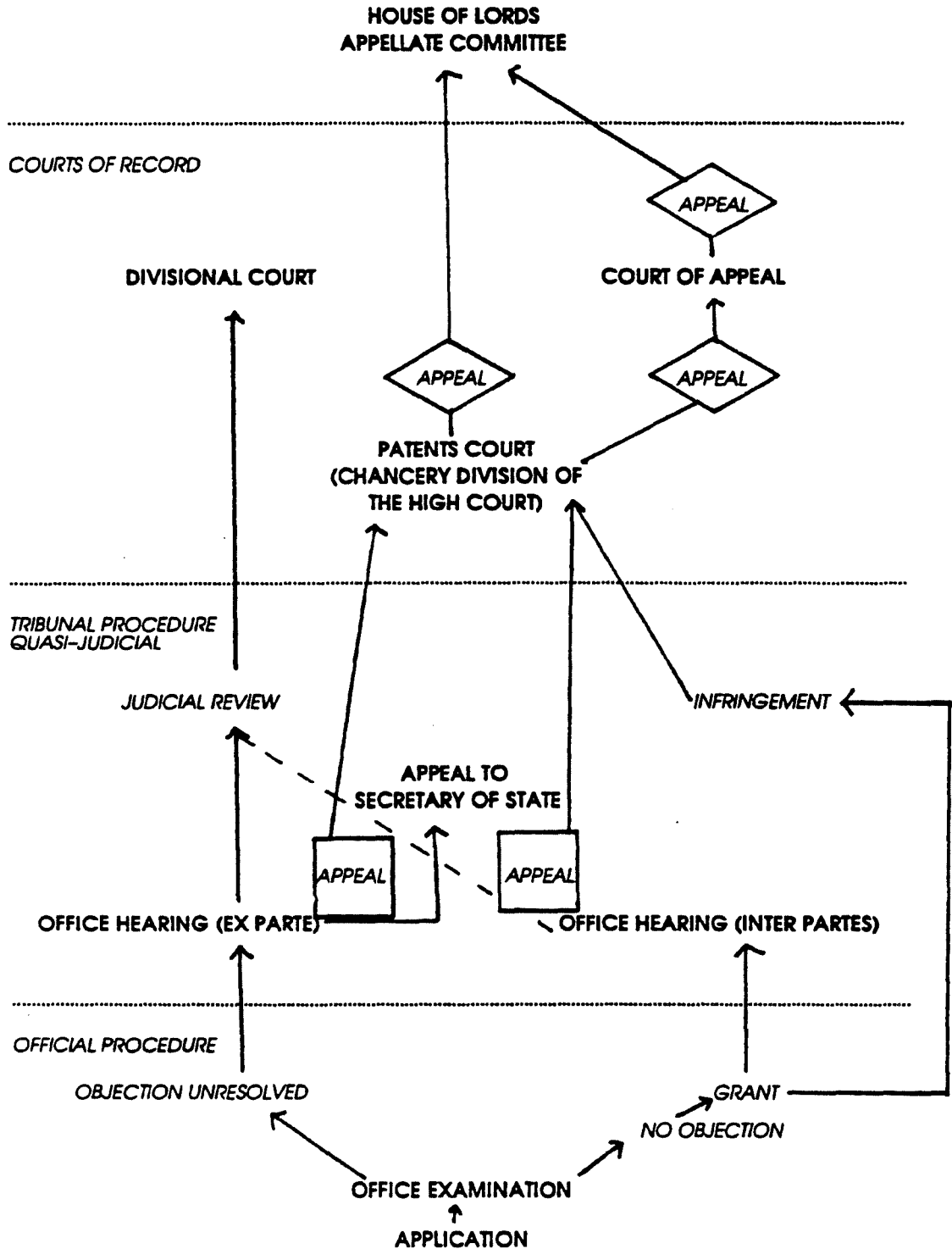
Hearing Officers may depart from another Hearing Officer's 'precedent' if there has been a change in Registry policy or they have knowledge of a recent change in the market place. This should be regarded as desirable flexibility. Hearing Officers may never depart from a precedent of a Court of Record which is definitely equal to the case in question, no matter how apparently unjust this may be. It may, however, be possible to distinguish the case from the apparent precedent to the extent that it does not need to be followed.

## **The Work Manual**

Office practice reflects and interprets the current state of the law; but just as the law is always in transition, so practice must change to take factors such as fashions and new technology into account. If there is any doubt colleagues and/or senior officers should be consulted.

# JUDICIAL SCHEMA FOR PATENTS

PARLIAMENT





# A

## ⦿ ACCEPTANCE: DATE OF

This is the date when an application is formally accepted by the Registrar, the date of the relevant Acceptance Committee meeting in most cases. In the case of applications Advertised before Acceptance under Section 18(1) formal acceptance takes place automatically on the first working day following expiry of the opposition period, if no objection arises or no extension of time has been requested for opposition purposes.

## ⦿ ACE

Has in the past been accepted in Part A of the Register. However, in current colloquial usage it has come to mean 'of highest quality' or 'outstanding'. With these meanings ACE is prima facie neither adapted to distinguish nor capable of distinguishing, consequently objection will be taken in most instances under Sections 9 and 10.

It is thought unlikely that the word ACE would be used in relation to goods and services of a technical or specialised nature. For instance, in relation to chemicals used in industry (Class 1), precious metals (Class 14) and funeral services (Class 42) such marks may be acceptable in Part B.

## ⦿ ACUMEN

Acceptable in part B for goods, this means keen insight or discernment. This word is commonly used in the phrase BUSINESS ACUMEN and has laudatory connotations for all services.

## ⦿ ADVANTAGE

Acceptable in part B for goods. When used as a trade mark this word implies that the use of such goods/services is beneficial and will give purchasers an advantage over those who purchase those of competitors. This word is commonly used in advertising and it is necessary to object under Sections 9 and 10 for any services.

## ⦿ ADVERTISED BEFORE ACCEPTANCE BY REASON OF FACTUAL DISTINCTIVENESS

1. There are many considerations to be borne in mind when considering evidence; they are the goods or services, how many years the product or service has been on sale, the method of sale and any advertising campaigns that may have been run, and also the turnover.
2. There are no hard and fast rules to consider when examining turnover. What may appear to be a high turnover for one item may be very low for others. For example a turnover of £250,000 per annum for paper clips might be considered to be quite good, however, if it were for a construction company or a nuclear power station then the turnover would not be so impressive.
3. The examiner should look at the company who are applying for the mark; are they a well known company using their company name, or another well known house mark, alongside the trademark applied for. For example a company such as Barclays Bank might apply for a mark such as MORTGAGEGUARD, the evidence might point to a high turnover but looking at the evidence it might be apparent that the mark is

never used on its own. Barclays have a number of house marks and styles so the word **MORTGAGE-GUARD** might go relatively unnoticed or not be recognised as a trade mark.

4. The length of use required is also subject to discretion to a certain extent. Seven years use before the filing date is considered to be the bench mark. However companies often invest in a lot of advertising to launch their product or service. If the advertising has involved television, radio, national newspapers and magazines it is likely that the public will be well aware of the product or service and will recognise the trade mark. This is especially true if the company is well known, such as Ford Cars, where a lot of interest would be shown in a new model. In cases such as this, for example, the examiner may consider only two years use to be acceptable. Often the amount spent on advertising over a relatively short period will indicate saturation of the public awareness.
5. Some new products are launched with a minimum of advertising, some new food lines for example may appear in the supermarkets without any publicity. The evidence would have to show a very high turnover to be acceptable if the advertising had been low.
6. Some goods or services may not be fully understood by the examiner and therefore the evidence could be hard to examine. If it is very technical or limited to a small number of outlets, such as mail order through a specialised catalogue, it is possible that evidence by way of statutory declaration and letters from other traders in the same field may help.

#### **ADVERTISED BEFORE ACCEPTANCE BY REASON OF SPECIAL CIRCUMSTANCES**

See also **TRADE EVIDENCE**

It is important to remember that the question of special circumstances is purely a discretionary one for the Registrar and every circumstance of its use cannot be set down. At the end of the day it is a question of 'feel' and what is reasonable in relation to the case at issue.

According to Section 18(1) of the Trade Marks Act the Registrar may cause an application to be advertised before acceptance if 'it appears to him that it is expedient by reason of any **exceptional circumstances** to do so'. Section 12(2) states that it is possible to make use of 'other **special circumstances**'. These may permit the registration of trade marks that are identical or nearly resemble each other, or which are applied for in respect of the same goods or description of goods by more than one proprietor. These registrations may be subject to such conditions and limitations as the Court or the Registrar may think it right to impose.

The following instances may be used as guidelines:

- 1 A slightly different mark.

If an applicant has a mark registered by virtue of use and a new application is filed in respect of a slightly different mark but for identical goods/services then it can be allowed to proceed by reason of special circumstances. The obvious question is what constitutes a slightly different mark. Examples would be a mark presented in normal lower case converted to block capitals and vice versa, or a mark in a possessive or pluralised form converted to a singular form and vice versa. If the mark as registered is incorporated into a device then only association is required but if combined with another word so that the 'equity' is somewhat hidden then the use of special circumstances may be appropriate.

Marks registered in fanciful form do not always give rights for marks in plain block capitals. Such applications cannot normally be accepted without evidence of use when there are prima facie objections to the mark. Much depends on the degree of fancifulness and the circumstances of the case in question. ➡

## 2 Closely allied goods.

If an applicant has a mark registered by virtue of use and a new application is filed for the same mark but for goods closely allied with those of the existing registration, then special circumstances can be considered. An example would be an existing registration for PHILLIP'S covering 'television sets' and a new application for PHILLIP'S covering 'television sets, video recorders and radios'. This is a normal progression in trade and would justify the application proceeding to advertisement under the provisions of special circumstances.

## 3 Goods associated with Services.

Use of special circumstances is usually appropriate when a mark was accepted on evidence of use for goods, and the applicant wishes to register a mark for services, based not on evidence of use but on the existence of the goods registration. This of course applies vice versa. It is, however, necessary for there to be a reasonably close connection in the course of trade between the goods and services, for example rental services for goods are closely connected with the sale of such goods and there is a close connection between television sets and television repair services. Registrations for well known marks in goods classes will normally provide equities for allied services, but without the limitation of providing specific goods. Registrations for McDonalds in respect of restaurant services at large can be accepted even though their equities in goods may be limited to food. For special circumstances to be invoked, the registered association on which the special circumstances are based must be identical or closely similar to the mark applied for and there must be a close association between the goods covered by the associated mark and the services claimed.

## 4 Full names.

If an applicant has an existing registration for a surname, accepted because it is within de minimus limits, special circumstances may be used to extend rights to a full personal name filed later.

An example is **MIKE NEEDLEMAN**

- i. **NEEDLEMAN** is a rare surname which is acceptable in Part A prima facie.
- ii The addition of the christian name **MIKE** reinforces the surname significance of **NEEDLEMAN**, therefore **MIKE NEEDLEMAN** can be accepted in Part A prima facie, subject to a disclaimer of **NEEDLEMAN**.
- iii If the owner of the mark **NEEDLEMAN** wished to register **MIKE NEEDLEMAN**, **NEEDLEMAN** could be used as an equity so that **MIKE NEEDLEMAN** can proceed without a disclaimer, on the basis of this equity, Advertised Before Acceptance, by reason of special circumstances. Section 18(1)(proviso).

Another example is **JOHN SHANNON**

- i **JOHN** and **SHANNON** are both common surnames; **JOHN** with another well-known meaning.
- ii **JOHN SHANNON** could be accepted in Part B on the basis of separate disclaimers.
- iii If the owners of the mark **JOHN SHANNON** already have a registration for the mark **SHANNON**, then **JOHN SHANNON** can proceed, Advertised Before Acceptance, by reason of special circumstances. Section 18(1)(proviso). Subject to a disclaimer of the word **JOHN**. ➡

5 Disclaimed matter.

Special circumstances may occasionally be used to accept a mark consisting of matter which was disclaimed in an earlier associated mark.

6 Different range of goods/services.

Special circumstances cannot normally be used where both the mark of the application differs from the existing registered mark and the range of goods/services applied for is wider than the existing registration. If the addition to the mark is a non-distinctive feature and this is disclaimed, this should not debar the acceptance of a slightly wider specification.

7 Creeping equities

Marks accepted by reason of special circumstances cannot normally be used as a basis of further such acceptances under special circumstances. This is to avoid what is known as 'creeping equities'. This is a step by step process by which a series of applications are made on the basis of an original registration which proceeded on evidence of use. By invoking special circumstances on all applications and by changing the mark or the specification of goods/services in each case, the applicants eventually achieve registrations in goods or services which are far removed from those of the original registration and for which evidence of use was furnished in which to obtain registration. Much will depend on the notoriety of the mark in the first instance and the extent of the expansion of the specification sought.

⊗ **ADVERTISED BEFORE ACCEPTANCE**

The wording to be adopted, depending on the particular circumstances, is as follows:

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

Note for examiners: On OPTICS this information is inserted in the Advertised before Acceptance text field. On display case, this information is shown under Journal Information.

⊗ **ALBION**

Acceptable in Part B (Ancient name for England).

⊗ **ALCOHOLIC COCKTAILS**

'Wines, spirits (beverages) and liqueurs' in Class 33 does not cover alcoholic cocktails. They must be specifically stated ie 'Wines, spirits (beverages) and liqueurs; alcoholic cocktails; all included in Class 33'.

⊗ **ALCOHOLIC DRINKS**

See **NON ALCOHOLIC and LOW ALCOHOL DRINKS.**

## ● ALWAYS

This is used in phrases such as **ALWAYS THE BEST CHOICE** and is non-distinctive for a wide range of goods. Objections should be taken under Sections 9 and 10 prima facie. (1986 RPC 93 refers)

See also **TOUJOURS**

## ● AMENDMENT OF MARKS

Amendments accepted under Section 17(2) differ from those accepted under Section 35(1). These differences stem from the fact that Section 17(2) is applied to pending applications and Section 35(1) is applied to existing registrations.

### Section 35

In the case of Section 35 the assumption must be (at least prima facie) that these registered marks are already known to the public. Therefore an amendment could only be accepted if it did not materially effect the identity of the mark. Otherwise, backdated rights would be given to a proprietor to which they were not entitled.

The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse or may grant it on such terms and subject to such conditions as he may think fit.

Where amendment of the registered mark results in a redundant disclaimer the advertisement of the amendment in the Trade marks Journal will be accompanied by the following clause:-

*As a consequence of the amendment of this mark the disclaimer on the Register of the '.....' is redundant. The Registrar has therefore deleted it from the registrar.*

Justification for this approach can be claimed from Section 35(1) which provides that the Registrar may refuse, leave or grant application for amendment 'on such terms as he may think fit'.

### Section 17(2)

This Section states that, subject to the provisions of the Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.

Section 17(2) allows the Registrar some latitude as the mark in question must be new and unused (If evidence of use is available then the provisions of Section 18(1) would apply). The test is less onerous because, provided the mark is not changed to the extent that a further search for conflicting registrations, or earlier filed applications, is required, an amendment will be allowed.

The amendment of a mark which can be allowed, without recourse to a fresh and separate application, must be such as not to alter the mark to any material extent. In the case of word marks, the longstanding practice is that the amendment should not exceed the alteration of two letters in the word or the addition or removal of one letter. The alteration of the initial letter of a word mark should not be permitted because it would produce a substantial change necessitating an entirely new search.

In the case of a mark consisting of a number of features, the applicant may be allowed to remove one of these features if it would serve to overcome an objection taken by the office, provided that the remaining features constitute an inherently acceptable mark. ➡

Care should be taken where a mark is to be amended by the addition of an already registered mark. The whole of the previously registered mark must be added and the specification of the new mark must be no wider than that of the earlier mark. One mark of a series may be used as an equity.

See **EQUITY USE OF**

When the Registrar considers an amended mark under Section 17(2) he requires from the applicant a written statement that he intends to use the mark as amended. An amendment to an application must not just be a device to get past an objection of the Registrar; there must be a genuine intention to use the mark actually applied for and the Registrar must be satisfied of this.

### ● ANGLIA

Object under Sections 9 and 10 prima facie because of the significant geographic area of East Anglia.

### ● ANIMAL NAMES

Objections may arise under Sections 9, 10 and 11 for some confectionery items such as sweets, lollipops, ice creams, ice lollies and biscuits where there is thought to be a reasonable expectation that the product would be in the shape of the animal concerned. If deception would arise if it were not in the shape of an animal then the Section 11 objection will be justified and **PENGUIN PRACTICE** cannot be applied. If the mark consists of words that would lead to less well defined expectations, such as **FUNNY BUNNY**, **CHIRPY CHICK**, **HAPPY CHIMP** no objection should be taken under Sections 10 or 11.

Animal names or devices attract objections under Section 9, 10 and 11 in Class 25 for goods manufactured from animal skins, unless very fanciful. Objections may be overcome by excluding such goods from the specification.

See also **PENGUIN PRACTICE**

### ● ANSWER(S)

Non-distinctive for a wide range of goods because it means 'to meet the requirements (of); be satisfactory (for); serve the purpose (of)' (Collins Dictionary). Object under Sections 9 and 10 prima facie.

### ● ANZAC

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. An offence is committed if the word **ANZAC** is used in connection with any trade, business or profession, without the authority of The Secretary of State.

### ● APPEALS TO THE SECRETARY OF STATE REGARDING THE REGISTRAR'S DECISION.

If circumstances change between the date on which the appeal is lodged and the Hearing of that appeal which could enable the proceedings to be settled, any application should be addressed to the appellate authority, the Secretary of State's representative, as at that point the matter is no longer before the Registry.

## ● AQUA

The well known Latin name for water. Practice appears to have been mixed in the past but in future Part B is considered appropriate for goods or services associated with water e.g. bathroom apparatus.

## ● ARCADE

This is defined as 'a covered and sometimes arched passageway, usually with shops on one or both sides' (Collins Dictionary). It is considered non-distinctive for any goods which may be sold in such a place and objection under Sections 9 and 10 is appropriate. (The Statement of Grounds relating to application No. 1167525 for the mark ARCADE refers.) The same applies to words such as MALL, PRECINCT, SHOP and STORE.

## ● ARMAGNAC

See COGNAC

## ● ARTICLE 6 TER

Objection to protected words and symbols should be under Rule 17 and Section 17(2) of the Trade Marks Act 1938 (as amended). The Section provides the authority for the Registrar to refuse whereas the Rule merely states that he shall consider whether or not to refuse. In the case of the international words or devices one of the matters considered by the Registrar is that there is an international obligation placed upon him.

The standard wording to be used is:

*The mark appears to be open to objection under Rule 17 and Section 17(2) of the Trade Marks Act 1938 (as amended).*

Some 6 Ter marks may also attract other objections, for example under Sections 9 and 10, if they are not considered distinctive.

## ● ARTICLE 6 TER OF THE INTERNATIONAL CONVENTION

This Article protects the armorial bearings, flags, other emblems, official signs and hallmarks used by states and the names, abbreviations, armorial bearings, flags and other emblems used by inter-governmental organisations. It does this by preventing them from being registered or used as trade marks or as elements of trade marks without the approval of the competent authority.

There is no connection between considering whether or not a mark conflicts with a word or symbol which is protected under Article 6 ter and comparing marks under Section 12 of the Trade Marks Act 1938. If the mark applied for consists of or contains a protected word or symbol the objection raised under Rule 17 cannot be overcome by the entry of a disclaimer.

A state or inter-governmental organisation can apply to register its protected symbol as a trade mark but it must meet all the normal requirements of the Trade Marks Act (ie. it must be distinctive, the owner must be trading etc). The one exception to the requirement that the applicant must be trading is if they wish to register the protected symbol as a certification trade mark (in which case they must be certifying goods and the symbol must qualify for Part A registration).

## ● ARTICLE 6 TER: HOW PROTECTION IS SOUGHT.

A state or inter-governmental organisation wishing to protect its emblem etc. notifies it to the other contracting states of the Paris Union through the World Intellectual Property Organisation (WIPO). Any other state may then, within twelve months of receiving notification, indicate that it will not protect the emblem etc. [This notification is not obligatory in the case of flags of states because other contracting states are expected to be aware of such flags.] If no objections are received, emblems etc. stand protected as from two months after their notification to the Patent Office (usually the Comptroller-General). Notifications received by the UK are published in the Trade Marks Journal.

Protection is rarely refused; as far as is known the UK has only ever refused to protect one such symbol; the emblem of the USA's National Aeronautics and Space Administration (NASA). This was done because it was considered that protection under this Article could not be extended to an emblem belonging to a department of central government, or to official organisations under the control of a central government.

## ● ARTICLE 6 TER: AS APPLIED TO THE UK TRADE MARKS ACT

Article 6 ter requires that registration of a trade mark which consists of, or contains, a protected word or symbol should be refused unless:

- 1 The use of the protected word or symbol has been authorised by the competent authority;
2. The word or symbol belongs to an inter-governmental organisation and its use does not suggest to the public that a connection exists between the organisation concerned and the trade mark owner;
- 3 The emblem concerned is an official sign or hallmark and the trade mark covers goods which are not the same or similar to those covered by that official sign or hallmark;
4. The mark was registered not more than two months after the communication or notification giving details of the protected word or symbol was received from WIPO.

## ● ASSOCIATION OF MARKS WITH DIFFERENT ADDRESSES

If there is a discrepancy between the address stated in the application and that recorded for the existing registered mark or marks to be associated, the association report should be noted 'Address differs' in the right hand margin alongside the particulars of the mark or marks. Such marks should be raised as technical cites pending clarification.

The applicant should be encouraged to bring all the addresses into line but the Registrar cannot insist that the addresses of associated marks are all the same. If the Applicant or Agent refuses to file the forms (TM18 or 33) the alternative is a clear written confirmation from the Applicant or Agent that the Proprietor of the registered mark and the Applicant are the same legal entity. Differences in the name are **not allowed**.

## ● ATLANTIC AND PACIFIC

In future both ATLANTIC and PACIFIC are acceptable in Part A, other than for goods associated with the sea such as fish, ships, oil, natural gas and minerals which might be obtained from the sea bed. In these cases, object under Sections 9 and 10. The practice had been to take PACIFIC in Part B for geographic reasons unless the goods are objectionable (eg. fish, boats etc) whilst ATLANTIC marks have for many years been accepted in Part A with the same proviso. There is clearly no difference between the two on geographic grounds and, since ATLANTIC marks have been registered in Part A for 20 years with no apparent problems it has been agreed that there is no valid reason for downgrading ATLANTIC to Part B.

## ☉ AURORA

Acceptable in Part B because it is a geographical name with another better-known meaning.

See also **GEOGRAPHICAL NAMES WITH OTHER WELL KNOWN MEANINGS**

## ☉ AVENIR

This French word means **FUTURE** in English. **FUTURE** is considered open to objection under Sections 9 and 10 because it is non-distinctive. It was felt that, to be objectionable, **AVENIR** would have to be used in a sentence in French (which was considered unlikely in an English speaking country) and it could therefore be accepted in Part B.

See also **FOREIGN WORDS**

## ☉ AVON

Already registered for various goods before it was adopted as the name of a county. No further such marks can be accepted although, of course, if an equity is already registered it may still be accepted in applications from the same proprietors for goods covered by the earlier registrations. The specification cannot be extended beyond these equities.

See also **GEOGRAPHICAL NAMES: PREVIOUS REGISTRATIONS (EQUITIES)**

## ☉ AWARDS/MEDALS

Representations of exhibition awards or medals or statements about the award of medals or diplomas must be justified by the applicant if they are to remain in a mark. A Statutory Declaration will be required which confirms the facts about the awards. No disclaimer will be required as no trade mark rights can exist in such representations. If these features cannot be justified they must be removed.



## B

### 🌐 BADGES/INSIGNIA

A trade mark must be something apart from, or additional to, the goods concerned. For this reason insignia which appear on badges are not normally considered to constitute trade marks because such insignia are part of the badges. It is necessary to object under Section 9 and 10 prima facie but such marks may be accepted on sufficient evidence of use. For example, the AA badge and the Rolls Royce radiator device for motor cars have both been accepted on evidence of factual distinctiveness

See also **SHAPE OR FEATURES OF GOODS AS TRADE MARKS**

### 🌐 BANK CARDS

In future objections under Section 68 will not be raised against applications in Class 9 or Class 16 which include Coded Bank Cards or Bank Cards in specifications.

### 🌐 BEEFEATER

The Lord Chamberlain's office has confirmed that they have no objection to the word **BEEFEATER**, or pictorial representations of **BEEFEATERS**, being used as trade marks. It is correct to object under Rule 16 to the title 'Queen's Bodyguard of the Yeoman of the Guard', or simply 'Yeomen of the Guard' as these imply Royal patronage.

### 🌐 BEER: IN SPECIFICATIONS

**BEER** covers 'beer, lager, ale, stout and porter'. **LOW-ALCOHOL BEER** has only 1.2% alcohol by volume.

See also **SHILLING**

### 🌐 BEER: GEOGRAPHICAL NAME

**BEER** is a village in Devon with a population of 1,266. Industry is listed as tourism, fishing and lace-making. An application for 'soaps, perfumes, cosmetics' etc was 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 be sold as holiday gifts etc. and nobody should have a monopoly in the name. **BEER** may be acceptable in Part B for some goods, for example computers, which have a specialised market.

See also **GEOGRAPHICAL NAMES WITH WELL KNOWN OTHER MEANINGS**

### 🌐 BETA

It has been practice to accept **BETA** alone in Part A of the Register but where the word is combined with the name of the goods or a descriptive element it was accepted only in Part B. The rationale for this is that in combination **BETA** is closer phonetically to **BETTER** and therefore the mark as a totality is objectionable but this practice would appear to have little basis in law and should be discontinued. **BETA** marks may therefore be accepted in Part A in future.

## ● BIO

**BIO** is now commonly known as an abbreviation for **BIOLOGICAL**. Examples of dictionary words are **BIOCHEMISTRY, BIOCOLLOID, BIODEGRADABILITY, BIOMASS** but listings of **BIO** words are not exhaustive. **BIO** is commonly added to other words to indicate a biological factor and whether presented alone or with a descriptive prefix or suffix (for example **MICROBIO** or **BIOTREAT**) is likely to be very descriptive of goods in Class 1 and some other classes such as 5 and 9 and services connected with biology, science, research etc prima facie objections should be raised under both Sections 9 and 10 to any marks of this sort.

## ● BITTER

This is a description of the goods, not the name (which is 'bitter beer'). A variation clause including a reference to beer should, therefore, read;

*In use in relation to goods covered by the specification other than bitter beer the mark will be varied by the substitution of the description of such goods for the word 'bitter'.*

See also **VARIATION CLAUSE**

## ● BLANC DE MER

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'). **MER** is also a commune of 5,000 inhabitants on the extreme edge of the Loire Valley wine-growing region. An application for wine was objected to under Sections 9 and 10 and a 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.

## ● BLANK SPACES OR PANELS

The practice regarding composite marks incorporating an obvious blank panel or a large blank space is as follows;

- 1 If, as in the **REYNOLD CHAINS** Case (1966 RPC 487), the mark comprises essentially a blank space or panel embellished with descriptive or non-distinctive matter which merely provides a surround for whatever is inserted in the blank space then prima facie the mark is objectionable.
- 2 If the mark as a whole is considered 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.
- 3 **BLANK SPACE CONDITIONS** 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 is:

*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. ➡*

For example:



- 4 It is normal Registry practice not to ask for a blank space condition when a mark is limited to colour. This is because any descriptive matter could only be shown in the same colour and therefore would not show on the mark. Additionally it can reasonably be assumed that if the mark is limited to specific colours then that is the form in which it is going to be used.

For example:



A blank space condition was not requested in this case because the following colour limit was agreed:

*The Trade Mark is limited to the colours white, red, blue and black as shown in the representation on the form of application.*

- 5 **CASTROL-TYPE CONDITION.** Following the decision of Mr Justice Whitford in the **CASTROL** Case (1972 RPC 531) Registry practice relating to blank space conditions was reviewed. Evidence was submitted at the appeal stage to show that the applicants had been using registered marks in a blank space within the 'flash' device for many years. (See 1972 RPC page 538 lines 14 to 34). The condition for proceeding (as recently amended) is as follows:

*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 mark 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 matter of a wholly descriptive and non trade [service] mark character.*

A condition such as that formulated for the **CASTROL** application should not be imposed unless there is a request from the applicant or his/her agent for an alternative to the ordinary blank space condition. Conditions for proceeding are requirements of the Registrar so Hearing Officers must not be persuaded into imposing a Castrol-type condition:

- 1 if there is no necessity for one, or
- 2 unless the circumstances are analogous to those of the **CASTROL** application, that is, it is shown in evidence that the applicants have customarily and for a reasonable length of time inserted in the blank space registered trade marks of theirs for specifications within that under examination.

If a Castrol-type condition is agreed it will be necessary to identify in the Trade Marks Journal advertisement the registered marks which may be inserted in the blank space (marks associated under Section 17(2))

rather than under Section 23(2) of the Act). Any request to add further marks to the list of those which may be inserted into the blank space should be submitted for consideration by an officer of Grade 7 level. The insertion of new later marks in the blank space of the registration subject to the condition should not be suggested to applicants or agents.

#### ● **BLEND**

In relation to **WHISKY** there is no need to request a disclaimer as the word **BLEND** is commonly used on labels to distinguish between blended whiskies and single malts and is therefore totally non-distinctive.

#### ● **BLUSH**

This is now a recognised term for rosé type wines. It was originally coined in USA and has become a well established and commonly known term in English speaking countries. The word should be regarded as having a generic signification in relation to wines.

#### ● **BORDERS: FANCY**

These are not considered to constitute 'distinctive' marks, or to lend any element of distinctiveness to a mark in a case where the matter within the fancy border is itself not 'distinctive' (the **BENZ** Case – 1913 RPC 177).

#### ● **BOTTLES**

Where a mark consists of a device of a bottle, with an acceptable trade mark element on it, it is no longer necessary to object to the bottle being too prominent. Bottles are considered so non-distinctive that they would not be considered part of the registration and need not be disclaimed. Care needs to be exercised where the bottle is limited to colour as in such cases a disclaimer is necessary. If presented as a line drawing (which on **COCA-COLA CRITERIA** is registrable) a disclaimer may be necessary if the bottle is in any way stylised.

See also **CONTAINERS**

#### ● **BOX: WORD USED IN COMBINATION WITH A COLOUR**

eg **BLACK BOX, BLUE BOX.**

Coloured boxes and packaging are frequently used to display goods but it is now thought unlikely that traders would wish to use words such as **BLUE BOX** to describe or advertise items and the nature and colour of the packaging is unlikely to be a factor materially affecting a purchase. The words **BLUE BOX** or **WHITE BOX** as distinct from devices of packaging would in consequence be distinguished as a trade mark. Such marks can now proceed prima facie in Part B on the basis of a suitable exclusion, for example:

*but not including any such goods sold in (blue) boxes*

The exclusion both overcomes any objection on descriptiveness grounds and protects the rights of other traders to use coloured boxes in the normal course of their activities. It is emphasised that this practice relates only to word marks; objection should still be taken to devices of boxes or other items of packaging

See **CONTAINERS** →

**Note:** Particular care should be taken in relation to applications with specifications which mention boxes or which cover a broad range of goods which could include boxes. Boxes are classified according to both material (cardboard, metal, glass) and purpose (boxes for pens, soap boxes, nesting boxes) and consequently occur in a wide range of classes. The WIPO guide gives further information. Applications for goods which include boxes should continue to attract prima facie objections under Sections 9 and 10 on the grounds that the mark simply consists of a colour plus the goods themselves; the exclusion referred to above will not overcome such objections.

If evidence of use is filed in support of the application in order to obtain a registration in Part A and avoid an exclusion along the lines mentioned above it will be necessary to obtain agreement to the following condition of registration;

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

If an application is proceeding with a disclaimer of the words '(blue) box' the above mentioned condition of registration will not be required as the disclaimer ensures that the owners of the mark do not have exclusive rights in the use of these words.

#### ☉ BREAK

'To break ones fast' means to eat after fasting, especially overnight. **BREAK** has become popular for use in trade marks and is commonly used in relation to food, drink or catering. **BREAK** is considered non-distinctive for these goods and services and should be subject to objection under Sections 9 and 10.

#### ☉ BRITANNIA

This means Great Britain personified and is usually represented as a female figure forming an emblem of Great Britain. As **BRITANNIA** suggests that goods are British made it may be accepted in Part B. (On the same basis as **CALEDONIA**).

#### ☉ BRITANNIC

Unlike **BRITANNIA** this word is still in use, for example 'on Her Britannic Majesty's Service' and means of or relating to Britain. It is necessary to Object under Sections 9 and 10 for any services, prima facie.

#### ☉ BUDGET

Held to be unregistrable for car-hire services. (the Statement of Grounds on application Nos. 1282323/4 refers.) this word is unacceptable for any services.

#### ☉ BUILDINGS: PICTORIAL REPRESENTATIONS OR NAMES OF.

If a non-stylised representation of a building appears in a mark the applicant is required to state whether they own the building in question; if they do not, they must obtain the written consent of the owner of the building to the registration of the mark. A statement will be printed in the Journal;

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

If the required consent is not obtained it will be necessary to take an objection under Section 17 (discretion) and also Section 11. (The statement of grounds issued in respect of the mark MANSION HOUSE, application Nos. 1088121/2 refers). Similar objections arise to the name of buildings as to pictorial representations of them.

This practice applies to all UK buildings both public as well as private and in respect of all goods and services. Where foreign buildings are concerned this practice applies only in respect of tourist films and videos, 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.

### ● BUS SERVICES

Some earlier service marks involving **BUS SERVICES** were subject to Section 11 geographical objections if the mark included a place name. This is now considered unrealistic – the public look to the destination board and not the operator's name to establish where the bus is going. Section 11 objections need not be raised in this situation in future.

### ● BY

In marks including **BY**, for example, **PRETTY SET BY NIVEA** or **YOUNG YOU MIDLINE BY SILHOUETTE** the only registrable element is often the last word, ie. **NIVEA** or **SILHOUETTE**. There is a danger that this is overwhelmed by the disclaimed matter which precedes it. Wherever possible such marks should be presented in a form which makes the registrable element predominant if Part A is sought, though most can be accepted in Part B with a disclaimer. Amendment of the marks for Part A need not necessarily mean that the registrable element should precede the disclaimed elements (omitting the word by) but that may be one way of overcoming objection. The criteria to bear in mind are similar to those which apply to composite word/device marks where the wording is disclaimed; the registrable element should be presented as a predominant and memorable part of the mark. The examiner should take into account the prominence or length of the disclaimable matter and the strength of the registrable element – if it is a household name (**CADBURY'S**, **KODAK** etc) it can perhaps be somewhat less prominent since its impact will still be strong.

# C

## ● CAD

Standard abbreviation for 'Computer Aided Design'.

## ● CALEDONIA

Acceptable in Part B (ancient name for Scotland).

## ● CALVADOS

See COGNAC.

## ● CAP: CAPSULES

It is no longer practice to raise Section 11 objections in Class 5 (pharmaceuticals) where the mark includes CAP.

## ● CARE

For services, object under Sections 9 and 10 when combined with another descriptive element, for example HOUSECARE for insurance, MOTOR CARE for nursing home services, but accept in Part B when the other descriptive element alludes to the services, for example LEGALCARE for legal services.

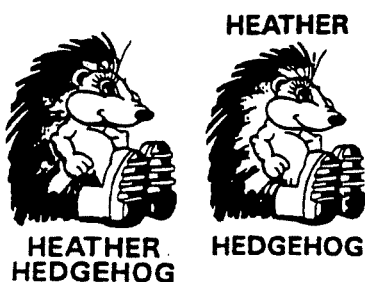
## ● CARTOON CHARACTERS

If cartoon marks are accompanied by the name of the character, each mark should be considered on its merits with regard to Section 9 and 10 objections.

A penguin objection is not normally relevant where a mark consists of a non descriptive term along with an animal name, for example, BABS BUNNY, BUSTER BUNNY. The same applies to marks consisting of a cartoon character and the name of the character. In these cases the characterisation in the mark is usually enough to take it away from just a simple representation of the animal/character etc.

See also PENGUIN PRACTICE

A Penguin exclusion would not be required in the examples shown below.



● **CASTROL CONDITION**

See **BLANK SPACES**

● **CAT**

Over recent years the word **CAT** has become generally recognised as an abbreviation for **CATAMARAN** (Collins dictionary). Accordingly an objection under Section 11 of the Act should be raised against marks incorporating the word **CAT**, for example **SEACAT** in Class 12, for specifications including types of watercraft. This can be overcome by a qualification along the lines of 'all being in the nature of catamarans' or 'all having twin hulls' or a condition of registration.

● **CELL**

This word is now considered meaningful in relation to machine tools and computers, and it is necessary to object under sections 9 and 10 [SOG relating to **CELLNET** No. 1213145 refers]

● **CENTRAL**

A geographic name with a well known other meaning. It is a department in Southern Paraguay with a population of 163,000. Evidence showed that area was low-lying and swampy so it was allowed prima facie in Part B for 'films prepared for exhibition' as the climate was humid and unsuited to film making. There is also an area in Scotland called Central Region but in view of well known non-geographical meanings for **CENTRAL** it has been decided that marks consisting of this word, for goods, can be accepted in Part B. **CENTRAL** is more relevant to service marks and is considered objectionable for many types of services ie. descriptive of a central location.

See also **GEOGRAPHIC NAMES WITH OTHER WELL KNOWN MEANINGS**

● **CERA**

This is not recognised as an abbreviation for ceramics so it is not necessary to object to marks containing **CERA** which cover ceramics (Class 19)

● **CHANNEL ISLANDS**

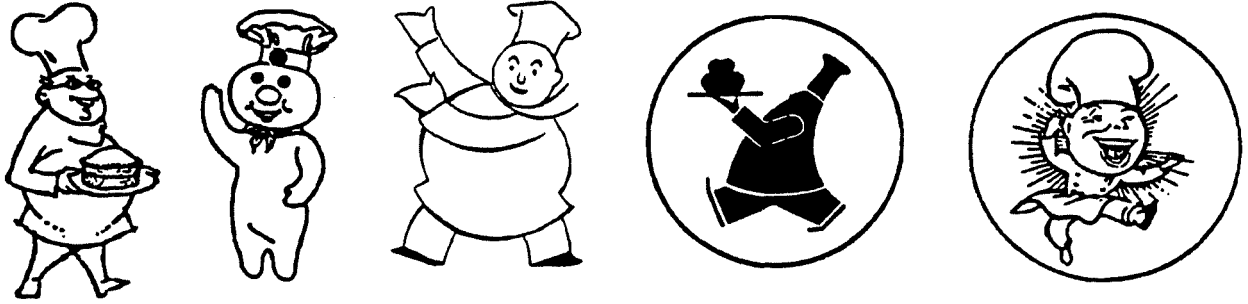
The **CHANNEL ISLANDS** do not form part of Great Britain for the purposes of the Trade Marks Act.

● **CHARTERMARK**

See **CITIZEN'S CHARTER**

● **CHEF**

The word **CHEF** and **CHEF** devices are considered non-distinctive for food, drinks, kitchen equipment and food catering services and should be objected to under Sections 9 and 10 unless they are very stylised. The examples shown below were considered acceptable for part B registration because they possess a distinctive element. ➡



### ● CHRISTIAN NAMES

See FORENAMES

### ● CITATION OF MARKS SHOWN AS LAPSED

Marks raised as cited under Section 20(4) do not usually present many problems as applicants are content to await the complete expiry of such marks. Such cites can be waived if evidence clearly indicates that the cite has not been used for some time.

A mark cited under Section 20(4) may be waived by the Unit SEO if sound evidence is filed to show that the mark in question has not been used during the preceding two years. Such evidence should be presented in the form of a Statutory Declaration, stating the methods used to identify whether or not the mark has been in use. It should include any approaches made to trade associations, trade magazines and must indicate that the address for service or agent has been contacted and what the outcome was. In effect it is necessary to demonstrate that all reasonable avenues have been explored. The decision as to whether to waive the cite or not should be taken at SEO level or above.

### ● CITIZEN'S CHARTER

This has received a great deal of publicity and should now be recognisable to the general public as denoting the government instigated programme to improve public services in the 1990s.

The only organisations permitted to use the **CHARTERMARK** are those providing public services deemed to have met certain quality standards. A representation of the **CHARTERMARK** is shown below:



Any marks similar to the words **CITIZEN'S CHARTER** or to the **CHARTERMARK** should be treated with the utmost caution.

## ☉ CITY

See **WORLD**

## ☉ CLASSIC

Means 'of the highest quality or rank: having recognised and permanent value: of enduring interest and appeal' (Websters Dictionary). The word is applied most often to works of literature and the fine arts but can be used to describe any object which displays artistic taste and style, for example cars. Given the purely laudatory meaning of **CLASSIC** it must be regarded as a word which is unregistrable. [1915 RPC 15 refers].

The statement of grounds relating to application no. 1108537 for the mark **CLASSIC** in Class 21 is a source of reference. The decision of the Hearing Officer to refuse this application was upheld by Mr Justice Whitford in the High Court.

## ☉ CLOCKS AND WATCHES

There are three main considerations to bear in mind when an application is made for these goods:

- 1 The face of a clock or watch can be decorated. Applications for **THE PENNY WATCH** and **THE HALF PENNY WATCH** were refused under Sections 9 and 10 as a photograph in a catalogue showed that the face of the watch was manufactured from a penny and halfpenny using 'old money' (i.e. not legal tender).
- 2 Watches, particularly, often have additional functions such as calenders, stop watches and calculators. **LAP TIME** would be refused because it is a function of a watch.
- 3 Time pieces may be manufactured to perform in certain areas or conditions. In the past objection was taken to words such as **ADMIRAL** or **SQUADRON LEADER**, but in recent times such words have been seen as fanciful since such occupations would require specialist functions on their watches.

## ☉ CLOS

See **ESTATE NAME**

## ☉ CLUB

When presented alone **CLUB** is descriptive of and non-distinctive for goods bearing a club's motif or sold through a club. It is also unregistrable for any services capable of being provided by a club.

## ☉ COCA COLA BOTTLE

See **CONTAINERS** and **BOTTLES**.

## ☉ COCKTAIL NAMES

Marks in Class 32 consisting of the names of alcoholic cocktails should be objected to under Section 11 if the specification includes non-alcoholic beverages, on the grounds of confusability with the alcoholic version in Class 33. ➡

Marks consisting of the names of non-alcoholic cocktails should be objected to under Sections 9, 10 and 11 if the specification includes non-alcoholic beverages on the grounds of descriptiveness and non-distinctiveness.

The references used for raising such objections should be carefully checked. 'The New International Guide to Drinks' compiled by the U.K. Bartenders Guild is a reliable source of information.

### ☛ COCKTAILS IN SPECIFICATIONS

The specification 'wines, spirits (beverages) and liqueurs' does not cover cocktails. Cocktails must be specifically mentioned if they are intended to be covered.

See also **ALCOHOLIC COCKTAILS**

### ☛ CODED BANK CARDS

see **BANK CARDS.**

### ☛ COGNAC, ARMAGNAC AND CALVADOS

The United Kingdom Government has given the French Government an undertaking (Exchange of Notes Cmnd 6301) to protect the designations **COGNAC, ARMAGNAC and CALVADOS**. No trade marks bearing these words can be accepted for registration in respect of goods other than those so designated. This restriction will equally apply even if these words are used with an indication of the true origin, for example **JAPANESE COGNAC**, or with the addition of an expression such as 'kind', 'type' or 'style'.

### ☛ COLOUR: WORD APPEARING IN A MARK.

If the words **COLOUR, COLOURS** or names of hair shades, for example **BLONDE**, appear in a mark for goods which impart colour, such as cosmetics, toiletries and hair preparations, it is necessary to raise an objection under Section 11. This may be overcome by an appropriate limitation.

Objection arises under Sections 9,10 and 11 because the mark is descriptive of goods that are coloured (red, green) and deceptive if not as described above

### ☛ COLOUR: WORD USED IN A MARK FOR PAINT

Colours may describe the actual colour of the paint. The following guidelines should be applied:

Object under Sections 9, 10 and 11 to colour names such as **CRANBERRY, DAMSON, GARNET AMETHYST, AQUAMARINE and CAFE AU LAIT**;

Accept in Part A, **QUARTZ** (no colour or various colours depending on the impurities present), **AGATE** (variegated appearance, but no single colour indicated), **PAPAYA** (green fruit, yellow flesh, purple flowers - not known by one colour);

Colours in combination with other non-distinctive matter can be accepted in Part A: **ICE COFFEE** (limited to coffee coloured), **VANILLA ICE** (limited to white or off-white) and **MISTY BLUE** (limited to blue). Where the specification of goods is not limited, it will be necessary to raise an objection under Sec-

tion 11 (there is a clear expectation of a certain colour). Descriptive colours such as **DEEP BLUE** should not be accepted.

Dictionary words which are descriptive but obscure and unlikely to be used by others can be accepted in Part B: **LUNA** (alchemists' name for silver) and **CARNELIAN** (an alternative name for **CORNELIAN**; a red gem stone which is not well known).

#### ● **COLOUR: MARKS DEPICTED IN.**

A combination or arrangement of colours can be sufficiently distinctive to merit registration. Consequently a mark, although otherwise not distinctive, can be considered capable of distinguishing if it is limited to the particular colours in which it is shown in the application. For example, if a 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 mark could be accepted in Part B. In this case it would be necessary to agree to limit use of the mark to specific colours, which will need to be represented in heraldic shading in the Trade Marks Journal. The clause should be worded as follows:

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

This clause will be required 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.

A mere statement of the colours, for example 'the mark consisting of the colours red, yellow and blue', is not an acceptable representation of the mark. A representation of how the colours are used in relation to each other is required. The applicants need to show that they have built up a reputation in the mark, so extensive evidence of use is required before such a mark can be accepted for registration.

#### ● **COLOUR BACKGROUNDS**

If a mark consists simply of matter which is not 'distinctive' in itself, acceptance is not normally justified if the non-distinctive matter is simply printed in a colour or colours different from the colour of the background.

#### ● **COLOUR LIMIT: REQUESTED BY APPLICANT.**

Where an applicant wishes to limit their mark to certain colours but the colour requirement is not a formal requirement of the Registrar, for example to ensure acceptance in Part A or Part B, it is not necessary to seek a camera ready copy in heraldic shading for the advertisement. The colours may be depicted in half tone and the colour limit clause will then read as follows:

*The Mark is limited to the colours ..... as shown on the form of application.*

If the applicant prefers to submit a camera ready copy in heraldic shading this may be accepted, in which case the colour limitation clause should read:

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

## ☉ COLOUR: MARKS NOT LIMITED TO BUT APPLIED FOR IN.

If a mark is depicted in colour on the form of application but it would qualify for registration even if represented in black and white, and the applicant does not wish to limit the mark, then no colour limit is necessary. Black and white representations are not required for the file and the advertisement can be in black and white depicting the various colours in half tone.

If the applicant prefers to submit a camera ready copy in heraldic shading this may be accepted and again no colour limit is necessary. The following clause will clarify the position:

*The Mark, here depicted in heraldic shading, is shown in the representation on the form of application in the colour(s)... but the Mark is not limited to colour.*

## ☉ COLOUR: NAME OF COLOUR IN A WORD MARK

Where a word mark includes the name of a COLOUR, either alone or with a non-distinctive element, objection should be taken under Sections 9, 10 and 11 because the mark is 'descriptive of [goods] that are coloured [red, green] and deceptive if not as described above'. If the colour is seen as fanciful, such as blue margarine, red sugar or mauve bread there will be no justification for raising Section 9 and 10 objections.

**Note:** This applies mainly to colours pure and simple, like **RED, GREEN** etc. Certain other words such as **PEACH, GOLD, APRICOT, MINK AND CHOCOLATE**, although having alternative meanings are recognised as having a strong connotation with definite colours. Certain other words such as **EMERALD, SAPPHIRE OR FLAMINGO** do not have a sufficiently strong colour connotation to overwhelm the other alternative non-colour connotation.

Some marks have been accepted because the colour component is felt only to describe the distinctive element that follows it, for example **RED DEVIL, BLUE LAGOON, YELLOW CAB**. Care should be taken to avoid instances where the mark could be read into the goods for example **GREEN MACHINE** in Class 25 seems acceptable at first glance, but not if the goods are knitted pullovers as 'green machine knitted pullovers' would clearly be unregistrable. **GREEN** is also a common surname.

## ☉ COMMUNITY

Not acceptable for any goods or services which are likely to be sold or provided between members of the EEC. It may also imply that the goods comply with EEC standards.

See also **ECONOMIC COMMUNITY**

## ☉ COMPANY NAMES

A special provision is contained in Section 9(1)(a) of the Act to provide for the prima facie registration of a company name in Part A of the Register if the name is represented in a special or particular manner.

If a company name is not represented in a special or particular manner it can be accepted under the provisions of Section 9(1)(d) as long as it is distinctive for the goods/services concerned i.e. providing it contains an essential element which is acceptable for registration in Part A the name may be accepted in Part A. Similarly if the essential element of a company name is acceptable in Part B the name may be accepted in Part B.

An example is the mark **TIFFANY & CO**. **CO** is an abbreviation for company but the word **TIFFANY** alone is acceptable for registration in Part A (a very rare surname) so the mark as a whole is acceptable for registration in Part A.

## 🌐 COMPARISON OF GOODS AND SERVICES

### COMPARISON OF GOODS

A record of decisions on 'goods of the same description' is kept and this is called the **COMPARISON OF GOODS INDEX (COGI)**. It is, however, a guide only.

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

The Court's guidance at the present time is that consideration should be given under the three headings specified in **JELLINEK'S APPLICATION (63 RPC 59)**

- 1 Nature of goods
- 2 Purpose of goods
- 3 Channels of trade of the goods

In practice, if it is considered that the respective goods coincide in respect of two headings then this is sufficient to justify a finding that the goods are of the same description.

It is doubtful whether goods can be considered to be 'goods of the same description' merely because they pass through the same channels of trade.

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

- 1 Producer/manufacturer
- 2 Wholesaler (if any)
- 3 Retailer if any

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

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

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

The **DAIQUIRI RUM CASE (1969 RPC 600)** concerning, inter alia, whether rum was the same as, or of the same description as, or different to rum cocktails gave support to the way the Law had developed in deciding the question of conflict of goods.

Lord Reid in his judgement in this case, gave a useful interpretation of the words 'the same goods' and 'goods of the same description'. Additionally Lord Wilberforce in his judgement in the same case gave a useful commentary on the same topic.

## ● COMPARISON OF MARKS

There is no precise set of rules laid down as to when or when not to cite a mark. The question whether one trade mark is so similar to another that public confusion is likely to arise if both marks appear on the market in relation to the same goods to goods of the same description, is a matter for individual common sense, which examiners need to exercise in carrying out their duties. Nevertheless, over the years the courts have laid down certain principles to be borne in mind, and these are referred to below. It is not thought that the new Act will make any difference to these principles.

It must be assumed that the marks will be used normally and fairly in respect of all the goods or services applied for. The onus is on the applicant to prove to the Registrar that confusion will not arise.

The **PIANOTIST CASE** (23 RPC 774) provides good authority for the basic principles involved in a comparison.

1. **APPEARANCE:** You must compare the appearance of the two marks.
2. **SOUND:** You must compare the sound of the two marks.
3. **GOODS:** You must consider the goods to which the mark is to be applied. For instance the purchaser of an expensive new car is likely to take more care over the purchase than the purchaser of a cheap pair of socks and thus the purchaser of the car is less likely to be deceived or confused.
4. **CUSTOMER:** You must consider the kind of customer who is likely to buy the goods. The more knowledgeable or specialised in a particular trade the purchaser is then the less likely that purchaser is to be deceived or confused.
5. **SURROUNDING CIRCUMSTANCES:** All the surrounding circumstances must be considered and this includes the previous factors plus any other relevant factors which become known.

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

6. The question whether one mark resembles another mark should not be decided as the result of a meticulous comparison of the two marks side by side, letter by letter or syllable by syllable.
7. **FIRST IMPRESSION AND IMPERFECT RECOLLECTION:** **ARISTOC V RYSTA** (62 RPC 72) provides a useful guide to this principle.
8. **SIMILARITY OF THE BEGINNINGS OF WORD MARKS** is generally more important because of the tendency which many people have of slurring the ends of words or of dropping their voices at the ends of words. There is also a tendency to abbreviate many trade marks. For example **MARKS AND SPENCER** is commonly referred to as **MARKS**.
9. **MARKS MUST BE COMPARED AS WHOLES:** That is to say, marks should not be split up or dissected when being compared.
10. **DISTINGUISHING OR ESSENTIAL FEATURES:** However where device marks which may have a number of elements including words, are being compared it is important to identify the essential feature or features of the mark. (See (58 RPC 147) and (68 RPC 103)

Lord Radcliffe observed:

*In most persons the eye is not an accurate recorder of visual detail and marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. (68 RPC 103). ➡*

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

For example a mark consisting of a word or words which in effect describe a particular device mark must be regarded as likely to be confused with that device and vice versa. For instance, the words **BLACK CAT** could be confused with the device of a black cat. Examiners should be aware of the descriptiveness of a word mark and carry out a search of the device index or **TRIMS** accordingly.

12. **ENGLISH AND FOREIGN EQUIVALENTS:** There is judicial support to the view that foreign words and their English equivalents may be confusingly similar. (13 RPC 295 **GOLDEN FAN**) Later practice was that this should not be applied too rigidly. However, in the light of the Single Market since 1992 and the opening up of commercial trading throughout Europe it is possible that examiners should be more prudent when examining foreign words. If the mark is in a major language such as French, German, Italian or Spanish it is possible that many people in Britain would know the meaning. Many foreign words are also similar in spelling and phonetically similar. Other words have crossed into common English use, sometimes as slang or as an expression which may not have an appropriate English translation.

Examples of French and German words that are probably known to a wide public:

#### FRENCH

Vin, Parfum, bon, petit(e), bijou, hippotame, jardin, and many other words particularly those connected with the food of cosmetics industries.

#### GERMAN

Achtung, liebe, lieblich, nacht, schmalz, kitsch, qualitat.

13. **PLURALISED WORDS:** Trade marks are often used by themselves when ordering goods, without any specific mention of the goods as such. For example it is quite likely for some to walk into a newsagents and ask for 20 **ROTHMANS** and a box of **SWAN VESTAS**, rather than a packet of **ROTHMAN'S CIGARETTES** and **SWAN VESTA MATCHES**. In such cases, a person ordering a quantity of goods under the trade mark will often do so by simply adding an 's' to the trade mark itself. Therefore it is necessary when comparing word marks to allow for the possibility of that the marks themselves may in practice be pluralised and to consider whether this process would have the effect of enhancing the likelihood of confusion between the marks. the degree of likelihood that a mark will be used in this manner depends to a large extent on the nature of the goods themselves.

14. **WORDS 'TALK':** If a trade mark contains words and devices it is more likely that the public will refer to the goods by the words in the mark. Words are usually more memorable, unless they are very non distinctive. If for example you wanted to buy a pair of **NIKE** trainers you would ask for them by name even though the flash on the side of the trainers is in itself very distinctive. You would not ask for a pair of trainers with a flash on the side.

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

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

## ⑥ COMPARISON OF DEVICE MARKS

It is not possible to lay down a precise rule as to when a Section 12 objection should be raised but recent experience with some animal marks provides useful guidelines.

At the pre-search stage the Examiner should decide whether it is necessary to conduct a phonetic or visual search. If the mark is likely to be referred to by word ie the device of a **BEAVER**, **PENGUIN**, or **OWL** then a phonetic search will be required and any other mark that may be referred to as a **BEAVER**, **PENGUIN** or **OWL** will represent a potential cite. Allowance should also be made for the degree of fancifulness. If one mark is a straightforward representation of an owl, and the other is an owl in evening dress (and is likely to be referred to as such) then confusion is less or unlikely. If one is a whole body and the other the head only with outsize spectacles or other adornment, confusion is again less likely.

Differences may be less marked if there are many similar marks on the Register. It is assumed that the public have become accustomed to differentiating between the marks for similar goods or services but one cannot ignore very similar marks for the same goods and services. If the mark does not lend itself easily to a usual description a phonetic search will not be required. Clearly, streaks of colour with no particular delineation, such as an artist might make in trying out colours on his palette would be such a case. In such cases the marks will need to be fairly close but side by side comparison is not enough; the test must be whether the two marks would be confused if one was seen last week and the other a week later?

Returning to the animal type marks – an un-fanciful representation of an animal will be regarded as confusable with another such un-fanciful representation even if the animal is in a different posture or the type of representation is different eg. a silhouette against line drawing. One owl on a perch will be regarded as confusingly similar to 2, 3 or 4 owls also sitting on a perch.

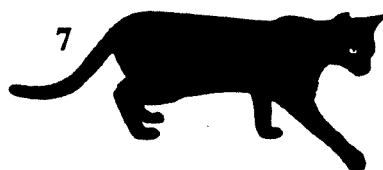
The following words and devices of cats and owls are examples of the above criteria in operation.

### CATS

- 1 **CAT** Cite against **CATS**, **KAT**, **KATS**, **BLACK CAT** and all cat devices other than 6.
- 2 **CATS** Cite against **CAT**, **KAT**, **KATS**, **BLACK CAT** and all cat devices other than 6.
- 3 **KAT** Cite against **CAT**, **CATS**, **KATS**, **BLACK CAT** and all cat devices other than 6.
- 4 **KATS** Cite against **CAT**, **CATS**, **KAT** **BLACK CAT** and all cat devices other than 6.
- 5 **BLACK CAT** Cite against **CAT**, **CATS**, **KAT**, **KATS** and all cat devices other than 6.
- 6 Do not cite against any **CAT** marks; this mark will be known as **LYNX**.



7 Cite against CAT, CATS, KAT, KATS, BLACK CAT and device 8 and 13.



8 Cite against CAT, CATS, KAT, KATS, BLACK CAT and device 7 and 13.



9 Cite against CAT, CATS, KAT, KATS, BLACK CAT and devices 12 and 14.



10 Cite against CAT, CATS, KAT, KATS and BLACK CAT but not against any devices shown here.

10



11 Cite against CAT, CATS, KAT, KATS and BLACK CAT but not against any devices shown here.

11



12 Cite against CAT, CATS, KAT, KATS, and BLACK CAT and devices 9 and 14



13 Cite against CAT, CATS, KAT, KATS and BLACK CAT and devices 7 and 8.

13

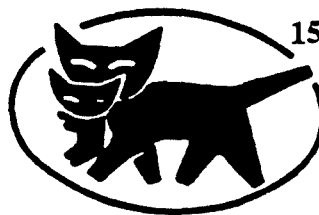


14 Cite against CAT, CATS, KAT, KATS, BLACK CAT and devices 9 and 12.



15 Cite against CAT, CATS, KAT, KATS and BLACK CAT but not against any devices shown here.

15



**OWLS**

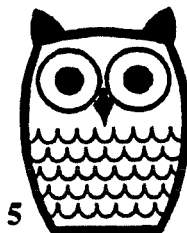
- 1 **OWL** Cite against **OWLS**, phonetic equivalents of owl and all devices of owls.
- 2 **NIGHT OWL** Cite against **OWL**, **OWLS**, phonetic equivalents of owl and devices 3 and 4.
- 3 Cite against **OWL**, **OWLS**, phonetic equivalents of **OWL**, **NIGHT OWL**, **NITE OWL** and device 4.



- 4 Cite against **OWL**, **OWLS**, phonetic equivalents of **OWL**, **NIGHT OWL**, **NITE OWL** and device 3.



- 5 Cite against **OWL**, **OWLS**, phonetic equivalents of **OWL** and device 6. (Imperfect recollection must be taken into account in this case).



- 6 Cite against **OWL** and **OWLS** since the device is very prominent in this mark. Also cite against device 5.



Imperfect recollection must be taken into account in this case.

- 7 Cite against OWL and OWLS because the device is very prominent in this mark and may not be recognised as MINERVA. Do not cite against the other owl devices shown here.



Cite devices 8 to 13 against OWL or OWLS, but not against each other or any of the other device marks shown here.

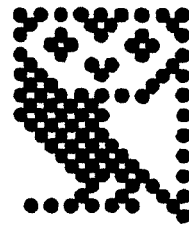
8



9



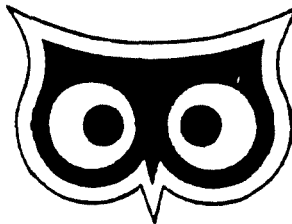
10



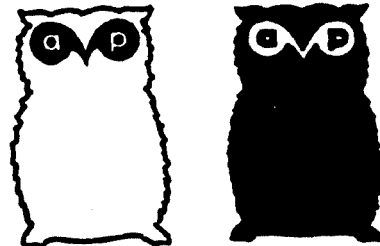
11



12



13



## COMPASS POINTS

There is no need to disclaim N, S, E and W when shown as part of a compass device.

## COMPOSITE MARKS CONTAINING NON-DISTINCTIVE ELEMENTS

Where a composite mark contains a non-distinctive element it will be considered acceptable only where the prominence of the distinctive element is sufficient to overcome the non-distinctive part.

As a rough guide the following factors should be considered but cannot be applied rigidly as the decision on any particular mark is always a subjective one.

### For Part A Registration

#### 1 PROMINENCE OF THE DISTINCTIVE ELEMENT

The distinctive element should be one which catches the eye first and holds the attention. ➔



Registration of this mark shall give no right to the exclusive use of the word 'ocean'.



Registration of this mark shall give no right to the exclusive use of the word 'Scottfresh'.



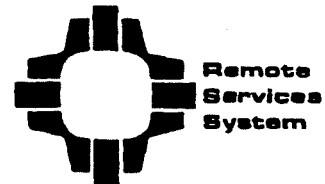
Registration of this mark shall give no right to the exclusive use of the words 'Adventure Team'.

## 2 POSITION OF DISTINCTIVE ELEMENT

The distinctive element generally appears more prominent if is placed above or to the left of the disclaimed elements but this is not conclusive in itself.



Registration of this mark shall give no right to the exclusive use of the letters 'H&E'.



Registration of this mark shall give no right to the exclusive use of the words 'Remote Services System'.



INTERNATIONAL MOBILE SATELLITE ORGANIZATION

Registration of this mark shall give no right to the exclusive use of the words 'International Mobile Satellite Organization'.

## 3 RELATIVE SIZE OF ELEMENTS

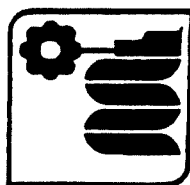
The disclaimed element(s) should not be too large in relation to the rest of the mark; as a rough guide the physical length of any disclaimed words should not exceed the width of the device. The height and boldness of the lettering should also be taken into account; 'Britain feels better for it' in small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



Registration of this mark shall give no right to the exclusive use of the words 'Super Electronic'.



Registration of this mark shall give no right to the exclusive use, separately, of the words 'Vision' and 'Express'.



Registration of this mark shall give no right to the exclusive use of the word 'Five'.



Registration of this mark shall give no right to the exclusive use of the letter 'S'.



Registration of this mark shall give no right to the exclusive use of the words 'European Year of Tourism'.



Registration of this mark shall give no right to the exclusive use of the letters 'U C B'.

#### 4. NON-DISTINCTIVENESS OF DISCLAIMED ELEMENT

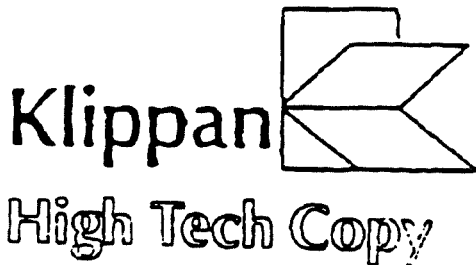
It may sound a contradiction in terms but the more obviously non-distinctive the disclaimed element is, the less damaging it may be to the mark as a whole. This is because the public are expected to realise that no rights exist in very common words or phrases; in the case of services no rights would exist in, for example, '24-hours', 'International' or 'Colour'.



Registration of this mark shall give no right to the exclusive use of the words 'Defense Research Agency'.



Registration of this mark shall give no right to the exclusive use of the word 'Insurance'.



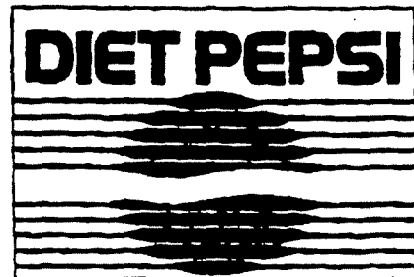
Registration of this mark shall give no right to the exclusive use of the words 'High Tech Copy'.



Registration of this mark shall give no right to the exclusive use of the word 'Center'.



Registration of this mark shall give no right to the exclusive use of the words 'Clothing Inc' and 'Genuine Product'.



Registration of this mark shall give no right to the exclusive use of the word 'Diet'.

5 IF THE DISTINCTIVE ELEMENT IS WELL KNOWN

If the distinctive element is so well known that it has become a household name or if it is a mark which has already been registered on the basis of strong acquired distinctiveness through extensive use (a house-mark); it may be considered capable of supporting a composite containing a relatively large or prominent amount of disclaimed material. This is because the public are already familiar with that part of the mark so it will necessarily catch their attention all the more.



Registration of this mark shall give no right to the exclusive use of the word and numeral 'Fifty 50'.



Registration of this mark shall give no right to the exclusive use of the words 'Body Butter'.



Registration of this mark shall give no right to the exclusive use of the words 'Merchant Services' and the letters 'PDQ'.

6 IF THE DISTINCTIVE ELEMENT IS PARTICULARLY STRIKING AND INVENTIVE



Registration of this mark shall give no right to the exclusive use of the word 'Prize'.



TVE

Registration of this mark shall give no right to the exclusive use of the letters 'TVE' and the device of a map of the world.



Registration of this mark shall give no right to the exclusive use of the word 'Life'.



Registration of this mark shall give no right to the exclusive use of the words 'Home School'.



Registration of this mark shall give no right to the exclusive use of the letters 'KC' and the words 'Kids Against Crime'.

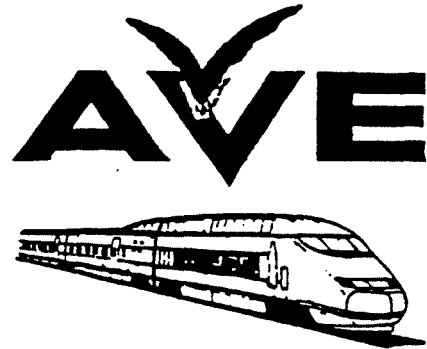
**FOR PART B REGISTRATON**

As a rough guide the following factors may preclude acceptance in Part A whilst still allowing acceptance in Part B.

- 1 If the disclaimed element and the distinctive element are of roughly equal prominence.



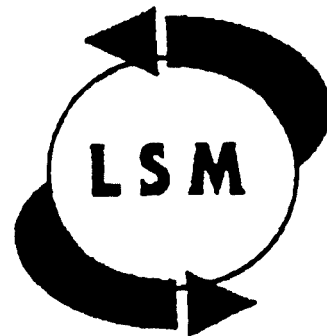
Registration of this mark shall give no right to the exclusive use of the words 'Drainage Center' and the device of a pipe



The Spanish word appearing in the mark means bird  
Registration of this mark shall give no right to the exclusive use of the device of a train



Registration of this mark shall give no right to the exclusive use of the word 'Marti'



Registration of this mark shall give no right to the exclusive use of the letters 'LSM'



Registration of this mark shall give no right to the exclusive use of the words 'People Care'

- 2 If the disclaimed element is placed above, or to the left of the distinctive element and has a visual impact almost equally as strong.



Registration of this mark shall give no right to the exclusive use of the words 'Plak Free'



Registration of this mark shall give no right to the exclusive use of the word "Toscano".



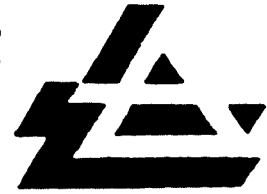


Registration of this mark shall give no right to the exclusive use of the words 'Collection d'Art'.



Registration of this mark shall give no right to the exclusive use of the letter 'M'.

**AIR  
PRODUCTS**



Registration of this mark shall give no right to the exclusive use of the words 'Air Products'.

- 3 If the disclaimed element, although positioned below or after the distinctive element, is visually very prominent.



Registration of this mark shall give no right to the exclusive use of the word "Premier".



Registration of this mark shall give no right to the exclusive use of the word "Depigmenten".



Registration of this mark shall give no right to the exclusive use of the word "Real".



Registration of this mark shall give no right to the exclusive use of the word "Datascan".



Registration of this mark shall give no right to the exclusive use of the word "Homecover".



Registration of this mark shall give no right to the exclusive use of the words "Air Cargo Express".

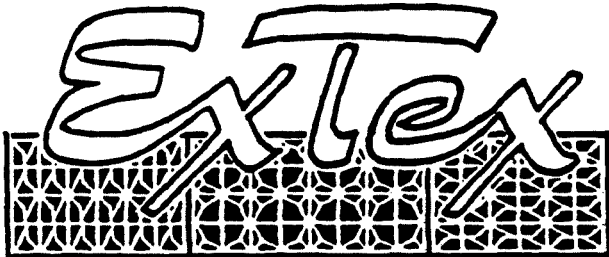
- 4 If the disclaimed element is itself sufficiently distinctive to be recognised as trade mark matter, for example mis-spelt or elided words.



Registration of this mark shall give no right to the exclusive use of a letter "B" and the word "Bellini".



Registration of this mark shall give no right to the exclusive use of the words "The Chart Show".

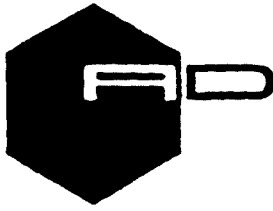


Registration of this mark shall give no right to the exclusive use, separately, of the words "Ex" and "Tex".



Registration of this mark shall give no right to the exclusive use of the word "Metaleurop".

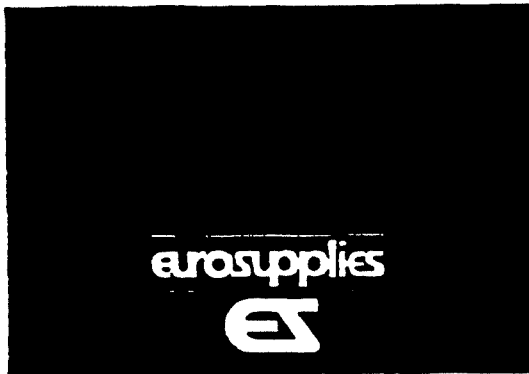
5 If the non-disclaimed element is not particularly distinctive or inventive.



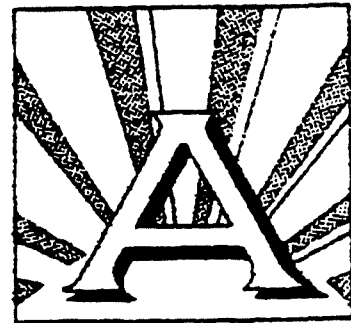
Registration of this mark shall give no right to the exclusive use of the letters "A" and "D".



Registration of this mark shall give no right to the exclusive use of the words "The Training Channel".



Registration of this mark shall give no right to the exclusive use of the word "Eurosuples".



Registration of this mark shall give no right to the exclusive use of the letter "A".

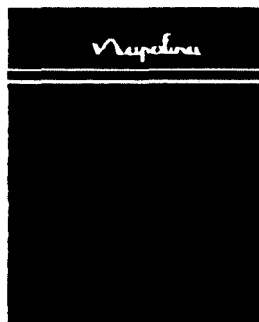
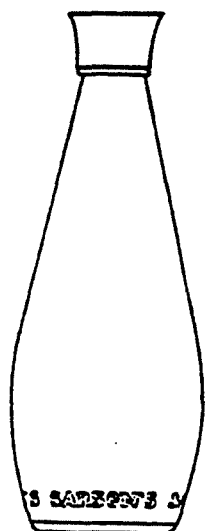


Registration of this mark shall give no right to the exclusive use, separately, of the words "Step" and "Safe".



Registration of this mark shall give no right to the exclusive use of the words "Furniture Warehouse".

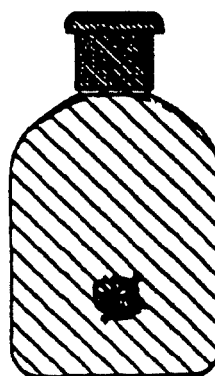
The following are examples where the distinctive element is not sufficiently prominent to allow the marks to proceed to registration.



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



Registration of this mark shall give no right to the exclusive use of the word "Girls", the device of a packet coloured blue, yellow, green, pink and white and the numeral 20.



## Ⓢ CONCEPT

Practice on the word **CONCEPT** has varied over the years. It is now widely used in advertising to denote a new or modern idea and is generally considered to be non-distinctive and prima facie not adapted to distinguish or capable of distinguishing. Consequently prima facie objection should be taken to **CONCEPT** (used on its own) under both Sections 9 and 10.

## Ⓢ CONCORDE/CONCORD

Several geographical locations are named **CONCORD**, the largest of which, with a population of 30,000 is an industrial town in New Hampshire. In view of the revised de minimus rule (October 1989) it should be objected to under Section 9 prima facie and offered Part B. **CONCORDE** should be treated as the phonetic equivalent of **CONCORD**.

## 🌐 CONDITIONS: USE TO OVERCOME SECTION 11 OBJECTIONS

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 mark wider infringement rights than a limitation of goods or services. It must be borne in mind that while the condition may overcome the Section 11 objection an application cannot be permitted to proceed if it is clear that the applicants cannot use the mark on some category of goods or services in the specification. (The Registrar has the power to take unilateral action under Section 33 to have the mark expunged if the condition is not observed).

Where a condition is appropriate:

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.

An example is **PILOFRENCH** for 'wine' which indicates goods of French origin. A potential Section 11 objection could be overcome by a condition that the mark shall be used in relation only to goods the produce of France, since all types of wine e.g. red, white, sweet, dry, sparkling, may be made in France.

Where a condition is not appropriate:

**PROSTEEL** for 'all goods included in Class 6' indicates goods which consist of or contain steel. A Section 11 objection could not be overcome by a condition that the mark shall be used in relation to goods consisting of or containing steel because the specification also includes 'non-ferrous metal ingots' which by their very nature could not consist of or contain steel. A condition would be appropriate if the specification was limited to 'screws'.

When consideration is given to possible ways of overcoming objections raised under Section 11 it must be remembered that either a condition or a limitation to the specification is necessary, both should not be sought.

Conditions in relation to Restaurant services

It is well known that speciality restaurants usually offer a wider choice of food than the speciality dish. Even if the mark conveys very clearly one type of food e.g. **JOE PALOOKAS CHICKEN RESTAURANT** then a condition that the services shall include the provision of chicken dishes would not in general be justified.

Note This practice relates to restaurant services and the like and not to goods.

## 🌐 CONFECTIONERY: SHAPED

Given the continued enthusiasm of confectionery manufacturers for producing sweets, biscuits, ice-creams and lollies in novelty shapes care should be exercised when examining trade marks in Class 30.

Section 9, 10 and 11 objections should be raised against marks such as **SUBMARINES, GIRAFFE, BEAR, TELEPHONE**. The wording to be used is '..... descriptive of and non-distinctive for e.g. goods in the shape of ..... deceptive if used on goods not in the shape of .....'. A **PENGUIN** exclusion is not appropriate because an objection has been raised under Section 11.

See also **PENGUIN PRACTICE**

Such marks are almost certainly unregistrable, even if substantial evidence of use can be demonstrated; objections may be overcome by the addition of an equity (the goods will need to be limited to all being in the shape described). ➡

Marks where these elements are combined with non-distinctive or descriptive matter, for example **LOTSALIPS**, **BABY BEARS**, **GREEN FROGS** or **JELLY BABY DOLPHINS**, will require similar objections to be raised as those above. Where the mark has a more unusual or distinctive element the Section 9 or 10 objections may be waived, for example **FUNNY BUNNY**, **CRAZY KANGAROO**, **SMELLY FEET**, **FUNNY FEET** or **FOREST FRIEND**. The objection raised under Section 11 may be overcome by limiting the goods to '..... all in the form of or decorated with .....

since the consumer, particularly children, would have an expectation that the goods are in the shape of or decorated with, for example, **FEET** or **BEARS**. This applies only where the shape is unambiguous; **FUNNY FEET**, for example, may not be feet shaped at all. Such a limitation will, of course, strengthen the Section 9 and 10 objections so it is essential that the mark, in totality, is distinctive or at least capable of distinguishing such goods while not unfairly restricting other traders. In borderline cases evidence of use may assist.

In cases where the goods have been limited to a shape (or decorated with a shape) the word should be disclaimed, for example **KANGAROO** must be disclaimed in **CRAZY KANGAROO**.

### ☛ CONFECTIONERY: NON-MEDICATED

See **NON-MEDICATED CONFECTIONERY**

### ☛ CONNECTION(S)

This is descriptive of and non-distinctive for services that provide a link between individuals or places. Object under Sections 9 and 10 for employment agencies, recruitment and transport related services.

See also **LINK**

### ☛ CONSENT

To be acceptable, **CONSENT** should:

- 1 Clearly identify the mark applied for and include a copy of any device.
- 2 Relate to registration, not just use, of the mark applied for.
- 3 Clearly identify the goods/services.
- 4 Cover all the goods applied for. If limited, the application can proceed only for the goods as limited;
- 5 Be on official letter-headed paper of the registered proprietor giving consent;
- 6 Not contain conditions or limitations.

When a mark proceeds by consent the words 'BY CONSENT' should be clearly stamped on:

- 1 The top of minute sheets
- 2 The top of TM-3
- 3 The file cover ('By consent, No(s) ..... Journal/Page .....') and also entered in the appropriate box on the OPTICS record.

## ● CONSENT: IN RELATION TO CLASS 5 GOODS

Extra care is required when a mark is used, or intended to be used, in relation to goods for use in or on the human body since danger to health could result from confusion between marks. Not all goods in Class 5 are for such use so there is not a blanket prohibition on the acceptance of letters of consent in respect of an application in Class 5 or an application facing a citation in Class 5.

The following points must be kept in mind when determining whether or not a letter of consent will be taken into consideration when Class 5 goods are involved:

- 1 When danger to human health is a possibility (over and above the ordinary commercial consequences of confusion) consent is not acceptable and a sufficiently strong conflict must be held to be a fatal objection.
- 2 This applies even if only one of the marks is in Class 5 and is for human consumption or for application to the human body, the other being in Class 1 or 3.
- 3 It follows that if one or both marks are in Class 5 but neither are for human consumption or for application to the human body, then consent is acceptable e.g. clashes between weed killers and air fresheners.
- 4 It should be remembered that some pesticides, insecticides and fungicides are used in or on the human body.

## ● CONTAINERS: ALONE

Devices of **CONTAINERS** for the goods concerned 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 canned goods. Devices of containers are considered so non-distinctive that they would not be considered part of the Registration and need not be disclaimed.

## ● CONTAINERS: REPRESENTATION OF CONTAINER PLUS DISTINCTIVE MARK

If the representation accompanying an application consists of an illustration of an ordinary container with the actual trade mark displayed on it there is no need to disclaim the device of a container if the trade mark is acceptable for registration. It is improbable that anyone would consider use of such a device an infringement.

## ● CONTAINERS: LIMITED TO COLOUR

An exception to the rule regarding disclaimers is when a mark is specifically limited to colour. In this case devices of eg. cartons or containers will need to be disclaimed. The designation of specific colours to such non-distinctive elements distinguishes them from elements not so marked and gives the impression that rights to the non-distinctive element are held in the coloured form. An example of the sort of disclaimer required is;

*Registration of this mark shall give no right to the exclusive use of the device of [a carton] coloured [yellow and black].*

If a container is shown in black and white and a coloured version, both devices need to be disclaimed. The disclaimer should read:-

Registration of this mark shall give no right to the exclusive use of the device of a container and no right to the exclusive use of the device of a container colour red, blue and green.

## CONTAINERS: THREE-DIMENSIONAL

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 (**SOBREFINA 1974 RPC 672** refers). Many perfume companies apply for their Trade Mark on 3D drawings of a container, for example Yves St Laurent. The devices of containers need to be disclaimed in these cases.

## CONTAINERS: COCA COLA BOTTLE

The law in relation to containers was 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 this decision was upheld on appeal to the High Court, the Court of Appeal and the House of Lords. A line drawing of a **COCA COLA BOTTLE** has, however, been allowed for registration. If a container is presented as a line drawing (which on **COCA COLA** criteria is registrable) a disclaimer may be necessary if it is in any way stylised. If it is not stylised a disclaimer will not be required.

## COOKS

See **CHEFS**.

## COPYRIGHT

A generic term used in the intellectual property field. Registration of this word could give the impression to others that the owners were able to claim copyright in some form in relation to services claimed. Objection under Sections 9 and 10 should be taken in relation to all services except those where there is no possibility of a **COPYRIGHT** connection such as book binding, brick-laying, riveting, or yoga instruction.

## COUNCIL OF EUROPE

See **EUROPEAN COMMUNITY SYMBOLS**

## COUNTERFEIT

The Registrar advertised this mark in Class 3 for cosmetics, perfumes etc. In the light of several complaints from firms in the trade and from the Anti-counterfeiting Group, saying that registration of this mark would encourage counterfeiting, the Registrar indicated to the applicants that he was not prepared to proceed with the application. The application was not pursued by the applicants and was subsequently removed from record.

## COUNTRY

When used in relation to clothing **COUNTRY** is open to objection under Sections 9 and 10 for goods which can be used for country pursuits, eg. Country coats. An example is the mark **COUNTRY CLASSICS** which is considered unregistrable because it is generic for classic clothing in a country style. Following the issue of a statement of grounds the application is under appeal to the Secretary of State and the outcome is awaited with interest.

**COUNTRY** is also widely used in relation to all types of foodstuffs, particularly basic foods such as pork, chicken and eggs, that being the case no one company should be granted a monopoly in such a term for

goods in Classes 29,30 and 31. Although **COUNTRY** may have been accepted for registration in the past marks consisting of **COUNTRY** plus the name of the goods will in future be subject to objection under Sections 9 and 10, prima facie, e.g. **COUNTRY PORK** for pork, **COUNTRY CHICKEN** for chicken and **COUNTRY EGGS** for eggs.

**COUNTRY** is open to objection under Sections 9 and 10 (and 11 in certain circumstances) for services such as insurance (cover provided in various countries), telecommunications, transport, food processing and agricultural and horticultural services.

### ☉ CREAM/CREME

When these words appear in a mark in respect of liqueurs etc. the goods must contain at least 4% milk fat, to comply with the trading standards requirements otherwise a Section 11 objection must be raised. This may be overcome by a suitably worded condition:

*It is a condition of registration that the mark shall, when in use in relation to liqueurs, be used in relation only to liqueurs containing not less than 4% milk fat.*

### ☉ CRETE

This is commonly used as a suffix in Class 19 and is probably intended to be an allusion to concrete. Objection would not normally be taken on these grounds but the geographical significance should always be considered.

### ☉ CRESCENT MOON

A red crescent moon on a white background is a protected emblem. No objection, under Rule 17, would arise if a **CRESCENT MOON** device appeared in a mark as a subsidiary feature 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, the following condition will be required:

*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.*

### ☉ CROSSES

If a mark has a cross of equal horizontal and vertical lines object under Rule 15 because it would be similar to the Red Cross or the Swiss Federal Cross which are protected emblems. This can be overcome by a **CROSS CONDITION**.

See **CROSS: GENEVA**

There is no need to object if the cross is in the form of a shield or if it is diagonal, unless it is diagonal and in the form of a flag in which case it may represent the St Andrews or Scottish Flag and be open to objection under Rule 17.

See also **FLAGS**

Restrictions on use of the Red Cross emblem and of designs closely resembling the Red Cross emblem:

The Red Cross emblem is a symbol to protect the wounded and sick, and is internationally recognised as such. It is a crime under the Geneva Conventions Act to use the emblem without the authority of the Defense Council. The only civilian body so authorised by the Defense Council to use the Red Cross emblem for its peacetime activities is the British Red Cross Society. Use of the emblem by any other civilian person or body is a criminal offense. On conviction, a fine may be imposed, and in addition, the offending goods may be confiscated. A successful application for a trade mark does not prevent the use of the design being an offense under the Geneva Conventions Act. A mark which so nearly resembles the red cross emblem as to be capable of being mistaken for it is in breach of Section 6(2)(b) of the Geneva Conventions Act 1957.

For similar reasons, the Geneva Conventions Act also restricts use of the red crescent emblem (a red crescent on a white background), the Swiss heraldic emblem (a white cross on a red background); symbols resembling the Red Cross, Red Crescent and Swiss emblems, and use of the words 'Red Cross' or 'Red Crescent'.

In the United Kingdom, the most common forms of misuse of the red cross occur in the health, medical, pharmaceutical and retail worlds and usually relate to first aid products and services.

The British Standards Institution has introduced BS 5378 (Safety Signs for the working Environment), the symbol of a white cross on a green background. This symbol indicates first aid and can be used on first aid kits and similar items.

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

The practice is governed by Section 11 and Rule 15(1)(a).

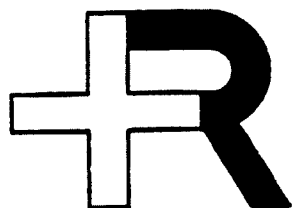
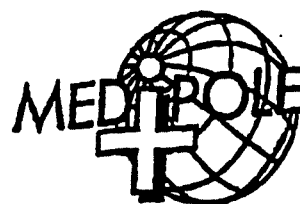
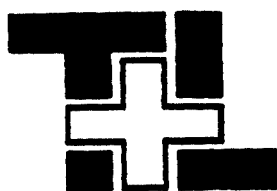
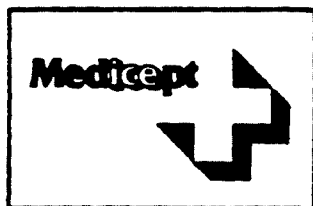
No mark may be accepted if it consists of, or features prominently, any cross device which is the same shape as, or is likely to be confused with, the **RED CROSS** or Swiss Federal Cross and is in red or any closely resembling colour. This applies to marks in all Classes, however, extra care must be taken with regard to marks for medical goods or services.

If a cross device does appear to be similar to the **GENEVA CROSS** a condition of registration will need to be imposed:

*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.*

Examples of marks which should be subject to a cross condition are:





#### CRYO

This means 'low temperature' but in itself is a vague term. In the past objections have been raised under Section 11 for goods or services which could be for use in (or with) low temperatures but in future this will not be necessary.

#### CUVE(E)

A French word meaning 'blend' or 'vat' found commonly in marks in Class 33 for wines etc. It is totally non-distinctive and need not be disclaimed. It must be combined with a distinctive element to make it an acceptable trade mark.

#### CYRILLIC LETTERS

See GREEK AND CYRILLIC LETTERS.

# D

## ☉ DANDY

One of the dictionary definitions of **DANDY** is of a laudatory nature; 'very good or very fine' (Collins English Dictionary). Use of this word as an adjective to describe the merits of a product would be unusual and old fashioned so **DANDY** may now be accepted prima facie in Part B.

## ☉ DANGER CITATIONS

A search for bleaches, disinfectants etc in Classes 3 and 5 and for chemical products used in agriculture, horticulture or photography in Class 1 must be undertaken when examining a mark covering drinks or liquids. A danger citation warning is given in case one is mistaken for the other.

## ☉ DATES

Dates found on label marks (eg Founded 1867) should be removed unless applicants can formally justify their validity but a disclaimer is not required since it is assumed that no-one would regard them as trade mark matter.

See also **LABELS** and **ESTABLISHED**

## ☉ DECORATIVE MATTER

See **PATTERNS**

## ☉ DELTA

Previously only accepted in Part B in view of an obscure geographical reference, **DELTA** is now acceptable in Part A because the reference is not thought to be an obvious geographical reference now. It will now be recognised only as a topographical feature or a Greek letter.

## ☉ DERM

This means 'the true skin'. For applications in Classes 3 and 5 it was the practice to limit to goods for use on the skin if the mark included **DERM** unless that word was lost in the totality of the mark. This practice is not to be continued.

## ☉ DEVICE MARKS: SECTION 11

In some instances a Section 11 objection will be justified if the connection between the mark and the goods is strong eg. in Class 31 the device of a cat for animal food would justify a Section 11 objection if the specification included goods other than cat food. In general the Section 11 objection is less strong if the mark conveys something by a device than by a word.

## ☉ DEVICES: REPRESENTATIONS OF THE GOODS/SERVICES

Ordinary or conventional representations of devices indicative of the origin or source of the goods concerned are not distinctive and consequently not acceptable for registration. For example, devices of animals in respect of leather, skins or hides; devices of cows in respect of milk, butter, cheese and other dairy products; devices of trees in respect of timber. The same principles apply to Service Marks. For example, ordinary representations of motor cars would not be acceptable for car repair, car leasing or taxi services; a typewriter for typing services; a head for hairdressing; clothed figures for hire of clothing and a house for estate agencies.

If a device is sufficiently stylised the mark can be accepted, either in Part A or Part B depending on the degree of innovation shown. In all cases it is a matter of judgement as to whether a device is sufficiently stylised to merit registration.

For example, while an ordinary representation of a cow would be objected to as not distinctive in respect of milk products the mark may be considered acceptable if the cow were shown in some fanciful manner such as dancing a hornpipe or laughing.



## SERVICES GENERALLY

Devices of human figures performing or connected with a given service, especially if dressed in uniforms, are not acceptable unless shown in a stylised, cartoon or fanciful way. Consider disclaiming, for example, a device of a plumber, or typist (if stylised) or the device where it is a straightforward device which appears in conjunction with another, registrable element.

## ☉ DIET

This is descriptive of and non-distinctive for any food or drink having a low or reduced calorie content. A Section 11 objection should be raised, which may be overcome by limiting the specification, for example: 'all having a reduced (or alternatively 'low') calorie content'. Although 'low' and 'reduced' apparently have no clearly defined meaning, precedents indicate the use of both. 'Reduced' is the preferable term.

## ☉ DISCLAIMER: OF TOTALLY NON-DISTINCTIVE WORDS/DEVICES

If a mark consists of or contains a device of, or relating to, the goods/services concerned but it is decided that this device is sufficiently stylised to merit registration the wording of the disclaimer should be in respect of 'a device of..'. If there is nothing special about the device (but it is not sufficiently prominent to mean that the mark as a whole is not worthy of registration) the wording of the disclaimer should be in respect of 'the device of...'.

## ⊗ DISCLAIMERS: APPLIED TO SERIES

The correct wording to be applied to series marks which include at least one disclaimable element is:

*Registration of these marks .....*

Although it could be argued that, for example in the case of conjoined words, a disclaimer would not be applicable, it is believed that the application of a disclaimer to all marks in a series will clarify rights and simplify the wording.

## ⊗ DISCLAIMERS: EFFECT ON COMPOSITE WORD/DEVICE MARKS

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 previously took 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. The higher judicial authorities have not, on the whole, shared this view and it is not uncommon for them to accept in Part A subject to disclaimer of fairly prominent non-distinctive matter [the **MACKENZIE** case 1967 RPC 628 provides an example]

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

### 1 MARKS ACCEPTABLE IN PART A WITH DISCLAIMERS

Where the disclaimed element is relatively small, so that the distinctive element, if by itself is acceptable in Part A, 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 realize that no service mark rights exist in very common words or phrases, eg. ‘24-hours’ ‘International’, ‘Colour’.
- iv where the distinctive element is a well-known mark, that is 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 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 the distinctive element is particularly striking and inventive.

### 2 MARKS ACCEPTABLE IN PART B WITH DISCLAIMERS

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 right of, the distinctive element and has a visual impact almost equally as strong as that of the non-disclaimed elements.
- ii the disclaimed element(s), even though positioned below or after the non-disclaimed element(s), are visually very prominent and tend 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, for example mis-spelt words or elided words.
- iv the non-disclaimed element is, in itself, not particularly strong or inventive.
- v for the mark to be acceptable the device, the registrable element, must be prominent and a memorable element in the composite mark.

### 3 MARKS UNACCEPTABLE EVEN WITH DISCLAIMERS

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 1iii 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 may still be possible to accept the mark as a totality in Part B.

### ⊕ DISCLAIMERS: INVOLVING AMPERSANDS OR STROKES

The following are examples of marks with disclaimable material incorporating an ampersand or stroke:



The disclaimer in this case should be worded:

*Registration of this trade mark shall give no right to the exclusive use of the letters 'H & S'*

#### M & M / MARS

*Registration of this Trade Mark shall give no right to the exclusive use of the letters, symbol and stroke 'M & M'.*

Or as it seems a little pedantic to spell out eg 'letters, symbol and stroke'. The following is sufficient:

*Registration of this trade mark shall give no right to the exclusive use of the letters 'M & M'.*

## ⊗ DISCLAIMERS: TWO WORD MARKS

The disclaimer of the first word in a two word mark does not necessarily put the mark into Part B. It is a question of balance. If the registrable element is overshadowed by the disclaimable matter then Part B may be appropriate. Where the balance is more equal Part A should be allowed.

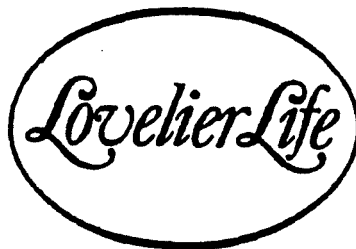
The prominence of disclaimable matter in marks often leads to much correspondence as agents seek to obtain registration of marks with disclaimable matter pre-eminent. In this case **L'OREAL** is a strong house mark and **FREE STYLE** recognisably non-distinctive; it is, therefore, felt that the mark is acceptable in Part A.



*Registration of this mark shall give no right to the exclusive use of the words 'Free Style' and of a device of a woman's head.*

## ⊗ DISCLAIMERS: TAKEN SEPARATELY

The following examples show cases where marks have been taken with separate disclaimers. Separate disclaimers should only be used when the mark is acceptable as a totality. In cases where the words are in normal type and are presented as an entity (eg **GOLD STANDARD**) separate disclaimers are not necessary.



*Registration of the Trade Mark shall give no right to the exclusive use, separately, of the words 'Lovelier' and 'Life'.*

### **MAGIC GIRL**

*Registration of this Trade Mark shall give no right to the exclusive use, separately, of the words 'Magic' and 'Girl'.*

### **SALMON PEARLS**

*Registration of this Trade Mark shall give no right to the exclusive use, separately, of the words 'Salmon' and 'Pearls'.*

## DISCLAIMERS: UP TO THREE LETTERS FOLLOWING A MARK

Where a mark consists of an acceptable element plus up to three unpronounceable letters which do not form a word, for instance:

**OLYMPUS CLV or DETTOX ABC**

There is no need to disclaim **CLV** or **ABC**. This is because it is considered that these are merely unpronounceable letters which are so non-distinctive that nobody could claim rights in them on the basis of a registration for the entire mark. If the three letters are pronounceable they form an acceptable Part A element, eg **MIV**, **POS**. Care should be taken if the three letter element is pronounceable but is well known as letters eg **RAC** which should be disclaimed because such a mark is not acceptable prima facie.

Where a mark consists of an acceptable element plus two pronounceable letters not forming a known word, for instance:

**COBRA IM or FAMMY OT**

then **IM** and **OT** should be disclaimed for Part A, otherwise the whole marks should be accepted in Part B only.

## DISCLAIMERS: COMPLETION OF THE EXAMINATION REPORT

When drafting the initial examination report for agents and applicants, please note that the reasons for disclaimers should be stated where these are not obvious. Where disclaimers are required as a matter of practice, rather than a specific point of law, (for example female forenames in Classes 3 and 25) the reasons for the requirement should be stated.

An example of an appropriate examination report in the circumstances outlined above is given below;

**FLORA NIKROOZ** Class 25

**FLORA** is a female christian name and **NIKROOZ** appears once as a surname in the New York telephone directory.

The following disclaimer appears to be necessary if the mark is to be registered in Part A.

*Registration of this mark shall give no right to the exclusive use, separately, of the words 'Flora' and 'Nikrooz'.*

Although **NIKROOZ** is a rare surname the presence of a forename emphasises its surnominal significance and it must therefore be disclaimed in Part A. Such a disclaimer is not required in Part B. A disclaimer of the female forename **FLORA** is required in both Parts A and B because female forenames are considered to be non-distinctive for goods in this Class.

## DISCLAIMERS: WORDING OF

A list of some difficult to word disclaimers are shown below. These wordings will not be appropriate in all situations, so each will need to be considered on its own merits. ➡

## 1 SEPARATE DISCLAIMERS

### TV-am

The disclaimer should read;

*Registration of this mark shall give no right to the exclusive use, separately, of the letters 'TV' and 'am'.*

**Note:** This is a fairly standard separate disclaimer whereby no rights exist in either 'TV' or 'am' individually, but only in the combination of 'TV-am' as a whole. Also note that the 'am' is written in lower case, as presented in the mark.

## 2 DISCLAIMING A WORD AND LETTER

### CEDAR POROSIS D

The disclaimer should read:

*Registration of this mark shall give no right to the exclusive use of the word and letter 'Porosis D'.*

**Note:** Disclaimers of this sort should read 'the word and letter 'Porosis D' as it appears in the mark. To disclaim the word 'Porosis' and the letter 'D' is incorrect.

## 3 DISCLAIMER OF A WORD AND SYMBOL

### RASCH ART & DESIGN

The disclaimer should read;

*Registration of this mark shall give no right to the exclusive use of the words 'Art & Design'.*

**Note:** It is not necessary to mention the ampersand by name, or refer to it as a symbol, where it forms part of the overall disclaimed element.



The disclaimer should read;

*Registration of this mark shall give no right to the exclusive use of a pound sterling symbol and the word 'Finance'.*

**Note:** Unlike RASCH ART & DESIGN above, where a symbol itself stands out as a disclaimable element, it should be referred to specifically. ➡

#### 4 DISCLAIMER OF A LETTER AND NUMERAL

##### P3-CRONISOL

The disclaimer should read;

*Registration of this mark shall give no right to the exclusive use of the letter and numeral 'P3'.*

**Note:** Use the words letter and numeral 'P3' and not the letter 'P' and the numeral '3'. The hyphen has been correctly ignored as being insignificant.

##### DOCTOR

This is commonly applied for in Class 37 combined with the goods being treated, for example **RUG DOCTOR** for rug repair, **CAR DOCTOR** for vehicle repair. Such marks can be accepted in Part B subject to separate disclaimers.

##### DOMAINE

See **ESTATE NAME**

##### DOUBLE

This is a measure of drink for goods in Class 33 (a 'double' whisky). It may vary as to one sixth of a gill in England to one quarter of a gill in Scotland but it is still descriptive. Objections under Sections 9,10 and 11 are appropriate when **DOUBLE** is prominent in a mark for drinks. [SOG relating to application No 1146492 refers]. **DOUBLE** could also imply 'double strength' when used in relation to beer and lager in Class 32. In this case it is still non-distinctive and objections under Sections 9 and 10 are appropriate but not Section 11 as it is not specific in this context.

##### DREAM

This word has a laudatory meaning which justifies a Section 9 objection ie. 'a person or thing that is pleasant or seemingly unreal as a dream' (Collins English Dictionary). It is normally acceptable in Part B. **DREAM** is particularly non-distinctive for services such as kitchen fitting or kitchen design and in such cases Section 9 and 10 objections are appropriate.

##### DURA

This is not an accepted abbreviation for **DURABLE** and, therefore, it is acceptable in Part A.

## E

### ECO

A combining form which is defined in Collins English Dictionary as denoting 'ecology' or 'ecological' and which is widely used in relation to the study of the environment or environmentally 'friendly' products. When combined with a term descriptive of goods/services which could relate to care for the environment (such as **ECOCLEAN** for cleaning preparations) it is necessary to raise objections under Sections 9 and 10, *prima facie*.

An example is **ECOSAFE** which was considered open to objection for bleaching and cleaning preparations because the mark was descriptive of goods which do not adversely affect the environment. Incidentally, it was also considered open to objection under Section 11 on the grounds that such goods may not be 'safe' to use except under particular conditions, so the public could be deceived or confused by use of the mark in relation to such goods.

See also **GREEN**

### ECU

Meaning 'European Currency Unit'. ECU notes are issued by the Government and there is now strong competition to buy them. The mark **ECU** is open to objection under Sections 9 and 10 on the grounds that it relates to currency used in the United Kingdom. **ECU** should be regarded as non-distinctive for all goods/services (provided for a fee).

Applications for the mark **ECU** for 'articles of clothing in Class 25' and 'base metals and their alloys and articles made therefrom in Class 6' were considered open to objection under Sections 9 and 10 on the grounds of non-distinctiveness.

### EEC

See **COMMUNITY**

### EMPIRE MARKS

In view of the current limited relevance of the term **EMPIRE** in relation to Great Britain, **EMPIRE** is now acceptable in Part B.

### ENVIRO

This term may not yet have found its way into dictionaries but it would be recognised by the public as indicating 'Environment'. The meaning of **ENVIRO** is sufficiently clear to raise objections against that element itself or where it is combined with a descriptive term.

The mark **ENVIROSAFE** was considered open to objection under Sections 9, 10, 11 and 17; it is descriptive of goods that are environmentally safe or environmentally friendly (Sections 9 and 10) and it is a term which should be available for use by others in relation to their goods so should be refused in the exercise of the Registrars discretion. With regard to Section 11, at this time there is no specific standard relating to the

meaning of this term so the Registrar is unable to limit the application in any meaningful way and this objection cannot, in consequence, be overcome.

### ⊗ EQUITY: USE OF

The addition of an equity may be proposed as a means of overcoming objections, usually objections raised under Sections 9 and 10 but also under Section 12. An equity may also be referred to as a 'Housemark' if it has already been registered.

In order to be considered acceptable, a proposed equity must possess the following characteristics:

- 1 It must have a filing date earlier than or the same as the mark to which the applicant wishes it to be added;
- 2 It must be in the same ownership as the later application;
- 3 It must be in the same Class as the later application;
- 4 It must cover all of the goods or services claimed by the later application (a restriction of the specification of the later application will be necessary if this is not the case);
- 5 It must be registered before the later application can be allowed to proceed.

An application cannot be allowed to proceed on the basis of the addition of an equity until the equity is registered because, even if the mark has been advertised, it may be subject to a late objection or opposition proceedings. When the addition of an equity has been agreed the later mark may be suspended until the outcome of the equity is known.

A representation of the proposed amendment should be requested before it is agreed that an equity can be added. The equity must be the prominent feature in the mark if the amendment is to be considered acceptable. The matter previously considered open to objection in the later mark will generally need to be the subject of a disclaimer if the object is to overcome objections raised under Sections 9 and 10.

### ⊗ EQUITY: USE IN RELATION TO SECTION 12

The addition of an equity or housemark may allow citations to be overcome if the conflicting marks originally applied for would be recognised as non-distinctive for the goods or services in question.

For example, equities **HERON**, **SPICER** and **LLOYDS** were added to three conflicting **LINK** marks to form **HERON LINK**, **SPICER LINK** and **LLOYDS LINK**. It was considered that confusion between these marks would be unlikely, so all the marks were allowed to proceed to registration. If several marks are involved it is necessary to wait until all of the proposed equities are registered and the precise form of the amendment agreed in all cases before any one mark is allowed to proceed on the basis of an equity.

See also **FAMILY OF MARKS**

### ⊗ ESTABLISHED

Statements such as 'established 1871' or 'founded in 1750' must be justified if they are to remain in the mark. The applicant must be asked to justify such statements by confirming the facts about them in a Statutory Declaration. If the statement is to be retained, it is not necessary to disclaim it since it is assumed that no-one would regard them as Trade Mark matter. If such features cannot be justified, they should be removed.

See also **DATES** and **LABELS**

## ESTATE NAME

Marks applied for in respect of wines and spirits in Class 33 and which contain words such as CHATEAU, CLOS, DOMAINE, ESTATE or VINEYARD are generally acceptable in Part A (providing the other part of the mark is itself acceptable) but it may be necessary to raise a Section 11 objection if the mark is or includes the name of a well-known wine-producing estate having a specific reputation for particular wines. In this context 'well-known' means any estate with sufficient reputation to warrant a mention in 'World Atlas of Wine' or the Pocket wine guides. If an objection is justified it can be overcome by a condition of registration:

*It is a condition of Registration that the mark shall be used only in relation to wine produced on the Estate of.....*

## EURO

The following practice is followed by the Registrar when dealing with the many EURO marks filed:

- 1 EURO (alone): object under Sections 9, 10 and 11.
- 2 EURO plus name of the goods or services: object under Sections 9, 10 and 11.
- 3 EURO plus inventive word, conjoined: accept Part A.
- 4 EURO plus a word descriptive of a characteristic of the goods conjoined: accept Part B.

## EUROPEAN COMMUNITY SYMBOLS

The European Community and Council of Europe symbols listed below must not, generally speaking, be registered as trade marks or parts of trade marks.

### 1. THE ECO-LABEL



On 23 March 1992 the Council of the European Communities adopted a Regulation on a Community ECO-LABEL award scheme. The ECO-LABEL (which incorporates the ECO-LABEL logo shown above) will be awarded to products which provide a high-level of environmental protection. The Member States have six months in which to identify or create a body which is to award the ECO-LABEL.

Notwithstanding that, the provisions of the Regulation protecting the ECO-LABEL logo came into force on 1 May 1992 and became binding in their entirety on, and directly applicable in, the United Kingdom. Any false or misleading advertising or the use of any label or logo which leads to confusion with the ECO-LABEL is prohibited by the Regulation. Accordingly, any mark which contains the ECO-LABEL logo or anything which could lead to confusion with it will be refused.

Staff are asked to note that this type of protection has nothing to do with the type of protection afforded by Article 6ter of the Paris Convention, it is a matter of Community law. Consent cannot be obtained for this mark. ➡

## 2. CE MARK

This comprises the letters 'CE' in the form illustrated below:



It is used to signify that a product conforms with the requirements of certain EC Directives. So far, eleven Directives have been adopted which require the CE mark. These Directives cover toy safety, simple pressure vessels, construction products, electromagnetic compatibility, machinery safety, personal protective equipment, gas appliances, non-automatic weighing instruments, active implantable medical devices, telecommunications terminal equipment and hot water boilers. Products which meet the requirements of these Directives must generally carry a CE mark, but products which are not yet regulated by any directive are not entitled to carry it.

In addition to this a draft regulation concerning use of the CE mark itself is under discussion in Brussels. If adopted (which is likely) this will:

- i define the conditions under which, and in compliance with which, the CE mark may or must be affixed to products covered by these Directives,
- ii oblige EC Member States to take action to prevent misuse of the mark and to prohibit any possibility of confusion,
- iii prohibit the affixation to a product of any mark, sign or indication other than
- iv the CE mark which might be confused with it in meaning or design.

It follows that marks which contain the letters 'CE' as illustrated above should not now, and cannot after adoption of the regulation, be accepted as trade marks or part of trade marks. If in doubt staff should consult a senior officer.

## 3. EUROPEAN COMMUNITY SYMBOLS AND COUNCIL OF EUROPE SYMBOLS PROTECTED UNDER ARTICLE 6TER OF THE PARIS CONVENTION

In relation to marks and symbols protected under article 6ter 'protection' means that no one can register a trade mark which contains any of the under mentioned symbols, devices and abbreviations unless:

- i. the applicants have permission from the organisation concerned  
Refusal is appropriate if the mark contains the symbols, devices or abbreviations without approval.
- ii use of the mark in relation to the goods/services concerned is unlikely to suggest that there is a connection between the organisation and the applicant.

In cases under 'b' above and all cases of doubt under 'a' it is essential that the examiner seeks the advice of a senior officer.

**Note:** In the case of some Community marks and symbols protected under Article 6ter Mr L Ferrao, Commission of the European Communities, Directorate General XIII, Batiment Jean Monnet, Plateau du Kirchberg, L2920, Luxembourg, has been identified as a source of consent. Applicants may be directed to him in particular cases, such as the twelve star devices and the E symbol referred to below. ➡

#### 4. THE SIGN OF THE COUNCIL OF EUROPE

The distinctive sign of the Council of Europe incorporates the name of the Organisation in English and French as well as a circle of twelve stars, their points not touching. The size of the layout can vary in the light of circumstances.



#### 5. THE COUNCIL OF EUROPE FLAG

Twelve gold stars on a blue background has been protected since 1979 and is represented below:



#### 6. EMBLEM 'E'

This is a stylised letter 'E' in gold on a blue background and has been protected since 1979 as the emblem of the Commission of the European Communities and is represented as follows:



#### 7. THE EUROPEAN ECONOMIC COMMUNITY

The name and abbreviation of the European Economic Community is protected in 7 of the official languages. The name and abbreviation in Dutch, French, German and Italian were notified by WIPO in December 1966 and Danish, English and Irish were added in December 1979. The list of names and abbreviations follow:

##### THE EUROPEAN ECONOMIC COMMUNITY

##### i ITS NAME

- |               |                                      |
|---------------|--------------------------------------|
| a in Danish:  | Det europæiske økonomiske Fællesskab |
| b in Dutch:   | Europese Economische Gemeenschap     |
| c in English: | European Economic Community          |
| d in French:  | Communaute Economique Europeenne     |
| e in German:  | Europäische Wirtschaftsgemeinschaft  |
| f in Irish:   | Comhphobal Eacnamaiochta na hEorpa   |
| g in Italian: | Comunita Economica Europea ➡         |

ii ITS ABBREVIATION

- |               |     |
|---------------|-----|
| a in Danish:  | EO  |
| b in Dutch:   | EEG |
| c in English: | EEC |
| d in French:  | CEE |
| e in German:  | EWG |
| f in Irish:   | CEE |
| g in Italian: | CEE |

8. THE EUROPEAN ATOMIC ENERGY COMMUNITY'S EMBLEM, NAME AND ABBREVIATION

The emblem and 'hallmark' plus the wording, including abbreviations, have been protected in German, French, Italian and Dutch since 1963 and in Danish, English and Irish since 1979.

The wording and abbreviation are reproduced below:

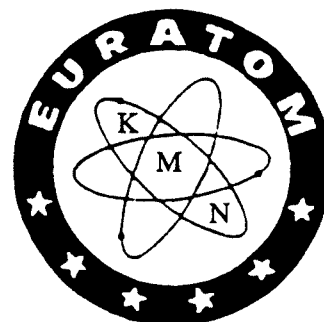
i ITS NAME

- |              |  |
|--------------|--|
| a in Dutch   | Europese Gemeenschap Voor Attoomenergie (Eurotom)    |
| b in French  | Communaute Europeene De L'Energie Atomique (Eurotom) |
| c in German  | Europaische Atomgemeinschaft (Euratom)               |
| d in Italian | Comunita Europea Dell'Energia Atomica (Euratom)      |

ii ITS ABBREVIATION

- |              |      |
|--------------|------|
| a in Dutch   | EGA  |
| b in French  | CEEA |
| c in German  | EAG  |
| d in Italian | CEEA |

iii ITS EMBLEM



## 9. THE EUROPEAN COAL AND STEEL COMMUNITY

Its name and abbreviation have been protected in Dutch, French, German and Italian since December 1963 and in Danish, English and Irish since December 1979. Full details are given below but it should be noted that the equivalent in Greek, Portuguese and Spanish have not, so far, been notified.

### i ITS NAME

- |   |             |  |
|---|-------------|--|
| a | in Danish:  | Det europaeiske Kul- og Stalfaellesskab        |
| b | in Dutch:   | Europese Gemeenschap voor Kolen en Staal       |
| c | in English: | European Coal and Steel Community              |
| d | in French:  | Communaute Europeenne du Charbon et de l'Acier |
| e | in German:  | Europaische Gemeinschaft fur Kohle und Stahl   |
| f | in Irish:   | Comhphobal Eorpach do Ghual agus Cruach        |
| g | in Italian: | Comunita Europea del Carbone e dell'Acciaio    |

### ii ITS ABBREVIATION

- |   |             |      |
|---|-------------|------|
| a | in Danish:  | EKSF |
| b | in Dutch:   | EGKS |
| c | in English: | ECSC |
| d | in French:  | CECA |
| e | in German:  | EGKS |
| f | in Irish:   | CEGC |
| g | in Italian: | CECA |

## 🌐 EUROPEAN ECONOMIC INTEREST GROUPINGS (EEIGs)

An **EEIG** is intended, by virtue of EC Regulations, to be able to hold property of any kind, ie to have the rights and obligations of an owner of property, and consequently it can own a trade mark.

The status of **EEIGs** is not consistent throughout the EC. In the United Kingdom they do have legal status and can hold property including trade marks. In other countries they may not have such power and, if they file applications here, it will be necessary, at least in the first instance, to enquire into their status.

In most instances **EEIGs** will be entitled to own property and this should generally be assumed to be the case. If there are any doubts as to the applicant's status or capacity it will be necessary to ask for confirmation by way of a Statutory Declaration.

## ● EVIAN

See MINERAL WATER: RIGHTS OF EXTRACTION and NATURAL PRODUCE.

## ● EXPIRY: OF MARKS

There has been some confusion recently about the removal of marks from the Register and the effective date of expiry. It is clear from Rule 68 of the Trade Marks and Service Marks Rules 1986 that even though a mark is not removed from the Register until it has been advertised as unpaid in the Trade Marks Journal (usually 5 weeks or more after the date of expiry of the last registration period) the effective date is the date of expiration. Thus the one year referred to in Section 20(4) of the Act is in fact the one year following this date.

## ● EXPORT

Found mostly on beer labels in Class 32. No Section 11 objection is appropriate as the fact that the goods are exported as well as offered for sale on the home market should not affect purchasing decisions. Precedents are mixed as regards disclaimers but the current view is that a disclaimer is no longer required.

## ● EXTENSIONS OF TIME: GRANTING OF: EX PARTE

The Registrar's practice on extensions of time is governed by Rules 55, 114 and 116-119 of the Trade Marks and Service Marks Rules 1986.

As a general guide, the more time requested by way of extension the more detailed and more compelling should be the justification. Probably the most common acceptable justification for requiring more than 6 months to respond to an objection is that the applicant is collecting evidence of factual distinctiveness, trade terminology, independent trade evidence etc. This can be time consuming, especially if the declarants are outside the control of the applicants. Nonetheless it should be rare for applicants to need more than a total of 6 months to respond to an objection and even rarer for them to require more than 12 months.

It is obviously time consuming and inefficient for several extensions of time to be granted when a single extension would suffice. Agents and applicants who have a genuine need should thus be encouraged to ask for one long extension of up to 6 months rather than three extensions each of two months duration. **In all cases the aim is to give a realistic extension of time in the first instance and thus avoid the need for further extension.** It is important to complete applications as quickly as possible. Therefore, as cases get older, the office should progressively adopt a stricter line in relation to granting further extensions of time.

## ● EXTENSIONS OF TIME: DATE FROM WHICH THEY RUN: EX PARTE

Problems arise from time to time in relation to the date from which ex-parte extensions of time should run. This is because Rules 33 and 34 of the Trade Marks and Service Marks Rules refer to the date of receipt, rather than dispatch of official letters and this date is not known to the Registrar. In future all ex-parte extensions should run from the date of the examination report/official letter, with a reasonable margin (usually 14 days) allowed within which the substantive reply or further request may be accepted. When an extension of time is to be granted it must be remembered that the extension runs from the date of expiry of the Statutory period, or of any previous extension of that period and not from the date of the request or the date on which the request is being dealt with.

**Note** These guidelines do not relate to inter partes proceedings.

## ⊗ EXTRA

This means something more than what is usual or expected, or something that is better than usual in quality. **EXTRA** or phonetic equivalents should be regarded as laudatory and probably unregistrable (even if factual distinctiveness is established).

## ⊗ EXTRA JAM

Also applies to extra jelly, reduced sugar jam, reduced sugar jelly, reduced sugar marmalade and UK standard jelly

The Jam and Similar Products Regulations 1981 set out specific criteria which the above goods must meet to be so described. It would be unlawful to use these positively descriptive terms in relation to goods which do not meet the criteria laid down in regulations. In future therefore objections under Section 11 should be taken where these descriptions appear in a mark.

Such objections might be overcome by either of the following:

1. A condition of registration that the mark shall be used in relation only to extra jam etc. as defined in Schedule 1 of the Jam and Similar Products Regulations 1981 or any regulation which supersedes these.

OR

2. A variation clause to the effect that when used in relation to goods covered by the specification (of Jams etc) other than (jam) as defined in Schedule 1 of the Jam and Similar Products Regulations 1981 or any regulations which supersede these the mark will be varied by the name of such goods for the words (Extra Jam etc).



# F

## 🌀 FAMILY OF MARKS

The presence of marks on the Register other than the one with which the comparison is being made is regarded as one of the surrounding circumstances which the Registrar is required to take into account.

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

If, on the other hand, the marks incorporating an identical element are registered in the names of several different proprietors, an applicant for a mark incorporating this element can argue that this common characteristic is one well recognised in marks in use in the particular trade. This common characteristic can consequently be regarded as sufficiently non-distinctive to mean that a comparison of the marks should be based on any additional matter.

## 🌀 FAX

This is short for facsimile and is a phonetic equivalent of **FACTS**. In view of its meaning in relation to facsimile transmissions it should be objected to under Sections 9 and 10 for eg. computer programs, facsimile transmission apparatus, facsimile transmission services and telecommunications services. In view of its meaning in relation to **FACTS** marks for goods in Class 16 (printed matter) are also open to objection under Sections 9 and 10. For example, objections were raised under Sections 9 and 10 to the mark **TRAVELFAX** in Class 16 (No. 1262249, Journal 5723,1360). The mark was eventually allowed to proceed in Part B but only for a very limited specification; 'Book covers; loose-leaf binders and sheets of paper therefor; all included in Class 16, but not including sheets of paper in the form of printed matter.' This excludes any goods which may list or contain facts.

## 🌀 FIBRE

Marks for food which contain the word **FIBRE** (found largely in Class 30) should be objected to under Section 11. This can be overcome by limiting the specification to 'all containing dietary fibre' or 'all having added fibre'.

## 🌀 FILTER

Marks containing the word **FILTER** in Class 34 are open to objection under Section 11. This can be overcome by the following variation clause:

*In use in relation to goods covered by the specification other than filter cigarettes, the mark will be varied by the substitution of the description of such goods for the word 'filter'.*

## 🌀 FINE/FINEST

No objection under Section 11 should be raised when this appears in a mark, even for whisky, because **FINE** or **FINEST** would be difficult to define. The word should, however, be disclaimed because it is obviously non-distinctive.

## ● FINESSE

This means 'elegant skill in style or performance' (Collins English Dictionary) but it is generally accepted in Part B for goods as the word usually refers to people.

**FINESSE** is laudatory in relation to personal services such as beauticians and consequently open to objection under Sections 9 and 10. Accept in Part B prima facie for services that are generally provided by organisations or performed on goods, for example repair of vehicles.

## ● FINLANDIA

Clearly refusal of this mark could be justified as the addition of a non-distinctive suffix **-IA** to the word **FINLAND** does not constitute invention but if anyone wished to use the geographical connotation they would use **FINLAND** or **FINNISH**. **FINLANDIA** is also a piece of music relating to **FINLAND**. It has now been agreed that, as there are precedents, this mark can be accepted in Part B irrespective of the goods.

## ● FINO

This means 'dry sherry' and is consequently meaningful in relation to goods in Class 33. A Section 11 objection should be raised if the mark is used on goods in Class 33 other than dry sherry.

## ● FLAGS

Under the predecessor to the present Rule 16 there was an absolute prohibition of representations of national flags either in colour or in black and white. Following a review it was decided that flag devices, even if prominent and unstylised, might remain in marks provided that the Registrar was satisfied that the mark as a whole possessed the necessary distinctiveness for registration. Marks, therefore, need to be considered very carefully in relation to Sections 9, 10, 11 and 14 of the Trade Marks Act 1938 (as amended).

## ● FLAGS: OBJECTIONS UNDER SECTIONS 9, 10 AND 11

If the flag elements are particularly prominent the mark will be non-distinctive and objections under Sections 9 and/or 10 will be appropriate. If the flag element closely resembles, for example, the UK national flag the public might expect goods sold under this mark to be manufactured or produced in the UK. A Section 11 objection would be appropriate if the goods were not limited. A statement that the goods are designed in a particular country will not overcome the Section 11 objection, which relates to origin. The considerations which will apply to the importance of a flag element in a service mark will be similar to those relating to geographic names.

## ● FLAGS: SECTION 14 (DISCLAIMERS)

Where the device is a black and white representation of, or consists of a substantial part of the Union Flag, then a disclaimer of the device of a Union Flag will be necessary; where the device is a stylised version of the Union Flag a disclaimer of a device would be appropriate.

## ● FLAGS: APPLICATION OF ARTICLE 6 TER OF THE PARIS CONVENTION

Under article 6 ter of the Paris Convention for the protection of industrial property of March 20 1883 (as revised), the Registrar must refuse to register the flag unless he is satisfied that the applicant has permis-

sion from the 'competent authority' in the State concerned. Even then, the mark must meet the same requirements as marks consisting of or containing the Union Flag in terms of Sections 9, 10, 11 and 14.

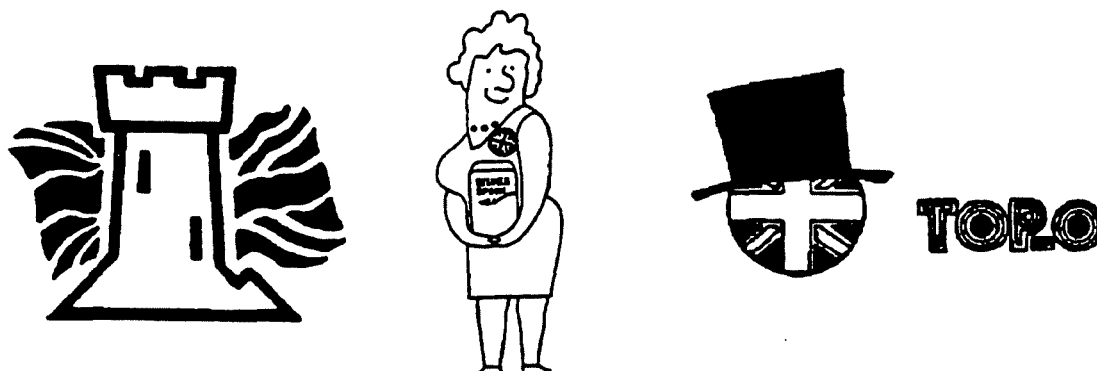
● **FLAGS: EXAMPLES OF REGISTRABLE MARKS**

- 1 Very stylised representations of the Union Flag are considered acceptable in Part A, prima facie, without a disclaimer and are not open to objection under Section 11

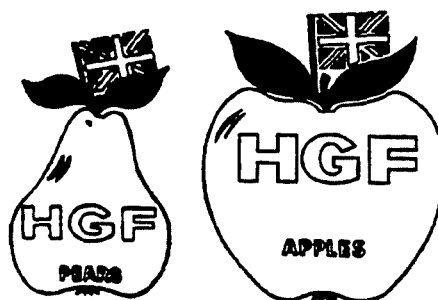
For example;



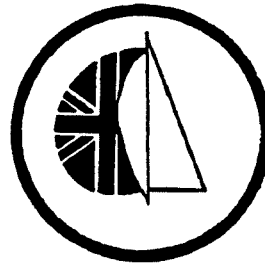
- 2 Stylised representations forming part of an overall distinctive mark may be accepted in Part A prima facie without a disclaimer, but they may be open to objection under Section 11, for example;



- 3 The following marks were accepted in Part B with separate disclaimers of a device of a union flag, the letters 'hgf' and a device of a pear/apple. A Section 11 objection was raised because the marks would be deceptive if the goods were not limited to produce of the United Kingdom. The specification was limited accordingly



- 4 In order to overcome an objection raised under Section 11 the following marks were accepted with a condition of registration that they be used in relation only to goods manufactured in the U.K.



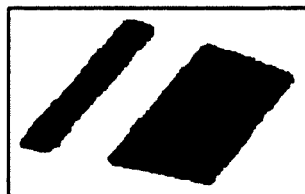
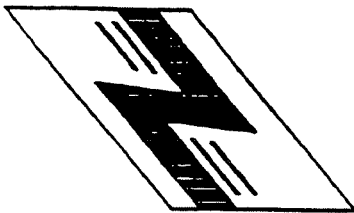
⊕ **FLAGSHIP**

Open to objection under Sections 9 and 10 because of the common use of the word as a laudatory term (meaning 'the leading item in a range, or the leading establishment', Collins English Dictionary).

⊕ **FLASH DEVICE**

Such marks are usually presented fixed inside a shoe or on the underside of a shoe. Marks in Class 25 consisting of a **FLASH DEVICE** may be accepted either in Part A (if inherently distinctive) or in Part B (if simple and less distinctive) as long as they are enclosed in a line border.

Some examples of **FLASH DEVICES** which have been registered in the past are shown below;



Where the mark, distinctive or otherwise, is not contained within a line border the following objection should be taken under Sections 9 and 10;

*..... because it consists of a decorative design of a kind frequently found on the side of sports shoes and is therefore non-distinctive for these goods.*

## ☉ FLEXI AND FLEX

If the application is for goods which may be described as flexible, because they are pliable, for example **FLEXI** for pipes or **FLEXI** for plastic sheeting, object under Sections 9 and 10 because the mark is descriptive/non-distinctive for flexible goods. (The SOG relating to **FLEX-FOOT**, No 1268222, for artificial limbs refers). If the goods are flexible, but flexibility is not a characteristic by which the goods are likely to be described, for example clothing or photographs, accept in Part B. If the goods are totally non-flexible they are acceptable in Part A (eg portable buildings). No objection should be raised on the grounds that the goods are flexible (adaptable) in their application.

## ☉ FLOAT

This is a generic name for goods consisting of carbonated soft drinks served together with ice-cream (See Collins English Dictionary). It is consequently open to objection under Sections 9 and 10 for such goods and a Section 11 objection is also appropriate on the grounds that the mark would cause deception if used on goods not being carbonated drinks containing ice-cream.

## ☉ FLOWERS, SHRUBS AND TREES

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 in Class 3 or in respect of similar medicated goods in Class 5. They are, however, considered distinctive for beauty salons because research has demonstrated that they are not generally used in respect of these services. Flower, shrub and tree devices are not considered distinctive for services such as gardening or landscaping.

## ☉ FOREIGN CHARACTERS OR WORDS

In cases where the mark consists of or contains a word or words in foreign characters or in a foreign language it is essential that the meaning of such words should be known before examination. The departmental translation service may be consulted if the meaning of the character or words cannot be found from the dictionaries available in the Registry.

See also **TRANSLATION AND TRANSLITERATION CLAUSES**

## ☉ FOREIGN SURNAMES

See **SURNAMES: FOREIGN**

## ☉ FOREIGN WORDS: ARCHAIC

Latin or archaic Greek words cannot be made the basis of objections unless they are words or phrases which most people will have become acquainted with as a matter of general knowledge.

See also **GREEK AND CYRILLIC LETTERS**

## ☉ FOREIGN WORDS: OBSCURE

Some languages may be known to relatively few people in the United Kingdom eg Tibetan. If a word has a descriptive or laudatory significance in an obscure language it is a valid argument that, as the meaning of

the words would not be recognised by the general public, the word can be regarded as invented. This argument cannot be sustained where the meaning of such a word has been drawn to the attention of the purchasing public (perhaps through advertising material) and has consequently become well known. [The statement of grounds issued on the **TENBA** case (application no. 1129387) refers]

### ☉ FORENAMES

**FORENAMES** are frequently used as decorations on a wide range of goods such as mugs, glasses, key-rings, jewellery, children's crockery/cutlery, pottery, gift items etc. Section 9 and 10 objections should be taken but may be waived subject to an exclusion of goods decorated with forenames (Christian names).

### ☉ FORENAMES: FEMALE

These are so commonly used for some goods and services that they cannot be regarded as distinctive or capable of distinguishing any one persons goods or services in certain trades. Where appropriate, objections should be phrased:

*.... because it consists of a female forename which is non-distinctive for the goods (services) claimed, since such names are in common usage in the trade (in business).*

Class 3 objection should be raised in respect of perfumes, cosmetics and similar goods.

Class 25 objection should be raised in respect of women's and girl's clothing but not in respect of footwear (ie.boots, shoes, slippers, sandals, etc) or babies' items.

Class 42 objection should be raised in respect of beauty salons, massage services, cafes, tea shops and similar eating places.

**FORENAMES** may also be customarily used in relation to other services; consider each case on its own merits.

### ☉ FORENAMES: MALE

These are commonly used for services such as hairdressers and cafes and in such cases they cannot be regarded as distinctive, prima facie.

### ☉ FOREX

This is unregistrable for foreign exchange or financial related services.

### ☉ FREE NEWSPAPERS

The test is whether it is a proper newspaper in the normal sense, with the usual range of articles or is it simply free advertising; the former is acceptable, the latter is not. In relation to Class 16 the question of 'trading in ...' (Section 68) should always be resolved. Normally, such newspapers are financed by revenue from advertising and this will satisfy Section 68 even though the newspapers are not sold. This need not be formally proved by evidence, but a clear statement to this effect should be provided by the applicants (or their Agents).[**GOLDEN PAGES** (1985) FSR 27 refers]

## 🌐 FULL NAMES

See Also **ADVERTISED BEFORE ACCEPTANCE BY REASON OF SPECIAL CIRCUMSTANCES.**

## 🌐 FULL NAMES: STATUTORY RESTRICTION

The surname element is debarred from prima facie acceptance by the wording of Section 9(1)(d) of the Act. If a full name is considered acceptable in Part A as a totality the surname will need to be disclaimed. The only exception to this rule is when the apparent surname does not appear in any relevant telephone directories. There is no statutory restriction on the acceptance of surnames under Section 10.

## 🌐 FULL NAMES: REPRESENTED IN A SPECIAL OR PARTICULAR MANNER

Full names may be accepted in Part A under Section 9(1)(a) if represented in a special or particular manner. It is not sufficient that the name is represented slightly out of the ordinary or is shown 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 **ROB-IN HOOD** case, 69 RPC 125)

## 🌐 FULL NAMES: PRESENTED AS A SIGNATURE

Full names may be accepted in Part A under Section 9(1)(b) if presented in signature form provided the signature is that of the applicant or a predecessor in business. A name shown in copperplate form is not acceptable as it would fall within the prohibition of Section 9(1)(e) as being non-distinctive (see the **BARRY ARTIST** 1978 RPC 703)

See also **SIGNATURES: GENERAL**

## 🌐 FULL NAMES: IN ORDINARY TYPEFACE

Full names may be accepted under Section 9(1)(d) subject to the following requirements;

1. If the surname is within de minimus limits for Part A it will still be necessary to disclaim the surname because the surname significance is reinforced. If the surname is within the de minimus limits for Part B the mark may proceed in Part B without a disclaimer of the surname.

see **SURNAMES: DE MINIMUS PRINCIPLE**

2. If the forename is particularly unusual, eg **AUGUSTUS** or **THEODORE**, full names can be accepted in Part A or Part B if the usual de minimus limits are slightly exceeded. This is because the mark as a whole becomes much more distinctive. In each case the commonness of the forename must be weighed against that of the surname. The surname will need to be disclaimed if the mark is accepted in Part A.
3. If a mark is presented as a full name but the **surname does not appear in relevant telephone directories** it may be accepted in Part A (see **JOE PALOOKA**, Journal 5512 page 1134). This is the only time when a disclaimer of the surname will not be required.
4. If the **whole name has another well known meaning** a full name can be accepted in Part A, for example **JENNY WREN** which is the nursery name of a bird. In this case a disclaimer of the surname will be required. ➡

5. If the **forename is also a surname** (The mark could be seen as two surnames rather than the name of an individual) and if in combination they convey a clear signification going beyond the surnames themselves, for example **BLACK KNIGHT, OCEAN GOLD** or **LONG LEA**, the mark as a totality is distinctive. The disclaimer(s) required will depend on the frequency with which the surnames appear in relevant telephone directories.

See **SURNAMES : DOUBLE AND MULTIPLE IN COMBINATION**

6. If the **forename is considered non-distinctive** for goods/services and the surname falls within the de minimus limits for Part A a full name can be accepted in Part A on the basis of separate disclaimers of the surname and forename, or in Part B subject to a disclaimer of the forename. If the surname falls within the de minimus limits for Part B, acceptance in Part B should be on the basis of separate disclaimers.

See **FORENAMES : FEMALE/MALE**

## ⊙ **FUTURE**

The word **FUTURE** is considered, prima facie, to be non-distinctive in relation to goods where technical development and innovation are occurring and which will result in a significantly improved product. This is not a rigid rule and some flexibility should be allowable in practice taking into account the type of goods for which a mark is applied for.

The word **FUTURA** and its masculine equivalent **FUTURO** have in the past been refused for paints and varnishes in Class 2, printing presses in Class 7 and dental instruments in Class 10.

<b>FUTURE</b> )	( particularly bad for services relating to commodities bought for
<b>FUTURA</b> ) refuse	( future delivery at a specified date where technical development
<b>FUTURO</b> )	( and innovation are occurring.

The objection to the word **FUTURA** is not that it is a form of the Italian adjective, and also the noun, 'futuro' but that it is also very close visually to the English word **FUTURE**, a word which traders in 'technical' goods should be free to use, to indicate that their goods are modern and up-to-date to the extent that they anticipate future design trends. Although such a use of the word does not accord strictly with the dictionary definition it is in ordinary usage a legitimate type of ellipsis, so that such an expression as 'the future hair dryer' would be quite meaningful in relation to a hair dryer already in existence.

# G

## 🌐 GARDEN

This is non-distinctive for hotel services as it is commonly used in hotel names, for example **HOLIDAY INN GARDEN COURT**. **GARDEN** should be disclaimed if it appears in marks for these services.

## 🌐 GEM

This has a laudatory meaning ie. 'a person or thing held to be a perfect example; treasure' (Collins English Dictionary). It is usually acceptable in Part B.

## 🌐 GEOGRAPHICAL NAMES: GENERAL

Generally not acceptable as trade marks particularly in respect of natural produce (food and wines). Although guidelines can be laid down it is often a matter of fine judgement whether or not to accept geographical names for registration. The mark must be considered in relation to the goods (or services) and all the surrounding circumstances. Acceptance of a word in the past is not a conclusive argument that it should be accepted again and vice versa. The onus is upon the applicant in each case to satisfy the Registrar as to the acceptability of a 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.

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

## 🌐 GEOGRAPHICAL NAMES: RELEVANT RPCs

**MAGNOLIA** (1897 RPC 621)

**LIVERPOOL CABLES** (1929 RPC 99)

**GLASTONBURYs** (1938 RPC 253)

**YORKSHIRE** (1954 RPC 150)

**TIJUANA SMALLS** (1973 RPC 453)

**YORK** (1984 RPC 231)

There have as yet been no decisions by the Courts in respect of geographical names as service marks.

## 🌐 GEOGRAPHICAL NAMES: DE MINIMUS PRINCIPLE

As a general rule 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 the likelihood of traders wishing to use such place names in relation to their goods is considered so remote that it can be ignored.

## 🌐 GEOGRAPHICAL NAMES: DIFFERENCES BETWEEN TRADE MARKS & 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. Goods are almost invariably transported from the area and sold elsewhere in the UK, whereas a service may be provided only in that locality.

See **GEOGRAPHICAL NAMES: RELATIVELY UNKNOWN SERVICES**

Where the service is provided outside the named locality the geographical signification is lost. Where a service organisation has built up a considerable reputation nationwide under a geographic mark (for example building societies and insurance companies) that organisation should justly be granted service mark registration rights except, of course, in the area where others might legitimately wish to use the geographical name ie. in the area of the named place.

## 🌐 GEOGRAPHICAL NAMES: REDUNDANT

Care must continue to be exercised if a mark consists of a geographical name which is no longer in official use, but which may well still be in common use. For example, **WESSEX** is still used in relation to the local Police force and the regional Water Authority and is therefore open to objection under Sections 9 & 10.

See **SIAM** and **SOLO**

## 🌐 GEOGRAPHICAL NAMES: WELL KNOWN AND IN THE UK

In relation to trade marks, 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 in Part A or Part B *prima facie*, and may prove to be unregistrable even if supported by extensive evidence of use (**YORK 1984 RPC 231**).

If an application is for clothing in class 25, and the mark consists of a geographical name known to be a fashion centre eg **PARIS** or **LONDON**, then it is necessary to raise an objection under Section 11. The objection can be overcome by a clause stating that the goods are manufactured in that place. It is not sufficient to say that the clothes were designed in that place.

This is not necessary if the place is a geographical location not known to have a reputation in fashion; merely disclaim. Marks which contain mere suggestions of geographical location eg **FRENCH CONNECTION** are not subject to a Section 11 objection, nor a disclaimer.

In relation to service marks **WOOLWICH**, **HALIFAX** and **LEEDS** are **not** acceptable in Part A or B *prima facie* but they can be accepted on evidence (substantial turnover over a period of eg., 10 years, depending on individual circumstances: those which are known to be household names will need to submit less detailed evidence). A geographical exclusion will be required, covering the named place and neighbouring areas eg., excluding rights in 'Greater London' for **WOOLWICH** or 'West Yorkshire' for **HALIFAX**. If the town/city is at the edge of a county it may be necessary to exclude the neighbouring county as well. In the case of a county name it may only be necessary to exclude the county itself.

## 🌐 GEOGRAPHICAL NAMES: RELATIVELY UNKNOWN (SERVICES)

In respect of essentially local services eg. plumbing or building and services provided in remote rural areas eg rental of farm equipment or provision of camping facilities the de minimus rules for UK geographical

names will not be applicable as long as a geographical limitation is specified which limits use to an area isolated from the place named in the mark. For example, **HORSTED KEYNES** would be registrable for plumbing services provided in the Glasgow area but not for a service confined to the village of 'Horsted Keynes' in Sussex, or any area in the proximity of Horsted Keynes.

### ⊗ GEOGRAPHICAL NAMES: FOREIGN

- 1 Well Known Foreign geographic names may become known in this country by reason of their use as trade marks eg. 'HITACHI', if not for the reputation of the names as trade marks the places concerned would be virtually unknown. In such cases examiners should not be unduly influenced by the fact that the name is well-known as a trade mark, as once a geographical meaning has become apparent the Registrar is no longer required to decide what is the ordinary signification of the word.
- 2 Use in respect of local services This can be regarded as fanciful use and not services originating from the foreign place eg. **BOMBAY** shoe repairers, **FLORIDA** chimney sweeps, **MADRID** plumbing services; others offering the same service would be unlikely to wish to use such names in a descriptive sense. Foreign geographic names can be registered in Part B prima facie or in Part A with a modicum of factual distinctiveness in respect of essentially local services such as plumbing, chimney sweeping, taxis etc., but not in respect of international services such as banking, import/export services or transport. This does not affect the general de minimus practice.
- 3 County names in the USA Evidence has in the past been filed showing that;
  - i In formal or legal usage the word 'County' is never omitted, ie. 'County of Liberty' or 'Liberty County' is never abbreviated to 'Liberty'.
  - ii 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 and 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.

### ⊗ GEOGRAPHICAL NAMES: NATURAL PRODUCE

Objection should be taken to all place names in respect of produce which could originate from that area eg. food, wines, timber, minerals. In each case, details of location, population, activities etc. must be considered.

Apart from de minimus 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 if supported by strong evidence of use. 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? Much greater caution is required in respect of locations in the UK than, for example, in South America, and in respect of easily made, easily transportable goods than heavy and/or bulky goods.

### ⊗ GEOGRAPHICAL NAMES: COMPANY TOWNS

Applicants have occasionally been able to show that they established their business at a particular location and 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 the mark can be accepted in Part B prima facie and in Part A if supported by sufficient evidence of use.

## 🌐 GEOGRAPHICAL NAMES: SPLIT

It may be possible to accept a geographical mark by splitting into two words. For example 'MAYFAIR' was accepted when split to form 'MAY FAIR' because of its well known other meaning.

## 🌐 GEOGRAPHICAL NAMES: TWO (OR MORE) COMBINED (SERVICES)

### 1 UNCONNECTED PLACES

eg., **LIVERPOOL VICTORIA** or **NORWICH PETERBOROUGH**

If the combination is an unlikely one and it is reasonable to assume that other businesses could not have legitimate cause to use the combination the mark should be accepted in Part B on separate disclaimers. Where any doubt exists a modicum of evidence of use would permit Part B, ABA and extensive use would permit Part A, ABA, on separate disclaimers.

Care is needed with some major locations eg. **LONDON AND EDINBURGH** in relation to services connected with finance or law as each centre has a national reputation and it is possible that traders may wish their mark to reflect a base at each location. In such cases extensive evidence of use will be required and independent trade evidence eg. from local chambers of commerce should be called for to establish that the proposed registration will not impinge upon the rights of other traders and businesses.

### 2 PLACES ASSOCIATED WITH ONE ANOTHER

If a mark includes geographical names that are situated within a few miles of each other, eg. **BRADFORD AND BINGLEY**, other businesses may wish to use this combination so the mark can only be accepted on evidence of use with the appropriate geographic limitation. If the combination is unlikely eg. **CARDIFF AND ROGERSTONE** (a suburb of Newport, Gwent) the mark can be accepted prima facie subject to separate disclaimers but with no geographic exclusion.

Another variant of geographic names links specific locations with wider associations, for example **BRISTOL AND WEST** or **HASTINGS AND THANET**. In these instances a judgement has to be made as to the likelihood that the combination might be used by other traders. For instance, would traders wish to use **BRISTOL AND WEST** or would they use **BRISTOL AND THE WEST COUNTRY**? **BRISTOL AND WEST** is considered acceptable in Part B, prima facie with separate disclaimers, or Part A (ABA) if supported by evidence of use with **BRISTOL** disclaimed. **NATIONWIDE ANGLIA** could be similarly accepted but, because of the increased disparity between the two elements, would require less weight of evidence for Part A (ABA).

When separate disclaimers are agreed to in respect of such marks it will not normally be necessary to impose a geographical exclusion.

## 🌐 GEOGRAPHICAL NAMES: RIVERS, SEAS, LAKES, MOUNTAINS

These are usually accepted prima facie in Part B for goods or services which are not directly relevant. Names of rivers, seas and lakes would not be acceptable as marks for eg. fish, boats or holiday services and

names of mountains would not be acceptable as marks for agricultural produce or, again, holiday services. Some rivers flow through heavily industrialised areas and they would not be acceptable for registration eg. **TYNE MADE** as this is a common expression. With regard to names of mountains, the practice previously was to object under Sections 9 and 10 for clothing, on the grounds that such names were non-distinctive for clothing which was for use in mountaineering. The practice now is not to object under Section 10 unless the word is descriptive in a general sense (eg **ALPINE**, **HIMALAYAN** or **PYRENEAN**, which might suggest a particular local style or materials). Names of individual mountains (**MONT BLANC**, **KILIMANJARO**, etc) would not be open to the same objection (but examiners should watch for names which have other significations, like **EVEREST** or **SNOWDON**, which are surnames).

### ⊗ GEOGRAPHICAL NAMES: OCEANS

Practice is to accept **ATLANTIC** and **PACIFIC** prima facie in Part A for goods or services which are not directly relevant.

See also **ATLANTIC** and **PACIFIC**

### ⊗ GEOGRAPHICAL NAMES: DESERTS

Care needs to be exercised as the development of desert areas for agricultural or industrial use has increased significantly in recent years. For a wide range of heavy and sophisticated goods acceptance in Part A or B can be considered. Reputation is a factor to be taken into account; **SAHARA** would not be acceptable for dates or **KALAHARI** for diamonds.

Examples of accepted marks:

**SAHARA**

CLASS 3 - perfumes; non-medicated toilet preparations, cosmetics; etc.

CLASS 20 - furniture

CLASS 30 - baked foods

CLASS 32 - non-alcoholic drinks and fruit juices

**GOBI**

CLASS 25 - footwear

### ⊗ GEOGRAPHICAL NAMES: DISTRICTS STREETS AND ROADS

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 on a par with **BOND STREET** for fashions, and **WALL STREET** would be objectionable for services connected with stocks, shares or investments etc. ➔

The names of districts of larger towns and cities may not correspond with precise geographical areas or administrative units eg **SWISS COTTAGE**, **BILLINGSGATE**, **COVENT GARDEN**, but may well be known for particular goods or services. Thus **COVENT GARDEN** would not be acceptable for restaurant services. Regard should also be had to any historical reputation which may continue, eg **BILLINGSGATE** for fish.

The names of certain London districts such as **MAYFAIR**, **PARK LANE** and **KNIGHTSBRIDGE** may be used to add prestige to the name of the trader. Consideration must be given to the goods in question, eg **MAYFAIR** may be acceptable in Part A for fire engines or tea, but unregistrable for hotel and restaurant services. **ST JAMES'** would not appear to add prestige to any goods and would be acceptable in Part B on geographical grounds

### ⊗ GEOGRAPHICAL NAMES: SIMILAR AND PHONETICALLY CLOSE

When marks closely resemble geographical names there must be a significant 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 marks were considered acceptable for registration:

**SHILTERN, EXTER, TREIST, JAMOCA, TEXIS**

### ⊗ GEOGRAPHICAL NAMES: WITH OTHER WELL KNOWN 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' (**CANNON Case 1980 RPC 519**) objection will normally be taken against a geographical name even though it possesses other non-objectionable meanings.

On the other hand the **MAGNOLIA Case (1897 RPC 621)** provides a precedent for permitting an examiner to decide, *prima facie*, 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.

In practice the following guidelines should be followed;

- 1 Places with populations lower than 5,000 in the United Kingdom and which have another very common and non-objectionable meaning which outweighs the geographical significance are accepted in Part B. In the case of names of places overseas the location is more important than the size eg. in the case of industrialised areas such as the USA, Japan and Europe 100,000 population size would be sufficiently small, while in the case of places in China or South America, names with populations up to 250,000 would be sufficiently small to merit Part B acceptance.
- 2 If formal evidence is filed, for example a properly conducted survey showing that the geographical meaning of the word is not one of its ordinary significations in this country, Part A acceptance can be considered.
- 3 Falling between 1 and 2 are place names with other meanings which have been registered many times in the past and which can be considered precedents for the population sizes considered acceptable for places in certain countries; ➡

MARK	POPULATION AND LOCATION	ACCEPT
MONARCH	2,000 USA	Part A
AURORA	50,000 USA	Part B
FALCON	200,000 USA	Part B

See also **SIERRA, CENTRAL, BEER** and **BLANC DE MER**

### ⊗ GEOGRAPHICAL NAMES: COMBINED WITH OTHER MATTER

When used in an otherwise distinctive trade mark, solely to indicate the origin of the goods, an objection under Section 11 may arise if the area concerned has a reputation for the goods in question, but there is no need to disclaim if it is not given prominence in the mark.

In the case of service marks a geographical name itself cannot be monopolised for the named area and will generally have to be disclaimed unless the applicant is willing to proceed on substantial evidence of use, 'Advertised before Acceptance, Section 18(1)(proviso)', using a geographical exclusion. Depending on the added matter it may be possible to proceed without a geographical limit but on separate disclaimers. When considering **WOOLWICH EQUITABLE BUILDING SOCIETY** and **NORWICH UNION** neither 'Equitable' nor 'Union' would be considered distinctive alone, but the combination of such words with a geographical name is considered capable of distinguishing and acceptable prima facie in Part B subject to separate disclaimers. The words 'Building Society' clearly do not add any distinctiveness and may also need to be disclaimed.

On reasonable use, Part A may be offered (ABA) but separate disclaimers should still be required to emphasise that rights exist only in the combination of words.

### ⊗ GEOGRAPHICAL NAMES: PREVIOUS REGISTRATIONS (EQUITIES)

Some place names, for example **AVON** and **BEDFORD**, were registered in the past but are now considered to be unregistrable. 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 whatsoever 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'.

### ⊗ GEOGRAPHICAL NAMES: FOR WINES

The European Community adopted Council Regulation No 3485/87 on 17 November 1987 which imposes wide ranging controls over the production, sale, description, etc of wines. One aspect of it affects the Registry. Article 43 provides, amongst other things, that no trade mark may be registered which is likely to cause confusion with a 'geographical unit'. By way of derogation, marks which are already registered may remain so until 2002 but member states are required to inform the Commission of all registered trade marks which are identical to 'geographical units' as and when they are informed by the Commission. Marks registered before the adoption of an identical geographical name are not exempt from the Regulation or the threat of eventual rectification. ➡

1. Since no comprehensive list of 'geographical units' exists, examiners should continue to search new applications for geographical objections as at present. The EC has detailed but incomplete lists of recognised geographical names which are quite impractical for use in searching; the Registry ADP team are investigating the possibility of producing one alphabetical list which might then become a useful source of information.
2. No action is required to search for marks already on the Register which are identical to 'geographical units'.
3. It is unlikely that foreign wine organisations, particularly the German Stabilisierungsfond, will undertake searches in an attempt to persuade us to notify the Commission of offending marks. Any approach should be referred up to the appropriate senior officer (Grade 6). It seems that only a member state may notify the Commission and that only registered marks which are identical in every respect to the name of a 'geographical unit' are threatened with eventual rectification. For the avoidance of uncertainty it is stressed that new applications should continue to be searched against identical and confusingly similar geographical place names as at present.

### ⊗ GEOMETRICAL FIGURES: PLAIN

Triangles, squares, diamonds, circles, ellipses etc, are not considered distinctive and they are commonly used as mere borders or outlines in marks. Geometrical figures with ten or more sides are similarly regarded because they resemble mere circles too closely. Figures having from five to nine sides are considered to be acceptable either

- 1 if they are made solid

OR

- 2 if they are coloured, shown in combination with words describing them and limited to the particular colour in which they are shown.

A pentagonal device shown in the colour red, combined with the words **RED PENTAGON** and limited to the colour red would consequently be considered acceptable in Part A (the **PENTAGON** case (1964 RPC 138) refers). If a mark is considered borderline it should be offered Part B.

### ⊗ GEOMETRICAL FIGURES: SPOTS

A device of a circle filled in with a single colour may be acceptable for registration in Part B if the words descriptive of the spot (eg, **BLUE SPOT**, **RED SPOT**) are added to the device and if the applicant is willing to limit the mark, including the spot, to the colour named.

### ⊗ GEOMETRICAL FIGURES: IN COMBINATION

The combination of a relatively non-distinctive 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. An example is:



## ● GET-UP

This is not considered distinctive prima facie.

Get-up is the dress in which goods are presented to a buyer. It may consist of the size or shape of packaging, the material, colour or decoration of wrappers or the lettering or arrangement of labels. Get-up may also consist of a fanciful addition to the goods themselves, for example paintwork, colouring or shaping. A trader who introduces a new feature into the get-up of certain goods does not acquire any proprietary interest in it, so as to be able to prevent its use by competitors, until it has become so identified with his/her goods that its use by others would be calculated to deceive. If get-up does become identified with a trader's goods then it can be regarded as 'passing off'. Only things which are put prominently forward so as to be likely to catch the eye of the purchaser and remain in his/her memory need generally be considered. Consequently printing on the back or sides of a box may usually be disregarded in considering whether the get-up of goods is likely to deceive.

The Trade Marks Registry is not concerned with passing-off actions; merely with the examination of marks from the point of view of their suitability for Registration. When a device is presented merely as a background to disclaimed words and/or letters the mark cannot be considered as distinctive prima facie. This is because get-up is not considered distinctive prima facie. Such marks can only be accepted on the basis of evidence of distinctiveness acquired through use.

The mark shown below consists essentially of the words **AU BIFIDUS ACTIF**, the letters **BA** and a non-distinctive device which is limited to the colours blue, yellow and red. The mark was subject to a disclaimer of the words and letters which left rights in only the non-distinctive device element. As the device is presented merely as a background to the words and letters it must be regarded as get-up. The mark cannot be allowed to proceed to Registration on the basis of get-up so the mark must be refused.



## ● GHOST MARKS

These are marks that a proprietor seeks to register not for use in the course of trade but because it is wished to gain infringement rights to protect another mark which they do intend to use but which may itself be unregistrable. The case usually quoted is that relating to an application for the mark **NERIT** which was proposed for registration for cigarettes when the proprietor's real interest was in **MERIT** (1982 FSR 72). **NERIT** qualified as a trade mark under Section 68(1) but the applicants had no bona fide intention to use the mark at the time of registration and no subsequent bona fide use. **NERIT** was only registered by the proprietors to protect their real mark **MERIT**, which itself was not registrable. **NERIT** was consequently removed from the Register. ➡

Ghost Marks are not acceptable. If an applicant wishes to amend their mark as originally filed then assurance should be sought that the applicant will use the mark in its amended form. If the original mark is already in use a statement from the applicants themselves will be necessary to confirm that the amended mark will be used. The Registry does not have authority to seek a discontinuance of use of the original mark although this, of course, cannot be presented as a registered mark. The applicants can continue to use it as an unregistered mark if they so wish.

See also **AMENDMENT OF PENDING MARKS**

### ● **GLEN**

This refers to areas in Scotland, Ireland (and New Zealand). It is considered non-distinctive (as well as a surname) for whisky, and should therefore be objected to under Section 9 and 10. In combination with another acceptable word it may be accepted in Part A with no disclaimer. If the combination strongly indicates Scotland, for example **HIGHLAND GLEN**, then a Section 11 objection should be raised. This may be overcome using a Scotch Whisky condition.

See also **SCOTCH WHISKY**

### ● **GOLD**

When used in relation to milk, objection to **GOLD** should be taken under Section 11 because it would be deceptive if used in relation to milk or powdered milk which does not comply with the Gold Cap standards. Under the terms of the Ministry of Agriculture's Cap Colour Regulations, the colour gold is used for milk from the Jersey and Guernsey breeds of cow which have a fat content of more than 4%. In most other instances the word **GOLD** is open to objection because it is a common surname and is also laudatory.

### ● **GORBACHEV OR GORBY**

**GORBACHEV** is the name of the former USSR President and **GORBY** is widely used as a nickname. In some countries there have been cases of registration as trade marks of **GORBACHEV** and phonetic derivatives therefrom.

It is the opinion of the Registrar that the use of such words as trade marks would be likely to give offence to a substantial number of Russian citizens. It is considered appropriate to raise an objection under Section 11 of the Act.

All applications to register such words should be referred to senior officers so that the Assistant Registrar may be consulted.

### ● **GRAPES AND VINE LEAVES**

Devices of bunches of **GRAPES** and **VINE LEAVES** are not considered distinctive in respect of wines since such devices are a common feature of wine labels. The same would apply to wine bar, restaurant and public house services. It is now considered that such devices are so common and non-distinctive that a disclaimer is not required. Object under Sections 9 and or 10 if such features are prominent in a mark.

## 🌐 GREEK OR CYRILLIC LETTERS: ACCEPTABILITY

The fact that Greek letters are quite common in trade marks does not mean they are necessarily non-distinctive. The lambda, psi, omega, beta and sigma symbols and the words delta, omega, gamma and beta are registered in many classes and successfully serve the purpose of a trade mark.

However, Greek letters are frequently used as symbols for electrical processes and care must be taken when examining marks consisting of or containing Greek letters, or the phonetics of these, applied for in relation to Class 9 goods. Similarly, some Greek letters have a significance in mathematics, eg delta, pi and sigma, and therefore are non-distinctive for calculators and the like.

The European Community have adopted a reverse Greek letter epsilon to indicate aerosol dispensers which meet certain standards. For this reason the letter epsilon is not distinctive if used in relation to aerosol dispensers or goods related thereto (there might also be a Section 11 objection in such cases). A reversed epsilon is, in any event, essentially the numeral 3 and not acceptable in the prima facie case. The symbol and word Beta are totally descriptive of the characteristic of some video cassette recorders and tapes for use therewith.

In all cases where the Greek letter closely resembles a letter of the Roman alphabet, eg the symbols for chi, omicron, kappa, etc, Sections 9 and 10 objections should be taken in the prima facie case according to how similar the symbol is to a Roman alphabet letter.

It is not known whether Cyrillic letters are used in any symbolic way but they are frequently very similar to Roman alphabet letters and will be acceptable/not acceptable prima facie according to this similarity. In particular cases disclaimers may be necessary.

Where Greek or Cyrillic letters, or their phonetics, appear as or in trade or service marks they should not be automatically objected to but considered according to the circumstances of each application

## The Greek alphabet

A	α	alpha	=	a	N	ν	nū	=	n
B	β	bēta	=	b	Ξ	ξ	xī	=	x (ks)
Γ	γ	gamma	=	g	O	ο	omicron	=	o
Δ	δ	delta	=	d	Π	π	pī	=	p
E	ε	epsīlon	=	e	P	ρ	rhō	=	r
Z	ζ	zēta	=	z	Σ	σ ζ	sigma	=	s
H	η	ēta	=	ē	T	τ	tau	=	t
Θ	θ ϑ	thēta	=	th (th)	Υ	υ	ūpsīlon	=	u (yōō, ōō, ū)
I	ι	iōta	=	i	(often transcribed y)				
K	κ	kappa	=	k	Φ	φ	phī	=	ph (f)
Λ	λ	lambda	=	l	X	χ	chī	=	kh (hh)
M	μ	mū	=	m	(often transcribed ch, as in Latin)				
					Ψ	ψ	psī	=	ps
					Ω	ω	ōmega	=	ō

The Greek alphabet, apart from its use as the official script in Greek-speaking areas, is of world-wide importance as a source of symbols used in all branches of science and mathematics.

## The Russian alphabet

А а	= a (ä)	С с	= s
Б б	= b	Т т	= t
В в	= v	У у	= u (ū)
Г г	= g	Ф ф	= f
Д д	= d	Х х	= kh (hh)
Е е	= e (ye)	Ц ц	= ts
Ё ё	= (yö)	Ч ч	= ch (ch)
(often printed as E, e)		Ш ш	= sh
Ж ж	= zh (zh)	Щ щ	= shch
З з	= z	(often pronounced rather as sh followed by consonantal y)	
И и	= i (ē)	Ъ	= hard sign
Й й	(consonantal y sound; only used as the second letter of a diphthong)	(sign used to separate in pronunciation a following palatalised vowel from a preceding consonant either palatalised or unpalatalised)	
К к	= k	Ы	= i (a sound similar to i)
Л л	= l	Ь	= soft sign
М м	= m	(sign used after a consonant to indicate palatalisation, a sound like consonantal y)	
Н н	= n	Э э	= e (e)
О о	= o (ö)	Ю ю	= u (yū)
П п	= p	Я я	= ya (yā)
Р р	= r		

### Ⓢ GREEK OR CYRILLIC LETTERS: DISCLAIMERS

Where it is considered that a disclaimer is required, the disclaimer should refer to the Greek or Cyrillic letters or the word (eg Beta). The use of the expression Greek or Cyrillic symbols or characters should be avoided. The only exception should be in these cases where the letter is so stylised as to throw doubt on whether it is actually a Greek letter. In such cases, depending on the degree of stylisation, no disclaimer will be necessary.

### Ⓢ GREEN

In addition to being a common surname, **GREEN** has a meaning in relation to ecology and environmentally 'friendly' products. Objections should be raised under Sections 9 and 10 when **GREEN** is presented alone or combined with other descriptive words such as 'safe', 'friendly', 'care' or 'system', unless the mark is not being applied to products or services which could be considered environmentally 'friendly'.

See also **ECO**

### Ⓢ GUERNSEY

See **CHANNEL ISLANDS**

# H

## HAZE

Although the word is phonetically close to the common surname **HAYES** (also a geographical reference) the non-surname signification overshadows that of the surname. Taking into account previous acceptances in Part A and the visual differences it may continue to be accepted in Part A because the ordinary signification is not that of a surname.

## HEADS: OF WOMEN

Devices of women's heads are commonly used for advertising purposes in the perfumery trade and especially for hair-waving preparations and hairdressing or beauticians 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.

## HEARINGS: EX PARTE

The Trade and Service Mark Rules provide that, following examination of an application by the Registrar, an applicant who has encountered objection may apply for a hearing or may submit a considered reply in writing. In a case where a hearing is sought, the applicant or agent will be contacted by the Registrar's Hearing Clerk so that an appointment may be made.

Hearings are traditionally held face to face between the applicant and a Hearing Officer, who is one of the senior members of the Registry. The relocation of the Registry to Newport has involved the introduction of an alternative mechanism for hearings to be held over a live teleconference link between London and Newport. This mechanism is available at the option of the applicant. However, the nature of the proceeding is unchanged. It is a 'one to one' discussion of the objection taken at examination to determine, if possible, whether it can be overcome.

A Hearing session may involve a single application or a multiplicity of applications – usually not more than 20. The nature of the objections faced will be clear from the examination report. It is expected that the applicant and the Hearing Officer will have studied each application and will be fully prepared to discuss it in the light of the Act and Rules, of relevant leading cases, and any relevant evidence of user. Occasionally, a Hearing Officer in preparing for a hearing may find it necessary to raise a late objection. Care will be taken to give applicants as much notice as possible in these cases. It may be that on occasion the applicant will wish the Hearing to be re-appointed so that he can have further time to consider the new objection raised. This can normally be arranged.

Hearings are not meant to be confrontational. Hearing Officers are briefed to be constructive in their approach. The aim is always to investigate in discussion whether objections can be overcome, while respecting the requirements of the Act and Rules. It may be necessary for an applicant to provide evidence of use to justify registration, or to be prepared to modify the mark, or to restrict the specification, or to indicate consent to registration by the proprietor of a mark judged to be in conflict. There are many possibilities for discussion.

If the system is to work as intended, Hearings on every application should be decisive. Applicants should be fully prepared to discuss each application in as much depth as necessary, to produce any necessary material in support of their arguments, and to agree on the spot decisions involving change

to applications in order to make them acceptable. The onus of preparedness on Hearing Officers is the same. Hearings should never be regarded as occasions of preliminary consultation with a view to further Hearings or correspondence. In rare cases, it may be necessary to adjourn the hearing to enable an applicant to file evidence, additional evidence, or counsel, as the case may be. If it is appropriate, an applicant will be allowed a short period to withdraw his application rather than have it refused.

The mechanics of hearings are simple. Whether for conventional hearings or teleconference hearings, applicants should attend just before the appointed time and ask for the Hearings Clerk. They will be shown to the Hearing Officer's room or the teleconference room, and, after the preliminary courtesies, discussion takes place 'across the table' in a manner which, it is hoped, is informal and workmanlike. The aim is to move matters along at a pace which allows reasonable consideration of each case without unduly prolonged debate.

### ⊗ HEAVENLY

Not acceptable for many goods because of its laudatory meaning in modern usage, ie something which produces feelings of great pleasure. This meaning may not be directly given by many dictionaries, but it was accepted in the HEAVENLY case (1967 RPC 306) 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.

There will, however, be some goods/services where the mark HEAVENLY could be regarded only as a fanciful use of the word and which might be acceptable, eg roadmaking machinery or watch repair services; things which could not have any aesthetic appeal.

### ⊗ HERALDIC DEVICES: MARKS CONTAINING

Rule 17 requires that where a representation of armorial bearings, coats of arms, heraldic crests, insignia etc, appears on a mark the Registrar shall consider whether to refuse to accept an application unless the consent of the owner of the armorial bearings is given.

The Registrar may object (under Rule 17) to a mark containing a heraldic emblem only if that emblem is identical to a recorded crest or coat of arms and for this purpose the opinion of the Garter King of Arms (the Lyon King of Arms in the case of Scottish residents) is sought. In dealings with the Garter King it must be remembered 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.

If the Garter King or Lyon King reports that the emblem in question does not 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 that the Garter King will express the view that the heraldic emblem 'resembles an emblem owned by...'. The fact that it merely resembles, but is not identical to, an emblem does not constitute a ground on which the Registrar can validly refuse to register a mark. Objection could only be taken to non-identical device marks, which so nearly resemble bearings etc, that they would be taken as 'representations' of the bearings.

See also **HERALDIC DEVICES: PROCEDURE FOR CONTACTING THE GARTER KING**

## ☉ HERALDIC DEVICES : COMPOSITE MARKS

Heraldic devices are incorporated into marks to give an up-market impression and in practice the public will probably recognise the mark by another element, especially a word element. For example, in the mark below 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.

## ☉ HERALDIC DEVICES: PROCEDURE FOR CONTACTING THE GARTER KING

### 1 COMPOSITE MARKS INCORPORATING HERALDIC DEVICES:

- i if the heraldic device is obviously fanciful search the Register in the usual way and disregard the heraldic significance;
- ii if the device appears to be a proper coat of arms or heraldic crest ask the applicant for details of its derivation;
- iii 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;
- iv if the reply is that it is someone's coat of arms, other than the applicant's ask for the consent of that person and refuse the application if the consent is not forthcoming.

### 2 MARKS IN WHICH HERALDIC DEVICE IS SOLE DISTINCTIVE ELEMENT:

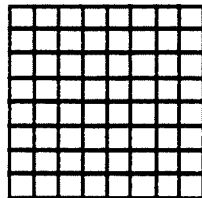
- i if the heraldic device is obviously fanciful search the Register in the usual way and disregard the heraldic significance;
- ii if the device appears to be a proper coat of arms or heraldic crest, refer to the Garter Principal King of Arms (or the Lyon King of Arms in the case of Scottish residents) using the appropriate standard letter, asking for his opinion whether the use of the mark would infringe the rights of any proprietor of arms recorded in his Register;
- iii 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 Boutell's Heraldry. If the arms appear identical, or virtually so, to the eyes of the Examiner, then an objection should be taken;
- iv if the mark is a combination of elements that are similar to existing coats of arms, but as a whole it does not truly represent one coat of arms, then it is not necessary to raise an objection on heraldic grounds.

## HERALDIC SHADING

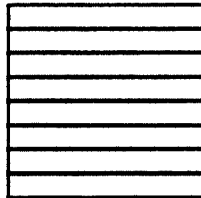
If the mark, when registered, is intended to be limited to the colours as shown on the form of application the block should, as far as possible, show the colours by means of the Heraldic Convention.

BLACK	HORIZONTAL AND PERPENDICULAR CROSSHATCHING
BLUE	HORIZONTAL LINES
RED	VERTICAL LINES
GREEN	DIAGONAL LINES - TOP LEFT TO BOTTOM RIGHT
YELLOW	DOTTED
WHITE	PLAIN
PURPLE	DIAGONAL LINES - TOP RIGHT TO BOTTOM LEFT
CHESTNUT	HORIZONTAL LINES WITH LEFT TO RIGHT CROSSHATCHING
BROWN	DIAGONAL CROSSHATCHING

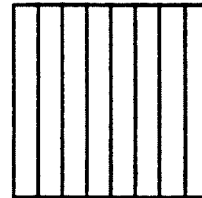
The following chart contains examples of the shading to be used:



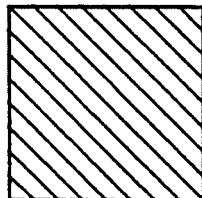
BLACK



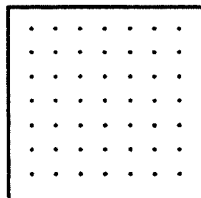
BLUE



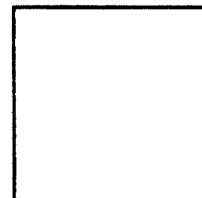
RED



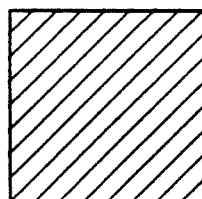
GREEN



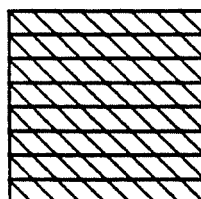
YELLOW or  
GOLD



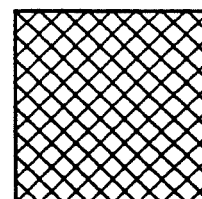
WHITE or  
SILVER



PURPLE



CHESTNUT or  
DEEP ORANGE



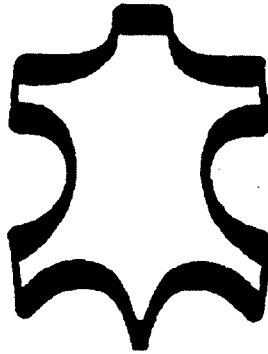
DARK BROWN

### ⊗ HIBERNIA

Acceptable in Part B (ancient name for Ireland).

### ⊗ HIDE DEVICES

Devices of the shape shown below are non-distinctive for goods made of leather and Section 9 and 10 objections should be raised.



### ⊗ HIGH TECH (OR PHONETIC EQUIVALENTS)

This is considered non-distinctive and attracts objections under Sections 9 and 10 for most goods (manufactured to the highest standards by means of the latest technology) and for services which employ technology, for example engineering, health screening or research.

See also **TECH**

### ⊗ HIGHLAND

This is a large administrative region in Scotland and is consequently open to objection on geographical grounds, under Sections 9 and 10.

### ⊗ HOLOGRAMS

The current practice is to refuse to examine marks consisting of holograms as they can change shape and colour depending on how they are viewed. If they are represented as a black and white line drawing it should be possible to proceed with the application. [Rule 26 of the Trade Marks and Service Marks Rules 1986 requires that the representation of a mark should be clear and durable]. All such applications should be referred to a senior officer for advice before refusal to examine.

### ⊗ HOUSE OF

Marks that include use of the words **HOUSE OF** should be examined on the basis that the words which follow, and the device, if any, are the important element of the mark. If the word following is also non-distinctive, for example a common surname, or if it is descriptive, then an objection should be raised under Sections 9 and 10 of the Act. If the word following is distinctive then the mark should be allowed to proceed in Part A. ➡

Examples of marks that should be objected to prima facie are:

<b>HOUSE OF FRASER</b>	-	Any goods or services	-	common surname
<b>HOUSE OF SCOTLAND</b>	-	Any goods or services	-	geographical
<b>HOUSE OF FLOWERS</b>	-	Florists, silk/fresh flowers etc	-	descriptive
<b>HOUSE OF TRAVEL</b>	-	Travel agency services	-	descriptive

Examples of marks that are acceptable in Part A prima facie are:

<b>HOUSE OF ANGELS</b>	-	Restaurant services, clothes, magazines etc
<b>HOUSE OF CHITTENDEN</b>	-	All goods and services
<b>HOUSE OF DRAGONS</b>	-	Theatrical agency services etc

Some marks may be acceptable, prima facie, in Part B if the mark only contains a characteristic of the goods or services, for example:

<b>HOUSE OF SPEED</b>	-	Computers, kitchen equipment etc
<b>HOUSE OF PLAY</b>	-	Toys, games etc

The examples are not exhaustive and each case should be examined on its merits.

It is not normally necessary to disclaim the words 'House of' as it would be unlikely that anyone would claim exclusive rights in these words.

It is likely that any objections can be overcome by the filing of evidence of factual distinctiveness. (Even **HOUSE OF SCOTLAND** might be registrable on extensive use with separate disclaimers.)

## ⊗ HUMAN FIGURES

See **DEVICES OF HUMAN FIGURES**.

## ⊗ HYBRID WORDS

In the **PARLOGRAPH** case (1914 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. If the foreign word is well known in this country a combination of this word plus an English element would not be recognised as invented. For example, **BONTOY** for toys or **BONCHOCS** for chocolates were not accepted as invented because the word 'bon', meaning 'good', is so well known in this country.

See also **INVENTED WORDS**

## ⊗ HYPHENATED WORDS

A hyphen in a mark should be treated in exactly the same way as a space. Hyphenated words should be treated as two separate words.

See also **LETTERS: TWO GROUPS IN UPPER CASE, HYPHENATED**

and for further details of what constitutes non-distinctive matter in the case of letter combinations

see also **LETTERS: GROUPS OF FOUR/THREE/TWO**

# I

## ☉ IDEAL

Now considered unregistrable for any goods or services because it means 'a person or thing considered to represent perfection' (Collins English Dictionary) and is consequently laudatory.

## ☉ IMPERIAL

Past practice has been to object under Sections 9 and 10 because the word has a laudatory connotation. **IMPERIAL** is now regarded as somewhat old fashioned and is no longer in common use. It can consequently be accepted in Part B, prima facie, for goods or services other than those in e.g. Classes 16 or 14 where the word still has a specific meaning.

## ☉ INFRINGEMENT: POSSIBLE DEFENCES

Section 4 (and 5) of the Trade Marks Act provides that infringement can only arise if the offending usage is as a trade mark or in a trade mark sense. In a recent court case (1988 RPC 113) **MOTHERCARE U.K. LTD** objected to the publication of a book by **PENGUIN BOOKS LTD** entitled 'MOTHER CARE / OTHER CARE' alleging passing off and infringement of its trade mark **MOTHERCARE** registered in respect of books. It was shown that the title 'MOTHER CARE / OTHER CARE' was chosen as a descriptive title which refers to the care of children by their mothers as opposed to the care of children by others, and does not refer to **MOTHERCARE** or claim any association with **MOTHERCARE** at all. The Court of Appeal held that the words 'Mother care' in the title of the book were not used as a trade mark or in a trade mark sense (the defendant's trade mark being **PENGUIN**) they were merely being used descriptively. There was no serious issue to be tried on infringement.

Rights derived from registration are quite separate from registrability and it is well established that the protection given to other traders by various sections of the Act – eg 4,5 and 8 – is not a consideration to be taken into account in assessing registrability. For specific authority refer to Mr Justice Falconer's decision in respect of the trade mark **LOOKING GOOD** regarding Sections 4 and 5, and the House of Lords **YORK, YORKSHIRE** and **LIVERPOOL CABLES** in respect of Section 8.

## ☉ INSIGNIA

See **BADGES.**

## ☉ INTER

The following practice has been adopted:

- |                            |  |
|----------------------------|--|
| <b>INTER</b> (alone)       | - Accept Part A  |
| <b>INTER</b> + the goods   | - Accept Part A  |
| <b>INTER</b> + invented    | - Accept Part A  |
| <b>INTER</b> + descriptive | - consider whether the <u>combination</u> can have a meaning. If not (eg Intercolour) Accept Part A. If so (eg. Interlink, shelving) object under Sections 9 and 10. |

**Note** The suggestion that **INTER** is an accepted abbreviation for **INTERNATIONAL** is not sustainable as an objection in this country (despite Websters).

## INTERNATIONAL

In future wherever **INTERNATIONAL** appears, whether in conjunction with another word or with a device alone, it should always be disclaimed. While the word **INTERNATIONAL** is close to being unregistrable it has been accepted in the past for paints and for agricultural machinery.

## INTERNATIONAL PRIORITY: GENERAL

Under Section 39A of the Trade Marks Act 1938 (as amended), any person making an application in the UK who has previously made the same application in a relevant country within six months of the application in the UK may claim priority as from the date of the earlier application. Relevant countries for trade marks are those party to the International Convention. For service marks it is those Countries which have specific agreements with the UK. In all cases the relevant countries are specified by Orders in Council.

If a mark is proceeding under International Priority arrangements the following information will appear in the journal;

*International Priority date claimed under Section 39(A) of the Trade Marks Act 1938 (as amended)..[date].. [country].*

**Note** On OPTICS insert the IP date and country of origin on the case details screen. There is no need to insert the clause elsewhere on OPTICS.

## INTERNATIONAL PRIORITY: CASCADING

Cascading is a hypothetical situation whereby an applicant claims a chain of successive rights to priority for the same mark in different countries, under International Priority arrangements.

An example is where a company files a first trade mark application in its home country, for instance France, and then subsequently files a foreign trade mark application, for instance in Germany, within six months of the French application and claiming priority therefrom. The situation is so far acceptable. If the company then filed a UK application within 6 months of the German application, but more than six months from the original French application it is not possible to claim priority under Section 39A of the Trade marks Act from the German filing date.

The period of priority starts from the date of filing of the first relevant application and this must be within the six month limit.

In most cases it will not be possible to ascertain whether a priority claim stems from a first application but it is not Registry practice to enquire unless there is some doubt about the claim.

## INTERNATIONAL PRIORITY: CERTIFICATE

In any case where an applicant includes in his/her application a claim to priority of date, he/she should be asked to furnish a certificate from the appropriate authority in the country in which he/she has made the application in respect of which he/she is claiming priority (with a certified translation thereof if not in the English language).

If priority documents are lodged prior to examination of an application they should be checked by the Examiner to ensure that: ➡

- 1 the earlier application is made in a relevant country;
- 2 the applicant is the same;
- 3 the mark is the same;
- 4 the specification of goods or services is no wider than that of the application on which the claim is based;
- 5 the UK application is made not more than six months after the relevant application in the country stated.

If the claim is acceptable on all counts the examiner should stamp the file cover with the appropriate stamp and enter the date claimed. If it is not acceptable, the examiner must give the reason(s) to the applicant in the Examination Report or by letter.

If Priority documents are lodged at any stage during or after formal examination of an application they should immediately be placed on the file and the file routed to the examiner concerned for action as described in the paragraphs above.

If the Priority claim is in order then the Priority date may be treated as the date of filing of the application at this Office, the following statement being inserted by the applicant in the Form TM No 3:

*International Priority date claimed under Section 39A of the Trade Marks Act 1938 (as amended)  
... (stating the date of foreign application and country).*

#### ☉ INTERNATIONAL PRIORITY: NON-ASSIGNABILITY OF RIGHTS

It should be noted that priority rights are not assignable, since they do not constitute a species of property. Article 4A(1) of the International Convention clearly indicates that the claimant to a priority date must be the applicant in the overseas country or his successor in title. Section 39A of the Trade Marks Act 1938 (as amended) is the statutory provision enabling such priority claims to be made under UK law. That Section clearly limits such claims to the applicant in the qualifying country 'or his legal representative or assignee'. In other words priority of date in a UK application can be accorded only where the applicant here is the person who applied earlier in the qualifying country or who has acquired title to the earlier application or registration, in the qualifying country.

#### ☉ INTERNATIONAL PRIORITY: THE SIX MONTH PERIOD

Where an applicant is claiming an International Priority date, and the six month period ends on a Saturday, the filing of the application on the following Monday is allowable. The relevant Rule is 128(2) of the 1986 rules, which states that Saturdays shall be excluded days for all purposes except the filing of applications for the registration of a trade or service mark not falling within Rule 21(4). Applications under Rule 21(4) are applications claiming International Priority.

#### ☉ INTERNATIONAL PRIORITY: LATE CLAIMS

Occasionally applicants submit a belated claim to International Priority. The view is that it is not Registry practice to allow the insertion of an International Priority date after the date of filing but further consideration may be possible if the full reasons and explanations for the omission are given in the form of a statutory declaration. ➡

In a recent instance a form TM20 was filed the month after the application date. The view taken was that an entitlement to International Priority is a matter of fact which may be proved by means of a statutory declaration confirming the circumstances of the omission notwithstanding the effect it may have on an associated Section 12(3) objection. Rule 121 of the Trade Mark and Service Mark Rules 1986 allows documents filed in any proceedings before the Registrar to be amended if the Registrar thinks fit, and on such terms as the Registrar may direct.

## ⊕ INVENTED WORDS: EXAMPLES

The following marks were considered not to be invented words:

### **ABSORBINE**

(Absorbing) 1904 RPC 97 and 755;

### **ARSENOID**

made up of a 'perfectly common chemical word with a common suffix added to it' 1916 RPC 285;

### **EANCO**

E and Co 1920 RPC 134;

### **ORLWOOLA**

All-wool-a or All-wooly 1909 RPC pages 683 and 850;

### **PANORAM**

Panoramic 1903 RPC 349;

### **UNEEDA**

You need a 1901 RPC 170 and 1902 RPC 281;

### **SCOTCHLITE**

Scotch lite 1948 RPC 230;

### **PUSSIKIN**

pussy kin 1955 RPC 36;

### **ELETRIX**

electrics 1959 RPC 283 (House of Lords judgement);

### **YOURT**

yogurt Opposition No 16511 (application No 1111816).

Examples of invented words are:

**SOLIO, KODAK, WHISQUER** (whisky liqueur), **PERSPEX, FORMICA, TWIX, VASELINE, ASPRO, AMSTRAD, ASDA, CANDA, JONELLE**

## 🌐 ISLE OF MAN

For the purposes of Trade Mark law this is treated as part of the United Kingdom.

## 🌐 ISOTONIC

This is a generic term for balanced drinks adapted to replace salts and minerals lost when taking part in sports activities. It is necessary to raise an objection under Section 11 of the Act if this word appears in a mark for drinks, this can be overcome by limiting the specification to isotonic drinks.



# J

## ☉ JAFFA

This is a registered trade mark. Care should be taken not to refer to this word as a generic term when dealing with similar marks.

## ☉ JERSEY

See CHANNEL ISLANDS.

## ☉ JIFFY

Connotes speed (although invariably used in phrases like 'in a jiffy' or 'only take a jiffy' in ordinary speech). Where speed is relevant to the goods it may still be acceptable in Part B. **JIFFY** light bulbs would be acceptable in Part A. **JIFFY** for laundering services would be acceptable in Part B but acceptable in Part A for funeral services. Objections were maintained under Sections 9 and 10 for the mark **JIFFY** for toothache drops in Class 5 but **JIFFY LUBE** was taken in Part B for 'Repair, cleaning and maintenance of motor vehicles'.

## ☉ JUMBO

Where size of packaging is relevant eg detergent, foodstuffs, some DIY materials, objections should be taken under Sections 9 and 10 (the Statement of Grounds relating to the mark **JUMBO** for oats and products made from oats, No.1186112 refers). Similarly where the size of the goods is relevant, as for aircraft or other transport vehicles, objections should be taken under Sections 9 and 10.



# K

## ⦿ **KINGSIZE**

A Section 11 objection should be raised in relation to cigarettes unless the specification is limited to king size cigarettes (a recognised size in the trade) or an appropriate condition is agreed to. If a variation clause is not used, the word should be disclaimed.

## ⦿ **KIT**

When this is presented as part of a mark but has no special prominence (eg. **ANAKIT**) even if goods may be in kit form do not raise a Section 11 objection. If **KIT** is prominent, as in **KIT-SAT** or **ANA-KIT**, then a Section 11 objection may be justified if the goods could be available in kit form, for example first aid kits.

For **KIT** on its own a limit of 'but not including any such goods sold in kit form' should be used to overcome the Section 9 and 10 objections. If a Section 11 objection arises then the mark cannot be accepted.

## ⦿ **KITCHEN**

In future **KITCHEN** should be disclaimed if it appears in a mark which covers food.

**KITCHEN** is also commonly used in the catering trade. It should be regarded as non-distinctive and should need to be disclaimed in marks such as **FARMHOUSE KITCHEN** for restaurants.

## ⦿ **KRETEK**

The generic name of a cigarette made in Indonesia, containing cloves.



# L

## ⊗ LA

This should now be regarded as non-distinctive for low-alcohol beers, ciders, wines etc, and should be disclaimed. A Section 11 objection should be raised unless the specification is limited, or a condition of registration is used. Note as the term low-alcohol is not a precise definition this should be replaced by 'beverages containing not more than 1.2% (by volume) of alcohol'.

## ⊗ LABEL : WORD USED IN COMBINATION WITH A COLOUR

Terms such as **RED LABEL** or **WHITE LABEL** are often used to describe goods such as drinks. Examples include **RED LABEL** tea, **BLACK LABEL** lager and **RED LABEL** wine. Particular care is required in Classes 3,5,32,33 and 34 but as a general rule objections should be raised under Sections 9 and 10 on the grounds that such marks are non-distinctive for any goods or services. Such marks can only be accepted for Registration on the basis of acquired distinctiveness demonstrated by evidence of use, generally over a modest period of time. Agreement to a condition of Registration will also be required:

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

If an application is proceeding with a disclaimer of the words '(red) label' the above mentioned condition of registration will not be required as the disclaimer ensures that the owners of the mark do not have exclusive rights in the use of these words.

In other Classes, for example Class 1, it may be possible to accept such marks as **RED LABEL** or **WHITE LABEL** prima facie in Part B with a suitable exclusion but care is required.

The following mark was accepted subject to a disclaimer of the words 'Red Label'



## ⊗ LABELS

Labels are very commonly used in food and drink classes and often contain added matter of no trade mark significance.

**The following details should normally be removed from a label before advertisement (the most important is 4).**

- 1 Indications of quantity, volume, alcoholic content, ingredients, specific gravity, instructions ie. recipes etc.
- 2 Code numbers and computer bar codes. ➡

- 3 Legal terms certifying origin or methods of production eg. 'Appellation Controlee' 'Qualitätswein mit Pradikat' 'Denominazione di origine controllata' etc.
- 4 The words 'Registered Trade Mark' or the symbol ®. However the words 'Trade Mark', or 'TM' may remain.
- 5 Other non-trade mark matter like descriptive passages relating to the goods, a history of the product or the firm etc.
- 6 Name and address of any company other than the applicants.

**The following need not be removed provided they are de minimus:**

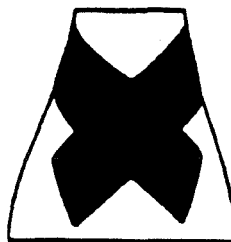
- 1 Applicants name and address including statements like 'bottled by ....' or 'distilled by ....'.
- 2 Statements of geographical origin, eg 'Produce of France' or 'Distilled in Scotland'. Also geographical names that solely indicate origin of the goods.

**The following details should either be justified or removed:**

- 1 Dates or statements relating to the founding of the firm '1889'; 'Established 1843'; 'Maison Fondée En 1724'. etc.
- 2 Devices of medals claimed to have been won at exhibitions or claiming high distinction or words claiming the winning of such medals.

#### Ⓢ LABELS : DEVICES OF

A device of a label is considered non-distinctive. This applies especially when the goods concerned include bottled drinks. The following mark would be open to objection under Sections 9, 10 and 68 because labels similar to the one depicted are commonly found on the necks of wine or beer bottles.



#### Ⓢ LADY

In general the addition of **LADY** to a common female forename will be regarded as adding a degree of fancifulness; such marks (e.g **LADY FIONA**) may be acceptable in Part A, subject to a disclaimer of the forename. This applies equally to marks in Classes 3, 5, 25 and 42 where female forenames are primarily objectionable.

See **FORENAMES: FEMALE.**

#### Ⓢ LAND

See **WORLD.**

## ☉ LASER

This is a relatively common surname (eg 35 times in the Hamburg telephone directory) but its overwhelming meaning in this country is now that of a powerful light-emitting device (**L**ight **A**mplification by **S**timulated **E**mission of **R**adiation). It is therefore non-distinctive for goods incorporating or produced by **LASERS** or for services performed by **LASER** equipment and may give rise to a Section 11 objection. It is also frequently used to suggest speed, but there is no realistic objection on this ground.

On normal surname principles **LASER** is acceptable in Part A, being a surname occurring less than 100 in the relevant directories (Hamburg) and having another well-known meaning.

## ☉ LEDA

The practice in dealing with such marks is mixed but we have recently tended to put in Part B. As the word is close phonetically to the unregistrable word **LEADER** it is thought that Part B is appropriate when handling future applications. **LEDA** plus a descriptive element should also be accepted in Part B. Incidentally, **LEDER**, its phonetic equivalent means 'leather' in German.

## ☉ LETTERS: DISTINCTIVENESS

It is well established that traders commonly desire to use initial letters to identify their goods. Evidence of use is required to show that such marks have achieved a measure of distinctiveness in the marketplace.

To be regarded sufficiently distinctive to merit registration it must be shown that the letters qualify as an invented word. The test must be whether the public would take the letters as signifying a word. The question is not 'can these letters be pronounced as a word' but 'would these letters be taken as a word'. Pronounceability may be used to test whether sets of letters would really be taken as words to the public but pronounceability is not the only test. The amendment of a borderline mark to upper and lower case to read as a word increases the chances of them being taken as a word.

## ☉ LETTERS: FICTITIOUS

No objections are raised to marks which consist of or contain hieroglyphics purporting to be foreign characters but which upon examination are found to be fictitious and without meaning.

## ☉ LETTERS: NOT PRONOUNCEABLE

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 (**W & G Case - 1913 RPC 661**). Single letters after a mark applied for in Class 5 should be disclaimed as they are meaningful for goods in this class, ie vitamins C, D and E.

## ☉ LETTERS: PLUS ADDITIONAL FEATURES

When a letter or letters have some additional features added (other than borders or decorative features of 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 the letter(s) will need to be disclaimed. (**Ford-Werke AG Case - (1955 RPC 196)**). In each case the mark should be considered on its own merits. The main point to consider is the relative prominence of the letters in the mark.

## ⊗ LETTERS: PLUS NUMERALS

Letters and numerals are themselves non-distinctive but when used in combination they may be considered at least capable of distinguishing in Part B. Examples quoted are:

**NA22H or 22NH7**

Acceptable in Part B because the numeral (or letter) component is preceded and followed by letters or numerals. These are unusual combinations which are unlikely to be required by traders for references in catalogues and the like.

**CGP10 or KP140**

These marks are unacceptable because they are merely letters plus numerals in an ordinary combination. An argument that the last element is a letter 'O' would not be acceptable.

**KE10**

This could be seen either as a combination of letters and numerals (KE10) or as a word KEIO. In such cases a prima facie objection should be taken on the grounds that the mark is merely a non-distinctive combination of letters and numerals. To overcome such objections the mark may be presented as a word ie in upper and lower case (Keio).



The above mark has strong visual appeal and it was felt that acceptance in Part B was justified with separate disclaimers.

## ⊗ LETTERS: PHONETIC EQUIVALENT SPELLING OF

Marks which consist of the obvious phonetic equivalent, or of a mere spelling-out, of letters (eg ELLANDGEE) are not acceptable prima facie (the OGEE case 1916 RPC 117 refers). Word marks which consist of a spelling-out of initial letters with a phonetic equivalent of 'and Co' added are also not acceptable. The mark EANCO was refused because it was phonetically the same as 'E' and 'Co', the applicant's initials. The refusal was upheld by the Court on appeal (1920 RPC 134 refers).

In the EXXATE (1986 RPC 567) Case the High Court ordered registration in Part A despite the Registrar's objection that the word was merely the phonetic rendering of X8 and in the light of this the following guidelines have now been adopted. ➡

A phonetic objection should be raised only where there is no reasonable 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:

- 1 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.
- 2 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 Part B.
- 3 If there is no reasonable doubt that a word would be seen as a representation of letters eg **ELLANDGEE** – object under Sections 9 and 10.

Examiners should make themselves familiar with the Greek and Cyrillic alphabets and make suitable enquiries when foreign characters appear in a mark, for example, ‘**ϕOTOFORM**’ could be seen as ‘**IOTOFORM**’ but ‘**ϕ**’ in Greek represents PH. The Greek ‘**PHOTOFORM**’ aspect should not be overlooked.

### ⊗ **LETTERS: GROUPS OF FIVE OR MORE**

Such marks are acceptable in Part A unless the letters form a word meaningful for the goods/services.

### ⊗ **LETTERS: GROUPS OF FOUR**

If the four letters form an invented word which is clearly pronounceable (eg **TOCS**, **YOCA**) the mark will 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, prima facie.

### ⊗ **LETTERS: GROUPS OF THREE**

If a three letter mark is clearly pronounceable and likely to be pronounced as a word it may be accepted in Part A of the Register, assuming that its pronunciation as a word does not mean the mark is open to other objections.

Examples of marks acceptable in Part A:

**MEP, PIV, LIF, WAC, FAL, SYL, MEP, PIV, LIF, WAC, FAL, SYL, ODI, EAN, AZO, CEM, IMI, BOI, MIC, ARX, REI, NIX, OSA, EOS, LAT, BRI, DAF, SMI, CHO.**

A mark which is unlikely to be pronounced as a word is open to objections under Sections 9 and 10 as it consists of a non-distinctive letter combination. If it would otherwise be acceptable in Part A or B it could still proceed if presented in upper and lower case.

Examples of marks unacceptable prima facie in upper case;

**XYC, ITP, MLK, ATP, MCD, ATP, MCD, LTA, CMG, BFP, CCF, KTN, ICL, TDX, VME, PCM, CDX, SCM, IUC.**

Care should be taken if marks are represented in a way which highlights the fact that they are letters rather than words and in all cases if there is any doubt that a three letter mark will not be recognised as a word the examiner would be justified in raising objections under Sections 9 and 10. This would apply in the case of borderline marks such as **AIT** or **MEU**.

### ⊗ LETTERS: GROUPS OF THREE (WELL KNOWN)

Marks such as RAC, LEB, BOC, ICI and SAS are unlikely to be recognised as a word and are consequently open to objections under Sections 9 and 10. In cases where the marks are recognised as letters because of the applicants reputation then a modicum of evidence of use in the form of a statutory declaration will suffice to allow the applications to proceed ABA. In other cases where third parties apply to register well known letter marks, for example SAS, then the normal rules of evidence apply.

### ⊗ LETTERS: GROUPS OF THREE AND GROUPS OF TWO

If a two or three letter mark is clearly pronounceable and likely to be taken as a word, it may be accepted in Part A of the Register, assuming that its pronunciation as a word does not mean the mark is open to other objections. If a mark which would otherwise be acceptable in Part A is not likely to be pronounced as a word it may still proceed in an amended form; if presented in upper and lower case. Acceptance in such circumstances would then be in Part A or Part B depending on the merits of the mark.

### ⊗ LETTERS : GROUPS OF TWO

If a mark consists of two letters which are likely to be pronounced as a word then, as long as no other objections apply, it can be accepted in a Part B.

Examples of marks acceptable in Part B;

IM, CA, EF, TY, PO, OV, DE, EZ.

If pronunciation is difficult or doubtful objections should be raised under Sections 9 and 10 prima facie.

Examples of marks unacceptable prima facie;

ST, ZF, PD, BK, DT, FL, XL, PG, HR, XO, YR.

### ⊗ LETTERS: GROUPS OF TWO (WELL KNOWN)

Marks consisting of two letters which are pronounceable but are recognised as letters, for example BA (British Airways), FA (Football association), EG (For example) are open to objection under Sections 9 and 10 prima facie. In cases where the marks are recognised as letters because of the applicants reputation then a modicum of evidence of use in the form of a statutory declaration will suffice to achieve registration.

### ⊗ LETTERS: PUNCTUATION BETWEEN

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.), objections should be raised as the mark consists of mere 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:



### ⊗ LETTERS : SPACING OF

Excess spacing between letters which would otherwise be pronounceable creates the impression of letters rather than a word. Such marks would attract Section 9 and 10 objections as non-distinctive letters. Similarly if a mark is presented as letters, objections under Sections 9 and 10 will be appropriate even if the mark, as a totality, is pronounceable. For example:



### ⊗ LETTERS: ELISION OF THREE

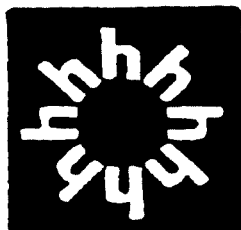
A mark consisting of an elision of three letters will usually be accepted in Part B unless it clearly has a device look about it or it is recognisable as a pronounceable word, which would allow it to qualify for Part A registration. For example:



The above mark was accepted in Part A.

### ⊗ LETTERS: NON-DISTINCTIVE: COMBINATIONS OF THE SAME LETTER

If presented in a distinctive way combinations of a letter which would itself normally be open to objection under Sections 9 and 10 may be accepted. A disclaimer of the letter should always be requested to ensure that rights exist only in the combination. An example of such a mark is shown below:



The disclaimer in this case was worded;

*Registration of this mark shall give no right to the exclusive use of the letter 'h'*

### ⊗ LETTERS: TWO GROUPS IN UPPER CASE, HYPHENATED

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.

<b>MARK</b>	<b>GOODS</b>	<b>DISCLAIM</b>	<b>COMMENTS</b>
XYZ-XYZ	any goods	letters XYZ	two groups of mere letters (Accept in Part B)
XYZ-ABC	any goods	separately letters XYZ and ABC	two groups of mere letters (Accept in Part B)
XYZ-PEN	pens	separately letters XYZ and the word PEN	mere non distinctive letters and the name of the goods (Object Sections 9 & 10)
XYZ-PEN	fencing		mere non distinctive letters and a reference to the goods (Object Sections 9 & 10)
POL-PEN	fencing		mark can be read as a word. (Accept in Part A)
XYZ-PEN	fertilizer	letters XYZ	no reference to goods, but the mark cannot be read as a word (Accept in Part B)
CAR-PET	carpets		combination is the goods (Object Sections 9 & 10)
SLO-GRO	plant growth inhibitors		combination has a direct reference to the goods (Object Sections 9 & 10)
LON-DON	any goods		combination has a geographi cal meaning (Object Sections 9 & 10)
MIL-TON	any goods		combination a common surname (Object Sections 9 & 10)
HIG-HAM	any goods		mark is close to a common surname but sound and look altered slightly (Accept in Part B)

In considering the degree 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

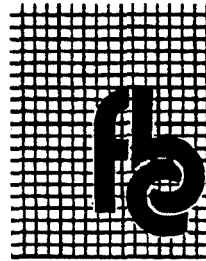
taking an objection under Section 11 should be borne in mind in appropriate cases as should the possible need for disclaimers for reasons other than mere letters and the effect of such a disclaimer on any acceptance in Part A.

## ⊕ LETTERS: MONOGRAMS

To qualify as a monogram the letters in a mark must be intertwined. The degree to which the marks are intertwined determines whether a mark is considered acceptable *prima facie* or open to objection in line with the guidelines stated for mere letter marks.

### 1 Monograms Made Up of Three or More Letters

Such marks are accepted as registrable in Part A if the letters are sufficiently intertwined. The mere placing of the letters one upon the other, without intertwining, does not necessarily produce a monogram. The following marks are examples of what is considered acceptable:



### 2 Monograms Made Up of Two Letters

Such marks are not regarded as sufficiently distinctive for registration (*prima facie*) under Section 9, but are considered to be acceptable for registration in Part B. For example:



## ⊕ LETTERS: SINGLE

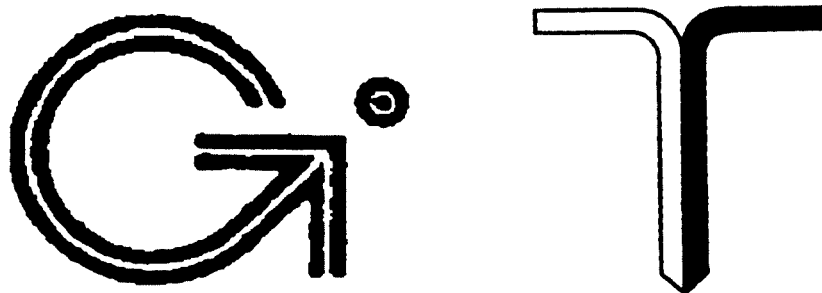
Marks consisting essentially of a single letter are not generally considered sufficiently distinctive to merit registration. If the overwhelming impression is that of a device, rather than a letter, marks can be accepted *prima facie* in Part A. In such cases a disclaimer of the letter is unnecessary.

These marks are acceptable in Part A.



Where the mark gives the impression of a letter but it is sufficiently stylised to be considered distinctive it may be acceptable in Part B on disclaimer of 'a letter'.

For example:



If a mark appears to consist of a letter represented in an existing font or it is too close to such a font, and it would be recognised as a mere letter written other than in plain type, it is open to objection under Sections 9 and 10 on the grounds that it is non-distinctive. Substantial evidence of use will be required before such marks are allowed to proceed to registration – even in Part B. For example:



## ⊙ LETTERS: SOURCES OF REFERENCE

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 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.

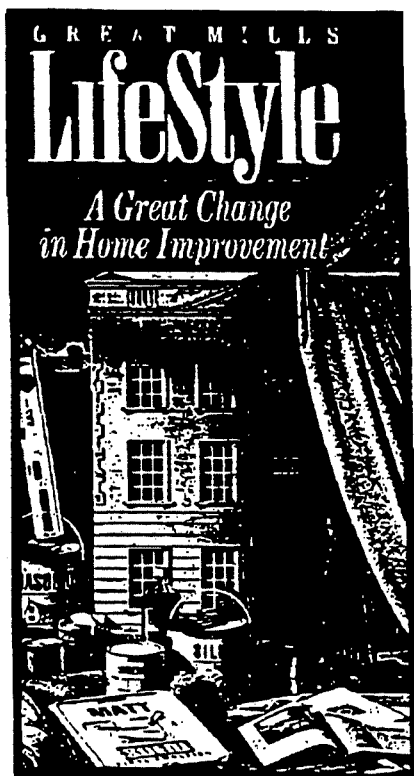
## ⊙ LIFESTYLE

In view of the increasing popularity of the word **LIFESTYLE** in advertisements, newspaper articles, radio and media generally, it is now appropriate to introduce a practice in relation to its use as a trade mark. Two examples of recent use follow this entry.

Object under Section 9 and 10 to **LIFESTYLE** if used in relation to such goods and services as cars, domestic furniture, clothing, food, spectacles, housing, insurance in general, travel agency services and provision of leisure facilities: in other words, items which relate to 'lifestyle' in the general sense of the word.

Objections are not necessary in relation to such goods and services as motor vehicle lubricating oil, computers (but not including those adapted for the control of home environments), rental of bulldozers, and goods and services associated with office furniture.

Health screening services may be accepted in Part B.



**MERPHISIO**  
SHOES CREATED FOR  
TODAYS  
LIFESTYLES



## ☉ LIGHT/LITE

A Section 11 objection should be raised if either of these words appear in a mark applied for in respect of cigarettes, unless the specification of goods is limited to cigarettes having yields of not more than 0.8mg nicotine and 10mg of tar per cigarette, or a condition along the following lines is agreed to:

*It is a condition of registration that the mark shall (\*when in use in relation to cigarettes) be used in relation only to cigarettes yielding not more than 0.8mg nicotine and 10mg tar per cigarette.*

\*this insertion to be used for specifications wider than just cigarettes.

**Note** This meaning of the word light (lite) does not apply to tobacco, 'tobacco products' (other than cigarettes) or cigars. It cannot be applied to 'smokers' articles' either as this term does not cover cigarettes.

This term is descriptive of and non-distinctive for food products low in calories, low in fat, light in colour etc. Because it has so many meanings no Section 11 objection need be raised in respect of food or drink but a disclaimer is usually required.

## ☉ LINE BORDER

If a 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 requested in respect of any mark consisting of multi-panelled labels or a repetitive pattern which could be applied to goods as a mere decoration.

A strong line border separate from the mark is required. If an acceptable line border is not present marks may be open to objection under Section 68 as they consist of mere decorative matter, not recognisable as a trade mark.

## ☉ LINK: GENERAL

Marks consisting of the word **LINK** or a phonetic equivalent are the subject of many trade mark applications. A survey conducted in 1990 showed over 600 marks on the Registry database and it is apparent that practice has varied in the past due to a lack of recognised guidelines. In future **LINK** marks should be treated as follows:

### ☉ LINK: ALONE

If **LINK** describes a characteristic of the goods or services, object under Sections 9 and 10 e.g. for telephones or telecommunication services, computers, software and associated services or for transportation services.

'Links' is used generically in relation to golf courses so **LINK** would not be acceptable for services associated with golf.

If the connection is less obvious offer Part B e.g. for trucks, industrial design, marketing or employment agencies.

If there appears to be no connection with the goods/services accept in Part A e.g. for tea, coffee, cafe services or restaurant services.

## 🌐 LINK: AS A PREFIX OR SUFFIX

If **LINK** alone would be considered open to objection for the goods/services in question the following would apply:

### 1 **LINK** + Word acceptable for the goods/services:

Accept in Part A e.g.

**WOARTLINK** for air transport

**LINKSHARN** for telephones and telecommunications

### 2 **LINK** + Word which has an indirect reference to the nature of the goods/services:

Accept in Part B e.g.

**SISLINK** for telecommunications

### 3 **LINK** + Word descriptive of the goods/services:

Object under Sections 9 and 10 e.g.

**CITYLINK** for intercity bus or train services

Particular care is needed in relation to computers, software and some other goods in Class 9 for which **LINK** is very descriptive e.g.

**SMARTLINK** for 'terminal emulation and file transfer computer programs' was refused because it was considered descriptive of a 'clever (intelligent) or quick connector'.

**WORLDBLINK** for 'computer programs' was refused because it 'is likely to convey immediately to the public its facility of linking separate geographic locations' by means of computer messages which are sent around the world in seconds.

## 🌐 LINK: PHONETIC EQUIVALENTS

**LINC(S)** should be treated as **LINK(S)** marks unless, in combination, the phonetic equivalent has a different connotation. If the phonetic equivalent has a well known alternative meaning e.g. **LYNX** the other meaning will overshadow the objectionable meaning and such marks have been accepted in Part A (for transportation services). When computer software or associated services are involved Part B would be more appropriate.

## 🌐 LINK: CONSIDERATION UNDER SECTION 12

The word **LINK** has become fashionable, particularly in Classes 9,36 and 42 in the fast developing computer and financial services sectors. In these areas the monopoly should be narrowed as much as possible to permit the maximum number of Registrations. For the purposes of Section 12, as distinct from Sections 9 and 10, **LYNX** would be recognised as the phonetic equivalent of **LINKS** and consequently raised as a citation where necessary.

Where the clash is between **LINK** (or **LINC**) and another mark (or vice versa) with additional elements proceed as follows: ➡

- 1 Where **LINK** is non-distinctive under the criteria proposed above but is presented with another distinctive element (whether as a single or combined word) do not cite. For example **LINK** should not be cited against **LINK EAGLE** or **EAGLE LINK** if the goods or services clashed.
- 2 Where **LINK** is non-distinctive and the additional element is also non-distinctive, for example when **LINKMOTOR** is compared with **LINKLUBRICATION**, **LINKPLUS** or **LINKEURO** the citation would be fatal.
- 3 Where **LINK** is distinctive and the additional element is also distinctive and introduces a new idea it is not necessary to raise a citation, for example **LINKPUSH** would not be cited against **TWIRLYLINK** or **NEGATELINK**. In general the likelihood of confusion is less where **LINK** is a suffix.

See also **EQUITY: USE OF** and **FAMILY OF MARKS**

### ⊗ **LIPPINCOTTS GAZETTEER**

This was used for many years as the main source of reference for geographical names. However, because the last available edition was printed in 1962 it was decided in May 1989 to switch the official source of reference to Websters New Geographic Dictionary and Chambers World Gazetteer. Examiners should bear in mind that Lippincotts may be consulted in appropriate cases.

### ⊗ **LOGY**

See **OLGY**

### ⊗ **LOW**

This may refer to low-nicotine or low-tar cigarettes. Therefore this word has a dual meaning when appearing in marks for cigarettes. No Section 11 objection can be raised but the word should be disclaimed. If **LOW** is combined with tar (**LOW-TAR**) then a Section 11 objection should be raised in respect of cigarettes yielding not more than 10mg of tar per cigarette. **LOW-NICOTINE** has no defined meaning and cannot therefore be the subject of a Section 11 objection.

### ⊗ **LOW ALCOHOL DRINKS**

Given the similarities (colour, taste, packaging, points of sale) between de alcoholised beer, low alcoholic beer and alcoholic beer these products must be regarded as goods of the same description. All low alcohol products are consequently treated as being goods of the same description as their alcoholic equivalent e.g. beer, wine or lager.

As beer and wine are regarded as being goods of the same description as spirits and liqueurs, low alcoholic beer and wine should also be regarded as goods of the same description as spirits and liqueurs.

See also **NON-ALCOHOLIC DRINKS**

### ⊗ **LUX**

This is defined as a unit of light. It is not normally objected to because of this, the only instance would be if the item has some control over the amount of light being emitted.

# M

## Ⓜ MACHINES

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 accepted in Part B subject to a suitable disclaimer.

## Ⓜ MAESTRO

An Italian word meaning 'master'. When used in English it generally connotes 'genius', 'highly qualified' or 'highly experienced', often in the sphere of music. It is acceptable in Part B for most goods, but not for music recordings, books about music, musical performances or entertainment.

## Ⓜ MAGI

This was previously considered too close to **MAGIC** but this is now thought too far fetched and is not a grounds for objection. It is, however, an Italian surname which is acceptable for 'local' services but may be open to objection for goods exported to and marketed in the UK.

## Ⓜ MAGIC

Colloquially, means 'brilliant', 'excellent', 'super'.

**MAGIC** alone – object Section 9 and 10

**MAGIC** plus goods – object Section 9 and 10

**MAGIC** plus distinctive element  
eg **MAGIC DRAGON** for bicycles – accept part A but disclaim 'Magic'.

Following another word, even a descriptive word, it may often be acceptable in Part B because it then has less of a laudatory connotation. In particular cases separate disclaimers may be necessary. The following have been accepted in Part B:

**MIRROR MAGIC** for mirrors, etc

**ANIMAL MAGIC** for printed matter

**BEDROOM MAGIC** for bedrooms

**MILK MAGIC** for milk feeding apparatus

## Ⓜ MAGNA

Previously accepted only in Part B because of its connotations of large size. Current thinking is that it should now be accepted in Part A, either on its own or when combined with a descriptive element eg **MAGNABLOX** for building blocks.

## MANOR

This is non-distinctive for accommodation services, including nursing home services.

## MAPLE LEAF

Marks consisting solely of the words **MAPLE LEAF** or the device of a maple leaf are not acceptable. Marks incorporating the words **MAPLE LEAF** or the device of a maple leaf which are acceptable as a totality, may proceed if the following requirements are met:

- 1 the applicant agrees to disclaim the words **MAPLE LEAF** and/or the device of a maple leaf (as appropriate);
- 2 a condition to use the mark in relation only to goods the produce of Canada is imposed, if Canada has a reputation for the goods/service concerned;
- 3 consent to use the words **MAPLE LEAF** or the device of a maple leaf is obtained from the Director, Ceremonial and Protocol, Department of the Secretary of State of Canada, Ottawa, Ontario, Canada, K1A 0M5.

## MASTER: GENERAL

In view of a decision made by the Secretary of State in the case of **THE MASTER** for Class 33 goods, the practice relating to **MASTER** marks has been reviewed.

**MASTER** has, in the past, been recognised as having a laudatory meaning and the **BUSMASTER** case (1953 RPC 141) and the **EARTHMASTER** case (1956 RPC 73) outlined the practice to be adopted. Since these cases were reported use of the word **MASTER** in a laudatory sense, i.e. to suggest goods of a superior nature, has become less popular. Dictionary references to **MASTER** now concentrate on the significance when used in relation to people i.e. (according to Collins Dictionary) 'a person with exceptional skill at a certain thing', for example, **MASTER BUILDER**, **MASTER CRAFTSMAN**, **MASTER CROOK**. **MASTER** is consequently much more likely to be meaningful in relation to services than to goods.

An alternative meaning given for **MASTER** is 'a machine or device that operates to control a similar one' (Collins Dictionary). **MASTER** is consequently particularly meaningful when applied to goods with a control function, for example remote control apparatus for music centres or toy planes.

In summary the practice to be adopted in future is:

### 1 MASTER ALONE: GOODS AND SERVICES:

Acceptable in Part B, prima facie, when applied to goods such as whisky (**THE MASTER** Application No. 1337634 refers) or services provided by 'professional' people such as solicitors, accountants etc. Object under Sections 9 and 10 for goods with a control function or for services provided by artisans.

### 2 MASTER COMBINED WITH WORDS DESCRIPTIVE OF THE GOODS, WHEN APPLIED TO GOODS WITH A CONTROL FUNCTION:

Object under Sections 9 and 10.

For example, **MASTERTELEVISION** or **TELEVISIONMASTER** applied to apparatus for the remote control of television sets. ➡

3 **MASTER COMBINED WITH WORDS DESCRIPTIVE OF THE GOODS, WHEN APPLIED TO GOODS WITHOUT A CONTROL FUNCTION:**

Accept in Part B, prima facie.

For example, **MASTERBUS** or **BUSMASTER** applied to buses.

4 **MASTER COMBINED WITH WORDS TO FORM A LESS MEANINGFUL DESCRIPTION OF THE GOODS:**

Accept in Part A if no sensible objection can be raised.

For example, **SWINGMASTER** for golf clubs, **SHIFTMASTER** for excavating machines, **SLEEP-MASTER** for beds, **MASTERGUARD** for cleaning preparations, **MASTERPLAN** for cosmetics, **MASTERFLOW** for concrete mixes, **MASTERFOLD** for paper napkins and **MASTERFLAME** for heating and cooking apparatus.

5 **MASTER COMBINED WITH WORDS DESCRIPTIVE OF A NATURE OF A SERVICE PROVIDED BY ARTISANS:**

Object under Sections 9 and 10.

For example, **MASTER REPAIRERS** or **REPAIRMASTER** for shoe repairs, **MASTER CLEANERS** or **CLEANMASTER** for cleaning and **MASTER PRINTERS** or **PRINTMASTER** for printing.

6 **MASTER COMBINED WITH WORDS LESS DESCRIPTIVE OF A NATURE OF A SERVICE PROVIDED BY ARTISANS:**

Accept in Part B, prima facie.

For example, **MASTERPOINT** for building services, **MASTERHEAT** for plumbing services and **OFFICEMASTER** for cleaning services.

7 **MASTER COMBINED WITH WORDS LESS DESCRIPTIVE OF A NATURE OF A SERVICE PROVIDED BY 'PROFESSIONALS':**

Accept in Part A, prima facie.

For example, **MASTERCOURT** for law practices, **MONEYMASTER** for accountants and **PULLMASTER** for dentists.

🌐 **MASTER: CONSIDERATION OF EVIDENCE OF USE**

Evidence of factual distinctiveness through use will assist to obtain a Part B registration or upgrading to a Part A registration in most cases but care must be taken to detect unregistrable combinations such as **MASTER BUILDERS**, **MASTER BAKERS** or **MASTER CRAFTSMEN** in respect of relevant goods and services.

🌐 **MATE**

When combined with a word which is meaningful for the goods, the practice previously was to accept in Part B only. The following are examples of marks accepted in Part B; ➡

- CHISEL MATE** - chisel-sharpening apparatus
- DRAIN MATE** - cleaning preparations for drains
- GROW MATE** - foodstuffs for animals
- BRUSH MATE** - anti-hardening chemicals for paint brushes

In conjunction with a word having only an oblique reference to goods, or to their effect, it was accepted in Part A, For example:

- COOL MATE** - cosmetics, after-shave, etc

Now all such marks can be accepted in Part A unless the goods are adapted to 'mate', ie join together, with something or to join other things together (eg adhesives).

### ⊗ **MATIC**

This is not recognised as an abbreviation for **AUTOMATIC** so there is no Section 11 objection and it is not a non-distinctive suffix within the context of Sections 9 and 10.

### ⊗ **MATURE: APPLIED TO CHEESE**

When this word appears in a mark for cheese no Section 11 objection should be taken as no clear definition as to what constitutes **MATURE** cheese exists. This word should, however, be disclaimed.

### ⊗ **MAXI**

A mark consisting of the prefix **MAXI** (meaning large, great or much) together with a word which is meaningful for the goods/services concerned is open to objection. The word has a wider signification than **MINI** in that it connotes not only size but also a high degree of something.

See also **MINI**

The following examples are intended as guidance:

- 1 **MAXI** and name of goods/services: object under Sections 9 and 10.  
eg **MAXICHIPS**: descriptive of large potato chips or **MAXI INSURANCE**: descriptive of a high degree of insurance.
- 2 **MAXI** and word descriptive of a quality or function of the goods/services: object under Sections 9 and 10.  
eg **MAXICOVER**: for paint: descriptive of paint that gives wide coverage or **MAXICOVER**: for insurance: descriptive of a high level of cover under an insurance policy.
- 3 A mark that is less directly descriptive of the goods/services ie terms not commonly used: accept in Part B  
eg **MAXICRUISE** or **MAXIZOO**
- 4 Where concept of size or degree is not relevant: accept in Part A  
eg **MAXISAND** for sand

## ● MEDALS

Devices of **MEDALS** or awards on the labels of bottles should either be removed or justified. Confirmation by letter from an agent is sufficient. There is no need to request a Statutory Declaration.

## ● MEDI

In the light of the decision by Mr Justice Goulding given on 21 November 1983 in the **MEDICALL** case, it is now considered that the use of **MEDI** as a prefix meaning **MEDICAL** has been established. Consequently prima facie objections should now be taken to any application consisting of **MEDI** plus a descriptive non-distinctive word, when the mark is to be used in a medical context.

## ● MEGA

Meaning 'large', has laudatory connotations in addition to inferences of size. **MEGA** alone or **MEGA** plus the goods should in future be subject to objections under Sections 9 and 10. **MEGA** plus a characteristic of the goods should be accepted in Part B.

## ● MEL

A pharmaceutical term meaning 'honey'. If presented in combination to form an invented word, it is acceptable in Part A. If presented in combination with a descriptive word, or descriptive prefix/suffix, accept in Part B

## ● MELLOW

This is non-distinctive when it appears in a mark for cigarettes and it should be disclaimed in these instances. No objection under Section 11 is appropriate.

## ● MICRO

It was past practice to disclaim the word **MICRO** where it appeared as a separate element in marks in the food classes. In some instances objections under Section 11 were also raised.

In October 1989 it was decided that the word **MICRO**, when used in relation to food, was so obviously non-distinctive that it need no longer be disclaimed in the prima facie case. Examiners will wish to note that Collins Dictionary (Second Edition) defines **MICRO** as, inter alia, 'short for microwave oven'. Section 11 objections should not be raised. Although there are undoubtedly some ready meals which are specially packaged etc for cooking in microwave ovens, most food can in fact be cooked using them.

**MICRO** is also an abbreviation for 'microcomputer' and is thus non-distinctive for small computers. (Collins English Dictionary)

## ● MILD: APPLIED TO TOBACCO

According to Voges Tobacco Encyclopedia, this is a subjective concept which has no definite meaning in relation to marks in Class 34. A Section 11 objection is not appropriate but the word should be disclaimed in this Class.

## Ⓜ MILD: APPLIED TO CHEESE

When this word appears in a mark in respect of cheese no Section 11 objection should be taken as no clear definition as to what constitutes **MILD** cheese exists. This word should however be disclaimed.

## Ⓜ MINERAL WATER: RIGHTS OF EXTRACTION

See **NATURAL SPRINGS: OWNERSHIP OF**

## Ⓜ MINI

It is practice to object to marks consisting of the prefix **MINI** (indicating something small) when combined with the name of the goods/services or of some feature of the goods/services. A source of reference is **MINIGROOVE** (1955 RPC 183) which was refused registration in respect of long playing gramophone records (ie records having smaller grooves than the short playing type).

The following examples are intended as guidance:

- 1 **MINI** + word directly descriptive of the goods/services – object under Sections 9 and 10

**MINILIFT** directly descriptive of installing and repairing small lifts such as those for transporting the disabled up a flight of stairs in their own home.

**MINICRUISE** directly descriptive of short term or otherwise limited cruises.

**MINIBUS/MINICAB** directly descriptive of bus and taxi services utilising the generic minibuses and small saloon cars.

- 2 **MINI** + word with indirect reference to the goods/services – Offer part B

**MINISWEEP**: chimney sweeping.

**MINIGUARD**: security services.

## Ⓜ MIS-SPELLING OF WORDS

Marks which consists of mis-spellings of known words or which differ from known words only to a trifling extent are not held to be invented and must be considered as though they consist in fact of those known words (the **SCOTCHLITE** Case, 1948 RPC page 234, lines 9 to 27 refers). **BORAXE** would, for example, be considered as though it consisted of the known word 'borax' and should be objected to as having direct reference to the character or quality of goods if the latter consists of borax, borax compounds or derivatives of borax. The word **FYNPOWDA** would be considered as though it were in fact the words 'fine powder' of which it is an obvious mis-spelling. In such examples where a mark is open to objection because of its descriptiveness in relation to the goods, an objection will generally arise under Section 11 if the propounded specification does not contain an appropriate restriction.

See also **INVENTED WORDS**

## Ⓜ MIST

A Section 11 objection should be raised for goods in Classes 1 to 5 if not limited to sprays. This can be overcome by an appropriate limitation.

## Ⓜ MISTER

See **TITLES**

## Ⓜ MONO

The acceptability of a mark incorporating the prefix **MONO** (meaning 'one' or 'single' – Collins English Dictionary) will depend on whether the word with which it is combined has a direct reference to the goods/services concerned. The following guidelines should be followed;

- 1 **MONO** alone – Generally acceptable in Part A, except where it has by common usage become an adjective in its own right, eg **MONO** has come to mean 'monochrome in relation to TV sets/VDU's and 'monophonic' in relation to music producing equipment.
- 2 **MONO** + name of the goods/services– Acceptable in Part A, eg. **MONOBIT** for drill bits, or **MONOCLEAN** for cleaning services ('one clean' has no obvious meaning).
- 3 **MONO** + word with no direct reference to goods/services– Acceptable in Part A, eg. **MONOFIX** for tools.
- 4 **MONO** + word suggesting a characteristic of the goods/services– If the combination is unlikely to be used in a descriptive way in everyday speech the mark can be accepted in Part B, eg. **MONOGRIP** for tools.
- 5 **MONO** + word with direct meaningfulness for goods/services– object under Sections 9 and 10, eg. **MONORAIL** for rail services.

## Ⓜ MOSELTALER

The officially approved name for a white wine produced in a specified region of Germany (Mosel-Saar-Ruwer).

## Ⓜ MOUNTAINS

See **GEOGRAPHICAL NAMES.**

## Ⓜ MR

See **TITLES.**

## Ⓜ MULTI

In the **MULTILIGHT** Case (1978 RPC 601) it was held that **MULTILIGHT** was unregistrable for light fittings which comprised two or more lights. A mark consisting of the word **MULTI** (meaning 'one, many or much' – Collins English Dictionary) plus a descriptive element will consequently be open to objection.

The following examples are open to objection under Sections 9 and 10:

- 1 Where the goods/services comprise a plurality of features, as opposed to one, eg **MULTILIGHT** light fittings; **MULTIPOCKET** hold-alls; **MULTICARB** engines; **MULTIBLADE** razors; **MULTILENS** cameras or **MULTIINSURANCE** for policies including different types of insurance. ➡

- 2 Where the goods/services serve more than one purpose, eg **MULTIFABRIC** cleaners or dyes; **MULTI-BLADE** sharpening devices, for more than one type of blade; or **MULTICHOICE** pension services for schemes offering alternative benefits.
- 3 Where the goods/services perform more than one action at a time, eg **MULTIPUNCH** hole-punchers; **MULTISTITCH** paper-stitching machines or **MULTIMARKET** for market research in many markets.

The following examples are marks where the added element is less clearly descriptive, such marks can be accepted in Part B:

<b>MULTICLENS</b>	cleaning services
<b>MULTIWIPE</b>	cleaning materials
<b>MULTISUIT</b>	dry cleaning service
<b>MULTISTITCH</b>	textile repair
<b>MULTIWORK</b>	work study service

On its own or combined with the name of the goods/services **MULTI** may well be acceptable in Part A eg **MULTIPENSION** pension services would be acceptable but **MULTICHOICE** pension services would be open to objection. Similarly, **MULTICABLES** for cables would be acceptable but **MULTICORE** for cables would be open to objection.

## SECTION 11

An objection under Section 11 may be appropriate, eg **MULTI** for stitching (stapling) machines could be deceptive if the machines were not capable of performing more than one stitching (stapling) action at a time.

## 🎵 MUSIC GROUP CONDITIONS

Where an examiner recognises a mark applied for as the name of a music group it has been Registry practice to raise a Section 11 objection, which was normally overcome by agreement to a condition of registration. The condition was to ensure that the mark would only be used in relation to music performed or written by members of the group concerned. In future this will not be necessary because the view is now taken that there is very little likelihood of deception and confusion arising in relation to the use of such marks.

It is still important to ensure that the applicant does in fact own the mark applied for. In any case where doubt arises, for example if the name of the company applying for the mark differs from the name of the group, evidence to clarify the question of ownership should be sought.

## 🗨️ MUST

Meaning 'to indicate necessity' (Collins English Dictionary) is regarded as non-distinctive because it is used in the context of, for example, 'this product is a must!'

# N

## Ⓢ NAPOLEON

This is not a generic term for a specific grade of cognac. It is however recognised as indicating quality and should be disclaimed if it appears in a mark for these goods.

## Ⓢ NATIONAL FLAGS

See **FLAGS**.

## Ⓢ NATURAL: PARTICULARLY IN CLASS 3

Where the mark contains a clear reference to **NATURAL**, such word(s) should be disclaimed and the specification limited to natural products (eg **APPLEWOODS NATURALS**). Where the reference is only an oblique one (eg **NATURES SECRETS**) there is no need for disclaimer or limitation.

Marks have been accepted in the food classes which have included the word **NATURAL**. A Section 11 objection has not been considered appropriate for such goods because most foods are, in fact natural. Examiners should have regard to usage of the word and it is possible that eventually it will come to mean foods that are derived from 'natural' nutrients. If this happens Section 11 objections will be justified.

## Ⓢ NATURAL PRODUCE

This term generally includes agricultural and horticultural products; certain forestry products e.g. trees; live animals and birds; tobacco (whether raw or manufactured); natural mineral water and natural aerated water.

Beer, although not strictly **NATURAL PRODUCE** should be treated as such. This is because the Registrar is aware that beer is often produced in small locations, for example **MARSHAM**, to take advantage of local water supplies. Beer is however treated slightly differently to natural produce in that evidence of use may allow registration provided no other brewer is using the same location i.e. 'de minimus' does not apply.

See also **GEOGRAPHICAL NAMES: NATURAL PRODUCE**

Whisky or whisky based liqueurs are not **NATURAL PRODUCE** but they must be given the same consideration as if they were with regard to geographical locations in Scotland and Ireland. This is because the Registrar is aware that many whisky distilleries in Scotland and Ireland are intentionally placed in small locations to take advantage of local water supplies untainted by chemicals etc. (Whisky flavour and brand distinctiveness depends, to some extent, on the water used.) Therefore, applications in Class 33 which are for geographical names may be accepted in Part B if they fall within the de minimus rules and do not include 'whisky' or 'whisky-based liqueurs'. (Note 'Spirits' and 'Alcoholic beverages included in Class 33' will, of course, include whisky.) If an application does include whisky or whisky-based liqueurs it may be possible to allow the application to proceed in Part B provided the applicants can show evidence of use and can demonstrate that they are the only manufacturers of the product in that location.

**NATURAL SPRINGS** Section 9, 10 and 11 objections should be raised in respect of the name of places where springs are known to exist. The 9 and 10 objections may be overcome if the proprietors provide

evidence to show that they have exclusive rights to sell the water from that particular place. The following ('Evian') condition is also required:

*It is a condition of registration that in the event of the proprietors of this mark ceasing to have the exclusive right to sell natural mineral water the produce of ..... they will voluntarily cancel this registration.*

To overcome the Section 11 objection a further condition can be used, as follows:

*It is a condition of registration that the mark shall be used in relation only to natural mineral waters the produce of the springs of.....*

If the specification covers a wider range of goods than water, it may be necessary to continue the above condition to ensure that it relates to all the goods concerned. An example of such a continuation is given below:

*.....and in relation only to non-alcoholic beverages and preparations for making such beverages containing natural mineral waters the produce of the springs of..*

#### Ⓢ NATWEST

Previously objected to on the grounds that it was an individual's name; Nat (Nathaniel) West. Current practice is to accept in Part A without any disclaimer.

#### Ⓢ NEED

This is now considered non-distinctive and open to objection under Sections 9 and 10 as it may be used in advertisements e.g. 'YOU NEED our goods/services because .....'.

#### Ⓢ NEW

Current opinion is that the word is now on a par with **SUPER**, **BEST** etc and is unregistrable. If it appears in a mark which is otherwise distinctive a disclaimer of **NEW** will not be required in future.

#### Ⓢ NEWSPAPERS

See **FREE NEWSPAPERS**.

#### Ⓢ NEXT

For services object under Sections 9 and 10, prima facie, on the grounds that it is non-distinctive. Service providers should be free to use this word in the course of advertising their services, for example 'For your **NEXT** car service come to **CWMBRAN FORD**'.

#### Ⓢ NON-ALCOHOLIC DRINKS

This term defines beverages containing not more than 1.2% (by volume) of alcohol (as from 27 April 1987 - prior to this the limit was 2%) and therefore includes such goods as alcohol free beer and alcohol free wine and cider. Beer is always classified in Class 32 regardless of type or alcoholic content.

## ⊗ NON-MEDICATED CONFECTIONERY

This term includes sweetmeats, cakes, biscuits, pastries etc and even ice cream. English dictionaries (eg Collins, Chambers, Shorter Oxford) make it plain that the term 'confectionery' relates to sweet things rather than savoury ones, and it would seem that when used in connection with goods sold in confectioner's shops the term would cover only sweet things sold in confectioner's shops, and not for example, bread or meat and savoury pies/pastries. It seems that in some instances the term 'non-medicated confectionery' has been held to cover most things sold in confectioner's or baker's shops. As this is not capable of being substantiated by reference to the dictionary meanings for the word it should be noted that such a broad view is not correct.

**Note** Although 'non-medicated confectionery' does not include savoury foods, these would in many cases be goods of the same description. Particular care therefore needs to be taken when considering possible conflict between, for example, specifications incorporating non-medicated confectionery (which covers cakes, pastries, sweet biscuits etc) and for other bakery products such as savoury pies and savoury or cheese biscuits. (the SOG 1336419 for the mark **PUFFLES** refers).

## ⊗ NON - TRADE MARK MATTER

Matter which falls into the categories set out below should normally be removed from the mark so that the essential features of the mark are apparent. Each case must however, be considered on its own merits:

- 1 indications of the price of goods/services or nett weight, ingredients etc of goods.
- 2 printer's markings or printer's or artist's name and addresses.
- 3 directions as to the use of the goods.
- 4 the name, address or telephone number of the applicant.
- 5 the times or dates when services are available.

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

See also **LABELS**

## ⊗ NOVA

Italian for 'new'. This word is usually accepted Part B in view of its other possible meanings (Bright Star).

## ⊗ NOW

This has been accepted for registration in the past but is now considered a non-distinctive word used in advertising and is consequently open to objection under Sections 9 and 10 e.g. 'BUY NOW, while stocks last'.

## ⊗ NUMERALS

When applied to goods, marks which consist simply of numerals or their equivalent expressed in words are not acceptable, prima facie, in either Part A or Part B. Such marks are considered non-distinctive because they are frequently used to indicate model numbers, catalogue reference numbers etc. ➡

When used in relation to services some numerals may be considered prima facie distinctive; the objection to these in relation to goods (commonly used as type or catalogue references) does not generally apply. Care must be taken to avoid the prima facie registration of numerals others might be expected to require for use in the normal promotion of their services, for example, it is common for those offering services to advertise a 24 hour service; No 1 has a laudatory signification; 2000 suggestive of the 21st Century or 1992, the single European market, should be regarded as non-distinctive. In the case of the numeral 2000 current practice is not to require a disclaimer because it is recognised as being very non-distinctive.

The number 112 is the standard European Community telephone number for contacting the emergency services. It is now available, in parallel with the UK's traditional 999 for emergency calls in the UK. Marks consisting of or containing the number 112, or the words **ONE ONE TWO**, should be considered on their merits, depending on the nature of the goods/services.

#### ● NUMERALS: 100s

This is used in relation to cigarettes and appears to have two meanings; either indicating a cigarette-length of 100mm or indicating packets of 10 cigarettes. With this dual meaning, no Section 11 objection need be raised. It is however necessary to disclaim 'the numeral and letters 100s'.

# O

## Ⓢ OFFENSIVE DESIGNS

Objection should 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. In current practice, no objection is raised to inexplicit outline drawings or photographs of nude figures; objection should be raised against explicit full frontal nudes and offensive (scandalous) back views.

## Ⓢ OLD

If **OLD** appears in a mark for Spirits or other alcoholic drinks (eg. old Scotch whisky) it is not necessary to raise an objection under Section 11 as 'old' would be difficult to define.

## Ⓢ OLOGY OR -LOGY

A suffix meaning 'the study of ...' or 'the science of...'. It is therefore descriptive/non-distinctive when combined with a word which relates to the goods and objections should be raised under Sections 9 and 10 where it creates a sensible word. Where the word is fanciful (eg **TEDDYOLOGY** for a range of toy bears) it may be accepted in Part A.

## Ⓢ OLYMPIC SYMBOL (AND WORD): GENERAL

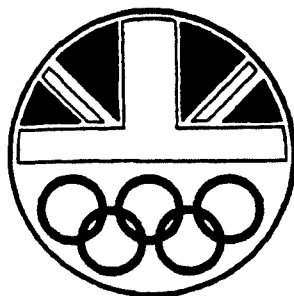
Since 1996 is an Olympic year there may be additional interest in seeking to register the Olympic symbol or the word **OLYMPIC** as a mark or as part of a mark. A Section 68 objection should normally be raised against any such mark unless the application is under Section 29(1)(b), ie for use by a body which is genuinely going to trade in goods. Although the International Olympic Committee is not a trading organisation many local organisers of Olympic Games do trade in connection with fund raising activities.

## Ⓢ OLYMPIC SYMBOL

At the present time any trader or manufacturer may use the Olympic Symbol without the permission of either the International Olympic Committee (IOC) or the British Olympic Association (BOA), providing they do not allege any connection with, or endorsement of their goods by either organisation. There is, in particular, no control on the use of the Olympic Symbol on T-shirts, pens, pencils, postcards or other souvenirs. There may be a particular demand in an Olympic year for use of the symbol as an embellishment in advertisements.

The option of registering a trade mark which incorporates the Olympic Symbol is, of course, open to the IOC or BOA in this Country. Such marks may be accepted prima facie, without a disclaimer of the Olympic Symbol, provided the device as a whole is distinctive and the symbol is not the dominant feature of it.

An example of such a trade mark which has been accepted for registration is shown below;



The U.K. Trade Marks Registry takes the view that the Olympic Symbol alone is, prima facie, non-distinctive for all goods at all times, the symbol as part of a device mark adopted the National Olympic Association may be acceptable providing the device as a whole is distinctive and the symbol is not the dominant feature appearing in that device.

The Moscow and Seoul Olympic organising committees have also registered device marks which incorporate Olympic symbols, as have other companies which do not appear to have any direct association with the Olympic Games. The British Olympic Committee does not have a Statutory monopoly in the use of the Olympic Symbol in the U.K.

### ● OLYMPIC : WORD

The word OLYMPIC is, prima facie, open to objection under Sections 9, 10 and 11 at all times for any goods connected with the Olympic Games or which may be thought by the public to be connected with the Olympic Games. (The word may also be open to objection for goods not associated with the Olympic Games on account of its geographical significance).

### ● OPEN

This is now meaningful in relation to computer services. OPEN is a term used to describe a type of computer system and Section 9 and 10 objections should be taken against marks containing this term if the mark as a whole is descriptive, for example OPEN SOLUTIONS (services that provide remedies for the customer's open system problems). In cases where a distinctive element is also present OPEN can be disclaimed.

### ● OPTIMA

This is the plural form of OPTIMUM and it is descriptive of, and non-distinctive for, goods/services which are the best or most favourable. Although it has laudatory connotations it is not a word in common use and is consequently considered acceptable in Part B. An example is the mark OPTIMA for golf clubs which was registered in Part B, the Section objection being that the word is descriptive of clubs adapted to enable the golfer to produce the best possible shot.

### ● OPTIMUM

This word has laudatory connotations ('most favourable or advantageous; best' Collins English Dictionary) and is a word in everyday use. It is subject to Sections 9 and 10 objections for all goods/services.

### ● ORIGINAL(S)

Objection under sections 9 and 10 will be justified for most goods and possibly some services. Clearly it would not be acceptable for food processing or air transport.

# P

## Ⓢ PACIFIC

See ATLANTIC

## Ⓢ PACK, PAC, PAK

Descriptive of, and non-distinctive for, packaging materials, equipment or services, and for goods sold in packs or packages, both in the physical sense (packs of screws, stationery) and the metaphorical sense (software packages). PAC is also an abbreviation for Personal Advanced Computer.

A mark consisting of a surname/geographical name plus **PACK/PAC/PAK** is acceptable in Part B. A mark consisting of a distinctive element plus **PACK/PAC/PAK** is acceptable in Part A and it is not necessary to raise any Section 11 objection for these terms.

## Ⓢ PAINTINGS: FAMOUS

Labels in the food and drink classes may sometimes incorporate a painting as part of the mark. An enquiry should be made at the initial examination stage as to whether the applicants are the owners of the painting or whether they have permission from the owners of the painting to include such a representation in their mark. If they are not the owners and cannot obtain the appropriate permission the representation of the painting will need to be removed.

## Ⓢ PARA

This has a geographical signification and is open to objection under Section 9 but acceptable in Part B because it has other connotations eg. a parachutist.

## Ⓢ PARCELS

The mark **FISHERMAN'S PARCELS** was accepted for registration in Part B by Robin Jacob on the grounds that **PARCEL** was an unlikely term for use in relation to, amongst other things, prepared meals. Subsequent investigation revealed that **PARCELS** is often used to describe dishes the main constituents of which are wrapped in pastry, pasta, dough, edible leaves etc, or which are simply wrapped in foil for cooking. This word is therefore non-distinctive for many dishes and, where appropriate, should be disclaimed. It is advisable to consult recipe books, etc where a word appears to be descriptive. Such recipes may be quoted to justify the objections, if challenged.

## Ⓢ PARTNER

(Meaning 'ally or companion', Collins English Dictionary). It is acceptable in Part B when combined with a word which makes a meaningful mark for the goods. For example;

**CHISEL PARTNER** – chisel sharpening apparatus

**DRAIN PARTNER** – cleaning preparations for drains ➡

**BRUSH PARTNER** – anti-hardening chemicals for brushes

If presented in conjunction with a word having only an oblique reference to the goods, or to their effect, Part A is appropriate. For example;

**COOL PARTNER** – cosmetics, aftershave

### 🌐 PASTORAL SCENES

Scenes of cows grazing in a field are not acceptable for registration in respect of dairy products because they are commonly used as mere decorative matter on butter wrappers, condensed milk labels etc.

### 🌐 PATTERNS: DECORATIVE

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, for example, textile piece goods, chinaware etc. If objections are raised to textile piece goods decorated with flowers these could be overcome by excluding from the specification 'textile piece goods decorated with flowers.'

### 🌐 PATTERNS: TARTAN

Tartan is regarded as a commonly used pattern or background which traders in general should be free to adopt for ornamentation purposes in their labels.

Tartans are not protected by law, unless the designer registers them as a Registered Design, but it is a Scottish custom that anyone belonging to a particular clan has the right to use that clan's tartan. Trade/service mark rights cannot be granted in respect of known tartan patterns, as such designs are in common use and therefore non-distinctive for trade/service mark purposes. If a tartan pattern or the name of a tartan appears in a mark for clothing it is necessary to object under Sections 9, 10 and 11

There can be no objection to registration of an invented pattern which, although it resembles a tartan in style, is not in fact a recognised tartan, provided it meets the normal test of distinctiveness. 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 encyclopedia of tartan patterns but in cases of doubt, the advice of the Tartan Society should be sought.

### 🌐 PENDING APPLICATION: TRANSFER FROM SECTION 17 TO SECTION 29(1)(B) AND VICE VERSA (REGISTERED USER)

A normal application is one based on use, or intention to use, by the applicant. An application under the provisions of Section 29(1)(b) is based on use, or intention to use, not by the applicant but by somebody else who will be a registered user effective from the date of the application. The latter type of application must be accompanied by an application to register a registered user (TM50). Exceptionally, the late filing of a TM50 can be permitted under the provisions of Rule 121 if the Registrar is satisfied it could have been filed with the TM3 but was not done so in error. The reason for the error must be fully explained, usually in a statutory declaration.

If an applicant states on his/her Application Form TM3 that the application is proceeding under the provisions of Section 29(1)(b) this indicates that at the date of application he/she does not use, or intend to use,

the mark him/herself. If an applicant does not indicate on the Form TM3 that his/her application is proceeding under the provision of Section 29(1)(b), this implies, at the date of application, that he/she is using or intends to use the mark him/herself. Clearly, to request the transfer of a normal application to one under the provision of Section 29(1)(b), or vice versa, means that the original application may well have been defective. But the provisions of Rule 121 permits the amendment of applications and if the circumstances surrounding an application are such that it could have been made under the alternative provisions, and these are satisfactorily explained in a statutory declaration, or exceptionally a letter, the application can be amended accordingly.

A request to transfer from one category of application to another is a serious step. If the request is incorrectly allowed, and the application is subsequently attacked, it might well prove to be vulnerable as regards 'intention to use' either under Section 17 or Section 29. A senior officer (unit SEO) must be consulted whenever a request for such a transfer is received.

### 🌐 PENGUIN PRACTICE: HISTORY

The practice was first used for an application by Penguin Book publishers (No. 608514) in respect of printed publications. This mark was allowed to proceed to registration subject to a limitation of the specification reading 'but not including any such goods relating to birds'. In the Penguin Case evidence was filed showing that the public always bought books because of the subject matter/title/author and never because of the trade mark. Thus the public would not be deceived into thinking that the publications should relate to penguins and no objection under Section 11 was applicable.

### 🌐 PENGUIN PRACTICE: PRESENT APPLICATION

1. Penguin Practice involves the raising of objections under Sections 9 and 10 if goods may be in the form of the mark or decorated with representations of the mark.
2. Penguin objections are overcome by exclusions (Penguin exclusions). Some Penguin objections can sound very strange but there is often a straightforward means of overcoming them and it is usual to suggest a way forward in the examination report.
3. Penguin exclusions can be applied only in the absence of an objection under Section 11. Consider whether you would expect all of the goods to be in the form of or decorated with the object described by the mark; if not, then a Penguin exclusion can be used. If goods are generally bought on sight rather than by a brand name then a potential purchaser is unlikely to be deceived. In the case of fabrics or wallpaper a manufacturer would be unlikely to limit their range of goods to only those decorated with a specific item so again a potential purchaser is unlikely to be deceived.
4. For marks in Classes 9 and 16 exclude goods in a similar form to that actually described: use a subject heading or Latin Genus name. This is to avoid the possible argument that the specific usage is of the same object but in a stylised form.
5. For marks in Classes other than 9 or 16 exclude goods in the actual form of the object described. This is to simplify the practice.
6. Use the standard wording.

There are four acceptable forms of wording to fit requirements:

*but not including any such goods in the form of..... ➡*

*but not including any such goods in the form of, or decorated with.....*

(Classes 9 and 16)

*but not including any such goods relating to.....*

(for posters and art prints)

*but not including any such goods depicting.....*

If any doubt arises over the wording of the exclusion staff should consult their Unit Manager or a Hearing Officer. Such staff have the right to suggest wording to cope with particular circumstances.

7. Do not apply Penguin exclusions to cartoon characters. In these cases the characterisation in the mark is usually enough to make it more distinctive than just a simple representation of the animal/character etc.

### **🐧 PENGUIN PRACTICE: GOODS/SERVICES AFFECTED**

Penguin exclusions may not be applied to the following goods and services. The list is not all inclusive and it does not mean that the Penguin practice can always be applied. Each case must be considered on its own merits.

**CLASS 3: NOVELTY TOILET SOAP.** This can be in the shape of animals, sea-shells etc.

**CLASS 6: ORNAMENTS.**

**CLASS 9: COMPUTER PROGRAMS OR RECORDINGS ON DISCS/TAPES.** Penguin objections are raised where it is conceivable that the mark could describe the subject matter of the goods. Records and tapes are bought by title and not by the name of the record company so a potential purchaser would not expect all records sold under the mark **HAMLET** to relate to the works of Shakespeare.

Examples;

**MOUNTAIN**

*Computer programs.....;but not including any such goods relating to topography.*

**COCONUTS**

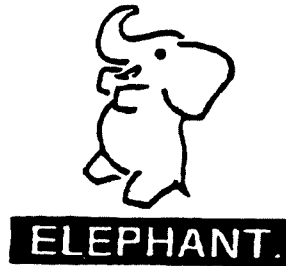
*Films, videos, records and tapes...computer games, sunglasses...;but not including any such goods relating to palmae.*



*computer software.....; but not including any such goods relating to felidae*

**CLASS 14 : JEWELLERY,** it is not unusual to see brooches in the shape of birds, animals, flowers or other objects. Charm bracelets incorporate 'charms' which can take many shapes and are bought separately to be added to the bracelets as desired. ➡

Examples;



*watches....watch straps...; but not including any such goods in the form of or decorated with elephants.*



*Jewellery...; but not including any such goods in the form of, or decorated with pandas.*

**CLASS 16 : BOOKS, MAGAZINES and POSTERS.** Penguin Practice originated in this Class. Penguin objections are raised if the publications could relate to the object described by the mark. The classic example is for the mark **PENGUIN**. Objections are raised under Sections 9 and 10 because it is descriptive of and non-distinctive for eg. publications relating to penguins. The public would not expect all titles sold under this mark to relate to penguins so a Penguin exclusion will allow the objections to be overcome; 'but not including any such goods relating to birds'. The exclusion of goods is wider than the title suggests so that birds which have a similar appearance to penguins are also excluded. In this way a slightly stylised representation of a penguin is not open to interpretation and consequently argument.

Applications for books and magazines attract Section 9 and 10 objections because, in the case of the mark **PENGUIN**, the mark is descriptive of and non-distinctive for publications about birds. These objections can be overcome by ensuring that the proprietor has no exclusive rights to deny others using the mark as a book title (ie granting the trade mark **PENGUIN** to one person does not restrict others from writing on the subject of Penguins).

Posters attract Section 9 and 10 (Penguin) objections as the 'scene' depicted by the poster may relate to the trade mark. The objections are overcome by excluding goods depicting the object described by the mark.

Examples;



*Publications and printed matter...;but not including any such goods relating to hymenoptera. ➡*



*Printed matter...; but not including any such goods relating to vegetables.*

#### SQUADRON PRINTS

*Artprints; printed publications relating to art prints; all included in Class 16; but not including any such goods depicting armed forces squadrons.*

**CLASS 18 : BAGS.** These can be made from animal skin or simulated animal skin so it is usually necessary to limit rights in marks in relation to the materials used (rather than in relation to representations of animals). If a proprietor decorates goods with, for example, devices of tigers such use is not recognised as trade mark use and a Penguin exclusion is unnecessary. Exceptions can occur when the examiner is aware of the particular nature of the goods concerned, for example bags for children have been made in the shape of various animals and it has been necessary to request a Penguin exclusion in such cases.

**CLASS 19 : ORNAMENTS AND STATUETTES.**

**CLASS 20 : FIGURINES, SCULPTURES AND FURNITURE.** Figurines and sculptures can obviously take many forms and are bought on sight. Furniture, especially for children, may be made in the form of or decorated with animals or objects, for example chairs in the form of a bear, or novelty beds in the shape of cars, trains etc.

An Example;



*Figurines and sculptures...; but not including any such goods in the form of Griffins.*

**CLASS 21 : HOUSEHOLD ITEMS** Mugs, teapots, oven gloves etc. can take the form of or be decorated with animals or objects.

Examples;



*Tableware made of ceramics or of plastics; serving dishes, mugs, containers, paper plates, paper cups;..but not including any such goods in the form of, or decorated with, dogs.*



*Ornaments and articles, all made of glass; hollow glassware; tableware; fruit bowls; schnapps glasses; candlesticks of glass....but not including any such goods in the form of or decorated with swans.*

**CLASS 24 : FABRICS** The name of a flower or animal describes fabrics bearing such representations.

Examples;



*Towels, napkins and table cloths; bedlinen; sheets, pillowcases and blankets; curtains; draperies and wall coverings....; but not including any such goods decorated with elephants.*

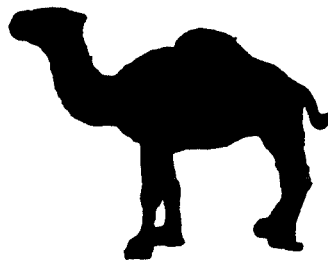


*Textile piece goods..; but not including any such goods decorated with lyre birds. ➡*

**CLASS 25 : CLOTHING** an animal or flower could describe clothing decorated with such objects. Footwear may also be in the form of animals, especially novelty slippers.

The following example include a Penguin exclusion and also an exclusion relating to the materials used.

**CAMEL**



*Boots and shoes.....;but not including sport shoes, boots and shoes in the form of or decorated with camels, or made of camel hair or camel leather.*

**CLASS 26 : HAIR DECORATIONS, BUTTONS AND BROOCHES**

An example;



*Badges.....; but not including any such goods in the form of or decorated with roses.*

**CLASS 27 : WALLPAPER RUGS** The name of a flower or animal could describe wallpaper decorated with such items. Rugs can be made from animal skin or simulated animal skin and it is necessary to limit rights in marks in relation to the materials necessary to limit rights in marks in relation to the materials used. Rugs can also be in the shape of animals so a Penguin exclusion relating to rugs in a certain shape may be appropriate if an examiner suspects that this may be necessary in a given case.

An example;

**FOX**

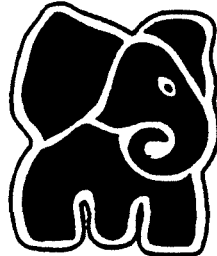
*Carpets, coverings for existing floors; non-slip mats; non-slip underlays...; but not including any such goods made of fox skin, in the form of foxes or decorated with foxes.*

**CLASS 28 : TOYS AND PLAYTHINGS** These may include or incorporate characters in the form of animals. Objections should be raised under Sections 9 and 10 on the grounds that the mark is considered descriptive of toys or playthings in such a form. ➡

Examples;

## SERPENT

*Games, toys and sporting articles...;but..not including any such goods in the form of or decorated with serpents.*



*Toys....; but not including any such goods in the form of or decorated with elephants.*



*Games and toys...;but not including any such goods in the form of or decorated with otters.*

## CLASS 30 : CONFECTIONERY

Penguin exclusions are not normally applied to these goods as an objection under Section 11 is generally appropriate.

See also **CONFECTIONERY**

**CLASS 41 : SPECIALIST PUBLISHING** Penguin exclusions are applied to the publishing of material relating to specific areas such as religion, wildlife or music. An example would be an application for OTHELLO for publishing services; a Penguin exclusion would apply since publishers could specialise in the works of Shakespeare, but would not be expected to limit themselves to such works.

## 🌀 PERSONAL ORGANISERS

Although on the face of it this is a somewhat vague term it is now acceptable as a description of goods when classifying applications in Class 16.

## 🌀 PHARMACEUTICAL NAMES: GENERAL

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 included as a search option on the OPTICS system. They can be picked up as grounds for objection under Sections 9, 10 and 11 for applications relating to goods in Class 5. 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. It is not necessary to raise an objection under Section 12 on the grounds that a mark conflicts with an approved name.

Objection is not 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.

#### ⊕ PHARMACEUTICAL NAMES: INDEXING

The practice for pharmaceutical name indexing is as follows:

- 1 the proposed name is submitted by the BPC or BSI to the Registry for search;
- 2 after searching, the result is reported in writing to the body concerned;
- 3 the body notifies the Registry when the name is actually approved;
- 4 the name is inserted on the Registry's search databases.

#### ⊕ PHONETIC EQUIVALENTS OF UNREGISTRABLE MARKS

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.

See **LETTERS: PHONETIC EQUIVALENT SPELLING OF (EXXATE)**

Phonetic similarity was 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 owners use of **MERIT** and to prevent others using **MERIT**. Two of the appeal Judges (Lawton L J and Shaw L J) held that **NERIT** was inherently capable of distinguishing but the third judge, Brightman L J took the opposite view, that words which are virtually the same phonetically are just as unacceptable as the exact phonetic equivalents. Brightman L J considered the issue of phonetic resemblance in much greater depth than the other two judges and his decision is considered to carry the most weight. Where 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 (the **OMBRELLA** Case 1974 RPC 683 refers)

#### ⊕ PLUS

In view of the common usage of the word **PLUS** as a laudatory term to indicate goods or services which offer something extra the practice with regard to **PLUS** marks has recently been updated. The new practice can be summarised as follows:

- 1 **PLUS** alone: Object in the prima facie case under both Sections 9 and 10. Mark may, however, be accepted provided it is supported by significant evidence of factual distinctiveness.
- 2 **PLUS** as a word following mark as a whole could be descriptive or non-distinctive and objected to under both Sections 9 and 10
- 3 **PLUS** as a word following an acceptable word; always disclaim
- 4 **PLUS** as a prefix word: Treatment depends on the totality of the mark but in most instances **PLUS** should be disclaimed. Clearly if combined with descriptive or non-distinctive words the whole mark is likely to attract objections under Section 9 and 10. ➡

**PLUS** is frequently used in connection with advertisements for various savings accounts operated by building societies and banks. In future, object under Section 9 and 10 for **PLUS** on its own for finance related services and proceed with caution for other services. In combination with other acceptable words the word should invariably be disclaimed for finance related services.

#### 🕒 **POINTER**

This is a surname but acceptable in Part A because of its well known other meaning.

#### 🕒 **POLY**

The acceptability of a mark incorporating the prefix **POLY** (meaning 'more than one, many or much' – Collins dictionary) will depend on whether the word with which it is combined has a direct reference to the goods/services concerned. When used alone **POLY** is generally acceptable in Part A except where it has, by common usage, become an adjective in its own right eg. **POLY** is now virtually generic for polythene or for polyester content in fabrics.

#### 🕒 **POP GROUPS/MUSICAL PERFORMERS**

No condition necessary

see **MUSIC GROUP CONDITIONS.**

#### 🕒 **PORTA**

This is often used in the sense of 'portable...' but no objection under Section 9 or Section 11 should be raised on this ground. It is, however, phonetically the same as the surname **PORTER** and when conjoined with the goods/services, or a closely descriptive word, an objection under Section 9 should be raised. **PORTA** plus distinctive/invented word is acceptable in Part A.

#### 🕒 **PORTRAITS**

If a mark consists of, or includes, a portrait of a living or recently deceased person the written consent of the person, or if recently deceased their legal representatives, is required. If the representation is that of a child the consent of the parent or guardian will be required. The following statement will need to be printed on the application form and appear in the Journal:

*The portrait appearing in the mark is that of.....*

#### 🕒 **PRECINCT**

See **ARCADE.**

#### 🕒 **PRIMA/PRIMO**

An Italian word meaning 'first' or 'pre-eminent' as in 'prima donna'. It may be considered acceptable in Part B.

## 🌐 PRINCIPALLY : AS A CLASSIFICATION TERM

- 1 May be used to indicate the nature of the goods to clarify which class is appropriate – ‘ all made principally of plastic ....’ etc.
- 2 Should not be used to overcome Section 11 objections – hence the wording needs to be more specific and the accepted form is ‘all made wholly or substantially wholly of .....’.

## 🌐 PRO

PRO (professional) is meaningful for certain goods, especially in Classes 8 and 28. Pro is also a dictionary word which may attract objections in particular cases as being descriptive or non–distinctive in its meanings of:

on behalf of

in favour of

in support of

Objections arise most obviously in the sporting field where the term Professional is in common use. PRO is thus non–distinctive for a wide range of sporting goods and services. Other goods and services where objections may arise are, for example, hand and power tools. These are commonly rated according to whether they are suitable for the DIY or professional/tradesman market. Sound systems, kitchen equipment and protective clothing might equally be designed for a professional rather than a domestic or casual market. PRO would attract Section 9 and 10 objections in these cases and should be disclaimed in otherwise acceptable marks. The use of PRO on , for example, fruit and vegetables, drinks, perfumes etc could be considered as fanciful.

## 🌐 PROCHAIN(E)

This French word means NEXT in English. NEXT has in the past been refused registration, prima facie, because it is non–distinctive but PROCHAIN(E) can be accepted in Part B because, to be objectionable, PROCHAIN(E) would have to be used in a sentence in French (which is unlikely in an English speaking country).

## 🌐 PRODUCE OF

The words ‘Produce of England’ or ‘Produit de France’ etc can remain on any mark. No Section 11 objection needs to be taken as this type of statement is covered by the Trade Descriptions Act.

## 🌐 PROFILE

A general dictionary definition of PROFILE is ‘a representation of the extent to which a person, field, or object exhibits various tested characteristics or tendencies’.

PROFILE has a specific meaning when applied to bicycles because these can be profiled to cut down wind resistance. Such bicycles are referred to as ‘low profile’ and their parts are referred to as ‘profiled’.

Profile is considered non–distinctive for bicycle parts and vehicle tyres in Class 12. Part B is appropriate for business and financial services.

## Ⓢ PROTECTED MATTER

See ANZAC, GENEVA CROSS and ROYAL

## Ⓢ PUBLIC HOUSES: NAMES

Some names are frequently used for public houses eg **RED LION, WHITE HORSE, PRINCE OF WALES**. A name is deemed known if listed in the London telephone directory or in Dunkling and Wrights 'Dictionary of pub names'. Such marks should be objected to prima facie as being non-distinctive. They may be acceptable on evidence of use, but the locality for which registration is granted should be strictly limited.

## Ⓢ PUNCTUATION MARKS

Punctuation marks such as !, ?, ' ', full stops, commas and symbols such as &, + and - are regarded as so non-distinctive that a disclaimer is not required.



# R

## Ⓜ ® : SECTION 60 OF THE TRADE MARKS ACT 1938

In the past few years the Registrar has received an increasing number of complaints about allegedly false representations that particular trade marks are registered in the United Kingdom, most notably by the use of the symbol of a capital R in a circle. The Registrar has taken the view that the ® symbol can be taken to constitute a representation that a mark is registered in the United Kingdom.

Recently the European Court of Justice has issued a decision in the case of **PALL V DAHLHAUSEN** which concerns use of the ® symbol. The Court ruled that Article 30 of the EEC Treaty was to be interpreted as prohibiting the application of a national rule on unfair competition which enabled a trader to seek, in the territory of a member state, the prohibition of the distribution of a product bearing the letter R, surrounded by a circle next to a trade mark, where that mark had been registered in another member state.

Following this decision of the European Court of Justice, the Registrar takes the position that if a person states in terms, or otherwise represents, that a trade mark is registered in the United Kingdom and this is proved to be untrue, then the person will be at risk under Section 60 of the Act. If a person makes a statement or representation that a mark is registered, without implying that it is registered in the United Kingdom, then the Registrar will not seek to invoke Section 60 if he is satisfied that the mark is in fact registered in another country.

## Ⓜ RAC

Under current practice a clearly pronounceable three letter combination may be accepted in Part A. However, **RAC** is an example of a well known abbreviation which is pronounceable as a word but which in common usage is pronounced as letters. In future it is necessary to raise an objection on the grounds that the mark is recognised as mere letters. Other examples are **SAS** and some electricity boards such as **MEB** and **LEB**.

See also **LETTERS: GROUPS OF THREE**

## Ⓜ REDUCED SUGAR

See **EXTRA JAM**

## Ⓜ REFUNDS OF FEES

The first principle applicable to a request for the refund of fees paid on any official form is that no refund can be admissible merely on the grounds that the application made on the form is officially declined in accordance with the provisions of the Act and Rules. Examination and consideration of the application will necessarily have consumed official time and expense and, under Treasury instructions, the fee may not be refunded.

In order to ensure consistency of treatment of requests for refunds, it is the aim to refund the fee in full, or not at all. For example, the jacketing, setting up of a file and placing the information on the computer is considered to be an 'in house' costs administrative arrangement and does not preclude an application fee from being refunded provided no other work has been carried out, i.e. checking of the specification of goods/services, formulation of the search strategy etc.

## ☉ REGAL

Over the years the practice on **REGAL** marks has become mixed. Webster's dictionary defines **REGAL** as 'relating to royalty' and 'of notable excellence or magnificence' and the latest edition of the Concise Oxford dictionary retains the meaning of 'magnificence'. Collins and Chambers dictionaries however suggest that 'relating to royalty' is becoming the main signification.

While the word retains its laudatory signification it cannot prima facie be accepted in Part A, but changing usage of the English language indicates that for many goods it can be accepted prima facie in Part B, eg frozen fish. If goods are not likely to be connected with Royalty Part B can be offered. Where the goods may be connected with royalty eg robes, jewellery, etc. prima facie objections under both Section 9 and 10 should be taken.

## ☉ REGISTER : DIFFERENCE BETWEEN PARTS A AND B

The protection offered by Part B falls little short of Part A. The proprietor has the same exclusive right to use the mark in relation to their goods/services and the same right to seek legal redress in the event of an infringement by another party. There are, however, two differences in relation to legal proceeding taken in respect of a mark.

- 1 The defendant in an infringement action brought by the proprietor of a Part B registration may, in defence, establish to the satisfaction of the court that the use complained of is not likely to deceive or cause confusion or be taken to indicate a connection in the course of trade between the defendant and the goods and services complained of.
- 2 A mark registered in Part A, after a period of seven years and assuming continuous use of the mark, is deemed to be valid in all respects unless it can be shown in legal proceedings that the registration was obtained by fraud or the mark offends against the provisions of Section 11 of the Trade Mark Act which make it unlawful 'to register as a trade mark or any 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'.

## ☉ REGISTERED USER: CHANGE OF DURING THE COURSE OF PROSECUTION UNDER SECTION 29 (1)(B)

The name of a **REGISTERED USER** can be changed only if this is merely a change of the name of the original person or company. It cannot be changed if it entails a change of legal entity.

Sections 29(1) and 29(1)(b) state:

*No application for the registration of any goods (services) shall be refused.....if the application is accompanied by an application for the registration of a person as a registered user of the trade (service) mark and the tribunal is.....also satisfied that that person will be registered as registered user thereof immediately after the registration of the trade (service) mark.*

It is considered that it is the clear intention of this Section of the Act to preclude any change of **REGISTERED USER** once the Registered User documents have been filed, even in instances when it is claimed that such a change merely involves different but closely related subsidiaries of a parent company. In previous instances the Act was not correctly interpreted. If a change of the **REGISTERED USER** is made during the course of prosecution the best course is to withdraw the current application and re-file a fresh application accompanied with Registered User documents showing the new **REGISTERED USER**. An alternative is to register the user as originally proposed and then submit an application for any new Registered User to be entered as replacement for the existing **REGISTERED USER**.

## ☉ REGISTERED USER : AN EXAMPLE

Difficulty sometimes arises in connection with the more complicated aspects of Registered Users. The following case provides a useful precedent;

- 1 Application in December 1988 filed by **SOLAGLAS NV**, a holding company, with **SOLAGLAS LTD** as Registered User of trade mark – **CRACKSPEED**.
- 2 Company re-structuring (January 1990) split the business of **SOLAGLAS LTD** into two – one part trading in vehicle glass and associated installation services and the other part trading in building glass and installation.
- 3 Another company in the group called **EASTRICH LTD** took over the building glass business.
- 4 **SOLAGLAS LTD** changed its name to **SOLAGLAS-AUTOGLAS LTD** and **EASTRICH LTD** changed its name to **SOLAGLAS LTD**.
- 5 The current **SOLAGLAS LTD** is not the same company as the originally proposed Registered User.
- 6 **SOLAGLAS LTD** is in the process of being sold to a French group.

Problem.

How to handle the, as yet, pending applications in view of the changes that have taken place or are imminent?

Proposed Solution

At the date of application the application was in proper form – we should register **SOLAGLAS LTD** as Registered User under Section 29(1)(b). After registration the original Registered User should be cancelled and the second mark **SOLAGLAS LTD** be appointed as a Registered User.

This procedure is necessary since Registered User rights cannot be transferred or assigned under the Act.

## ☉ RENTAL OF GOODS

It is increasingly common for companies offering a rental service to offer retail services for the same goods. A well known example is **RADIO RENTALS** who initially rented televisions and now sell them using the same mark. There may be a possibility of confusion if the words **RENT**, **HIRE** or **LEASE** were used in relation to goods being offered for sale, so the following condition should be used on all applications in classes 7, 8, 9, 12 and 25 if the words **RENT**, **HIRE** or **LEASE** appear in the mark;

*It is a condition of registration that the mark shall be used in relation only to those goods which are offered for both sale and rental.*

Applications in other classes should be treated on their own merits.

It is not thought that any action need be taken in relation to words such as **SELL**, **BUY** or **PURCHASE** if they appear in marks in the service classes.

## ☉ REPUTATION

This is a word which all traders should be free to use and it is consequently open to objection under Sections 9 and 10, prima facie. It may even prove to be unregistrable.

## ⊗ RITZ

A surname, but numbers of entries in the relevant telephone directories have fluctuated around the borderline of acceptance for Part B. It has been accepted in Part B several times and should continue to be offered Part B in future regardless of future fluctuation in numbers. The word also has laudatory connotations which emphasizes that Part B is appropriate in most cases.

## ⊗ RIVERS

See **GEOGRAPHICAL NAMES.**

## ⊗ ROADS

See **GEOGRAPHICAL NAMES.**

## ⊗ ROAD SIGNS

Devices of road signs officially adopted by the Department of Transport are open to objection under Sections 9 and 10 because they are not distinctive and are also open to objection under Section 11. These objections can be waived if the applicant can furnish the written consent of the Department of Transport to the registration of the mark, unless the goods concerned are motor vehicles or other goods/services directly connected with the roads, road traffic or transport.

## ⊗ ROSETTES

Devices of **ROSETTES** are commonly used by the Automobile Association (AA) to indicate the standard of food obtainable from catering establishments. They are not considered distinctive for hotels, restaurants, or foodstuffs as they indicate an award of excellence.

## ⊗ ROYAL: GENERAL

Rule 16 relates to certain words and devices which require careful consideration before being accepted as trade marks or as parts of trade marks. In practice, such marks should be objected to *prima facie*. It is for the applicant to convince the Registrar, by an appropriate means, that registration should be allowed. Marks containing the following will require particular consideration:

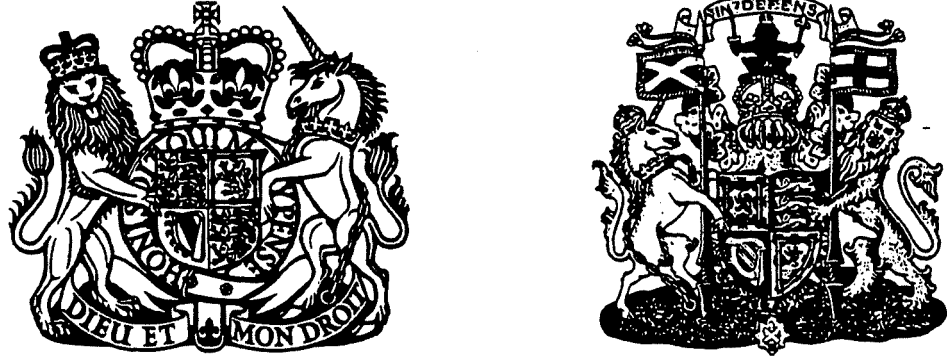
## ⊗ ROYAL ARMS AND SIMILAR EMBLEMS

Rule 15(1)(b) prevents registration of marks containing the **ROYAL ARMS** or **ARMS** which are too close to them, if their use by the applicant would be an offence under Section 92(2) of the Patents Act 1949, which reads:

*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.

Conventional representations of the ROYAL ARMS are shown below:



### ROYAL CROWN

If a mark includes a device of the ROYAL CROWN or a closely resembling device, it is necessary to consult with the ROYAL WARRANT HOLDERS ASSOCIATION to ascertain 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.

Conventional representations of the ROYAL CROWN are shown below:



### ROYAL MAIL

The mark ROYAL MAIL in the name of the POST OFFICE was allowed to proceed subject to a condition relating to voluntary cancellation of the registration;

*It is a condition of registration that the applicants shall undertake that if, at any time, they or their successors in title cease to hold Royal approval of their use of the title 'Royal Mail' they or their successors in title will make application forthwith to cancel the registration of this Trade Mark.*

Registry practice has since been reviewed and this condition will no longer be imposed.

## Ⓢ ROYAL PORTRAITS

Marks containing representations of Her Majesty, or any member of the Royal Family and any closely resembling device are open to objection under Rule 16.

## Ⓢ ROYAL SOVEREIGN

The association of these words with a coat of arms suggests Royal Patronage. Objections should be raised under Sections 9 and 10 if the words are presented alone, for the reason stated above, but there is no need to invoke Rule 16 unless the words are combined with a device closely resembling the Royal crests, armorial bearings or insignia. In the following mark the crest was considered sufficiently stylised to allow the mark to be accepted in Part B, subject to a disclaimer;



The disclaimer was worded;

*Registration of this Trade Mark shall give no right to the exclusive use of the words 'Royal Sovereign' or the letters 'R' and 'A'.*

## Ⓢ ROYAL: WORD

Rule 16 relates to the use of any words, in such a manner as to be likely to lead persons to think that the applicant either has or recently has had Royal Patronage or authorisation. In the **ROYAL** Case (1961 RPC 84) authority was given for objecting to **ROYAL** as a laudatory and descriptive term under Sections 9 and 10. The question of raising a Rule 16 objection might only arise when the evidence of use is considered. The practice to be adopted when considering **ROYAL** marks is:

- 1 **ROYAL** alone and closely similar words, eg **ROYALE**, are open to objection prima facie and should only be registered upon evidence of distinctiveness.
- 2 **ROYAL** in combination with words which give the mark a meaning which does not imply Royal Patronage, eg **ROYAL STAG**, **ROYAL FLUSH**, can be accepted in Part A prima facie.
- 3 **ROYAL** in combination with another registrable word or device, eg **RAYBURN ROYAL** or **ROYAL HARTEX**, can be accepted on a disclaimer of the word **ROYAL**.
- 4 **ROYAL** in combination with a descriptive word, surname or other unregistrable term or device would, in totality, be objected to prima facie, under Sections 9 and 10, eg **ROYAL FOAM** for foamed plastics materials or or **ROYAL McLEOD** for whisky.
- 5 **ROYAL** in combination with a word which implies royal patronage should be objected to under Rule 16 and Section 11, apart from other sections of the Act, eg **ROYAL BALMORAL** for any goods or services and **ROYAL CHEF** for foodstuffs, suggesting that the goods were used by the Royal Household Chefs.
- 6 **ROYAL** in combination with a geographical name is often used, and therefore non-distinctive in respect of tableware, especially china and glass. Such marks can be accepted on evidence of use, **ABA**, with the geographical element disclaimed.

## ROYAL WARRANT

When Royal Patronage is granted, for instance by **ROYAL WARRANT**, an application can proceed only on evidence of use and subject to a condition:

*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. (eg **QUEENS OWN**).*



# S

## SAFE

The word **SAFE** may remain in marks for use in relation to goods which have the word **SAFETY** in the generic description eg 'safety helmets' or 'safety glasses'. The word **SAFE** may also appear in marks if it is established that there is no danger to public health arising from a possible misunderstanding of the mark.

Where goods or services cannot reasonably be understood to involve safety considerations, or where there is only an indirect reference to safety (eg **SAFEGWAY** for a range of grocery products, or **INTERSAFE** for delivery services) the mark can be allowed to proceed without a condition.

If there is a clear and obvious possibility of danger to public health it is necessary to ensure that the public do not make assumptions with regard to the meaning of **SAFE** in a mark, so avoiding the risk of deception. For example, 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 such circumstances it is necessary for the applicants to agree 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 in advertising or trade literature. Where practicable the actual BSI code numbers should be stipulated in the wording of the condition. If several BSI standards could apply it is more appropriate to refer to the applicable British Standards Institution Safety Standards.

The wording of the appropriate conditions relating to safety standards should be as follows:

*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 .....*

- 1 for [first goods] – BS 123, [second goods] – BS 234, [third goods] – BS 345 etc (note: where the list of goods is reasonably short)
- 2 in force for the time being in relation to any of the goods specified, (nb: 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.

The following examples show the form of words to be used, where a condition can be agreed to:

- 1 *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 face shields, 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.*
- 2 *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. ➡*

The word **SAFE** in service marks is not normally as significant as in the case of trade marks, for example, **SAFE** has no particular significance in relation to estate agencies, credit services, tailoring, translation, clock repair etc. A safety aspect is relevant to a few services eg a **SAFE** service in respect of installing gas apparatus will imply the safe operation of the apparatus after installation and a similar understanding will apply in respect of some vehicle repair, electrical installation and repair, cloth fireproofing etc. Such services offered under marks incorporating the word **SAFE** should meet appropriate accepted standards and a condition of registration, along the same lines as that for trade marks, will be required.

## 🌐 SAVOY: GEOGRAPHICAL SIGNIFICATION

This is a phonetic equivalent of **SAVOIE** which is a geographic area of France. It is no longer considered necessary to impose a condition that the mark should not be used on goods manufactured in France.

## 🌐 SCOTCH WHISKY:

A statutory Instrument, 1990 No. 998 defined what constitutes **Scotch Whisky**. This was an amendment to the Scotch Whisky Act 1988 which applied simply to 'Whisky made in Scotland'. It is unlawful to sell as **Scotch Whisky** any spirits not conforming to the definition laid down, or to sell **Scotch Whisky** at an alcoholic strength less than that specified. The new regulations came into force on 1st of June 1990.

## 🌐 SCOTCH WHISKY ORDER 1990

### 1 Definition of Scotch whisky

For the purposes of the Act **Scotch Whisky** means whisky:

- i which has been produced at a distillery in Scotland from water and malted barley (to which only whole grains of other cereals may be added) all of which have been –
  - a processed at that distillery into mash;
  - b converted to a fermentable substrate only by endogenous enzyme systems;
  - c fermented by the addition of yeast;
- ii which has been distilled at an alcoholic strength by volume of less than 94.8% so that the distillate has an aroma and taste derived from the raw materials used in, and the method of, its production;
- iii which has been matured in an excise warehouse in Scotland in oak casks of a capacity not exceeding 700 litres, the period of that maturation being not less than 3 years;
- iv which retains the colour, aroma and taste derived from the raw materials used in, and the method of, its production and maturation;
- v to which no substance other than water and spirit caramel has been added.

### 2 Minimum alcoholic strength of Scotch whisky

40% by volume (being also the minimum alcoholic strength by volume prescribed in relation to *whisky/whisky* by Article 3(1) of Council Regulation (EEC) No 1576/89 laying down general rules on the definition, description and presentation of spirit drinks(a)).

## ⊗ SCOTTISH REFERENCES

Any word or device such as thistles, tartans, Highland Glen etc, that relates to or implies Scotland or Scottish goods is non-distinctive. In the case of goods where Scotland has a reputation, like whisky and knitwear etc, any Section 11 objection could be overcome by a condition of registration but of course, unless the mark as a totality is acceptable, the limitation will only serve to reinforce the objections under Sections 9 and 10.

## ⊗ SCOTTISH REFERENCES: IN CLASS 33

Any word or device, for example thistles, tartans, Highland Glen etc. that relates to or implies Scotland or Scottish goods is non-distinctive. In the case of goods such as whisky, for which Scotland has an obvious reputation, an appropriate Section 11 objection can be overcome by a condition of registration. This will however only serve to reinforce the objections under Sections 9 and 10 unless the mark as a totality is acceptable.

## ⊗ SEALS: IMPRESSED

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

## ⊗ SERIES MARKS: HISTORY

Series marks were introduced by Section 66 of the 1883 Act, which in substance is equivalent to 21(2)(a) and (b) of the 1938 Act.

The background, as outlined in the Herschell Report of 1887 (c.5350), is that the German Trade Marks Registry, for example, did not recognise 'blank space' conditions. If the proprietor of a mark registered in the U.K. wished to obtain a certified copy to support their case for obtaining a registration in Germany a mark containing a blank space condition would not be of any use. To overcome this problem, which applies particularly to labels for goods in the food Classes, provision for series marks was made under Section 66 of the Act. Instead of requesting that a proprietor of a label mark remove non-distinctive/descriptive matter (e.g. words such as 'Lemon drops' for confectionary) the proprietor is permitted to submit more than one version of the mark, each including different descriptive/non-distinctive matter but all with the same 'material particulars'. The marks must be used for the same goods.

The original reason for having series marks has long since disappeared. The type of mark described in the Herschell Report would now be covered by a blank space condition, whereby the proprietor of such a label mark would be required to remove the non-distinctive and/or descriptive matter, leaving a blank space, and give an undertaking 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.'

## ⊗ SERIES MARKS: PRESENT DAY USE

Applications for series marks are now made for marks which, for example, cover minor variations in the spelling of the words in the mark (Dead Sea Magic/Dead Sea Magik), upper and lower case versions of the same words, plurals or possessive versions of the same words plus hyphenated and unhyphenated versions. None of these are of the kind described in the Herschell Report, for which the provision was intended.

Under both the 1938 Act and the Directive, use of these variants would count as use of the basic mark for preserving the mark against revocation for non-use. So far as is known, no other system (save those based on U.K. law) has provision for series marks; certainly the Community System does not. ➡

**⊗ SERIES MARKS: EXAMPLES**

The following marks are considered to constitute a series:

- 1 ■ One mark consists of two words and the other mark consists of these words conjoined.

**WATERWISE**  
**WATER WISE**

- 2 Differences in upper case and lower case presentation.

**TELEMOBIL**  
**Telemobil**

**ROLMphone**  
**ROLMPHONE**

**FASTAID**  
**Fastaid**

**AdLites**  
**ADLITES**  
**Adlites**

**IBM SYSTEMVIEW**  
**IBM SystemView**

**SPACEFORTH**  
**SpaceFORTH**

- 3 Differences in punctuation

**STICK-EM**  
**STICK EM**  
**STICK 'EM**

**STICK-EMS**  
**STICK EMS**  
**STICK 'EMS**

**AOFR**  
**A.O.F.R.**

**W4**  
**W-4**

- 4 Slight differences in spelling

**KICKSTART**  
**KICK START**  
**KICK-START**  
**KIKSTART**

**EUROCHEK**  
**EUROCHECK**

→

5 A different word is used but the meaning is essentially the same

LOOKERS BY FREEMANS

LOOKERS FROM FREEMANS

1st ACT!

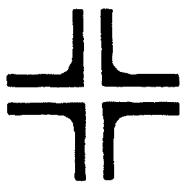
FIRST ACT!

**1<sup>st</sup>ACT!**

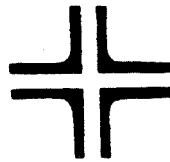
**SEE** *hear*

SEE HEAR

6 An element is more prominent in one of the marks



**Rippin**



RIPPIN

**GENENCOR**  
INTERNATIONAL

GENENCOR INTERNATIONAL

7 There are slight differences in presentation



The first two marks in the series, here depicted in heraldic shading, are limited to the colours red, white and blue as shown in the representation on the form of application. →

*Création Cilia*

CREATION CILIA

DANCE ENERGY

**DANCE  
ENERGY**

AFFIRMATIF

**AFFIRMATIF**

IMPULSE

**IMPULSE**

THE TAPESTRY COLLECTION

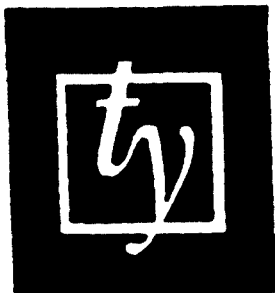
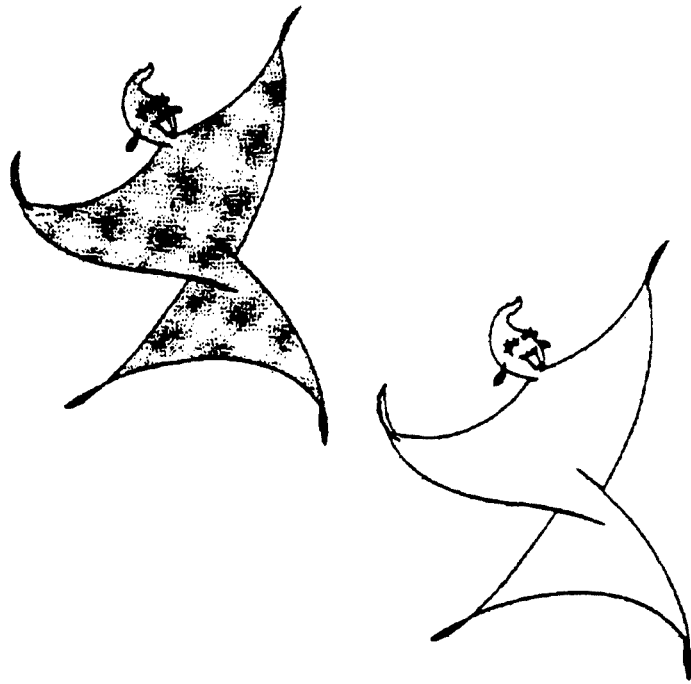
*The  
Tapestry  
Collection*

SOFTMART

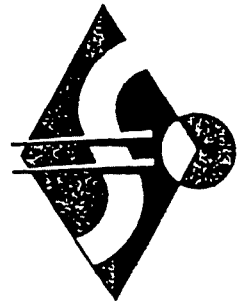
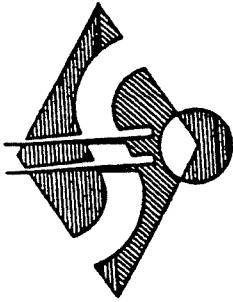
 **Softmart**



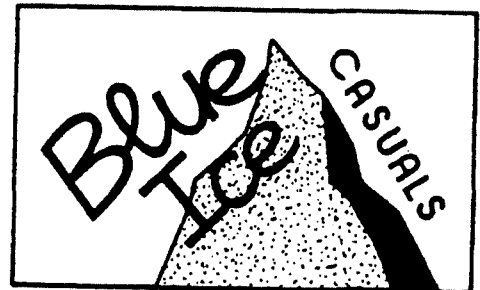
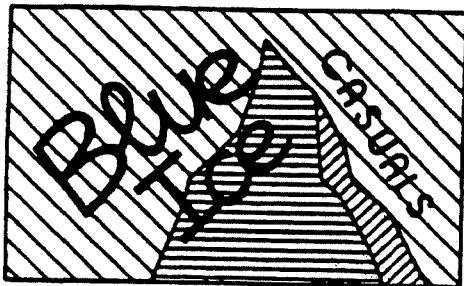
8 Different shading is used



9 A colour limitation is applied to only one of the marks



The first mark, here depicted in heraldic shading, is limited to the colours red, green and white as shown in the representation on the form of application.



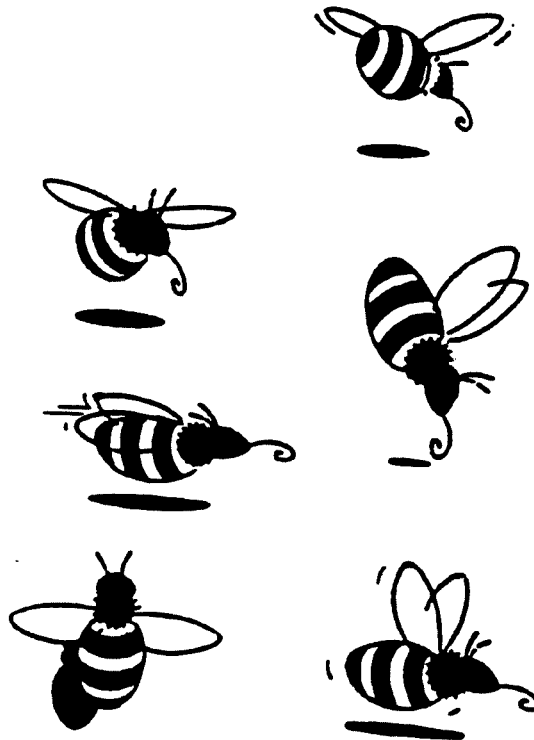
The first mark, here depicted in heraldic shading, is limited to the colours blue, green and purple as shown in the representation on the form of application.

10 The marks are limited to different colours



The marks, here depicted in heraldic shading, are limited to the colours blue, cream and grey, as shown in the representation on the form of application. ➔

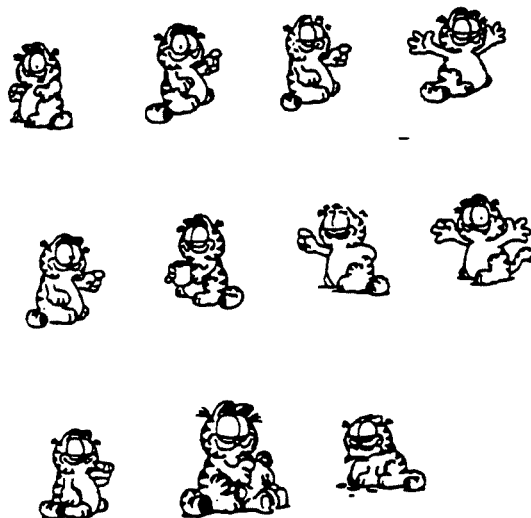
11 The series consists of the same character portrayed in different positions



**Crocodile**



**Crocodile**



**MEGAS**  
**MEGAS 4**  
**MEGAS 8**  
**MEGAS 12**  
**MEGAS 16**  
**MEGAS 24**  
**MEGAS 32**

The following marks are **not** felt to constitute a series:

1 Reflections

Application was made for a series of four marks. The mirror image of a word is, however, considered somewhat different from the word itself. It was felt that this was more a series of two marks; the word and its reflection being considered one mark.

**REFLECTIONS**  
**REFLECTIONS**

2 Prominence of different numbers after a mark

Section 21(2)(b) allows a series to vary in statement of number. These marks vary in this respect but the numerals are too prominent a feature. It was felt that the mark could proceed as a series only with the prominence of the numerals reduced by, for example, reducing them in size or by showing them in outline.



Registration of these marks shall give no right to the exclusive use, separately, of the words 'Clear-seal', 'System', the device of a seahorse and the numerals '56' '65' '85' '100' and '120'. →

3 Prominence of a certain element

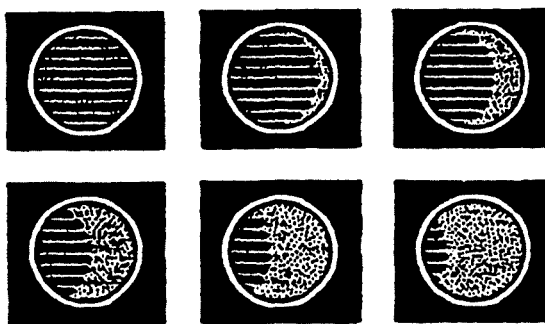
The letter Z in the first mark is considered too much larger than the other letters, so that it is a material particular in the first mark but not in the second.

·CEAZARO  
CEAZARO

Registration of these marks shall give no right to the exclusive use of a letter 'Z'.

4 Differences in presentation are too great

The difference between the first and sixth marks is far too great for this to be acceptable as a series. The first two, or the third, fourth and fifth marks could be accepted as a series.

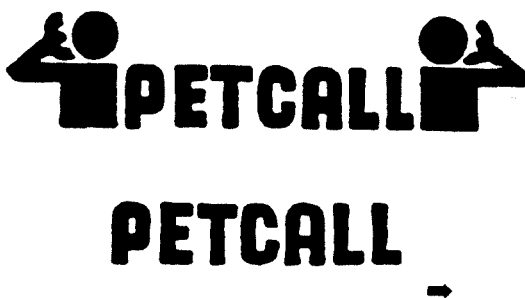


5 Punctuation creating a different meaning

These marks were not considered to constitute a series because BE is easily recognised as a word and B.E. would be seen as merely letters. In a similar application GU and G.U. were allowed to proceed as a series because GU is not a recognised word.

B.E.AQUAPLANE  
BE AQUAPLANE  
B.E.-AQUAPLANE  
BE-AQUAPLANE

6 The second version of the mark lacks a significant feature of the first.



- 7 Phonetically the words are the same but they can be interpreted differently.

## ABBEYCHEQUE ABBEYCHECK

### 🌐 SERIES MARKS: EXAMINATION OF

Where an applicant applies for 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 features of the marks are essentially the same. For example, an applicant may validly claim registration as a series of a number of label marks containing canned fruit and vegetables if the trade mark feature is the same in each label, the only differences between labels being that they each carry the name and an ordinary representation of a different kind of fruit or vegetable. The essential elements of Section 21(2) are that the marks must resemble 'each other in the material particulars thereof' and differ only in respect of:

- 1 A statement of the goods/services, or
- 2 Statements of the number, price, quality, or names of places, or
- 3 Other matter of a non-distinctive character which does not substantially affect the identity of the mark, or
- 4 Colour.

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

### 🌐 SERVICE MARKS: EXAMINATION UNDER SECTIONS 68 AND 1 (7)

Service Marks are defined under Section 1 (7) as marks 'used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, **IN THE COURSE OF BUSINESS** with the provision of those services'. Section 68 (1) defines provision of services: 'provision, in relation to services, means the provision **FOR MONEY OR MONEY'S WORTH**'.

Accordingly, for a mark to qualify as a service mark under the Act, the following criteria have to be satisfied:

- 1 there must be a business providing the service or services in respect of which registration is sought;
- 2 the services must be provided for money or money's worth;
- 3 the proprietor of the mark must be connected in the course of business with the provision of services; and
- 4 the proprietor of the mark must use or propose to use the mark to indicate his connection his connection in the course of business with the provision of the services.

Lord Justice Slade in the Dee Corp (retail services) case (RPC 1990 page 179) confirmed the view that

*the statutory requirement that provision in relation to services means their provision for money or money's worth can only mean that the services have to be CHARGED FOR as such. In relation to*

*the COURSE OF BUSINESS the judge said 'In my judgement...someone has to be engaged in the business of providing the relevant service for money or money's worth'. He added that the broad purpose of service mark legislation is to afford statutory protection for the goodwill of persons who trade in the provision of services. If those persons are not actually trading in the relevant services but the services provided by them are merely ancillary to their principal trading activities there is no reason why the legislature should have intended to give them any protection.*

No court has strictly defined what 'for money's worth' means but in the decision relating to the **GI-DEONS INTERNATIONAL** service mark (1991 RPC page 141) it was stated that 'money's worth' meant equivalent to money in the sense of being something essentially material. The services provided by the applicant were essentially the free dissemination of bibles. The agent argued that his client received satisfaction and peace of mind on earth that was no less than his anticipated reward in heaven, which constituted 'money's worth'. This interpretation was rejected.

A distinction is drawn between services that are funded and those provided for a charge. For instance, the Benefits Agency and the Citizens Advice Bureau applied for Service marks. Although both organisations are funded by government they do not charge their customers, consequently both applications were rejected. Some organisations are both funded by means of donations and also charge for services, for example churches charge for wedding but also rely on donations. In cases such as these it may be assumed that the services applied for qualify under the Act and no objection need be taken.

The examination Report Paragraphs offer two means of raising objections:

- 1 **Para 1C:** The mark appears to be open to objection under Section 17(2) of the 1938 Act and Section 1(7) of the 1984 Act (as amended). These require that the applicant be connected 'in the course of business' with the services provided. The objection will be reconsidered if the applicant provides evidence to show that the services are provided as a business activity. In this connection the provision of brochures, advertising material, invoices etc. may help to resolve the matter.

This paragraph should be used where there is doubt that the applicant is in the business of providing the services claimed, for instance in the case of a well known applicant applying for improbable services, for example **SNICKERS** for restaurant services).

- 2 **Para 1D:** The mark appears to be open to objection under Sections 17(2) and 68 of the 1938 Act and SI(7) of the 1984 Act (as amended). These require that the service specified in the application be provided 'for money or money's worth'. In this connection copies of price list, invoices etc. may help to establish that a charge is made for the services listed in your application.

This paragraph should be used EITHER where we believe that the services are not charged for and/or are ancillary to sale of goods (for example, retail services) OR where we accept that the applicants are engaged in an activity which might constitute a qualifying service in some circumstances, but we think that these particular applicants may not be providing it for money or money's worth (for example education and training services which appear to be for the applicant's own workforce).

Objections under Sections 68 and 1(7) should normally be raised against applications containing the following services:

Charitable fund raising (use paragraph 1D): these services qualify for a registration if the applicant takes a commission;

Custom construction and/or manufacture of goods (use paragraph 1C): An exception is construction of buildings and the like structures in Class 37 which are not subject to this objection.

Mail order services (use paragraph 1D): These are essentially retailing by another name and are consequently subject to objection under these Sections. Wrapping, packing and postage of goods for mail order are acceptable in Class 39. ➡

Missionary services (use paragraph 1D). It is unlikely that religious organisations charge for these services.

Provision/supply of goods (use paragraph 1D). This is equivalent to the sale of goods. However 'supply' has a transport connotation and if it turns out that the applicant intended this to mean delivery of goods then the applicant may proceed in Class 39.

Retailing, retail store, retail services etc. (use paragraph 1D). The courts have ruled that these services do not qualify for registration. Certain in-store services can be accepted if a charge is made, for example creche facilities, restaurants, shoe repairs, but applications need to be made in the appropriate classes.

Take-aways/take-away restaurants (use paragraph 1D). This is essentially selling of prepared meals. Restaurants that contain seating areas and take-away facilities qualify under the Act, for registration under the Act, for example **MACDONALDS, PIZZA HUT**.

The above list is not intended to be exhaustive and other services might attract objections. Much depends on the notoriety of the applicant and the examiner's own knowledge.

### 🌍 **SHAMROCK: DEVICE**

The **SHAMROCK** is one of the State emblems of the Republic of Ireland which is protected under Article 6ter of the Paris Convention (the other being the harp).

Paragraph 8 of Article 6ter says that nationals of any country who are authorised to make use of the State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country. Since the shamrock may be considered an emblem of Northern Ireland as well as of the Republic of Ireland this paragraph would appear to apply.

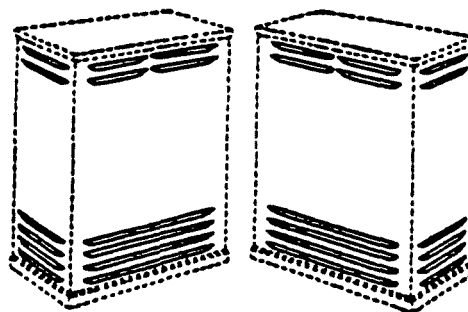
It has been agreed with the Patent Office of the Republic of Ireland that, in respect of trade mark applications from firms in Northern Ireland containing a device of a shamrock, it is necessary to ask merely for a disclaimer in respect of the device and limit the goods to those made in Ireland.

The word **SHAMROCK** is also descriptive of goods from Ireland and is not acceptable for registration as a distinctive mark or one capable of distinguishing.

### 🌍 **SHAPE OR FEATURES OF GOODS: AS TRADE MARKS**

Staff should be aware of the reasons for proceeding to advertisement before acceptance of Application No. B1116327 in Journal 5503 page 485.

The mark is defined as 'the arrangement of horizontal louvres incorporated into the structure of the loud-speaker cabinets as shown on the form of application' and this is accompanied by the following illustration:



The specification is for 'Loudspeakers and loudspeaker cabinets'.

It is important to note that the mark is not a representation of loudspeakers, nor of louvres on loudspeakers, but an arrangement of louvres in particular places on loudspeakers.

Evidence showed that:

- 1 The mark was factually distinctive. (The evidence included details of use supported by independent trade evidence).
- 2 The mark had inherent distinctiveness in that the louvres were only minimally functional in the projection of sound all other manufacturers used an open faced cabinet covered only with fabric, which was considered to be much more efficient.

Thus there are similarities with the devices of Rolls Royce and Bentley radiator grills, (accepted for motor cars) which were shown to be technically inefficient and non-functional, and which were registered upon evidence of factual distinctiveness.

### ☉ SHILLING (OR 60/)

Found on beer labels in Class 32 it indicates a strength of beer:- 60/ - light or mild beer; 70/ - heavy or bitter beer; 80/ - Export beer. These should be removed from any label or disclaimed.

### ☉ SHOP

A shop is a building or room for the retail sale of goods, services etc and should consequently be regarded as non-distinctive. Objections should now be raised under Sections 9 and 10 for all goods.

### ☉ SIAM

This was until 1949 the name of what is now Thailand. The mark has not totally lost its geographical meaning just because it is no longer in official use so it is considered acceptable in Part B.

### ☉ SIERRA

Example of a geographic name with a well known other meaning ie. a range of mountains. It is a county in New Mexico, USA: population 7,189. Evidence was filed showing that the county consisted of a 30 mile wide wooded valley, part of which was a national park. Industry is listed as timber, logging and a small gold mine. The Court of Appeal held that Part A registration was valid for motor cars.

### ☉ SIGNATURES: GENERAL

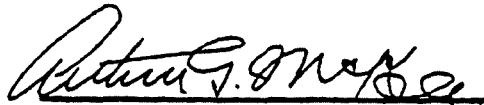
In order to be considered acceptable for registration, a signature should have the following qualities:-

- 1 It should be the usual, ordinary, signature used in the course of business by the applicant or some predecessor. If it agrees with the name given on the application form, either because the full name appears or the Christian names are represented by initials, it can generally be accepted. In doubtful cases it may be necessary to ask for evidence to support the claim of ownership. If the signature is that of someone else the consent of the person concerned to use his/her name is required.
- 2 It should, in the absence of very special circumstances, include a surname. ➡

- 3 It must be distinctive. If all the letters of the name are clearly printed it would be open to objection as a mere name of an individual or common surname. An individual generally tries to make their signature unusual in order to avoid possible forgery, so a signature in common use generally displays distinctive characteristics.

⊗ **SIGNATURE: PLUS THE NAME IN BLOCK CAPITALS**

If a name is printed in normal type together with a signature then a disclaimer of the name, except in the form of the signature appearing in the mark, is required. For example:



ARTHUR G McKEE

The disclaimer should be worded

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

⊗ **SIGNATURE: USE OF THE WORD**

A mark consisting of the word **SIGNATURE** would be considered non-distinctive for goods bearing an identifying signature and Part B is thus appropriate. If the specification of goods is limited by words such as 'but not including any such goods bearing an identifying signature' the mark may be accepted in Part A.

⊗ **SILK**

In future it will not be necessary to take a Section 11 objection to a mark containing the word **SILK** for an application for registration in Class 3. When used in relation to goods such as cosmetic preparations and hair care products the word silk is more likely to indicate to the public a property imparted by the product eg 'as smooth as silk' or 'silky hair', rather than that the product contains silk.

⊗ **SKINS: DEVICES OF**

See **HIDE DEVICES**

⊗ **SKY**

Although the phonetic equivalent of **SKYE**, an island off the west coast of Scotland, it is thought that the mark is acceptable for most goods and services. Objections should be taken for products associated with the island of Skye such as wool textiles, whisky and some services associated with travel.

⊗ **SLIM OR SLIMLINE**

If such words appear in a mark for food a Section 11 objection should be raised. This can be overcome by limiting the specification to '..... all being calorie reduced.'

## ☉ SLOGANS

If a slogan is laudatory, exhortatory or descriptive it is necessary to object under Section 68 of the Act (because it would not be regarded *prima facie* as constituting registrable trade mark matter, ie as constituting a trade mark within the definition of 'trade mark' in Section 68) and under Sections 9 and 10 (because the words have a 'direct reference to the character or quality of the goods', Section 9(1)(d) and 9(1)(e)).

Slogans such as 'Guinness is Good for you', 'Players please', 'Have a break' (Have a Kit Kat) and 'Buy British' are not considered acceptable for registration for the reasons mentioned above. 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. Before the Registrar can agree to acceptance of such marks, evidence that the slogan is being used as a trade mark and is recognised by the public as a distinctive trade mark will be required.

If the mark obviously consists of a slogan but is not so laudatory or descriptive it is necessary to seek evidence as to how it will be used. It may be that in some instances marks can be accepted in Part B when the necessary evidence is provided. For example in the 'I can't believe it's yoghurt' case Mr Jacob was shown how the mark was to be used and he was impressed by the fact that the mark was to be used on its own and would be taken as identifying the origin of goods and not merely as an exhortation to buy yoghurt. This was different from the finding by Mr Justice Whitford in the 'Have a Break' case where he found that the words 'Have a break' had never been used by people going into a shop and wanting to buy the applicants' goods nor was he able to find any evidence to establish that the words had acquired a secondary meaning in the sense that the words alone were distinctive of the applicants' products.

Having decided that the mark was being used as a trade mark to identify the origin of the goods, Mr Jacob went on to consider whether other traders would wish to use the phrase or a confusingly similar phrase and having come to the conclusion that this was unlikely he allowed acceptance in Part B. He took this decision in the knowledge that 'I can't believe it's not butter' was being used in an advertising campaign in relation to butter.

## ☉ SMOKERS ARTICLES

This term includes anything considered an accessory for use with cigarettes or tobacco, for example pipes, humidors, lighters, matches, ashtrays and pipe cleaners. It does not include tobacco, cigarettes, herbs for smoking, cigars.

## ☉ SOCIETY

When presented alone **SOCIETY** should be objected to under Section 9 because it is descriptive of and non-distinctive for eg. 'goods supplied by or as preferred by a society'. The following marks have been accepted in Part B;

- 1 **SOCIETY** for toilet soaps
- 2 **SOCIETY** for floor coverings
- 3 **SOCIETY** for goods in Class 32.

## ☉ SOLO

The town of **SOLO**, situated on the Solo river east-north-east of Yogyakarta in central Java, has changed its name to **SURAKARTA**. It is no longer necessary to raise a geographical objection to **SOLO**.

## ● SPRING

If this word appears in a mark which covers drinks a Section 11 objection should be raised. This can be overcome if the specification of goods is limited to 'natural spring water' and/or 'beverages containing natural spring water.'

See also **NATURAL SPRINGS**

## ● SPRINGS: OWNERSHIP OF

See **NATURAL SPRINGS**

## ● SPORTS CLUBS

For applications in Classes 16, 25 and 28 it is not necessary to disclaim the words 'Football Club' if these appear in a mark applied for by such a club. The disclaimer is not required because such words are so non-distinctive in this context that no one trader would expect to have sole rights in their use. This practice should be extended to other applications made by sports clubs which contain descriptive words such as **TENNIS CLUB** or **RUGBY CLUB**.

## ● STARS

Star devices are commonly used in marks for tobacco and spirits (whisky, brandy etc) and are consequently considered non-distinctive for these goods. Simple star or crown devices are considered non-distinctive in respect of hotels and restaurants since these are often classified by star or crown ratings.

Stars are non-distinctive for all other services since their use is creeping into other activities, for example gas central heating maintenance services are provided giving differing levels of service, dependent on whether the customer has a 1 star, 2 star or 3 star contract.

## ● 5 STAR/FIVE STAR

This is widely used in relation to services and is open to objection under Sections 9 and 10 as it has a laudatory signification. The term is also not acceptable for luxury goods such as jewellery or clothing. The mark has been accepted in Part B for 'weed killers' as its use in relation to these goods, is somewhat fanciful and others would be unlikely to wish to use the term in this area of trade.

## ● STATIONERY

In the past the term stationery has sometimes been narrowly interpreted as covering: writing paper, envelopes and similar writing materials. It is clear, from the definition given by Collins and other dictionaries that, while it is not possible to give a definitive list, the term goes much wider and can be taken to include all goods traditionally sold by a stationer. This is supported by the comments made by Mr Justice Pen-yuik in the **OFREX** case. (1963 RPC 169-171).

## ● STERLING

This is a surname that is within the de minimus limits for surnames with well known other meanings. It is also the phonetic equivalent of the geographical location in Scotland. The word does have laudatory con-

notations, mainly in relation to abstract qualities, for example, a *sterling* performance, *sterling* work, etc. However, there have been a number of prima facie acceptances in the past and it is now considered that *sterling* can be accepted in Part B for a broad range of goods and services.

Clearly the mark will continue to be unacceptable for some goods and services, for example, jewellery, currency dealing, metals etc.

## 🌀 STITCHING: DEVICES OF

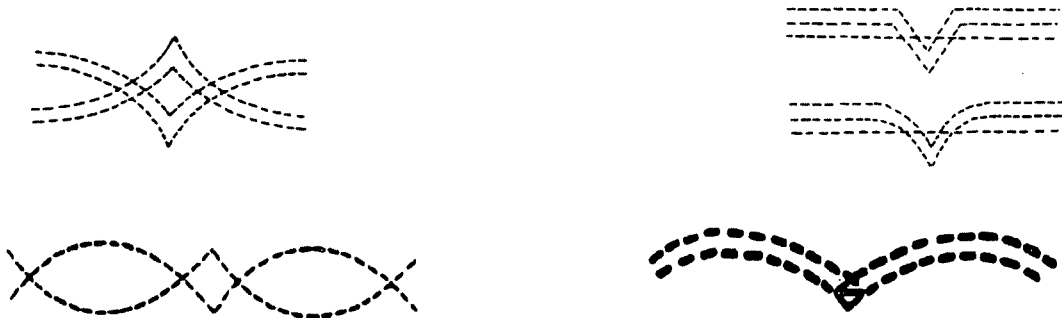
APPLICATIONS IN CLASS 25 – All stitching devices should have a Section 9 and 10 objection taken to them, prima facie –

*because it is a non-distinctive device of stitching such as is commonly used on the pockets of jeans and similar articles of clothing.*

The following paragraph may be found useful when replying to the inevitable correspondence.

*The mark applied for is an entirely non-distinctive stitching device of a kind used on an increasingly widespread scale by manufacturers of eg jeans. The mark applied for, far from being distinctive, has so little inherent capacity to distinguish that it is, in my view, almost unregistrable; (ie evidence of use the mark will need to be correspondingly substantial).*

Notwithstanding this, some stitching devices have been registered, examples of which are below. They were all Advertised before Acceptance.



## 🌀 STREET

See GEOGRAPHICAL NAMES

## 🌀 STUDIO

This has become fashionable and has connotations wider than a mere workshop. Practice relating to STUDIO marks has been mixed in the past but it should in future be regarded as non-distinctive for goods/services which may be sold/provided in a STUDIO. (In the same way as ARCADE).

Objections should be raised under Sections 9 and 10 particularly in relation to recordings in Class 9, lighting and bathroom goods in Class 11, printed matter in Class 16, household/kitchen utensils in Class 21, clothing in Class 25, carpets/wallhangings in Class 27, advertising in Class 35, all construction and repair in Class 37, all material treatment in Class 40, entertainment in Class 41 and many services in Class 42.

## ⊗ SUPRA

The word means 'over', 'above', beyond or greater than. It has obvious laudatory connotations and in the past practice has been mixed. It is now considered that it is not a word that traders normally use in their day to day business in the same way that they would use **SUPER** and it can be accepted in Part B (prima facie).

## ⊗ SURNAMES: DE MINIMUS PRINCIPLE

- 1 **Surnames with no other meaning** Common surnames eg 'Jones' or 'Brown' are not acceptable prima facie in Part A of the Register. If, however, a surname is so uncommon that its 'ordinary significance' to the public is that of an invented word it may be accepted on the 'de minimus' principle which was established in the CIBA Case (1983 RPC 75). The guidelines laid down in the CIBA Case have been adapted to take account of present circumstances and are now applied as follows:
  - i 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
  - ii 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.
- 2 **Surnames with other well-known meanings** Surnames with truly well-known meanings (ie, a meaning which is immediately known to the man in the street without use of reference books) may be accepted for registration under the principles set down in the SWALLOW case (1947, RPC 92), which were approved by the Court of Appeal in the CANNON case (1980 RPC 519):-
  - i 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 telephone directory;
  - ii Marks may be accepted in Part B if they appear as surnames not more than 100 times in the London telephone directory and/or not more than 200 times in any relevant foreign telephone directory.

## ⊗ SURNAMES: RARE BUT WELL KNOWN

If a surname is uncommon in the telephone directories, but it is well known eg, **HEARST** or **CRIPPEN**, the ordinary significance of the word is that of a surname, so these marks cannot be accepted in Part A of the Register. They may still 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: FOREIGN, INCIDENCE UNKNOWN

If a mark is a surname in a foreign country but the exact incidence is not known (perhaps because a suitable local telephone directory is not available) a prima facie objection under both Sections 9 and 10 should be raised, taking into account existing equities and precedents. Such surname objections may be waived upon proof that the surname signification falls within the criteria for acceptance. It is for the applicant to establish these facts to the Registrar's satisfaction.

## ⊗ SURNAMES: USE IN RESPECT OF LOCAL SERVICES

Purely foreign surnames may be used by persons of those names in relation to goods they export to this country, but the likelihood of such persons wishing to use their names in this country in relation to local

services (eg, restaurants, hairdressers, plumbing) is remote. The practice with regard to the acceptance of such marks is:

- 1 Marks may be accepted in Part A, prima facie, for services that are local in nature if they appear as surnames no more than 15 times in the London telephone directory and not more than 30 times in any relevant foreign telephone directory;
- 2 Marks may be accepted in Part B, prima facie, for services that are local in nature, if they appear as surnames no more than 50 times in the London telephone directory and are much more common overseas (without limit).

For example, the names **PRIEUR** and **SAUVAGE** appear over 130 and 200 times, respectively, in the Paris telephone directory but the former is not shown at all in the London telephone directory and only once in the latter case. Using the above criteria, these marks can be accepted in Part B, prima facie, for local services.

Marks offered Part B may be considered for Part A registration (Advertised Before Acceptance, Section 18(1) (proviso)) on evidence of use. In all cases, the weight of evidence required will be determined by the extent to which the UK de minimus criteria are exceeded and the localised nature of the services to be covered. The relative rarity of the name in the UK will considerably outweigh its frequency in a distant, but relevant, European telephone directory.

#### ☉ SURNAMES: PHONETIC EQUIVALENTS OF

The **ELECTRIX** Case (1959, RPC 283) established that the phonetic equivalent of an objectionable word is itself objectionable. It should be noted that in the **CRAG** case (1952 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 question, 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. The practice is as follows:

- 1 Surnames which are the phonetic equivalents of other surnames are regarded as essentially the same eg, the appearances of **GOLDWIN** in a directory will be added to the appearances of **GOLDWYN**;
- 2 If the mark in question has a well known other meaning eg, **HEART** (equivalent of **HART**), **HAWK** (equivalent of **HAWKE**) or **LION** (equivalent of **LYON**), it can be accepted in Part B;
- 3 If the phonetic equivalent of a surname has a well-known other meaning but the surname itself would be recognised as a surname, the mark can be accepted only on the filing of evidence of acquired distinctiveness eg, **HAWKE**, **SPRATT** and **LYON** have no signification other than as surnames and they are treated in the same way as 'surnames with no other meaning';
- 4 Where a surname appears with a device depicting the word (eg, a device of a lion plus the word **LYON**) the surname signification is less strong and the mark can be accepted in Part B;
- 5 If it is doubtful whether a word is the phonetic equivalent of a surname eg, **BLISS** and **BLIS**, acceptance in Part B is normally appropriate.

#### ☉ SURNAMES: DOUBLE, WITH OTHER MEANING

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 becomes distinctive (DIAMOND T Case 1921 RPC 373). If the signification is not so clear, Part B should be offered eg, **BROOKS BIRD** or **TOWNS BAKER**.

## ☉ SURNAMEN: DOUBLE AND MULTIPLE IN COMBINATION

Generally, the signification of surnames cannot be avoided where they appear in combination. Current practice is as follows:

### 1 Double Surname Marks

- i Accept in Part A without disclaimer on de minimus principle if the surnames occur not more than 15 times in the London telephone directory.
- ii Accept in Part A with separate disclaimers or Part B without if both surnames appear more than 15 times but not more than 50 times on the London telephone directory, or more than 30 times but not more than 100 times in any relevant foreign directory.
- iii Accept Part B with a 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 foreign telephone directory.
- iv Accept in Part B with 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 and 10 if both names 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 upon individual circumstances bearing in mind the likelihood of the two names being used in combination for the goods or services at issue.

### 2 Three or More Surname Marks

- i Accept in Part A with separate disclaimers or Part B without disclaimer if the surnames appear not more than 50 times in any relevant telephone directories.
- ii Accept in Part B with separate disclaimers if the surnames appear more than 50 times in any relevant telephone directories.

## ☉ SURNAMEN : WITH FORENAME (NAME OF AN INDIVIDUAL)

### 1 Accept in Part A

- i If the name is represented in a special or particular manner;
- ii If the name is presented as a signature and it is that of the applicant or a predecessor in business;
- iii If the name is presented in ordinary typeface but the surname appears no 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;
- iv If the forename is particularly unusual eg, **AUGUSTUS** or **THEODORE** and the limits listed at (c) above are slightly exceeded; ➡

- v 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);
- vi If the mark is presented as a name but the surname does not appear in the relevant telephone directories.

In view of the statutory restriction on the acceptance of surnames under Section 9 of the Act in all cases apart from 1(f) the surname will need to be disclaimed. 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.

## 2 Accept in Part B

- i If the surname elements appear 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;
- ii If the forename is particularly unusual and the limits listed at 2 ii are slightly exceeded;
- iii If the mark consists of initials and surnames and the surname elements appear not more than 30 times in the London telephone directory and not more than 50 times in any relevant foreign telephone directory. A disclaimer of the surname elements will not be required in this case.

## 3 Object under Sections 9 and 10, prima facie

- i If the surname exceeds the limits 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);
- ii If the application is made in respect of goods or services for which female forenames are considered non-distinctive eg, for cosmetics in Class 3, ladies clothing in Class 25 or hairdressing services in Class 42.

In the case of 3 ii, if the mark otherwise meets the criteria for acceptance listed in 1, the mark can be allowed to proceed in Part A if the applicant agrees to separate disclaimers of the surname and forename or in Part B if the applicant agrees to disclaim the forename. If the mark otherwise meets the criteria for acceptance listed in 2 the mark can be allowed to proceed in Part B on the basis of separate disclaimers.

## ☉ **SURNAMES: COMBINED OR COALESCED WITH FORENAME(S)**

If the surname element can be distinguished then acceptance should be on the same basis as set down for the name of an individual, except of course there will be no need for a disclaimer as the surname is not a separate element.

## ☉ **SURNAMES: PLUS TITLE**

See **TITLES**

## ☉ **SURNAMES: COMBINED WITH THE NAME OF THE GOODS**

Such marks do not qualify as invented (**SIMPLUG**, 1957 RPC 173) and are not acceptable in Part A or Part B unless the surname part of the mark is sufficiently rare to qualify under the criteria laid down for acceptance of surnames with no other meaning.

⊗ **SURNAMES: COMBINED WITH A WORD DESCRIPTIVE OF A CHARACTERISTIC OF THE GOODS**

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); **REEDCOAT** (object) : all for paper.

⊗ **SURNAMES: ALIEN TO APPLICANT**

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, for example, **NICKLAUS** for golf clubs, **CADBURY** for chocolate and confectionery, **KELLOGG** for breakfast cereals and **FORD** for motor vehicles. 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).

⊗ **SWEETS**

See **CONFECTIONERY**

# T

## ● TAB

It is no longer practice to raise Section 11 objections in Class 5 (pharmaceuticals) where the mark includes **TAB** (tablets).

## ● TARTAN

See **PATTERNS**.

## ● TEAM

At a recent Hearing the Section 9 and 10 objections were maintained for the word **TEAM** in relation to business training in sales and management. In future applications examiners should judge whether or not the services are the domain of the individual – as with fortune tellers and hair stylists. Other services, as with those associated with sales and management, advertising, airline travel, are more likely to be associated with team effort and advertised as such. In these cases Section 9 and 10 objections should be raised.

## ● TECH

An accepted abbreviation for ‘technology’ (Collins English Dictionary) which is objectionable when used in a combination which is descriptive, or has surnominal/geographic significance. **TEC** and **TEK** should be similarly treated as they are phonetically identical. **POOLTEC** (swimming pools), **SEALTEC** (seals) and **TILLTEC** (tilling machines) have been accepted but **HI-TEC** and **NUTECH** (new tech) have been refused.

See also **HIGH TECH**

## ● TECHNICAL CITES

See **ASSOCIATIONS**.

## ● TEX

Information provided by the British Man-made Fibres Federation and the Textiles Finishers Association suggest that although **TEX** is not a recognised abbreviation for textiles it is a technical term for a metric measure of the thickness of yarn. Under these circumstances Registry practice will, in future, be as follows:-

**TEX** alone: objections under Sections 9 and 10 are appropriate for goods in Classes 24 and 25 but marks may be accepted on evidence of use. **TEX** is unregistrable for goods in Class 23.

In composite marks **TEX** should be disclaimed if a separate element.

## ● THERMO (THERM)

A combining form meaning ‘related to, caused measuring heat’(Collins English Dictionary). It does not necessarily relate to **high** temperatures and is therefore unlikely to convey any precise meaning; it could

relate to articles for use in high temperatures, or low temperatures, or for producing heat, for shielding from heat, insulating etc. In most cases, it can be accepted in Part B. When combined with another word which creates a meaningful term, eg **THERMOSHIELD** Part B.

### ☸ **THISTLES**

Found largely in Class 33

Unless highly stylised, thistle devices are open to objection under Sections 9 and 10 in respect of goods for which Scotland is widely famed (eg. whisky), because such devices are commonly used by traders for the purpose of indicating the Scottish origin of the goods. If the goods do not originate in Scotland an objection under Section 11 would also arise. If they only form part of the background of a label no objection is taken and no disclaimer is required.

See also **SCOTTISH REFERENCES**

### ☸ **THOROUGHbred**

Unless related to people or animals (and horses in particular) this would be regarded as sufficiently fanciful for Part A.

### ☸ **TITLES**

- 1 **LADY**: Where prefixed by **LADY** (eg. **LADY FIONA**) or some other reasonably distinctive prefix (**MADAM, LITTLE, OLD** etc) forenames may be accepted in part A, subject to a disclaimer of the forename, provided the name has no common surname significance (the forename significance being taken into account as a 'well-known other meaning'). In some cases separate disclaimers of the two elements will be needed.
- 2 **MR/MISTER**: Although the word **MISTER** can have a laudatory connotation when combined with a word describing a subject matter and applied to a person, the view is now taken that the laudatory significance is somewhat reduced when such words are considered in the context of goods or services.

Applications for marks consisting of the word **MISTER**, or the abbreviation **MR**, combined with the name of the goods or services will, in future, be regarded as capable of distinguishing and therefore acceptable in Part B of the Register. A disclaimer will not be required unless the name of the goods or services is presented in a stylised form or is highlighted in the mark.

Marks consisting of **MISTER/MR** combined with a word describing a characteristic of the goods or services will normally be regarded as adapted to distinguish and therefore acceptable in Part A of the Register. There will usually be a requirement to disclaim exclusive rights in the descriptive word in such cases. For example **MR SPARKLE** for fireworks.

The normal rules relating to Section 11 should be applied in relation to these marks.

When **MR** is used as a title there is no need to disclaim the letters **MR** (when there is no full stop after **MR**) as has been past practice. This also applies to **MS** and **MRS** when used as titles. Where **MR** is shown in the middle of the mark or is obviously not used as a title it should continue to be disclaimed.

- 3 **CAPTAIN/MAJOR**: When a name is prefixed by a title such as **CAPTAIN, MAJOR** etc it is necessary to object under Section 9 (name of an individual), unless the combination is fanciful or the name is acceptable on its own on normal surname principles, eg **CAPTAIN JIM** or **MAJOR TIFFANY**. Such marks are normally acceptable in Part B, however, where the name is a common surname (eg Corporal Jones) **JONES** should be disclaimed.

## ☉ TOBACCO: RAW

This is defined as unprocessed tobacco, essentially the plant.

## ☉ TOBACCO: MANUFACTURED

This is defined as processed tobacco, for example pipe tobacco or roll-your-own tobacco. It does not include cigarettes, cigars or cigarillos.

## ☉ TOBACCO PRODUCTS

These include cigarettes, cigars, snuff, cigarillos, roll-your-own tobacco and manufactured tobacco. It does not include raw tobacco.

## ☉ TODAY

A word that is likely to be used in advertisements – e.g. ‘purchase your new ... today’ and should be objected to under Sections 9 and 10.

## ☉ TOMORROW

This is considered to be a non-distinctive word and generally descriptive of goods which are of an advanced or futuristic design; objections are taken under both Sections 9 and 10.

## ☉ TOUJOURS

This is the French word for **ALWAYS** which is considered non-distinctive and open to objection under Sections 9 and 10. Toujours is considered acceptable in Part B because, to be open to objection under Section 10, it would have to be used in a sentence in French (which was considered unlikely in an English speaking Country).

See **AVENIR** and **ALWAYS**

## ☉ TRADE EVIDENCE

Examiners are to be discouraged from requesting trade evidence if a mark appears bad prima facie. If trade evidence is submitted then it should be examined. If the mark still appears unregistrable then the applicant should be informed that the examiner remains unconvinced that the mark is distinctive. It should be stressed that this is the opinion of the examiner.

In Opposition proceedings applicants/agents are required to submit details of any survey conducted for the purposes of establishing distinctiveness; how many people were asked, how many replies were received, how many of those have been filed, etc as evidence in support of a case. This is not required at the initial examination stage and it should be remembered that the results of any survey submitted could be misleading.

Trade evidence may be requested in the case of marks which cover highly technical goods if the examiner is unsure whether a mark is distinctive in relation to such goods. In these cases the opinion of a Patents Examiner should normally be sought. ➡

If a case is proceeding on the basis of trade evidence it will now be advertised before acceptance. This will demonstrate to agents citing the marks as precedents that they had not been accepted prima facie. It will

also mean that marks are not accepted on the basis of narrowly based trade evidence without giving others the opportunity to comment.

If a case is proceeding by reason of trade evidence the exact wording to be used is:

*Advertised before acceptance by reason of trade evidence. Section 18(1) (proviso).*

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

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

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

The wording used will of course depend upon the circumstances which apply to each case.

### ● TRADING STYLES: GENERAL

A number of practitioners have, over the past few years, sought to include trading styles in their applications for registration. Until now the Registrar has refused such requests as trading styles do not add to ownership details. Additionally there is no provision on the application form for noting this information nor is there any provision on the computer system to hold and handle this information.

It has now been decided that if applicants wish to include trading styles as part of the applicant's name, they may do so in future. Trading styles may, however, only be included if the applicant's name and trading style is within the limit of 80 characters, including spaces, and they accept that the full name, including trading style, will appear in journal advertisements and on all computer generated documents such as certificates of registration and reminders.

### ● TRADING STYLES: HANDWRITTEN

Handwritten names of partnerships and trading styles, such as 'The Excellent Tea Company' or 'The London Stout Company' are not regarded as signatures; such a mark cannot consist of the signature of the applicants because corporations do not have 'signatures'. The name of a company or firm represented merely in ordinary handwriting as distinguished from print is not regarded as being represented in a special or particular manner and does not qualify for registration. [1915 RPC 453; British Milk Products Company Ltd, refers].

### ● TRANSLATION AND TRANSLITERATION CLAUSES

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.

#### 1 Mark 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.

#### i 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 .....*

ii 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*

iii 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*

2 Mark containing 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.

i 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 .....*

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

*The [French] word appearing in the mark means .....*

iii 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 .....*

☸ **TREES**

See **FLOWERS, SHRUBS AND TREES.**

☸ **TROPICAL**

It is difficult to define what constitutes a tropical fruit. If **TROPICAL** appears in marks for food or drink it is not necessary to raise an objection under Section 11.



# U

## ULTRA

In view of the common usage of the word **ULTRA** as a laudatory term to indicate goods or services which offer something extra, it was decided that it was appropriate to change the practice. The new practice can be summarised as follows:

- 1 **ULTRA** alone: object, prima facie, under Sections 9 and 10. Mark may be accepted if supported by significant evidence of factual distinctiveness.
- 2 **ULTRA** following a descriptive or non-distinctive word: mark as a whole may be descriptive and if so, objections under Sections 9 and 10 are appropriate.
- 3 **ULTRA** following an acceptable word: Always disclaim.
- 4 **ULTRA** as a prefix: Treatment depends on the totality of the mark but in most instances **ULTRA** should be disclaimed. If combined with descriptive or non-distinctive words the whole mark is likely to attract objections under Sections 9 and 10.

## ULTRO

**ULTRO** should be treated in the same manner as **ULTRA** since it will be seen and pronounced as **ULTRA** (eg **ULTROWHITE** for doors, door frames etc all being wholly or almost white in colour).

## UNI

The acceptability of a mark incorporating the prefix **UNI** (meaning 'consisting of, relating to, or having only one' - Collins dictionary) will depend on whether the word with which it is combined has a direct reference to the goods/services concerned.

When it is used alone **UNI** is generally acceptable in Part A and when used in combination with the name of the goods/services it is not open to objection eg **UNIBANKING** for banking services. Where the added element does not have a direct reference to a characteristic of the goods/services a mark will also be acceptable in Part A eg **UNICOVE** for cove adhesive or **UNIFLEX** for cables.

If the added element is descriptive of a characteristic of the goods Part B will be appropriate eg **UNIMIX** for dry-mixed building aggregates (only one mix, with water, required) or **UNICORE** for cables (having a single core).

See **MONO**

## UNIVERSITIES: FORMER POLYTECHNICS

Several universities have recently been created from former polytechnics, for example, **KINGSTON POLYTECHNIC** has become **KINGSTON UNIVERSITY**. Such universities may be unable to file evidence of use of their new name prior to the filing date. In such cases it is acceptable to file evidence in their former name and proceed 'Advertised before acceptance by reason of special circumstances section 18(1)(proviso)'. If they have a registration in the name of the polytechnic this will suffice to allow the University application to proceed by reason of special circumstances.

## 🌐 UNIVERSITIES WITHIN THE UK (WHOSE EXCLUSIVE TITLES ARE GRANTED BY ROYAL CHARTER)

The first point to be considered is whether the mark is open to objection under Section 11. If the application is made in a name other than that of the University concerned consent must be provided to the use of their name/insignia etc; failing this the mark should be refused under Sections 11 and 17(2).

When consideration is given to the mark's acceptability under Sections 9 and 10 the following points should be considered:

### 1 goods and services not associated with universities:

Where the mark consists of the name of the University itself, it may be accepted in Part A. In all cases a disclaimer of the non-distinctive word 'University' will be necessary. In addition, as the majority of university names incorporate a geographical place name; this must be disclaimed separately.

Where the mark is a variant of the applicant's official name (eg: the mark 'Scunthorpe University' applied for by The University of Scunthorpe), the mark may be accepted in Part A subject to disclaimers as above. However, as the mark does not correspond exactly with the university's title, the mark should proceed *Advertised before acceptance by reason of special circumstances*.

### 2 educational and other associated services in Classes 41 and 42:

The names of universities may only be accepted these services on evidence of factual distinctiveness. Such marks should proceed subject to disclaimers of the word 'University' and, where necessary, the geographical place name.

## 🌐 UNIVERSITIES OUTSIDE THE UK

It will be necessary to first ascertain whether the applicant is entitled to use the mark. Once this has been confirmed, the same considerations apply as above:

### 1 acceptance in Part A prima facie for goods and non-university services subject to a disclaimer of the 'University' and, where necessary, any geographical place name.

### 2 acceptance on evidence only for educational and associated services in Classes 41 and 42.

Disclaimers will be required as above.

## 🌐 USE: ACCRUING AFTER DATE OF APPLICATION

Following the **POUND PUPPIES** case (1988 RPC 529) it was argued that use of a mark accruing after the date of application could be taken into account as evidence of distinctiveness when considering objections raised under Sections 9 and 10 prima facie.

In the **POUND PUPPIES** case evidence of use was submitted in order to rebut an objection raised under Section 11; the claim being that there had been substantial user and no confusion had arisen. There was no discussion at the Hearing as to its relevance to either Part A or Part B registration.

The Registrar has sought legal advice and considered the point at issue again in the light of comments made by Buckley J. in the **ROTOLOK** case (1968 RPC 227 at page 230 lines 4-22), by Whitford J. in the **BLUE**

**PARAFIN** case (1977 RPC 473 at page 487 lines 19–25) and also in the **YORK TRAILERS** case (1984 RPC 231) where the House of Lords decisions concerned, in the main, the meaning of ‘capable of distinguishing’. In this case no comment was made on Graham J’s view of ‘evidence of distinctiveness’ (Section 10 (2)(b) at page 244 lines 12–20) and therefore that view may be taken as a correct statement of the law.

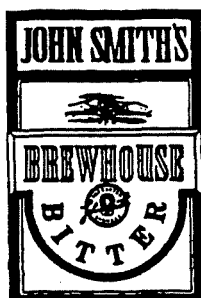
In the light of these statements on the law, the Registrar takes the view that the present practice of discounting use which occurs after the date of application in relation to factual distinctiveness or a capacity to distinguish, is correct. Should an appeal arise in connection with this matter the Registrar will request that the case be referred to the courts for decision and guidance.



## V

### ⊗ VARIATION CLAUSE

Not to be confused with series marks, a variation clause may be applied to a mark which contains the name of the goods or services for which it is to be used. Such clauses are most commonly used for marks covering food or drink. For example, the word 'bitter' appears in the label mark shown below but 'ale, stout and porter' are included in the specification in addition to bitter. The variation of the mark as shown will obviously be used only when the label is applied to bitter but the use of a variation clause will allow the words 'ale', 'stout' or 'porter' to be substituted for 'bitter' as necessary when the mark is in use.



The specification reads:

*Beer, ale, stout and porter, all included in Class 32.*

The wording of the variation clause in this case should be:

*In use in relation to goods covered by the specification other than bitter beer, the mark will be varied by the substitution of the description of such goods for the word 'bitter'.*

In addition to the name of goods a variation clause can be applied to the description of such goods. For example, in the term 'brown ale', 'ale' is the name of the goods and 'brown' is the description. If the applicants wish to use the mark on e.g. 'light ale' but 'brown ale' appears in the mark the variation clause should be worded as follows:

*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'.*

### ⊗ VARIETAL NAMES

These cannot be registered as trade marks as a genetic strain of a plant cannot also be a trade name. All word marks in Class 31 covering plants, seeds, fruit, vegetables etc must have a varietal clause imposed to state that the mark is not a varietal name (see **WHEATCROFT ROSES** 1954 RPC page 43).

It was brought to the Registrar's attention at a Hearing that a trade mark registered in Class 31 had become the proprietor's house mark and was invariably used as a prefix to any varietal name given to new stock or strains of produce. The mark had not been used as a varietal name per se, but only as part of a varietal name. In order to avoid similar cases arising in the future a revision to the standard varietal clause is necessary. With effect from 1 April 1991 all applications to which a varietal clause would apply should have the following amended varietal clause as a condition of subsequent registration.

*It is a condition of registration that the mark shall not be used as a varietal name or part of a varietal name.*

## 🌐 VILLA

**VILLA** means 'a country house or residence' and is often used in conjunction with a surname, in which this case objection should be raised if the surname is a common one (using the normal surname criteria). If the name alone would be acceptable then **VILLA** plus surname is similarly acceptable with disclaimer of **VILLA**. Care should be taken to investigate the possibility that even when the other element is not a surname, it may be a non-distinctive word in Italian or some related language; if in doubt, it may be advisable to check with the Departmental Translation Service or the relevant Embassy.

## 🌐 VINE LEAVES

See **GRAPES**.

## 🌐 VSOP

The letters **VS**, **VSOP** and **VVSOP** are generic indications of qualities of Cognac and should therefore be disclaimed in marks for alcoholic beverages.

## W

### WARE

When used in phrases such as 'Kitchen ware' or 'Computer ware', **WARE** simply means 'goods' and is therefore too vague for a description of goods in a specification.

### WEBSTERS DICTIONARY

Although use of this dictionary as a standard source of reference received judicial approval in the **ROTABRAKE** and **TARZAN** cases (1968 RPC 36 and 1969 RPC 301 respectively) in a subsequent case in the High Court (**NETWORK 90**) its use was criticised by Falconer J who took the view that the Registry should use the OED and other British publications. In another case (**DANROLL**) similar comments were made about Ralph de Sola's Abbreviations Dictionary. In each case the essence of the complaint was that American publications could not be taken as a conclusive guide to usage in this country.

The reason for using Websters is that it appears to be revised more frequently and is more comprehensive in relation to modern scientific and technical terms. In practice examiners should take care when relying solely on American publications. Words do have different meanings in English and American English (eg silencer/muffler; braces/suspenders; bedcover/comforter) and abbreviations and combining forms may not be recognised in this country. Some words will have a meaning in the USA but none at all in the U.K. If in doubt as to whether the word is used in this country a check should be made against a U.K. published source of reference and in the absence of a corresponding reference consider carefully whether the objection is a valid one.

### WORLD

The practice in respect of **WORLD**, **LAND** and **CITY** has been reviewed. In future no objection will be taken against **LAND** or **CITY** when used in conjunction with a word characteristic of the relevant goods, eg **LAND OF SPEED** or **SPEEDLAND** for computers. Objection will, however, continue to be taken under Section 9 in respect of these words plus the name of the goods eg **LAND OF COMPUTERS** or **COMPUTERLAND**.

Objection will be taken under Section 9 for **WORLD** plus a word characteristic of the goods eg **WORLD OF SPEED** for computers and under Sections 9 and 10 in respect of **WORLD** plus the name of the goods eg **WORLD OF COMPUTERS** or **COMPUTERWORLD**. In this latter case, use of the word **WORLD** in such expressions as 'In the computer world ....' or 'In the world of computers ....' is a common figure of speech.



**X**

**Ⓢ X: OR EX**

This denotes strength of beer or lager and is considered non-distinctive for such goods. No objection need be raised under Section 11 but **X** or **EX** should be removed or disclaimed.



# Y

## ● YES

This is considered to be a non-distinctive word following instances of use which traders have made of the word in the course of trading for example in advertising. Practice has varied in the past but to reflect current usage prima facie objections should in future be taken under both Sections 9 and 10. An example of use in advertising is shown below;



## ● YOG

A recognised abbreviation for YOGHURT. Objections under Sections 9, 10 and 11 are appropriate for goods which may contain YOGHURT.





