

1 THE PATENT OFFICE

Court Room 2,
13-15 Bouverie Street,
London, EC4.

2

3

Monday, 10th January, 2000.

4

5

Before:
MR. SIMON THORLEY QC
(Sitting as the Appointed Person)

6

7

In the Matter of The Trade Marks Act 1994

8

and

9

In the Matter of United Kingdom Trade Mark Application
10 No. 2,176,423 "SHOP" (Series of Six) to register a trade mark in
Classes 3, 4, 5, 6, 8, 9, 11, 12, 14, 15, 16, 17, 18, 20, 21, 22,
11 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 36, 37, 39, 41 and
42 in the name of Precis (1615) Limited

12

and

13

In the Matter of an Appeal to the Appointed Person from decision
14 of Mr. J. Hamilton-Jones under Section 76(1) of the Trade Marks
Act 1994 against the Decision dated 21st June, 1999.

15

16

(Transcript of the Shorthand Notes of Marten Walsh Cherer
17 Limited, Midway House, 27-29 Cursitor Street, London EC4A 1LT.
Telephone Number: 0171-405-5010. Fax No: 0171 405 5026)

18

19

MR. J.D. McCALL (of W.P. Thompson & Co.) appeared on behalf of the
20 Applicants/Appellants.

21

MR. A. JAMES (Principal Hearing Officer) appeared as the
22 Registrar's Representative.

22

23

J U D G M E N T
(As Approved)

24

1 MR. THORLEY: This is an appeal to the Appointed Person from a
2 decision of Mr. Hamilton-Jones dated 21st June, 1999. In that
3 decision he refused registration of a series of six marks on a
4 number of grounds.

5 Fundamental to his decision was his conclusion that none
6 of the marks were acceptable for registration having regard to
7 the provisions of sections 3(1)(b) and (c) of the Trade Marks
8 Act 1994.

9 The applicants are a company, Precis (1615) Limited, and
10 the series of marks were applied for in a large number of
11 classes.

12 On this appeal the applicants have proceeded only in
13 relation to the fifth and sixth marks. These marks are
14 similar save that in the sixth mark colour is specified. The
15 Hearing Officer concluded that the sixth mark represented the
16 applicant's best case, and Mr. McCall of W.P. Thompson & Co,
17 agents for the applicants who appeared before me, accepted
18 that this was the case. I, therefore, propose to deal, first,
19 with the sixth mark.

20 It has been common ground on the appeal before me that
21 registration stands or falls on consideration of section
22 3(1)(b). In particular, Mr. James, who appeared on behalf of
23 the Registry, waived any further objection under section 3(6).

24 The sixth mark consists of the word "SHOP" in large
25 letters with what is accepted to be a representation of an
26 exclamation mark following the word "SHOP" but elevated

1 somewhat above it. Underneath are the words THE HOME SHOPPING
2 CHANNEL, with the word THE in white on a blue background, the
3 remainder of the mark being in orange and blue; the word SHOP
4 being in orange on a blue background and the words HOME
5 SHOPPING being in blue on an orange background.

6 Both before the Hearing Officer and before me,
7 Mr. McCall contended that the combination of the words and the
8 presence of the exclamation mark, together with the colour
9 element, rendered the mark distinctive so that registration
10 should not be prevented under section 3(1)(b). He accepted
11 that the word SHOP by itself was not distinctive, and that the
12 words THE HOME SHOPPING CHANNEL were a descriptor of a kind of
13 business, but he used those latter words as part of his
14 argument in contending that their presence promoted the rest
15 of the mark -- that is the word SHOP and the exclamation mark
16 -- into references of trade mark signification.

17 There has been no use of this mark, or there is no
18 contention of any use of this mark, as at the date of
19 application. Therefore, I have to consider the prima facie
20 case under section 3(1)(b). Section 3(1)(b) provides: "The
21 following shall not be registered - (b) trade marks which are
22 devoid of any distinctive character."

23 Mr. McCall submitted before me that the word "any" was
24 important and that a mere spark of distinctiveness would be
25 enough. Mr. James suggested that this was not the correct
26 interpretation of section 3(1)(b). He contended that it was

1 necessary, having regard to the structure of the section, to
2 regard section 3(1)(b) as posing the question, "Does the trade
3 mark have the necessary character to function as a trade
4 mark?"

5 He also referred me to the decision of Robert Walker LJ
6 in Proctor & Gamble Company's Application [1999] RPC 673 at
7 680, which was cited by Mr. Hamilton-Jones. His Lordship
8 stated: "Despite the fairly strong language of
9 s.3(1)(b), 'devoid of any distinctive character' - and
10 Mr. Morcom emphasised the word 'any' - that provision must in
11 my judgment be directed to a visible sign or combination of
12 signs which can by itself readily distinguish one trader's
13 product - in this case an ordinary, inexpensive household
14 product - from that of another competing trader."

15 When one has regard to section 3(1)(b), it is, in my
16 judgment, necessary to take it in the context of the section
17 as a whole, and particularly to have regard to the fact that
18 section 3(1)(b), unlike section 3(1)(a), is conditioned by the
19 proviso to section 3. A mark which is devoid of any
20 distinctive character can, none the less, be registered if as
21 a result of use it has become sufficiently distinctive.

22 Conversely, under section 3(1)(a), a mark which does not
23 satisfy the requirements of section 1(1) -- that is a mark
24 which is capable of distinguishing goods or services of one
25 undertaking from those of other undertakings -- cannot be
26 registered even if it has acquired a distinctive character as

1 a result of use.

2 In my judgment, Mr. McCall is placing too light a
3 restriction upon section 3(1)(b) when he suggests that a mere
4 spark of distinctiveness is enough.

5 I am bound by and, with respect, agree with the
6 reasoning of Robert Walker LJ. One must have regard to the
7 mark as a whole, and ask whether the combination of signs
8 contained in the trade mark can by itself readily distinguish
9 the products or services of one trader from those of another.

10 I turn now to the facts of the present case. In his
11 argument before me Mr. McCall expanded upon his grounds of
12 appeal, but I think it is fair to say that his arguments are
13 encapsulated in paragraphs 4 and 5 of those grounds of appeal,
14 which read as follows: "It is submitted that the applied for
15 mark, as a whole, does have sufficient distinctive character
16 to qualify for registration. The individual elements of the
17 mark may be considered non-distinctive because of their
18 generic or descriptive nature, but the combination of the
19 various elements in the mark i.e. the word SHOP, the
20 exclamation mark at a 2 o'clock position to the word SHOP, the
21 words THE HOME SHOPPING CHANNEL, the colours blue and orange
22 and the emphasis on the word THE by showing it in white on a
23 blue background combine to form a registerable mark. The
24 presence of the words 'THE HOME SHOPPING CHANNEL', determine
25 the meaning of the word SHOP within the mark as a whole,
26 making it quite clear that what appears above is a title or

1 badge of identification, rather than an exhortation to shop,
2 as proposed by the Registrar. The fact that the exclamation
3 mark appears at a 2 o'clock position to the word SHOP and not
4 on the same line as the letters S, H, O and P, as one would
5 expect in normal text, is a vital clue in alerting the viewer
6 to the fact that SHOP is being used, not in its ordinary
7 sense, but in a trade mark sense. Use of otherwise
8 non-distinctive symbols can, if shown in unusual ways,
9 immediately promote an ordinary word into a trade mark. It is
10 the unusualness, or the unexpected manner of use, which
11 consumers have learned to identify as being fanciful and which
12 can render what are apparently commonplace words into badges
13 indicating origin. In fact often it takes very little added
14 matter to render a commonplace word into an immediately
15 recognisable trade mark.

16 "(5) The applied for mark is used to identify a home
17 shopping channel which is broadcast on television. There are
18 only a handful of shopping channels on cable and satellite TV
19 at the moment. The Appellant's shopping channel is selected
20 from a list of channels. It is immediately obvious to the
21 viewer that the word SHOP! THE HOME SHOPPING CHANNEL is a home
22 shopping channel identified by the word SHOP!"

23 I deal first with the contention that the appellant's
24 shopping channel is selected from a list of channels and that
25 it is immediately obvious to the viewer that SHOP! THE HOME
26 SHOPPING CHANNEL is a home shopping channel identified by the

1 word SHOP! I do not believe I can take this into account.
2 This is not a case where evidence of use is being relied upon.
3 I have to consider the notional and fair use of this trade
4 mark and ask myself the question whether, on a notional and
5 fair use upon the goods applied for, this mark has the
6 necessary capacity to distinguish?

7 The argument put forward correctly exhorts me to have
8 regard to this mark as a whole and not to dissect it into its
9 individual integers. Equally, I cannot ignore that the
10 primary features of the mark are the ordinary English words
11 SHOP! and THE HOME SHOPPING CHANNEL, which Mr. McCall, quite
12 correctly, accepted by themselves were not distinctive.

13 In his decision, Mr. Hamilton-Jones correctly, in my
14 view, considered the elements of the mark and then considered
15 the mark as a whole. What he said was this: "The mark
16 consists of several elements. Firstly, there is the word
17 'Shop' presented in a large typeface and to the top right of
18 this word is the device that, in my view, closely resembles an
19 exclamation mark. Directly below this word are the words 'The
20 Home Shopping Channel' which are presented in a smaller
21 typeface. The mark is presented in three colours which are
22 claimed as an element of the mark.

23 "In my view the words contained in the mark are the most
24 prominent feature of it and the meanings of them are well
25 known. It seems to me that the combination and presentation of
26 these words is one that indicates that the applicant provides

1 or intends to provide a television shopping channel from which
2 the public can purchase goods and services. The enlargement
3 of the word 'Shop' is likely to be taken as an exhortation to
4 shop via the applicant's home shopping channel. It follows
5 from this, in my view, that other traders may also wish to use
6 such a combination in relation to goods and services which are
7 sold or provided by such a television channel, for example, on
8 promotional material.

9 "However, I must, of course, consider the mark as a
10 whole before deciding whether it is devoid of any distinctive
11 character. In doing so I need to take account of the presence
12 of the device and colour elements and whether the combination
13 of these and the words result in a distinctive trade mark.

14 "Turning first to the device element, this, as I have
15 already mentioned, appears to me to closely resemble an
16 exclamation mark and I think it extremely likely that this is
17 how it would be regarded by anyone looking at the mark.
18 Indeed, this is how the device was described by Mr. McCall at
19 the hearing. An exclamation mark is, of course, commonly used
20 after exclamations. In the context of this mark, it is my
21 view that this sign is being used to emphasise that the
22 purpose of the services being provided is to enable people to
23 shop. I do not consider that the raised position of the
24 device detracts from this.

25 "As regards the colours contained in the mark, I do not
26 consider that there is anything particularly distinctive about

1 these colours or about the way in which they are presented.
2 Advertisements in promotional material or for that matter on
3 television are often in colour. The colours blue and orange
4 (the white being mere background) are no more distinctive than
5 any other two colours. Further, the colours are presented
6 mere background to the words."

7 Mr. Hamilton-Jones went on to cite from the passage in
8 Robert Walker LJ's judgment in the Proctor & Gamble case and
9 concluded that the dominance of the word SHOP and the words
10 THE HOME SHOPPING CHANNEL was too great and that, therefore,
11 the mark could not be registered.

12 I cannot fault the approach of the Hearing Officer as a
13 matter of law. He considered the prominent features of the
14 mark but made sure that he considered the mark as a whole. He
15 concluded that the descriptor THE HOME SHOPPING CHANNEL did
16 not, as Mr. McCall submitted, serve to elevate the word SHOP
17 and the exclamation mark into trade mark significance. He
18 concluded that it was an exhortation to use the channel to
19 shop. In this respect, I agree with the Hearing Officer and
20 not with Mr. McCall.

21 To my mind, there is insufficient material of a
22 non-descriptive nature in this trade mark for it to qualify
23 for registration having regard to the provisions of section
24 3(1)(b). The test is not that there should be a mere spark of
25 distinctiveness, but even if that were the test, I am doubtful
26 that this mark contains such a spark.

1 Mr. James pointed to the fact that this mark as applied
2 for as a series of marks with the fifth mark where colour does
3 not feature, and suggested, therefore, that colour was not a
4 material factor in this mark. I cannot accept that as a
5 matter of law. If I were satisfied that the sixth mark were
6 registerable and the fifth mark was not, it would be proper to
7 allow registration of the sixth mark only. It does, however,
8 I think, indicate that the colours themselves are not
9 considered to be particularly distinctive. Indeed, blue,
10 orange and white are regularly used as colours.

11 This leaves only, to my mind, the rather odd exclamation
12 mark, but I am not satisfied that that, in the context of this
13 mark, is in any way sufficient to elevate the sign into a
14 registerable trade mark.

15 For these reasons, I will dismiss the appeal, but before
16 doing so I should make some observations on some precedents
17 which were put forward by Mr. McCall suggesting that there was
18 a consistent practice in the Registry in relation to word
19 marks containing the word SHOP in allowing registration in
20 circumstances not dissimilar to the case before me. In
21 particular, he drew attention to three marks registered in
22 1987, each of which was for the words "SHOP ELECTRIC". It is
23 fair to say that there is a disclaimer in all of those marks
24 for the words SHOP and ELECTRIC, but there is no indication on
25 the documents before me that the marks were registered as a
26 result of use.

1 He also drew attention to a mark SHOPNET for computer
2 terminals, a mark EuroShop for the conducting of fairs, and
3 the mark ESHOP for scientific apparatus and instruments.

4 It is not for me on this appeal to indicate whether or
5 not, in my view, those marks should have been registered. I
6 do not, in any event, have any information as to the extent to
7 which there was any evidence of use. On an appeal, my duty is
8 to consider the mark applied for and only the mark applied
9 for. If, as a result of a decision of this Tribunal, the
10 Registry is minded to alter its practice, that is a matter for
11 them.

12 For the reasons given, I am wholly satisfied that this
13 mark, without evidence of use, should not be registered as it
14 falls foul of section 3(1)(b). The appeal will, accordingly,
15 be dismissed. In accordance with the usual practice, there
16 will be no order as to costs.

17 MR. JAMES: I was not going to ask for any costs.

18 MR. McCALL: Thank you.

19
20
21
22
23
24
25
26