

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2162087
BY ROBERT McBRIDE LIMITED
TO REGISTER A SERIES
OF TRADE MARKS IN CLASS 3**

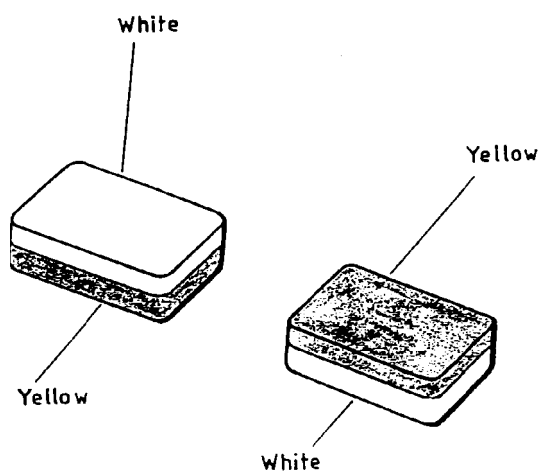
**IN THE MATTER OF
APPLICATION NO. 2162087
BY ROBERT McBRIDE LIMITED
TO REGISTER A SERIES OF TRADE MARKS IN CLASS 3**

BACKGROUND

1. On 25th March 1998, Robert McBride Ltd of Middleton Way, Middleton, Manchester M24 4DP applied for the registration of a series of two trade marks in Class 3 for the following goods:

Cleaning preparations; bleaching preparations; dish washing powders; textile washing powders; rinsing agents; all in tablet form.

2. The marks for which registration is sought, are represented below:



The applicants indicate that the marks are three-dimensional and a claim is made to the colours yellow and white as shown above.

3. The examination report was issued on 23rd April 1998 and an objection was taken, among others, to the application under Section 3(1)(a) of the Act because the marks are not

graphically represented and consist of a representation of the goods and are not capable of distinguishing goods of one undertaking from those of other undertakings.

4. On 18th November 1998, following arguments made in correspondence, the examiner wrote to the applicant's trade mark agent, Marks & Clerk, and waived the graphic representation objection.

5. On 7th October 1999, Marks & Clerk pointed out that on parallel applications made in respect of similar marks, objections had been raised under Section 32(2)(d) of the Act on the grounds that the marks had not been clearly and unambiguously recorded. The question of whether the same objection would arise on this application was posed and if so, a hearing would be requested at which it would be argued that the application should retain its original filing date. In the same letter, the colour yellow in the marks was defined by reference to the Pantone numbering system.

6. The registrar responded to Marks & Clerk on 12th October 1999 explaining that when the application was originally filed (25th March 1998) the marks failed to satisfy the requirements of Section 32(2)(d) of the Act and therefore the date of application would be changed to 7th October 1999. Although not stated, this is in accordance with Section 33(1) of the Act - the date on which the colour yellow was clearly defined, and consequently, the date the marks were properly represented. A hearing was offered to allow the applicant the opportunity to argue that the application should retain its original filing date.

HEARING AND GROUNDS OF DECISION

7. The hearing subsequently took place before me on 11th April 2000. The applicant was represented by Mr K Hodkinson of Marks & Clerk. Having considered Mr Hodkinson's submissions, the objection under Section 32(2)(d) of the Act was maintained and I decided that the date on which this application complied with the requirements of Section 32(2)(d) of the Act was 7th October 1999. In accordance with Section 33 of the Act, the filing date was deemed to be 7th October 1999.

8. Although various objections have been taken against the marks, this statement of grounds is concerned only with the date on which the registrar has decided to accord to this application.

9. Subsequent to issue of the examination report, the question of what is (and what is not) an acceptable graphical representation of novel trade marks has continued to develop and a number of decisions have been issued which have provided guidance on this point.

10. Following the decision of Geoffrey Hobbs QC in *Ty Nant Spring Water Ltd's trade mark Application* [2000] RPC 55, the Registrar changed her practice in relation to marks which were not clearly defined and a Journal Notice to this effect was published in Trade Marks Journal 6291 on 25 August 1999. The gist of the change was that the question of whether or not a sign was adequately represented for the purposes of registration primarily fell to be determined under Section 32(2)(d) of the Act, and that in line with the Appointed Person's directions in the *Ty Nant* case, the Registrar would revisit other applications facing similar objections under Section 1(1) and 3(1)(a) of the Act and re-raise the issue as a filing deficiency objection under Section 32(2)(d).

11. Section 76 of the Act states that:

“An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules.

For this purpose “decision” includes any act of the registrar in exercise of a discretion vested in him by or under this Act.”

This appears to me to be wide enough to include a decision made by the Registrar about the sufficiency of a representation of a trade mark for the purposes of Section 32(2)(d). In my view the applicant is entitled to challenge the Registrar's decision on this point.

12. Section 32(2) and Section 33(1) of the Trade Marks Act 1994 and Rules 11 and 62(3) of the Trade Mark Rules 1994 (as amended), which were the rules in force at the time of the

hearing, read as follows:

- 32.** - (1)
- (2) The application shall contain-
- (a) a request for registration of a trade mark,
- (b) the name and address of the applicant,
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
- (d) a representation of the mark.
- 33.** - (1) The date of filing an application for registration of a trade mark is the date on which documents containing everything required by section 32(2) are furnished to the registrar by the applicant.

The relevant paragraphs of Rule 11 read:

- 11** - Where an application for registration of a trade mark does not satisfy the requirements of section 32(2), (3) or (4) or rule 5(1) or 8(2) the registrar shall send notice thereof to the applicant to remedy the deficiencies or, in the case of Section 32(4), the default of payment and if within two months of the date of the notice the applicant-
- (a) fails to remedy any deficiency notified to him in respect of section 32(2), the application shall be deemed never to have been made.

13. In determining whether an application contains a representation of the mark within the meaning of the Act, I am guided by the decision of Geoffrey Hobbs QC sitting in his role as the Appointed Person in the *Ty-Nant Spring Water Ltd's trade mark application* [2000] RPC 55. After considering related decisions in *CREOLA Trade Mark* [1997] RPC 507, Case R4/97-2 *Antoni & Allison's Application* [1998] ETMR 460, Case R7/97-3 *Orange Personal Communications Ltd's Application* [1998] ETMR 460 and the decision of Mr Simon Thorley

QC (also sitting as the Appointed Person) in *Swizzels Matlow Ltd's Application* [1999] RPC 879 and Case R156/1998-2 *Venootschap onder Firma Senta Aromatic Marketing's Application* [1999] ETMR 429, Mr Hobbs reached the following conclusions:

(1) that the process of examination cannot begin until the registrar has been provided with a “representation” of the sign for which registration is sought (Section 32(2)(d));

(2) thereafter the scope for amendment of the filed representation is strictly limited, and can only be made if the amendment does not substantially affect the identity of the trade mark (Sections 39 and 44 of the Act refer);

(3) this indicates that a representation filed under Section 32(2)(d) must, from the outset, disclose the identity of the sign which is said to be registrable and which may in due course be accepted for registration;

(4) it must do so graphically because that is the only form of representation that can be entered in the register which the registrar is required to maintain under Section 63 of the Act;

(5) the degree of precision with which the sign is represented must be sufficient to permit full and effective implementation of the provisions of the Act relating to absolute unregistrability (Section 3), relative unregistrability (Section 5), infringement (Section 10) and public inspection of the register (Section 63). These provisions call for a fixed point of reference; a graphic representation in which the identity of the relevant sign is clearly and unambiguously recorded;

(6) that the scheme of rights and liabilities established by the Act cannot be implemented fully and effectively in relation to a graphic representation which fails to disclose the identity of the sign it purports to represent or to do so clearly and unambiguously.

14. Mr Hobbs QC concludes that where a sign fails to satisfy the requirements of (3) to (5) above:

“ such representations are, in my view, incapable of fulfilling the legal and administrative requirements of the Act and therefore cannot be accepted under Section 32(2)(d)”.

15. With this background to the development of case law in relation to graphical representation established, I now go on to consider Mr Hodgkinson’s submissions at the hearing.

16. Mr Hodgkinson said he was aware of the registry statements which led to change in practice affecting this application. In his view, the registrar should have granted a period of time in which to allow the applicant to supply the Pantone number and retain the original filing date. When the application was filed, it was made in accordance with practice in force at that time. There was nothing in the *Ty Nant* decision that dealt with this point and there was no judicial mandate which compelled the registrar to implement the practice in the way she did.

17. Mr Hodgkinson sought to distinguish the mark in this application from that in the *Ty Nant* decision. The applicant’s mark was clearly represented and the question of colour was one of tone. Moreover, in this particular case, there was no expansion of rights but a reduction (in the same way that an application involving a series of marks could be amended after filing).

18. Mr Hodgkinson said that no third party’s rights would be prejudiced by granting the original filing date and the applicant’s rights ought not to be prejudiced by imposing the amended filing date. The applicant had experienced delays of up to six months since the practice change before the objection under Section 32(2)(d) was raised - this had prejudiced them since intervening applications had been filed by other parties.

19. Mr Hodgkinson said that the registrar’s practice was inconsistent with that of OHIM and several European Union countries. For example, the BENELUX accepts claims which are no

longer acceptable under UK practice and OHIM have taken marks to be represented graphically where the colour is defined in words only (but not by reference to a colour standard).

20. Mr Hodgkinson emphasised that in his view the *Ty Nant* decision and comments made therein were not applicable to the present application, the registrar's practice was wrong because it was in breach of natural justice and that practice was inconsistent with that of OHIM and the Directive.

21. The resulting situation of the application being accorded a later filing date might, on the face of it, appear harsh. However, I take the view that the registrar had no option other than to require the applicant to further define the subject matter of the proposed registration. The colour yellow is imprecise and open to subjective analysis of the beholder. It could be applied to some colours that others could interpret as cream, lemon or even orange. This is particularly important where, as here, the colour is a main feature of the mark.

22. It is clear from *Ty Nant* decision that the registrar should not have given this application a filing date of 25th March 1998. Mr Hobbs QC said (at page 60, line 55):

“It nevertheless appears to me that an application for registration of a sign which may be “capable of being represented graphically” within the meaning of section 1(1) of the Act remains incomplete (and therefore subject to the operation of rule 11 of the Trade Marks Rules 1994) unless and until the applicant has filed a graphic representation for the sign which is sufficiently precise to be susceptible of examination with a view to registration in the form in which it is filed. Rule 11 (as amended) provides that “Where an application for registration of a trade mark does not satisfy the requirements of Section 32(2)... the registrar shall send notice thereof to the applicant to remedy the deficiencies.... and if within two months of the date of the notice the applicant - (a) fails to remedy the deficiency notified to him in respect of section 32(2), the application shall be deemed never to have been made....”.

Section 33(1) of the Act deals with the position where compliance with the

requirements of Section 32(2) are furnished to the registrar by the applicant. If the documents are furnished on different days, the date of filing is the last of those days. I do not accept the submissions made on behalf of the applicant at the hearing before me to the effect that the filing of an inadequate representation is not a deficiency which an applicant be required to remedy in accordance with these provisions of the Act and the Rules.”

23. It is clear from the *Ty Nant* decision that the registrar was directed to raise a Section 32(2)(d) objection on an application that been filed some years previously. This suggests that a potential prejudice to the applicant cannot and should not result in the registrar knowingly accepting an application that she believes does not meet the requirements for registration under Section 37 of the Act.

24. The applicant has now accepted the requirement for the colour yellow to be better defined and under Section 33(1) of the Act, the date of filing of an application is the date on which documents containing **everything** required by Section 32(2) are furnished to the registrar by the applicant. In my view, since the Pantone number was not added until 7th October 1999, the applicant only furnished everything necessary under Section 32(2) on that date.

25. Concerning the question of amending the application by introducing a Pantone reference, because the marks were not defined with sufficient precision from the outset and since the application could not be accorded a filing date, there was no application to amend until 7th October 1999. Section 39(2) of the Act may only come into play when there is an application which meets all the requirements of Section 32(2).

26. The delay in raising the objection under Section 32(2)(d) objection is regretted. At the time many applications had to be revisited in order to check on whether they complied with the revised practice and in some cases delays occurred.

27. Regarding the registrar’s practice at the time of filing, this was set out in Trade Marks

Journal no 6169 on 2nd April 1997. The relevant parts of the notice state:

COLOUR TRADE MARKS

1. *It is recommended that applications to register a sign consisting of :-*

- a) colour(s) applied to goods, their packaging or to advertising or business premises*
- b) a device and/or word in colour(s)*

- should be filed with the trade mark in the appropriate colour(s).

2. *In the case of signs in category “1 a)” above the colour(s) may be represented by inserting a specimen of the relevant colour(s) in box 2 of form TM3.*

3. *Where a representation of the trade mark is filed in colour(s) it will not normally be necessary to define the colour(s) by reference to any colour standard.*

4. *However, the Registrar will not object if colour(s) are represented in words, provided that the colour(s) is (are) properly defined by a widely known and readily available colour standard.*

For whatever reason, the applicant did not from the outset specify the colour by reference to a colour standard and this resulted in an objection being raised initially under Section 3(1)(a), which was later replaced by one under Section 32(2)(d). Accordingly, the original filing was not in line with the registrar’s practice at that time.

28. With regard to the OHIM practice in these type of cases, I take the view that the Second Board of Appeal’s decision in the *Orange Personal Communications Ltd’s Application* [1998] ETMR 460 decision is analogous to the present case. In the *Ty Nant* decision (57 RPC 2000 at line 36) Mr Hobbs QC, referring to the Board of Appeal decision, said:

“The question..... was whether an application for registration which purported to identify a colour mark by use of nothing more than the word “orange” could be

accorded a filing date under article 27 of the Community Trade Mark Regulation (equivalent to section 31(1) of the 1994 Act). The Third Board of Appeal of the Community Trade Marks Office decided that the word “orange” was not sufficiently precise to be a representation of a colour for the purposes of article 26(1)(d) of the Community Trade Mark Regulation (equivalent to section 32(2)(d) of the 1994 Act) and that the application did not qualify for a filing date until it had been particularised by the filing of a graphic representation of a particular shade of the colour orange on a separate sheet of paper. The Board observed that the original application was deficient because “an uncountable number of different colour shades, ranging in the specific case from dark to light and from the yellowish to the reddish tone, are conceivable which would all fall under the wide generic term “orange”.

29. For the reasons indicated, I have come to the conclusion that the representation of the mark filed on 25th March 1998 does not satisfy the requirements of Section 32(2)(d) of the Act. The applicant corrected the deficiency in the application on 7th October 1999 and therefore I have accorded this date to be the date on which the application was filed.

Dated this 8 day of February 2001.

**Charles Hamilton
For the Registrar
The Comptroller General**

