

BACKGROUND

1. On 10 January 2008, eSay Solutions Limited of Salford University Business Park, 38 Winders Way, Manchester M6 6AR (“the applicant”) applied to register trade mark number 2476683 under the provisions of the Trade Marks Act 1994. The mark consists of the letter and word “e say” presented in a stylised fashion as shown below:



2. The mark was applied for in classes 9, 38 and 42. The specifications presented on the application form read:

Class 9: All

Class 38: All

Class 42: All

3. An examination report was issued on 22 January 2008, in which earlier rights were raised under section 5(2) of the Trade Marks Act 1994 against classes 9, 38 and 42. In classes 9, 38 and 42, specification objections under Rule 8(2) were also raised in respect of the term “all”.
4. No response to the examination report was received from the applicant by the deadline of 22 March 2008.
5. The examiner responded by official letter, issued 10 July 2008, reminding the applicant that we were still awaiting a response to the examination report.
6. No response to the official letter was received by the deadline of 10 September 2008.
7. A formal notice of refusal was issued 29 September 2008. The Office then received a form TM5 dated 22 October 2008. As a result of accepting this form, I am now required under section 76 of the Act and rule 62(2) of the Rules to state in writing the grounds of the Registrar’s decision and the materials used in arriving at it.

DECISION

8. The applicant did not make any submissions with the form TM5. As a consequence, I must make my decision solely on the basis of the examination report and the official letter prior to the application being formally refused.
9. Although the examiner reminded the applicant that we still awaited a reply nothing was forthcoming and the formal refusal issued.
10. The grounds for objection to the application are under the terms of rule 8(2)(b) of the Trade Marks Rules 2000. If the objection raised under this section of the secondary legislation was not justified, then final refusal of the mark under section 37(4) of the Trade Marks Act 1994 should not have been issued.
11. Rule 8(2) of the Trade Marks Rules 2000 reads as follows:
 8. – (2) Every application shall specify –
 - (a) the class in Schedule 4 to which it relates; and
 - (b) the goods or services which are appropriate to the class and they shall be described in such a way as to indicate clearly the nature of those goods or services and to allow them to be classified in the classes in Schedule 4.
12. In the context of rule 8(2), which confirms the obligation on the part of the applicant to provide specifications which clearly indicate and describe the goods and/or services intended for coverage, reference must also be made to section 37(4) of the Act which states the following:
 37. – (4) If the applicant fails to satisfy the registrar that those requirements [for registration] are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.
13. In its introductory paragraphs under section 1(1), the Act confirms the minimum criteria required for a sign to be considered a trade mark. *Inter alia*, the sign must be “capable of distinguishing the goods or services of one undertaking from those of other undertakings”. It is implicit in this statement that, in order for any mark to be capable of distinguishing goods or services, one must be aware of what those goods or services actually are. The examiner’s refusal of this application under section 37(4) (pursuant to rule 8(2)) is based upon the Registrar’s belief that classes 9, 38 and 42 listed at paragraph 2 do not constitute a description or clear indication of those goods and services intended for coverage via registration of the trade mark application in suit.

14. For those reasons, I conclude that the classes 9, 38 and 42 specification listed in 2476683 do not comply with the requirements of rule 8(2)(b) of the Trade Marks Rules 2000 (as amended) as they fail to provide a clear indication of the nature of the goods and services intended for coverage. The application also therefore fails to meet the requirements set out in section 1(1) of the Trade Marks Act 1994 and is hereby refused under section 37(4).

Dated this 18 day of February 2009

Angela Davies