

O-377-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2513140
BY DR MOHAMMED FARAKH KAMRAN
TO REGISTER A SERIES OF 6 TRADE MARKS

TRADE MARKS ACT 1994

**IN THE MATTER OF application
No 2513140 by Dr Mohammed
Farakh Kamran to register a
series of 6 trade marks**

Background

1. On 6 April 2009, Dr Mohammed Farakh Kamran applied to register the following as a series of six trade marks:

GENETIC SIGNATUTE
GENEtic SIGNATUTE
GENEtic sigNATUTE
GENETM SIGNATURE
GENETM SIGTM NATURE
GENETM SIGNATURE

2. Registration was sought for the following goods and services:

Class 9

Analytical apparatus; educational apparatus; medical, scientific, biological, chemical, genomic, diagnostic, forensic, measuring, and data processing apparatus, devices and instruments relating to entering, collecting, transmitting, processing and presenting data, particularly information, evidence and images; apparatus, devices and instruments for identifying, sequencing, analysing, measuring, and/or recording data relating to DNA or other biological molecules or structures for non-medical purposes that include generating customised artwork based on the analysis or interpretation of biological material; apparatus, devices and instruments for identifying, sequencing, analysing, measuring, and/or recording data relating to DNA or other biological molecules or structures for research, scientific, pathway analysis, and medical purposes as well as the generation of artwork; devices including gene chips, protein chips, chemical chips used to detect and measure biological variation, including DNA sequence and gene expression variations; apparatus for microfabrication; microarray slides; glassware; vials and microvials; microtitre plates; cuvettes and test cells; bioinformatics apparatus and instruments; and parts and fittings for the aforesaid goods; measuring devices; measuring apparatus by standard measuring units; precision measuring machines and instrument; automatic control machines and instruments; material testing machines and instruments; multimedia apparatus and instruments; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing text, images, signals, software, information,

data and code, including for communication devices such as mobile phones, personal digital assistance and portable data storage devices; photographic apparatus and instruments; telecommunications apparatus including intercoms, automatic switching apparatus for telecommunication, manual switching apparatus for telecommunication; video telephones; mobile telephones; cordless telephones; combination mobile telephones and wrist watches; combination pagers and wrist watches; pagers; wire communication apparatus; apparatus that monitors, documents and records visual and audio signals, which includes apparatus that identifies individuals and is able to distinguish between individuals; audio frequency apparatus; optical devices and instruments; handheld data terminals; GPS receivers and transmitters; radar detectors; mobile and portable two-way radios; remote control units for electronic equipment; household electrical apparatus and instruments; electrical or electronic panels and columns for signalling, billposting, information, communication and advertising purposes illuminated or not, with moving or stationary display, illuminated signs, illuminated tubes for advertising purposes, illuminated or mechanical signalling, interactive terminals as information sources to the public; card readers; personal robots; databases, personal information databases, and bioinformatics databases; sound and image carriers, in particular optical storage media containing scientific and or personal images and data; digital and magnetic data carriers of sound and/or images; compact discs; DVDs; video tapes; cassette tapes; slide film mounts; encoded video discs and tapes containing picture; digital audio cassettes; exposed slide films; memory cards, sim cards, smart cards; smart cards, all bearing DNA profile and biometric information; non-printed publications; non-printed, magnetic, optical and electronic publications; information and retrieval systems; audio and visual recordings and media including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; electronic publications, including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; downloadable from databases or the internet audio and visual recordings and media including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; downloadable from databases or the internet media including electronic publications, including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; downloadable electronic competitions; downloadable computer programs for playing in the field of game; vending machines (automatic distribution machines); word processors; calculators; computer hardware for storing DNA profile and biometric information on smart cards; hand held computers; desktop computers; portable computers; laptop computers; computer peripherals; computer monitors; computer keyboards; computer printers; laser printers; digital signal processors; light emitting diode (LED) displays; liquid crystal diode (LCD) displays; scanners; computer software; downloadable computer software; computer software used to manipulate and visualise data from analysis of biological material and its derivatives; computer software for use in biotechnological research, including database management used

for distributing, manipulating and visualising biological analysis and chemical analysis data and for publishing text, images, annotations and analytical results and interpretations of thereof; computer software for manipulation, analysis and visualisation of biological and chemical data associated with the screening of chemical compounds on biological material in high through put screening (HTS) experiments; computer programs, computer software for use in genetic, medical, diagnostic, and scientific analysis and research as well as the production of general, custom, and bespoke works of art, including but not limited for use in analysing, detecting, quantifying, and sequencing polypeptides and polynucleotides, including polypeptide variants, polynucleotide variants, genetic mutations, single nucleotide polymorphisms, haplotypes and heterozygosity for the identification of diseases and disorders, the likelihood and potential of developing diseases and disorders, as well as the production of images, pictures, artwork, art, general art, customised art, and personalised art; computer software, computer hardware and computer firmware, particularly relating to DNA screening, DNA profiling, DNA analysis, pathway analysis, consideration of DNA evidence and DNA records; parts and fittings for all the aforesaid goods and services; computer software for accessing, reading and copying data from other instruments and apparatus, including mobile phones, personal digital assistance and portable data storage devices; computer software, for storage of DNA profile and biometric information on smart cards; computer software for use by healthcare professionals for decision making in the delivery of healthcare services, medical applications, and bioinformatics uses; mouse mats; mouse pads for computers; mouse for computers; mobile phone accessories; straps for mobile phones; instant cameras with films; microscopes; electron microscopes; mathematical instruments; refrigerator magnets; thermometers; household electrical apparatus and instruments; plugs; compasses; phone cards; computer workstations, comprising computer system units for reading and interpreting the sequence of genetic material; cash registers; encoded, financial, shopping, and identification cards; transponders; electronic security devices; smart cards, computer and electronic chips, and controlled access security systems; encoded security data suspended in an adhesive; secure access control systems; programmable electronic lock and security systems; security devices for premises; security monitoring apparatus for the detection of intruders; security products for protection against intrusion and theft; electronic security apparatus, devices and equipment other than for vehicles; security marking equipment; personal security apparatus including personal alarms; security apparatus, devices and equipment containing a pressurised canister for the purpose of spraying an intruder with a chemical trace which links them to the crime scene; devices that are exclusively responsive to a subset of individuals or a single individual that include electric and electronic locks for vehicles, remote keyless entry for vehicles, ignition controls for vehicles, and parts and fittings thereof; spectacles, spectacle frames, and spectacle cases; eyeglass lenses, eyeglass frames, eyeglasses and eyeglasses cases; contact lenses and cases for contact lenses; sunglasses; parts and accessories for eyeglasses and goggles; fire extinguishers; emergency (life-saving) and teaching apparatus and instruments; life nets; lifebelts; lifejackets; life-buoys; protective helmets; reflecting discs for wear; water wings (inflatable armbands and floatation devices); swimming jackets; diving suits.

Class 16

Images and works of art, art, general art, customised art, personalised art, images, illustrations, and interpretations of scientific analyses including genetic, protein based and histological analysis; images, illustrations, and interpretations of scientific analyses including genetic, protein based and histological analysis in the form of works of art; work of art produced in forms including canvas, paper, card, photographs, pictures, portraits, postcards, prints, graphic reproductions, lithography, transparencies, metals, plastics, perspex, wood, electronically generated images, computer generated images, and video capture; works of art that are framed or unframed; materials for artists; books; book covers; bookbinding material; note books; loose-leaf binders; handbooks; booklets; bookmarks; folders; plastic materials for packaging; writing instruments including markers, pens and pencils; stationary; office requisites; labels, tags and tapes; holograms and stationery items for use as product identifiers; stationery pads; paperweights; calendars; diaries; personal organisers; telephone number books; playing cards; iron-on transfers; badges; coasters of paper; decalcomanias; photographic albums; printed matter and publications; prints; photographs; paper; posters; postcards; paper banners; Christmas cards; greetings cards; birthday cards; gift cards; invitations; wrapping paper; pamphlets; stickers; flyers; magazines; newspapers; newsletters; newsletters; manuals; journals; catalogues; guide books science and genetics; fact sheets; instructional and teaching material (except apparatus); wrapping and packaging materials; advertisement boards; labels, tags and tapes; stamps; paper towels; paper handkerchiefs; facial tissues; napkins; products for carnival and party purposes.

Class 42

Biological and genetic screening for humans and animals; diagnostic biological and genetic testing services for humans and animals; gene disorder and paternity test services including the confirmation and evaluation of identity, paternity and maternity; biological and molecular biology research and development relating to predisposition to, prevention, diagnosis, monitoring and treatment of genetic disorders, cancers, coronary heart diseases, psychiatric and neurological illnesses, respiratory diseases and infections, and fungal, bacterial, viral and prion infectious diseases in humans and animals; biological and molecular biology research and development for identifying appropriate diet, medicinal and therapy regimes for sub-populations of humans and animals (particularly companion and farm animals) to improve health and wellbeing; information, advisory and consultancy services in the field of genetics and heredity variation for the biopharmaceutical industry, charities, non-profit organisations, academic institutions, public healthcare sector, private healthcare sector, clinicians, physicians, other healthcare providers, and individual customers; testing of biological samples via a network of veterinary, scientific research and diagnostic laboratories for third parties; processing and analysis of human and animal biological samples to produce works of art, general art, customised art, personalised art, and unique art specific to the analysed biological sample; scientific research and development in the field of medicine, biology, gene technology, and genetic engineering; DNA and RNA preparation and analysis services, including the detection of genetic mutations, polynucleotide variants, single nucleotide polymorphisms, haplotypes and heterozygosity for research and development as well as analysis on behalf of third parties; gene discovery and characterisation for research and development as well as analysis on behalf of third

parties; biological pathway analysis for research and development as well as analysis on behalf of third parties; gene expression studies for research and development as well as analysis on behalf of third parties; protein expression studies for research and development as well as analysis on behalf of third parties; pharmacogenetic and pharmacogenomic for research and development as well as analysis on behalf of third parties; providing third parties with computer database services and information related to the comparison and relatedness of genetic data from groups of individuals, genealogy, and medical condition information for drug discovery, medical diagnostic, medical therapeutic purposes and for the management of health services; forensic analysis services; scientific investigation services; security printing services; presentation of evidence.

3. A number of objections to the registration of the application were raised by the UK Intellectual Property Office (“IPO”). The examination report raising these objections was sent to the applicant on 30 April 2009. In respect of the marks themselves, the six marks were not considered to be a series with each other. The first three marks shown above were considered to be a series with each other. The fourth, fifth and sixth mark shown above were not considered to be a series, either with each other or with marks one, two and/or three above.

4. In respect of marks one, two and three above, the application was considered to be acceptable. In respect of marks four, five and six above, objections were raised under the provisions of sections 3(1)(b) and (c) of the Act on the basis that “the marks consists exclusively of the words ‘genetic signature’ and gene (combined with the device of a tick) signature, being a sign which may serve in trade to designate the kind and intended purpose of the goods/services e.g. goods or services that help to identify a person or thing, by their genes or genetic signatures.”

5. A number of queries were also made in relation to some of the terms included within the specification of goods and services as applied for. I do not set these out here but shall refer to them later in this statement of grounds. As a result of the combination of the objections to the marks as a series and the objections raised under section 3 of the Act, the application was considered to be objectionable as a whole.

6. There then followed a protracted exchange of correspondence and telephone calls between the applicant and the IPO. Dr Kamran’s first letter is dated 29th June 2009. It appears this first letter was written as a follow up to a telephone conversation he had had with the examiner the previous day following his having received and considered the examination report. The file note of this conversation records that “The applicant was not convinced that [the section 3 objections apply] directly to him because he is mainly trading in works of art. I explained that the art work appears to be a design made up from a persons (sic) DNA and therefore portrays their individual genetic signature or gene signature which is descriptive. The applicant agreed to put his views in writing for me to consider further”.

7. Dr Kamran’s letter explained how he had mistyped the first three marks when completing his application form and asked to be allowed to amend them. The letter also referred to another mark “I [Heart device] NY” as a comment on the use of

devices in place of words. In relation to the objections raised under section 3 of the Act, Dr Kamran stated:

“Please note the slogan “Genetic Signature” is a Brand Name rather than a service”.

Dr Kamran’s letter went on to state:

“ Please note that ‘genetic signature’ trademark encompasses (sic) many and diverse product and furthermore the project portfolio has very little to do with genetics, as is evident for the goods and services described in classes 9, 16 and 42”.

Dr Kamran then listed various goods and services ending with the word etc. and went on to state that he could “therefore remove all goods and services that may “help identify a person or thing, by their genes or genetic signature.”

8. The IPO’s response to that letter was issued on 4 September 2009. It maintained a previous refusal to allow the amendment of the first three marks applied for. It also maintained the objection that the marks were not considered to be a series. The letter also indicated that Dr Kamran’s reference to the “I (Heart Device) NY” case had been considered but was not on all fours with the current application. In relation to the objections under section 3 of the Act, the letter indicated that mark four was now considered acceptable for all goods and services. As for marks five and six, these were considered acceptable for goods and services which “clearly do not relate to the objectionable subject matter”. The apparently incomplete list of goods and services provided by Dr Kamran in his letter of 29 June was not considered to overcome the objections and so was rejected. Dr Kamran was invited to discuss any further proposals he might wish to put forward to amend the specification of goods and services of the application so as to overcome the objections and was reminded of his right to be heard.

9. In response, sent by way of an email of 12 November 2009, Dr Kamran indicated that “I am now looking to ideally take Mark 6 through as a single mark (as opposed to a series)” and that on this basis “I would be happy to discuss the removal or amendment of any specification that directly relates to the “field of DNA” and that “it would be objectionable if specifications were vaguely linked or indirect associations were drawn any specification” (sic).

10. Later the same day, the IPO sent an email to Dr Kamran with a list of goods in classes 9 and 16 which “may be acceptable in relation to the sixth mark” for him to consider. Dr Kamran replied later the same day asking the IPO to “provide written explanations (sic) and supporting evidence for the rationale for each of the exclusions”.

11. On 19 November 2009, the IPO responded. The response stated:

“Before replying to you previously all of the specifications submitted were reviewed in full, and the revised specification submitted (as per my email of 12 November), were deemed to be acceptable in respect of the 6th mark claimed. The goods and services that were omitted were considered to be objectionable as they were either clearly linked or closely related to the field of DNA and therefore may serve in trade to designate the kind and intended purpose of the goods and services.

The mark that you have sought protection for under this application (Mark 6) is deemed to be objectionable for the reasons stated in the examination report of 30th April 2009.

A ‘gene signature’ or ‘genetic signature’ appears to be a unique characteristic pattern of genes which distinguish a person or things from one another.

In your conversation with the Examiner Ms Reeves on 28 May 2009 you stated that you did not feel that the objection raised applied directly to you as you mainly trade in works of art. Ms Reeves explained that the art work appeared to be a design made up from a persons DNA; it therefore portrays their individual genetic signature or gene signature which is descriptive.

The Act states that trade marks which consists (sic) exclusively of signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication or origin function of a trade mark (Doublemint) C-191/01, paragraph 30). This does not mean that the mark must only consist of elements that designate a characteristic of the goods in some manner. It means that, for the mark as a whole, there is sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of the goods and services in question or one of their characteristics (Ford Motor Co T-67/07).

Taking all of the information in front of me into account I am maintaining the objection under Section 3(1)(b) and (c) of the 1994 Trade Marks Act in relation to the omitted goods/services as indicated in my previous E mail of 12th November 2009.

You may provide evidence under Rule 57 of the Trade Marks Rules (2000), to illustrate how the mark is used, or intended to be used. Suitable examples may be in the form of leaflets, advertising literature, pamphlets and/or brochures showing the mark. The objection will be reconsidered in light of any examples provided.

In the absence of further evidence you may request a hearing with a senior member of the Registry in order to argue your case further.....”

12. The following day (20th November) Dr Kamran responded. He indicated:

“I cannot accept and do not understand the grounds for the removal of the specifications from the trademark application.” He asked to be provided with “specific written explanation and documented grounds for exclusion of each of the specifications”.

13. The IPO responded in a letter dated 23 November 2009. The letter stated:

“You have requested that I provide you with specific written rationale and documented grounds and all supporting evidence for exclusion of each of the specifications. My rationale follows what is laid down under Section 3(1)(b) and (c) of the 1994 Trade Marks Act as explained previously and what I have to adhere to. The mark is unlikely to be perceived as anything more than a description in relation to the omitted goods/ services that are being offered.

In class 9, the apparatus/goods could merely be used in the field of DNA. **If this is clearly not the case the goods will need to be positively limited to the area of interest to avoid the objection.**

In relation to Class 16 a large number of the goods are relating to works of art which may well be made up from a persons’ DNA and therefore portrays their individual genetic signature or gene signature. I am willing to consider any further amendments to the specification you may wish to propose.

Class 42 makes clear reference to the field of genetics and DNA and there is in my view a direct descriptive reference between the mark and the services of issue.

I am enclosing a print of the original specifications with the proposed acceptable elements highlighted. I am happy to discuss any other items claimed which you believe is likely to avoid the objection.

I am enclosing details from our work manual which explains the test under Section 3(1)(c) of the Act.

If we cannot agree on the merits of the mark in relation to the objectionable goods/ services claimed you may wish to request a hearing before a senior officer at the Registry in order to argue your case further.”

14. Following a further telephone conversation, details of which are not recorded on file, the IPO wrote to Dr Kamran again. The letter, sent 7 December 2009, explained that “the law requires us to refuse a mark that describes a good or, in an obvious

manner, designates a characteristic of the goods or services for which they are applied for” (sic). It then set out a list of the goods and services to which the objection was considered to apply.

15. Dr Kamran responded on 4 January 2010 asking: 1) for confirmation of whether the list was comprehensive and fully inclusive, 2) for confirmation that there were “no other grounds for specification exclusion” and 3) for a list to be provided of all the additional reasons why each and any of the specifications should be excluded if the already stated reasons were not comprehensive and fully inclusive.

16. The IPO replied on 8 January 2010. In short, it confirmed that the reasons for the objection set out in the response of 7 December 2009 were considered to be “sufficient to require a response from you if the objection is not to be made final”. It again reminded Dr Kamran of his right to be heard.

17. Dr Kamran responded on 5th February 2010. In a 43 page letter, he asked that the mark be registered. He stated (his emphasis):

“I already have accepted that Marks 1-6 are not registrable **as a series of 6 marks**, and I provide evidence that Marks 1-3 should now be registered as a series of three (Marks 1-3) where the typing error of “T” instead of “R” is first amended. I believe that Mark 6 is registrable as well as the additional mark I emailed to you on 27 December 2009”.

18. Dr Kamran’s letter went on to set out his explanation of the meaning of the words GENETIC SIGNATURE indicating that the term is “only appropriately used in a descriptive sense to specifically refer to a very short specific section of DNA, typically 1 nucleotide out of the billions of nucleotides in a human beings genetic makeup, **and** where there **is a proviso** that this particular small variation in the genetic code does or can (potentially) predispose (or influence) a specific outcome for an individual or a defined sub-population”. The letter also provided what he referred to as ‘evidence’ that the word GENETIC SIGNATURE is “neither [...] interchangeable with, descriptive nor subsumes any of the contested specifications.” The ‘evidence’ took the form of further arguments and submissions. Dr Kamran “respectfully suggest[ed]” that the IPO’s definition of genetic signature was “incorrect and misleading, and at best may be considered as a vague statement” but went on to say that “the take-home point here is NOT that the IPO definition is incorrect, rather the key point is that different descriptive terms ...are not interchangeable.” (again, his emphasis). He asked that the marks be registered for the requested goods and services.

19. By way of a letter dated 8 February 2010, the IPO responded. It maintained its position that marks one to three could not be amended, that mark four was acceptable for all goods and services and that marks five and six were objectionable for the goods and services set out in the earlier correspondence. That position was maintained in a further letter, dated 19 March 2010, issued as a result of another telephone conversation with Dr Kamran which took place on 16th March.

20. At this point, Dr Kamran initiated an exchange of correspondence relating to the handling of his application which, for the purposes of this statement, I do not intend to summarise other than to say he was unhappy that his 'challenges' to the objections raised against his application had not been managed properly as he still had unanswered questions. At this point, the IPO responded by letter dated 17 May 2010 to say that matters appeared to have reached an impasse and advising Dr Kamran that the appropriate way forward would be for him to request to be heard. Dr Kamran then entered into another round of correspondence regarding the handling of the case. On 16 February 2011, the IPO issued a letter refusing the application under the provisions of Section 37(4) of the Act. Dr Kamran replied on 19 February putting the IPO on formal notice that he disputed the refusal of the application. He requested a full response to his earlier questions and indicated that he "reasonably expect[s] to have discussions with an independent party to try to find a way forward".

21. The IPO responded on 1 March 2011, maintaining the refusal and reminding Dr Kamran of his options of requesting to be heard or seeking a statement of grounds which would set out the reason for the refusal. Further correspondence followed, which again I do not intend to summarise, save that it resulted in the hearing before me being appointed.

22. The hearing took place before me on 13 July 2011. Dr Kamran represented himself. It was an extremely lengthy hearing wherein Dr Kamran again initially sought to argue that the first three marks applied for should be amended. That argument was firmly rejected by me and he ultimately agreed that he wished to proceed only in respect of mark six above. Dr Kamran also indicated that amendments to the specification previously suggested by him were withdrawn and that the application should proceed to registration for all goods and services for which registration was originally applied (though he accepted that any relating directly to genetic signatures would attract objection). I therefore considered the specification afresh and in full.

23. On 20 July 2011, I issued my after hearing letter which, for the sake of completeness and expediency, is attached as Annex A to this statement of grounds. In summary, my letter confirmed Dr Kamran's request to restrict his application so that it would proceed in respect only of the sixth mark as set out in paragraph 1 above. My letter also indicated that this mark was acceptable for limited goods in classes 9 and 16 (see paragraph 20 of Annex A). With the exception of some goods included in the specification which were not accepted for other reasons (see paragraph 36 of this decision) for all remaining goods and services the mark was open to objections under section 3(1)(b) and (c) of the Act. My letter confirmed that a period of two months was allowed for Dr Kamran to supply evidence challenging my findings or to put forward, in writing, any proposed amendments to the application.

24. Whilst Dr Kamran did respond in writing within the period allowed, his letter, dated 16 September 2011, did not propose any amendments to his application nor did he file any evidence to challenge my findings. His letter did, however, include further submissions which, essentially, repeated submissions made both during the examination process and again at the hearing. I do not consider the submissions made by Kr Kamran overcome the objections and thus the application (now

restricted to the sixth mark only) is formally refused under the provisions of section 37(4) of the Act in relation to all of the goods and services of the application with the exception of the following:

Class 9

GPS receivers and transmitters; radar detectors; electrical or electronic panels and columns for signalling, billposting, information, communication and advertising purposes illuminated or not, with moving or stationary display, illuminated signs, illuminated tubes for advertising purposes, illuminated or mechanical signalling, interactive terminals as information sources to the public; slide film mounts; calculators; digital signal processors; light emitting diode (LED) displays; liquid crystal diode (LCD) displays; instant cameras with films; mathematical instruments; thermometers; plugs; compasses; transponders; spectacles, spectacle frames, and spectacle cases; eyeglass lenses, eyeglass frames, eyeglasses and eyeglasses cases; contact lenses and cases for contact lenses; sunglasses; parts and accessories for eyeglasses and goggles; fire extinguishers; emergency (life-saving) and teaching apparatus and instruments; life nets; lifebelts; lifejackets; life-buoys; protective helmets; reflecting discs for wear; water wings (inflatable armbands and flotation devices); swimming jackets; diving suits.

Class 16

Advertisement boards.

25. Dr Kamran's letter of 16 September also indicated that given my position, he wished "to have a formal Appeal hearing based on the arguments presented here, and also the continued failure of the IPO to address legitimate challenges to the objections as set out in the letter sent to the IPO (dated 5 January 2010)".

26. In view of this indication, I hereby set out the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating that the mark has acquired distinctiveness. I therefore have only the prima facie case to consider.

27. The relevant legislation is contained in section 3 of the Act and reads:

"3.-(1) The following shall not be registered-

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering services, or other characteristics of goods or services,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

28. A number of ECJ judgments have considered the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – (*Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- thus Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;
- an otherwise descriptive combination may not be descriptive within the meaning of Article 3(1) (c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied

as regards both the aural and the visual impression produced by the mark – *Koninklijke Nederland NV v Benelux Markenbureau,(Postkantoor)*, paragraph 99.

29. In *Matratzen Concord AG v Hukla Germany SA* Case C-421/04) the ECJ stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I1725, paragraph 50). “

30. I am also mindful of the decision of the General Court (formerly the CFI) in *Ford Motor Co v OHIM*, Case T-67/07 where it was stated:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics.”

31. Dr Kamran has restricted his application such that the only mark to be considered is the sixth one shown at paragraph one above. It consists of two common English words GENE and SIGNATURE. There is also a device of a ‘tick’ symbol placed immediately after the word GENE. As I indicated in my letter issued following the hearing, the tick is so small in relation to the mark as a whole that it is likely to be overlooked by the average consumer of the goods and services for which the registration is applied. Even if it were to be noticed, it may be seen as an indication of approval but it is more likely it would be seen as part of a play on words with the word GENE becoming GENETIC. In any event, as the terms GENE SIGNATURE and GENETIC SIGNATURE are used interchangeably, the mark would send the same message however it was seen.

32. A gene signature or genetic signature is a representation of the nucleotide sequences specific to individual persons or other living things, the gene expression pattern characteristic of a particular cell type or characteristic genetic traits. Whilst it is a scientific term which has a specific technical meaning, the term is also used in a vernacular sense by the lay person to refer to that which makes up the very essence of someone or something whether that be by reference to e.g. biometric information or other personal or characteristic traits.

33. Although from the papers on file it appears that at one stage Dr Kamran indicated to the examiner that he ‘mainly traded’ in works of art, I have to consider the specification of goods for which the application for registration is made. The application seeks registration for a wide range of goods and services.

34. I found that the mark attracted objections under section 3(1)(b) and (c) for those goods and services as set out in paragraphs 11, 13 and 15 of my letter issued following the hearing. The reasons for my objections were set out in paragraphs 12, 14 and 16 respectively of the same letter. In my view, the mark designates characteristics of the goods and services set out in paragraphs 11,13 and 15 and is incapable of fulfilling the 'indication of origin' function of a trade mark. The relationship between the mark and those goods and services is sufficiently direct and specific such that it would enable the public concerned immediately to perceive without further thought a description of the category or one of the characteristics of those goods and services.

35. Consequently, I have found that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind and intended purpose of the goods and services set out in paragraphs 11,13 and 15 of my letter and which is therefore excluded from registration by section 3(1)(c) of the Act. I have also found that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. I therefore conclude that the mark applied for is devoid of any distinctive character in relation to these same goods and services and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

36. For completeness, I would also state that in paragraphs 21 to 23 of my letter I raised objections to the use of various terms within the specification of goods as set out in the application. Dr Kamran has not responded to these queries and therefore the application is refused in relation to these goods for the reasons given in my letter. Consequently, they have not formed part of my consideration under section 3 of the Act.

37. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under the terms of section 37(4) of the Act for all goods and services other than those set out at paragraph 20 of my letter because it fails to qualify under sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 01 day of November 2011

**Ann Corbett (Mrs)
Principal Hearing Officer**

Annex A

Dr Mohammed Farakh Kamran
9 Chaucer Grove
BIRMINGHAM
B27 7RE

Our ref: App 2513140/Hrnngs/RL
Your ref: MFK
Date: 20 July 2011

Dear Dr Kamran,

Application No 2513140

1. I write further to the ex parte hearing which took place before me on 13th July by telephone. The matter was, exceptionally, referred to me to carry out an independent review at your request. This letter sets out a brief record of that hearing and my findings.

Series issue

2. In your original application you sought registration for a series of six marks. The initial examination report raised an objection under the provisions of Section 41(2) of the Trade Marks Act 1994 (hereafter "the Act") because the six marks were not considered to be a series with each other. The examination report went on to state, however, that:

- marks 1-3, each consisting of differing representations of the words GENETIC SIGNATURE were considered to be a series of three marks;
- no one of marks 4, 5 or 6 formed a series either with any or both other(s) nor with marks 1-3.

3. As regards marks 1-3, you had stated in correspondence received some two months after the issue of the examination report that you had mistyped these marks when completing the application form and that you intended them to be differing versions of the words GENETIC SIGNATURE. You had sought to correct your error by relying on the provisions of section 39(2) of the Act but the request had been refused.

4. At the hearing, you maintained the view that the amendment of these marks should be allowed under section 39(2)(b) of the Act as this was not subject to the limitation that followed which you submitted only referred to subsection (c) of that section. I disagreed, explaining that the limitation applied to subsections (a) (b) and

(c) of section 39. I maintained the refusal to allow amendment of marks 1-3 because in my view the amendment sought would substantially affect the identity of these trade marks.

5. Having referred to the Act yourself, you then accepted the objection and indicated that you would file a new application for marks 1-3 in the form you had intended. As I indicated, that was a matter for you to consider but you would also have to bear in mind whether, depending on the goods and/or services for which registration may be sought, such an application would also attract objections under the provisions of section 3 of the Act.

6. As regards the current application, you stated that you wished to proceed by restricting it to the sixth mark only, namely:

GENE, SIGNATURE

7. The restriction is now accepted and the following therefore relates to this mark only.

The objections raised under section 3(1)(b) and (c) of the Act against the above mark

8. Your original application sought registration for a wide range of goods and services in classes 9, 16 and 42. The examination report indicated that the mark was considered objectionable for all of these goods and services because it consists of “a sign which may serve in trade to designate the kind and intended purposes of the goods/services e.g. goods or services that help to identify a person or thing, by their genes or genetic signature”.

9. In your email of 29 June 2009, you had proposed an amendment to the specification of goods and services. Using your proposed amendments as a starting point, the official letter of 4 September 2009 accepted your argument that the mark was acceptable for “the goods/services which clearly do not relate to the objectionable subject matter”. This led to further correspondence and telephone conversations wherein attempts were made to reach agreement on an acceptable specification. No agreement was reached. You now withdrew your proposed amendment to the specification and sought to register the mark for all of the goods and services as originally claimed. That said, you indicated that you were prepared to accept that the mark would be descriptive of goods and services which directly related or led to the identification of a gene or genetic signature.

10. On the basis that your proposed amendment has been withdrawn, matters return to that as set out in the examination report. This means that the objection under section 3(1)(b) and (c) has been raised against all goods and services and it is this specification that I consider.

11. The hearing was an extremely lengthy one and, as it later became clear you were recording it without having sought prior permission or otherwise having informed me, I do not consider it necessary to set out our discussions in any detail. That said, I confirm that I have listened to everything you had to say and considered the emails to which you referred me. Having done so, I consider the mark is open to objection under the provisions of section 3(1)(b) and (c) of the Act for the following goods and services:

Class 9

Analytical apparatus; educational apparatus; medical, scientific, biological, chemical, genomic, diagnostic, forensic, measuring, and data processing apparatus, devices and instruments relating to entering, collecting, transmitting, processing and presenting data, particularly information, evidence and images; apparatus, devices and instruments for identifying, sequencing, analysing, measuring, and/or recording data relating to DNA or other biological molecules or structures for non-medical purposes that include generating customised artwork based on the analysis or interpretation of biological material; apparatus, devices and instruments for identifying, sequencing, analysing, measuring, and/or recording data relating to DNA or other biological molecules or structures for research, scientific, pathway analysis, and medical purposes as well as the generation of artwork; devices including gene chips, protein chips, chemical chips used to detect and measure biological variation, including DNA sequence and gene expression variations; apparatus for microfabrication; microarray slides; glassware; vials and microvials; microtitre plates; cuvettes and test cells; bioinformatics apparatus and instruments; and parts and fittings for the aforesaid goods; measuring devices; measuring apparatus by standard measuring units; precision measuring machines and instrument; automatic control machines and instruments; material testing machines and instruments; multimedia apparatus and instruments; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing text, images, signals, software, information, data and code, including for communication devices such as mobile phones, personal digital assistance and portable data storage devices; photographic apparatus and instruments; optical devices and instruments; databases, personal information databases, and bioinformatics databases; sound and image carriers, in particular optical storage media containing scientific and or personal images and data; digital and magnetic data carriers of sound and/or images; information and retrieval systems; audio and visual recordings and media including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; computer hardware for storing DNA profile and biometric information on smart cards; computer software; downloadable computer software; computer software used to manipulate and visualise data from analysis of biological material and its derivatives; computer software for use in biotechnological research, including database management used for distributing, manipulating and visualising biological analysis and chemical analysis data and for publishing text, images,

annotations and analytical results and interpretations of thereof; computer software for manipulation, analysis and visualisation of biological and chemical data associated with the screening of chemical compounds on biological material in high through put screening (HTS) experiments; computer programs, computer software for use in genetic, medical, diagnostic, and scientific analysis and research as well as the production of general, custom, and bespoke works of art, including but not limited for use in analysing, detecting, quantifying, and sequencing polypeptides and polynucleotides, including polypeptide variants, polynucleotide variants, genetic mutations, single nucleotide polymorphisms, haplotypes and heterozygosity for the identification of diseases and disorders, the likelihood and potential of developing diseases and disorders, as well as the production of images, pictures, artwork, art, general art, customised art, and personalised art; computer software, computer hardware and computer firmware, particularly relating to DNA screening, DNA profiling, DNA analysis, pathway analysis, consideration of DNA evidence and DNA records; parts and fittings for all the aforesaid goods; computer software for accessing, reading and copying data from other instruments and apparatus, including mobile phones, personal digital assistance and portable data storage devices; computer software, for storage of DNA profile and biometric information on smart cards; computer software for use by healthcare professionals for decision making in the delivery of healthcare services, medical applications, and bioinformatics uses; microscopes; electron microscopes; computer workstations, comprising computer system units for reading and interpreting the sequence of genetic material.

Class 42

Biological and genetic screening for humans and animals; diagnostic biological and genetic testing services for humans and animals; gene disorder and paternity test services including the confirmation and evaluation of identity, paternity and maternity; biological and molecular biology research and development relating to predisposition to, prevention, diagnosis, monitoring and treatment of genetic disorders, cancers, coronary heart diseases, psychiatric and neurological illnesses, respiratory diseases and infections, and fungal, bacterial, viral and prion infectious diseases in humans and animals; biological and molecular biology research and development for identifying appropriate diet, medicinal and therapy regimes for sub-populations of humans and animals (particularly companion and farm animals) to improve health and wellbeing; information, advisory and consultancy services in the field of genetics and heredity variation for the biopharmaceutical industry, charities, non-profit organisations, academic institutions, public healthcare sector, private healthcare sector, clinicians, physicians, other healthcare providers, and individual customers; testing of biological samples via a network of veterinary, scientific research and diagnostic laboratories for third parties; processing and analysis of human and animal biological samples to produce works of art, general art, customised art, personalised art, and unique art specific to the analysed biological sample; scientific research and development in the field of medicine, biology, gene technology, and genetic engineering; DNA and RNA preparation and analysis

services, including the detection of genetic mutations, polynucleotide variants, single nucleotide polymorphisms, haplotypes and heterozygosity for research and development as well as analysis on behalf of third parties; gene discovery and characterisation for research and development as well as analysis on behalf of third parties; biological pathway analysis for research and development as well as analysis on behalf of third parties; gene expression studies for research and development as well as analysis on behalf of third parties; protein expression studies for research and development as well as analysis on behalf of third parties; pharmacogenetic and pharmacogenomic research and development as well as analysis on behalf of third parties; providing third parties with computer database services and information related to the comparison and relatedness of genetic data from groups of individuals, genealogy, and medical condition information for drug discovery, medical diagnostic, medical therapeutic purposes and for the management of health services; forensic analysis services; scientific investigation services.

12. In my view, the mark offends against the provisions of section 3(1)(b) and (c) of the Act because it consists of the words GENE SIGNATURE along with a very small device of a tick and is devoid of any distinctive character (section 3(1)(b)) and consists exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristics of those goods and services (section 3(1)(c)). This is because they are goods and services which are or may be used or adapted to be used to identify, compare, utilise or to create a representation of the nucleotide sequences specific to individual persons or other living things, the gene expression pattern characteristic of a particular cell type or characteristic genetic traits (a “gene signature” or “genetic signature”).

13. I also consider the mark is open to objection under the provisions of section 3(1)(b) and (c) of the Act for the following goods:

Class 9

Multimedia apparatus and instruments; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing text, images, signals, software, information, data and code, including for communication devices such as mobile phones, personal digital assistance and portable data storage devices; photographic apparatus and instruments; telecommunications apparatus including intercoms, automatic switching apparatus for telecommunication, manual switching apparatus for telecommunication; video telephones; mobile telephones; cordless telephones; combination mobile telephones and wrist watches; combination pagers and wrist watches; pagers; wire communication apparatus; apparatus that monitors, documents and records visual and audio signals, which includes apparatus that identifies individuals and is able to distinguish between individuals; audio frequency apparatus; handheld data terminals; mobile and portable two-way radios; remote control units for electronic equipment; household electrical apparatus and instruments; card readers; personal robots; digital and magnetic data

carriers of sound and/or images; memory cards, sim cards, smart cards; smart cards, all bearing DNA profile and biometric information; information and retrieval systems; audio and visual recordings and media including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; vending machines (automatic distribution machines); word processors; computer hardware for storing DNA profile and biometric information on smart cards; hand held computers; desktop computers; portable computers; laptop computers; computer peripherals; computer monitors; computer keyboards; computer printers; laser printers; scanners; computer software; downloadable computer software; computer software used to manipulate and visualise data from analysis of biological material and its derivatives; computer software for use in biotechnological research, including database management used for distributing, manipulating and visualising biological analysis and chemical analysis data and for publishing text, images, annotations and analytical results and interpretations of thereof; computer software for manipulation, analysis and visualisation of biological and chemical data associated with the screening of chemical compounds on biological material in high through put screening (HTS) experiments; computer programs, computer software for use in genetic, medical, diagnostic, and scientific analysis and research as well as the production of general, custom, and bespoke works of art, including but not limited for use in analysing, detecting, quantifying, and sequencing polypeptides and polynucleotides, including polypeptide variants, polynucleotide variants, genetic mutations, single nucleotide polymorphisms, haplotypes and heterozygosity for the identification of diseases and disorders, the likelihood and potential of developing diseases and disorders, as well as the production of images, pictures, artwork, art, general art, customised art, and personalised art; computer software, computer hardware and computer firmware, particularly relating to DNA screening, DNA profiling, DNA analysis, pathway analysis, consideration of DNA evidence and DNA records; parts and fittings for all the aforesaid goods; computer software for accessing, reading and copying data from other instruments and apparatus, including mobile phones, personal digital assistance and portable data storage devices; computer software, for storage of DNA profile and biometric information on smart cards; computer software for use by healthcare professionals for decision making in the delivery of healthcare services, medical applications, and bioinformatics uses; microscopes; electron microscopes; household electrical apparatus and instruments; phone cards; computer workstations, comprising computer system units for reading and interpreting the sequence of genetic material; cash registers; encoded, financial, shopping, and identification cards; electronic security devices; smart cards, computer and electronic chips, and controlled access security systems; secure access control systems; programmable electronic lock and security systems; security devices for premises; security monitoring apparatus for the detection of intruders; security products for protection against intrusion and theft; electronic security apparatus, devices and equipment other than for vehicles; security marking equipment; personal security apparatus including personal alarms; security apparatus, devices and equipment containing a pressurised

canister for the purpose of spraying an intruder with a chemical trace which links them to the crime scene; devices that are exclusively responsive to a subset of individuals or a single individual that include electric and electronic locks for vehicles, remote keyless entry for vehicles, ignition controls for vehicles, and parts and fittings thereof.

Class 16

Writing instruments including markers, pens and pencils; stationery; office requisites; labels, tags and tapes; holograms and stationery items for use as product identifiers.

14. In my view, the above goods are those which may require the identification of a specific individual or group of individuals to operate them, if not in accordance with the strictly technical scientific interpretation of the terms gene or genetic signature, then in terms of the vernacular use of the terms as meaning referring to biometric or other personal information. The goods may, alternatively, impart or contain a gene or genetic signature, again, in either sense. I have to take into account not only what is in existence now but what is foreseeable. Goods are being developed which are accessible to the user only after that user has been identified positively by e.g. the reading of his iris or fingerprint. It is, in my view, entirely foreseeable that further protection by the identification of a gene or genetic signature, again in either sense, may be developed. Taking all of this into account, the mark offends against the provisions of section 3(1)(b) and (c) of the Act because it is devoid of any distinctive character (section 3(1)(b)) and consists exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristics of the goods (section 3(1)(c)). Your application specifically seeks registration for e.g. scientific and other technical goods and services but also seeks registration of e.g. works of art illustrating interpretations of scientific analyses and it seems implausible to me that you would apply for this mark for any of the above goods and services against which I have maintained the objections if they did not refer in some way to gene or genetic signatures.

15. I also consider the mark is open to objection for the following goods:

Class 9

Digital and magnetic data carriers of sound and/or images; compact discs; DVDs; video tapes; cassette tapes; encoded video discs and tapes containing picture; digital audio cassettes; exposed slide films; non-printed publications; non-printed, magnetic, optical and electronic publications; information and retrieval systems; audio and visual recordings and media including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; electronic publications, including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers,

and literal information in the field of art, science, medicine, and personal information; downloadable from databases or the internet audio and visual recordings and media including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; downloadable from databases or the internet media including electronic publications, including images, pictures, artwork, art, generic art, customised art, personalised art, reports, journals, periodicals, newsletters, articles, reviews, magazines, books, newspapers, and literal information in the field of art, science, medicine, and personal information; computer hardware for storing DNA profile and biometric information on smart cards; computer software; downloadable computer software; computer software used to manipulate and visualise data from analysis of biological material and its derivatives; computer software for use in biotechnological research, including database management used for distributing, manipulating and visualising biological analysis and chemical analysis data and for publishing text, images, annotations and analytical results and interpretations of thereof; computer software for manipulation, analysis and visualisation of biological and chemical data associated with the screening of chemical compounds on biological material in high through put screening (HTS) experiments; computer programs, computer software for use in genetic, medical, diagnostic, and scientific analysis and research as well as the production of general, custom, and bespoke works of art, including but not limited for use in analysing, detecting, quantifying, and sequencing polypeptides and polynucleotides, including polypeptide variants, polynucleotide variants, genetic mutations, single nucleotide polymorphisms, haplotypes and heterozygosity for the identification of diseases and disorders, the likelihood and potential of developing diseases and disorders, as well as the production of images, pictures, artwork, art, general art, customised art, and personalised art; computer software, computer hardware and computer firmware, particularly relating to DNA screening, DNA profiling, DNA analysis, pathway analysis, consideration of DNA evidence and DNA records; parts and fittings for all the aforesaid goods; computer software for accessing, reading and copying data from other instruments and apparatus, including mobile phones, personal digital assistance and portable data storage devices; computer software, for storage of DNA profile and biometric information on smart cards; computer software for use by healthcare professionals for decision making in the delivery of healthcare services, medical applications, and bioinformatics uses; mouse mats; mouse pads for computers; mouse for computers; mobile phone accessories; straps for mobile phones; refrigerator magnets.

Class 16

Images and works of art, art, general art, customised art, personalised art, images, illustrations, and interpretations of scientific analyses including genetic, protein based and histological analysis; images, illustrations, and interpretations of scientific analyses including genetic, protein based and histological analysis in the form of works of art; work of art produced in forms including canvas, paper, card, photographs, pictures, portraits, postcards,

prints, graphic reproductions, lithography, transparencies, metals, plastics, wood, electronically generated images, computer generated images, and video capture; works of art that are framed or unframed; materials for artists; books; book covers; bookbinding material; note books; loose-leaf binders; handbooks; booklets; bookmarks; folders; plastic materials for packaging; writing instruments including markers, pens and pencils; stationery; labels, tags and tapes; holograms and stationery items for use as product identifiers; stationery pads; paperweights; calendars; diaries; personal organisers; telephone number books; iron-on transfers; badges; coasters of paper; decalcomanias; photographic albums; printed matter and publications; prints; photographs; paper; posters; postcards; paper banners; Christmas cards; greetings cards; birthday cards; gift cards; invitations; wrapping paper; pamphlets; stickers; flyers; magazines; newspapers; newsletters; manuals; journals; catalogues; guide books science and genetics; fact sheets; instructional and teaching material (except apparatus); wrapping and packaging materials; labels, tags and tapes; stamps; paper towels; paper handkerchiefs; facial tissues; napkins; products for carnival and party purposes.

16. In my view the above are goods which may be in the form of or decorated with a representation of a gene or genetic signature or may have this as their subject matter. Because of this, the mark offends against the provisions of section 3(1)(b) and (c) of the Act because it is devoid of any distinctive character (section 3(1)(b)) and consists exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristics of the goods (section 3(1)(c)).

17. You will note that some of the goods for which you seek registration attract objections for more than one reason although all are based on objections under the same section and subsections of the Act.

18. In reaching my view I have considered, as you requested, the marks belonging to third parties which you referred to in your earlier email. As I explained, I do not know the circumstances which might have led to the acceptances of these marks however such matters as the style of presentation of the mark itself, the date it was filed (and the examiner's knowledge of the state of the art at that time), the particular goods and services for which registration was sought and the extent of any use made of the mark could all have played a part. I have to consider your application in its own right.

19. In my view, your mark consists of the words GENE SIGNATURE along with the device of a tick. That tick is so small in relation to the mark as a whole that it is likely to be overlooked by the average consumer of the goods and services for which you have applied. Even if it were to be noticed, it may be seen as an indication of approval but it is more likely it would be seen as part of a play on words with the word GENE becoming GENETIC. In any event, as the terms GENE SIGNATURE and GENETIC SIGNATURE are used interchangeably, the mark would send the same message however it was seen.

20. In my view, the mark is acceptable for the following goods as the mark appears to be distinctive of them:

Class 9

GPS receivers and transmitters; radar detectors; electrical or electronic panels and columns for signalling, billposting, information, communication and advertising purposes illuminated or not, with moving or stationary display, illuminated signs, illuminated tubes for advertising purposes, illuminated or mechanical signalling, interactive terminals as information sources to the public; slide film mounts; calculators; digital signal processors; light emitting diode (LED) displays; liquid crystal diode (LCD) displays; instant cameras with films; mathematical instruments; thermometers; plugs; compasses; transponders; spectacles, spectacle frames, and spectacle cases; eyeglass lenses, eyeglass frames, eyeglasses and eyeglasses cases; contact lenses and cases for contact lenses; sunglasses; parts and accessories for eyeglasses and goggles; fire extinguishers; emergency (life-saving) and teaching apparatus and instruments; life nets; lifebelts; lifejackets; life-buoys; protective helmets; reflecting discs for wear; water wings (inflatable armbands and flotation devices); swimming jackets; diving suits.

Class 16

Advertisement boards.

21. You also sought registration of the mark for the following goods and services:

Class 9

Downloadable electronic competitions; downloadable computer programs for playing in the field of game; encoded security data suspended in an adhesive;

Class 42

Security printing services; presentation of evidence.

These terms are not understood and thus, under the provisions of rule 8 of the Trade Marks Rules 2008, cannot be accepted. You may wish to explain more fully what these terms are intended to cover and/or suggest an alternative wording for further consideration.

22. Your application also seeks registration of:

playing cards;

in Class 16 however these goods are proper to class 28 which is not covered by your application. The term cannot therefore be accepted in the application as it stands although you may wish to consider filing a Form TM3A (Fee-£50) seeking to add the additional class. I should, however, warn you that these goods would also attract an objection under section 3 (1)(b) and (c) of the Act as set out at paragraph 16 above as they could also be decorated with a representation of a gene or genetic signature.

23. Finally, your application seeks registration in class 16 of:

work of art produced in forms includingperspex.....

“Perspex” is a registered trade mark of Lucite International UK Limited and cannot, therefore, be used by you to specify your intended goods. You may wish to consider replacing the word with “acrylic sheeting” though again it would attract an objection under section 3(1) (b) and (c) as set out at paragraph 16 above.

24. As indicated at the hearing, I allow you a period of two months from the date of this letter to supply evidence challenging my findings or to put forward, in writing, any proposed amendments to your application. Again I confirm that any proposed amendments would also be considered by me though you should not expect to enter protracted correspondence. If you do not respond within the period allowed, and subject to any appeal being filed, the application will proceed to registration in respect of those goods noted above which have attracted no objection.

Yours sincerely,

Ann Corbett (Mrs)
Principal Hearing Officer