

O/177/12

**In the matter of UK Trade Mark Application 2513140
in the name of
DR MOHAMMED FARAKH KAMRAN**

**In the matter of an Appeal to the Appointed Person from
the decision of Ms Ann Corbett, Principal Hearing
Officer, acting on behalf of the Registrar,
dated 1 November 2011**

DECISION

Introduction

1. On 6 April 2009, the Applicant, Dr Kamran, applied to register a series of 6 trade marks ('the Application') as follows:

GENETIC SIGNATUTE
GENEtic SIGNATUTE
GENEtic sigNATUTE
GENE_{TM} SIGNATURE
GENE_{TM} _{SIG} NATURE
GENE_{TM} SIGNATURE

2. The Application was applied for in classes 9, 16 and 42 for a wide range of goods and services. I will refer to the individual marks in the series by the number in which they appear in the above table.
3. The examination report issued on 30 April 2009 raised 3 basic issues with the application:
 - (a) The marks were not a proper series, since they differed in matters which substantially affected the identity of the trade mark, and therefore failed to comply with the requirement of s41(2) of the 1994 Act. It was noted that none of marks 3, 4 and 5 could constitute a series with any of the other marks. However, marks 1, 2 and 3 (ie the 'Genetic Signatute' marks) could properly be grouped together as a series.

(b) Marks 3, 4 and 5 were also objectionable under s3(1)(b) and s3(1)(c) of the Act, since they each consisted of the words ‘Genetic Signature’ (in the case of mark 6, the ‘tic’ element of the word ‘Genetic’ being replaced by a symbol indicating a ‘tick’). The words ‘Genetic Signature’ were considered to be a sign which may serve in trade to designate the kind and intended purpose of the goods/services for which registration was applied – ie to identify someone or something by their genes.

(c) Some technical objections to some of the terminology included in the specifications were made, and solutions proposed which would overcome these objections.

4. Following this report, there was a protracted series of correspondence and telephone calls between Dr Kamran and the Registry about the Application. For the purposes of this Appeal it suffices to note that Dr Kamran took two separate points:

(a) He explained that marks 1, 2 and 3 were mis-typed on his application form. Rather than read ‘GENETIC SIGNATUTE’, they should have read ‘GENERIC SIGNATURE’, like the other marks. On that basis, he asked for the Application to be amended accordingly.

(b) He challenged the finding that the marks were descriptive, and/or offered to amend the specifications of goods and services to delete those goods or services for which they were descriptive.

5. The Registry took the view in respect of (a) that the Application could not be amended, since the change in question substantially affected the identity of the trade mark (changing a made-up word into a real word). So far as (b) was concerned, they were prepared to allow mark 4 in respect of all the goods and services applied for, and marks 5 and 6 for certain of the goods applied for in classes 9 and 16.

6. Following further correspondence, Dr Kamran was offered a hearing. Because he had expressed dissatisfaction with the way his correspondence had been dealt with, and had asked for a hearing before someone 'independent', the Registry agreed to provide a Hearing Officer from the Tribunal Department, rather than an Ex Parte Hearing Officer as would ordinarily be the case.

7. The matter came for hearing before Ms Corbett on 13 July 2011 at which Dr Kamran represented himself. The hearing was extremely protracted. I have had the benefit of reading a full transcript of it.

8. On 20 July 2011, Ms Corbett wrote a letter to Dr Kamran setting out what she described as a 'brief record' of the hearing and the findings she had made.

9. This letter records that Dr Kamran had initially maintained his position that marks 1, 2 and 3 could be amended to read ‘GENETIC SIGNATURE’, but that following a reference to the terms of s39, he had accepted that this was not so. In paragraph 5, Ms Corbett stated as follows:

‘Having referred to the Act yourself, you then accepted the objection [to the amendment] 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.’

10. The letter went on in paragraph 6 and 7 as follows:

‘As regards the current application, you stated that you wished to proceed by restricting it to the sixth mark only.’

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

The rest of the letter dealt with the acceptability of mark 6. It ultimately concluded that mark 6 is only acceptable for certain goods in classes 9 and 16. It provided for a period of 2 months for Dr Kamran to make further submissions.

11. Following the issue of that letter, Dr Kamran made further submissions in support of his Application. A formal Decision was issued by Ms Corbett on 1 November 2011. This came to the same conclusion as that expressed in the letter of 20 July 2011. For present purposes, and for reasons which will become apparent, I should quote paragraph 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.’

The Decision concludes in paragraph 37 as follows:

‘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.’

12. On 14 November 2011, Dr Kamran wrote to the Registry in respect of the Decision, indicating that he had sought legal advice. He also

noted that he did not have the sums of money likely to be required to support legal representation to take the matter forward with respect to what he called the '*gene[tic] signature*' trade mark. Instead, he pointed out that marks 1, 2 and 3 as applied for (ie the GENETIC SIGNATURE marks) had been originally been accepted by the Registry to be a legitimate series of marks which were registrable for all the goods and services applied for (subject to minor amendments to the specifications which had been agreed). Given what he called the impracticality of pursuing the position on GENETIC SIGNATURE as a trade mark, he therefore asked to be granted a series mark for marks 1, 2 and 3.

13. By a letter of 18 November 2011, Dr Trott on behalf of the Registry refused this request. He said that Dr Kamran had indicated his intention only to proceed with mark 6, and the decision of the Hearing Officer had been given on that basis. Since the Hearing Officer was now *functus officio*, his only avenue was to appeal. He also noted that, given Dr Kamran's previous insistence that GENETIC SIGNATURE was a misprint for GENETIC SIGNATURE, there may be an issue as to whether he had any *bona fide* intention to use marks 1, 2 and 3 in the form applied for.

14. Dr Kamran therefore appealed the Decision of Ms Corbett to me as the Appointed Person, seeking only the grant of marks 1, 2 and 3.

15. Before me Dr Kamran again represented himself. The Registry was represented by Mr Nathan Abraham.

16. The situation is somewhat unusual. Although Dr Kamran is appealing the Decision of Ms Corbett on behalf of the Registry (as the Registry has required him to do), neither Ms Corbett nor the Registry has found that marks 1, 2 and 3 are not registrable. On the contrary, the Registry accepts that they are registrable as a series for the specifications of goods and services applied for (subject to the minor amendments mentioned).

17. The only reason this matter is before me at all is because the Registry takes the view that marks 1, 2 and 3 were withdrawn by Dr Kamran at the hearing of 13 July 2011 and cannot be reinstated. At my prompting, Mr Abraham accepted that the position is governed by the Trade Marks Rules 2008, Rule 28(5). This provides as follows:

‘At any time the applicant for registration of a series of trade marks or the proprietor of a series of trade marks may request the deletion of a mark in that series and, following such request, the registrar shall delete the mark accordingly.’

Section 28(6) reads

‘Where under paragraph (5) the registrar deletes a trade mark from an application for registration, the application insofar as it relates to the deleted mark, shall be treated as withdrawn.’

18. Mr Abraham accepted that the only justification he could advance for not permitting the application to proceed in respect of marks 1, 2 and 3 was that Dr Kamran had, in the course of the hearing of 13 July 2011, requested the Registry to delete all the marks in the series apart from mark 6, and that the decision of Ms Corbett amounted to such a deletion on behalf of the Registrar.

19. The question for me therefore is whether Dr Kamran did in fact request deletion under s28(5). Before considering this issue, I make three preliminary points.

20. Firstly, Dr Kamran certainly did not explicitly request that any marks be deleted from the series, whether under Rule 28 or otherwise. The most that could be argued is that his words and/or conduct amounted to an implicit request for deletion.

21. Secondly, given the finality of the consequences of deletion, a communication should in my view only be regarded as an implied request to delete where it is clear that this is what the applicant intended. A statement which is consistent with some other intention is not enough.

22. Thirdly, where one is dealing with an applicant acting in person, one should be particularly careful not to make assumptions as to what was actually intended.

23. I have read the relevant parts of the transcript of the hearing of 13 July several times. I have concluded that it is far from clear that Dr Kamran intended to delete or withdraw any marks from the application.

24. Throughout the early part of the hearing, Ms Corbett was, very properly, seeking to ensure common ground between herself and Dr Kamran as to what he wished to do with what was on any view a set of marks which could never be granted as a series. It became clear in the course of that discussion that Dr Kamran accepted that the marks could not be granted as a series. It also became clear that if he could only keep one of the marks, it would be mark 6.

25. On two occasions, Ms Corbett raised the question of the other marks in the series. First of all, on p6-7 of the transcript, the following exchange took place:

MC Okay, which one would you want to keep

DK The one with the tic

MC Right so can we proceed today on the understanding that you will withdraw these other five and proceed only with the genetic signature

DK Yes, but the thing is what I don't want to do is to go away and then go through the whole rigmarole of having to ... debate with the trademark department whether genetic signature is a legitimate mark. I'd rather have a discussion with somebody neutral....

This is certainly not a definitive request to delete or withdraw marks 1-5. Firstly, it seems that Dr Kamran did not really understand that his hearing with Ms Corbett would definitively determine the Registry's position on registrability. He is still talking in terms of 'discussion' and going back to the 'trademark department'. Secondly, the context in which the suggestion of withdrawal of marks 1-5 is made is that mark 6 should be 'proceeded with'. This is consistent with what I suspect was Dr Kamran's actual position – he would have been prepared to withdraw them if mark 6 would thereby proceed to grant (for all the goods and services he wanted to cover).

26. The second exchange occurred between pages 8-9:

DK Can I split this application and make an amendment to the split? So that way I don't lose my date

MC An amendment in what way?

DK So, split the application, so mark six goes through and then the split application is for the first three marks being a series where I correct the 't' and pay an extra fee for that amendment

MC Right, you can certainly split this application into up to six separate applications. What you will never be able to do in my view is change those first three marks into SIGNATURE instead of SIGNATUTE...the only way that you are going to get the marks that you intended the first three marks to be, is to file a separate application

DK Right, a new application?

MC A new application. There is no point, as I see it, in you applying to divide those first three marks off....

DK Okay

MC All right? So if you want GENETIC SIGNATURE, as they're presented with the 't' replaced by an 'r', then it would have to be a separate, brand new application

DK OK

MC OK?

DK Right, so we are then clear now

MC Okay...if you're happy about that, and you're happy now that we are proceeding with this application in respect of the sixth mark only – the gene with a little tic beside and the word signature, then we'll move on to discuss the goods and services. Is that Okay?

DK Yeah, that's fine but obviously, I mean the caveat...the proviso is that I fully intend to submit for a series of three with the amendment as a separate application as soon as...

27. To my mind, this is extremely ambiguous. Dr Kamran starts talking about 'splitting' the application to keep marks 1-3, so he does not have to lose his date. He is told he can do this, but not if he wants to amend marks 1-3. Ms Corbett assumes that he is only interested in dividing out marks 1-3 so he could amend them (this

is not surprising, since Dr Kamran at that stage had not said he might want to keep GENETIC SIGNATURE without amendment). However, nowhere does Dr Kamran confirm that this is the case. He may well have believed that dividing out marks 1-3 and keeping them without amendment would always be a fall-back position if nothing else was available. Certainly, nothing he says is inconsistent with such a belief. Thus, when Ms Corbett says she will proceed with the application in respect of mark 6 only, Dr Kamran may well have believed that this was simply for the purpose of the hearing, not that he was formally withdrawing the other marks altogether.

28. In all the circumstances, it seems to me that there was no proper basis for implying a request to delete marks 1-5 from the series under Rule 28(5). Dr Kamran certainly agreed that the hearing should proceed only to consider mark 6, but I do not believe that he agreed that the other marks should definitively be removed from the application. Without a request to delete, it was not open to Ms Corbett or the Registry to delete marks 1-5 or to treat them as having been deleted or withdrawn.

29. In the circumstances, I will set aside Ms Corbett's decision insofar as it amounts to a deletion of marks 1-5.

30. Before me, Dr Kamran rightly accepted that only marks 1-3 could be registered as a series, and stated that he only wishes to proceed with those marks. Mr Abraham on behalf of the Registry agreed that in the event that there had been no deletion of marks 1-3, they should be accepted for registration as a series subject to the small amendments to the specification which had previously been agreed. Marks 1-3 will therefore proceed to grant as a series, and the other marks will be deleted from the application.

31. I should also say that Mr Abraham indicated at the hearing that the Registry did not pursue their objection to registration on the ground of lack of *bona fide* intention to use marks 1-3 (as mentioned in Dr Trott's letter of 18 November 2011). In my view this was a correct concession. Lack of *bona fide* intention to use is not of course an objection to registration in its own right. It is only an objection if there is some basis for suggesting that the application was made in bad faith under s3(6) of the Act. I do not consider that Dr Kamran has acted in bad faith at any stage. There is no reason to disbelieve his assertion that marks 1-3 were originally misspelt by mistake. Having made that mistake, I cannot see why he should not later take advantage of it and decide to proceed with (and indeed use) the marks in their 'misspelt' form. If he does not use the marks in that form within 5 years, they will of course be vulnerable to an attack of non-use.

32.I do not think it necessary to issue a separate order in this case but will do so if either party requests one within the next 14 days.

**IAIN PURVIS QC
THE APPOINTED PERSON**

5 April 2012