

O-507-18

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3292774
BY CLAIR CRISTOFOLI
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 44**

Beautique
Beautique Nails & Beauty
Beauty Beautique

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3292774
BY CLAIR CRISTOFOLI
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 44**

Beautique
Beautique Nails & Beauty
Beauty Beautique

BACKGROUND

1. On 26 February 2018, Claire Cristofoli ('the applicant') applied to register the above trade marks for the following services:

Class 44: Beauty salon services; Beauty salons; Beauty treatment.

2. On 14 March 2018, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 41(2) of the Trade Marks Act 1994 ('the Act') which reads:

'There is an objection under section 41(2) of the Act, because marks 1 and 2 differ in their material particulars to mark 3.

Mark 1 consists of the plain text 'Beautique' only, whereas mark 2 consists of the plain text 'Beautique Nails & Beauty' and, mark 3 consists of the plain text 'Beauty Beautique'. Marks 1 and 2 are considered a series as the addition of the words 'Nails & Beauty' in mark 2 do not alter the material particulars significantly. However, mark 3 in relation to marks 1 and 2 is visually, aurally and conceptually different and therefore cannot be considered a series with marks 1 and 2.'

3. The examiner stated that the objection under section 41(2) could be overcome by:

'.....selecting marks 1 and 2 together or by selecting mark 3 by itself.'

4. The applicant was also notified of a similar mark that it was considered they should be made aware of.

5. In accordance with standard procedure, failure to reply to the objection under section 41(2) of the Act, within the stipulated time period which expired on 14 May 2018, would result in the application being refused under section 37(4).
6. On 18 May 2018, 4 days after expiry of the response deadline, the examiner issued a 'Failure to Respond' letter. This letter confirmed that the Registrar had not received any response relating to the objection taken under section 41(2), and, that as a result, the application was being refused under section 37(4).
7. On 7 June 2018, the applicant filed a Form TM5, requesting a written statement of reasons for the Registrar's decision.
8. I am now required under section 76 of the Act and rule 69 of the Trade Marks Rules 2008 ('the rules') to state in writing the grounds of the Registrar's decision and the materials used.

DECISION

9. In the examination report of 14 March 2018 it was explained that failure to reply to the section 41(2) objection by the due date would result in the application being refused in accordance with section 37(4) of the Act.
10. Section 37 sets out the provisions which govern the examination and refusal of trademark applications, sub-section (4), in particular, providing the Registrar with grounds for refusing such an application where it fails to meet the requirements for registration. The provision reads as follows:

"If the applicant fails to satisfy the registrar that those requirements 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."
11. The applicant did not respond to the examination report nor did it provide any reason for not responding within the time period. As a consequence, I must make my decision solely on the basis of the failure to respond within the period prescribed in the examination report. Section 37(4) is a mandatory provision setting out the consequences of failure to respond; there is no discretion. The Registrar believes that the examiner's decision to refuse the mark, as a result of the applicant's failure to respond within a clearly-communicated time frame, was correct and the application is accordingly refused.
12. However, for the sake of completeness, and in the interests of legal certainty, I present below a review and confirmation of the examiner's original objection taken under section 41(2). Section 41(2) of the Act reads as follows:

'A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.'

13. The examination report made specific reference to section 41(2) of the Act and clearly communicated the reasons why it is appropriate.
14. Marks 1 and 2, namely 'Beatique' and 'Beautique Nails & Beauty' were identified as being sufficiently similar as to form a series of two marks. The addition of the term 'Nails & Beauty' being recognised as being of non-distinctive character which did not affect the overall identity of the mark.
15. Mark 3, namely 'Beauty Beautique' was identified as having an identity that was very much its own and not similar to the abovementioned marks.
16. In commenting on this matter, I take account of the LOGICA decision taken by Professor Ruth Annand sitting as the appointed person wherein she stated:

-The marks in a series must resemble each other in their material particulars;

-The differences between the trade marks must not comprise matter which, when considered as a separate element of the trade mark, would be regarded as having distinctive character;

-The differences between the trade marks must not comprise matter, which when considered in the context of the trade mark as a whole, substantially affects the identity of the trade mark.'

17. Since marks 1 and 2 differ in their overall identities from that of mark 3 the relevant consumer would first have to be educated to realise that all three marks emanate from the same legal source. Therefore, in the context of section 41(2), there is an obligation on the part of the applicant to select only those marks that form a series with each other or to select an individual mark.
18. No such selection was made by the applicant in relation to the original set of three marks presented at the time the application was submitted.
19. The lack of any response from the applicant limits this decision to an evaluation of the administrative actions taken by the Registrar following the issuing of the examination report i.e. in light of the objection raised, a deadline for reply was set; that deadline was not adhered to which subsequently resulted in refusal under section 37(4) of the Act. As I have said however I

have given a view on the substantive objection raised with the aim of dealing with all matters should the decision be appealed.

CONCLUSION

20. In this decision, I have considered the examination report on the official file and noted the lack of response from the applicant. For the reasons given above, the application is refused for all the services sought under section 37(4).

Dated this day 16th August 2018

Angela Davies
For the Registrar
The Comptroller-general