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TRADE MARKS REGISTRY

Room A2
Harmsworth House
13-15 Bouverie Street
London, EC4Y 8DP

Friday, 4th April 2003

B e f o r e:

MR. G. HOBBS, QC
(Sitting as the Appointed Person)

In the Matter of the **TRADE MARKS ACT 1994**

and

In the Matter of application by **Telecom Plus Plc**
to register a series of Trade Marks in
Classes 1, 4, 9, 36, 38 & 39.

and

**An appeal to the Appointed Person under Section 76 of the
Trade Marks Act 1994 against the decision of Mr. A J Pike
acting on behalf of the Registrar, dated 26th November 2002.**

(Computer-aided Transcript of the Stenograph Notes of
Marten Walsh Cherer Ltd., Midway House,
27/29 Cursitor Street, London, EC4A 1LT.
Telephone No: 0207 405 5010. Fax No: 0207 405 5026.)

MR. J STOBBS (Boult Wade Tennant) appeared on behalf of the
Appellant.

MR. M. KNIGHT represented the Registry.

D E C I S I O N
(As approved by the Appointed Person)

1 THE APPOINTED PERSON: In order to obtain a filing date, an
2 application for registration of a trade mark must comply with
3 the requirements of sections 32 and 33 of the Trade Marks Act
4 1994. Those sections provide as follows:

5 **"Application for registration**

6 32 - (1) An application for registration of a trade
7 mark shall be made to the registrar.

8 (2) The application shall contain -

- 9 (a) a request for registration of a trade mark,
10 (b) the name and address of the applicant,
11 (c) a statement of the goods or services in
12 relation to which it is sought to register the
13 trade mark, and
14 (d) a representation of the trade mark.

15 (3) The application shall state that the trade mark is
16 being used by the applicant or with his consent, in
17 relation to those goods or services, or that he has a
18 bona fide intention that it should be so used.

19 (4) The application shall be subject to the payment of
20 the application fee and such class fees as may be
21 appropriate.

22 **Date of filing**

23 33 - (1) The date of filing of an application for
24 registration of a trade mark is the date on which
25 documents containing everything required by section

1 32(2) are furnished to the registrar by the applicant.

2 If the documents are furnished on different days, the
3 date of filing is the last of those days.

4 (2) References in this Act to the date of application
5 for registration are to the date of filing of the
6 application."

7 In Ty **Nant Spring Water Ltd's Trade Mark Application**

8 [2000] RPC 55 I considered the scope of the requirement for
9 "a representation of the trade mark" to be filed under
10 section 32(2)(d). Having regard to the provisions of the Act
11 noted at pages 56 and 57 of the report of my decision, I
12 concluded that a representation must not only disclose the
13 identity of the mark put forward for registration, but must
14 provide a fixed point of reference which clearly and
15 unambiguously does so from the outset in order to receive a
16 filing date under section 33(1). In that case the
17 application rejected for lack of certainty related to a sign
18 represented in words alone as: "A blue bottle of optical
19 characteristics such that if the wall thickness is 3mm the
20 bottle has, in air, a dominant wavelength of 472 to 474
21 nanometres, a purity of 44 to 48 per cent, an optical
22 brightness of 28 to 32 per cent."

23 Also on the basis of the requirement for legal
24 certainty, Mr. Simon Thorley QC, sitting as the Appointed
25 Person, in **Swizzels Matlow Ltd's Application** [1999] RPC 879

1 upheld the rejection of an application for registration of a
2 three-dimensional sign graphically represented in words alone
3 in the following terms: "The trade mark consists of a
4 circular compressed tablet bearing a raised heart outline on
5 both flat surfaces and containing within the heart outline on
6 one side any one of several different words or phrases".

7 The requirement for certainty as to the identity of
8 signs presented for registration has since been emphasised in
9 paragraphs 48 to 55 of the judgment of the European Court of
10 Justice in Case C-273/00 **Ralf Sieckmann v Deutsches Patent -**
11 **und Markenamt**, 12th December 2002. In paragraph 53 of its
12 judgment the Court observed that: "In order to fulfil its
13 role as a registered trade mark a sign must always be
14 perceived unambiguously and in the same way so that the mark
15 is guaranteed as an indication of origin." The Court went on
16 to observe in paragraph 54 that: "The object of the
17 representation is specifically to avoid any element of
18 subjectivity in the process of identifying and perceiving the
19 sign. Consequently the means of graphic representation must
20 be unequivocal and objective." In paragraph 55 it was
21 confirmed that the applicable provisions of Community law
22 require the relevant graphic representation to be clear,
23 precise, self-contained, easily accessible, intelligible,
24 durable and objective.

25 Although the **Sieckmann** case related to an application

1 to register an olfactory mark, it is clear that the ruling of
2 the Court is of general application. In his Opinion
3 delivered on 12th November 2001 in Case C-104/01 **Libertel**
4 **Groep BV v Benelux-Merkenbureau** Advocate General Lger
5 focused on the requirement for certainty in relation to
6 applications for the registration of colours at large. In
7 his Opinion delivered on 3rd April 2003 in Case C-283/01
8 **Shield Mark BV v Joost Kist** Advocate General Colomer likewise
9 emphasised the requirement for certainty in relation to
10 graphic representation of signs in the form of sounds.

11 In the present case, Telecom Plus PLC ("the Applicant")
12 applied on 14th February 2002 to register 16 signs in series
13 as trade marks for use in relation to various goods and
14 services in classes 1, 4, 9, 36, 38 and 39.

15 Box number 4 on the prescribed form of application for
16 registration contained the following request for information:
17 "If the mark is not a word or a picture indicate here (for
18 example, three-dimensional)". The applicant responded to
19 this request in a single word: "description". The
20 descriptions put forward for registration were identified in
21 an attachment to the form of application in the following
22 terms:

23 "1. The mark consists of a pictorial representation of
24 a pig, not being a photographic representation,
25 attached to packaging and other materials relating to

- 1 the provision of the goods and services.
- 2 2. The mark consists of a pictorial representation of
3 a pig, not being a photographic representation, with a
4 slot in its back, as applied to packaging and
5 materials relating to the provision of the goods and
6 services.
- 7 3. The mark consists of a pictorial representation of
8 a pig, not being a photographic representation,
9 presented generally in profile, as applied to
10 packaging and materials relating to the provision of
11 the goods and services.
- 12 4. The mark consists of a pictorial representation of
13 a pig, not being a photographic representation, with a
14 curly tail, as applied to packaging and materials
15 relating to the provision of the goods and services.
- 16 5. The mark consists of a pictorial representation of
17 a pig, not being a photographic representation, with a
18 curly tail in the form of a telephone wire, as applied
19 to packaging and materials relating to the provision
20 of the goods and services.
- 21 6. The mark consists of a pictorial representation of
22 a pig, not being a photographic representation, with a
23 slot in its back and a curly tail, as applied to
24 packaging and materials relating to the provision of
25 the goods and services.

1 7. The mark consists of a pictorial representation of
2 a pig, not being a photographic representation, with a
3 slot in its back, and a curly tail in the form of a
4 telephone wire, as applied to packaging and materials
5 relating to the provision of the goods and services.
6 8. The mark consists of a pictorial representation of
7 a pig, not being a photographic representation,
8 portrayed generally in profile, with a slot in its
9 back, and a curly tail in the form of a telephone
10 wire, as applied to the packaging and materials
11 relating to the provision of the goods and services.
12 9. The mark consists of a pictorial representation of
13 a pig, not being a photographic representation,
14 portrayed generally in the colour pink, attached to
15 packaging and other materials relating to the
16 provision of the goods and services.
17 10. The mark consists of a pictorial representation of
18 a pig, not being a photographic representation,
19 portrayed generally in the colour pink, with a slot in
20 its back, as applied to packaging and materials
21 relating to the provision of the goods and services.
22 11. The mark consists of a pictorial representation of
23 a pig, not being a photographic representation,
24 portrayed generally in the colour pink, presented
25 generally in profile, as applied to packaging and

1 materials relating to the provision of the goods and
2 services.

3 12. The mark consists of a pictorial representation of
4 a pig, not being a photographic representation,
5 portrayed generally in the colour pink, with a curly
6 tail, as applied to packaging and materials to the
7 provision of the goods and services.

8 13. The mark consists of a pictorial representation of
9 a pig, not being a photographic representation,
10 portrayed generally in the colour pink, with a curly
11 tail in the form of a telephone wire, as applied to
12 packaging and materials relating to the provision of
13 the goods and services.

14 14. The mark consists of a pictorial representation of
15 a pig, not being a photographic representation,
16 portrayed generally in the colour pink, with a slot in
17 its back and a curly tail, as applied to packaging and
18 materials relating to the provision of the goods and
19 services.

20 15. The mark consists of a pictorial representation of
21 a pig, not being a photographic representation,
22 portrayed generally in the colour pink, with a slot in
23 its back, and a curly tail in the form of a telephone
24 wire, as applied to packaging and materials relating
25 to the provision of the goods and services.

1 16. The mark consists of a pictorial representation of
2 a pig, not being a photographic representation,
3 portrayed generally in the colour pink, portrayed
4 generally in profile, with a slot in its back, and a
5 curly tail in the form of a telephone wire, as applied
6 to the packaging and materials relating to the
7 provision of the goods and services."

8 The Registry objected to the application under
9 section 32 of the Act and Rule 11 of the Trade Marks Rules
10 2000 on the basis that the descriptions attached to the form
11 of application failed to disclose the identity of any sign
12 with precision sufficient to permit full and effective
13 implementation of the legal and administrative requirements
14 of the Act relating to registration. The Applicant was
15 allowed two months from 18th February 2002 within which to
16 remedy the deficiency.

17 The agents for the Applicant maintained that the
18 descriptions in question clearly and unambiguously disclosed
19 the identity of the signs in the series and that the
20 objection raised by the Registry was misconceived. A hearing
21 was appointed to consider submissions on behalf of the
22 Applicant as to the sufficiency of the application. The
23 hearing took place before Mr. A J Pike acting on behalf of
24 the Registrar on 10th June 2002.

25 The hearing officer maintained the objection under

1 section 32(2)(d) for the reasons subsequently given in a
2 written decision issued on 26th November 2002. He made the
3 following observations in paragraphs 14 to 26 of his
4 decision:

5 "14. The sixteen marks in question are similar to each
6 other in that although they are all intended to be a
7 description of the same thing they differ from each
8 other in the amount of information that they provide.
9 As an inevitable consequence of this practically all
10 of the words which constitute the first mark are
11 incorporated within the other fifteen marks. To an
12 extent this pattern continues so that the marks
13 contain various amounts of information but
14 nevertheless appear to be an attempt to describe the
15 same thing.

16 15. In order to determine whether or not these marks
17 satisfy the requirements of section 32(2)(d) of the
18 Act I consider it necessary to conduct a detailed
19 examination of their content. The first words in all
20 sixteen marks are 'The mark consists of a pictorial
21 representation of a pig, not being a photographic
22 representation'. The first three definitions of the
23 word 'pictorial' in Collins English Dictionary are as
24 follows:

25 'adj. 1. relating to, consisting of, or

1 expressed by pictures (of books, newspapers,
2 etc.) containing pictures. 3. of or relating to
3 painting or drawing.'

4 16. I note that the same dictionary defines a picture
5 as:

6 'n. 1.a. a visual representation of something,
7 such as a person or scene, produced on a surface
8 as in a photograph, painting, etc.'

9 17. It is clear from these dictionary definitions of
10 the words 'pictorial' and 'picture' that it is not
11 possible to determine with any degree of certainty
12 what the nature of the pictorial representation is
13 intended by these marks. Is it a painting? Is it a
14 line drawing? In my view it is impossible to answer
15 these questions with any degree of certainty as it is
16 not possible to determine what type of pictorial
17 representation it is.

18 18. The pictorial representation is 'of a pig'. In my
19 view there are further difficulties with this aspect
20 of the marks. Is it a representation from head on,
21 from behind or from the side? If from the side is the
22 pig facing left or right? Is the pig lying down or
23 standing up? What breed of pig is it? I am aware
24 from my own personal knowledge that there are many
25 breeds of pigs which are very different to each other

1 ranging from the breed made famous in the well known
2 film 'Babe' to breeds such as Tamworth and the
3 Vietnamese Pot Bellied pigs.

4 19. As a result of the lack of preciseness in these
5 words it is not possible to determine the nature of
6 the mark. There is no certainty as to its precise
7 nature.

8 20. As these words are common to all sixteen marks
9 that effectively decides the issue before me, but in
10 case I am wrong in my findings I will go on to
11 consider the other elements of the marks. The second
12 mark contains the additional words 'with a slot in its
13 back'. There is perhaps a tendency to expect the slot
14 to run lengthways down the back of the pig but this is
15 not the only possibility covered by these words. The
16 slot could just as easily run across the back at
17 ninety degrees to the length of the back or even
18 across the back at a diagonal angle. There is also no
19 indication as to the length or width of the slot.

20 21. The third mark contains the words 'presented
21 generally in profile'. There is no indication as to
22 what is meant by the word 'generally'. The fourth
23 mark contains the words 'with a curly tail'. Again,
24 there is no indication as to the size or position of
25 the tail.

1 22. The fifth mark contains the words 'with a curly
2 tail in the form of a telephone wire'. The first
3 point I will make is that I consider that a tail in
4 the form of a telephone wire is not an image that I
5 would understand when encountering the fourth mark,
6 however, the same problems exist, there is no
7 indication as to the size or position of the tail.
8 23. The sixth mark consists of words upon which I have
9 already commented. My comments regarding this mark
10 are simply a combination of those for the second and
11 fourth marks. The same applies to the seventh mark
12 which is a combination of the words contained in the
13 second and fifth marks. The eighth mark contains
14 words which are a combination of the third and fifth
15 marks.
16 24. The ninth mark is the same as the first mark but
17 with the additional words 'portrayed generally in the
18 colour pink'. Firstly I note the presence of the word
19 'generally'. This again demonstrates the imprecise
20 nature of the mark. The second point is that the
21 colour pink is not precisely defined. Following on
22 from the **Ty Nant** decision the registry issued guidance
23 on acceptable forms of graphical representation. The
24 appropriate section is reproduced below:
25 'Device or get-up marks consisting partly of

1 colour(s)
2 11. Where colour is claimed as an element of a
3 device or pictorial mark, the representation of
4 the mark should be filed in colour. A black and
5 white representation will not be accepted unless
6 each part of the mark is clearly identified as
7 such, and the colour(s) defined by a widely
8 available colour standard. This will not be
9 necessary where a colour representation of the
10 mark is filed.'

11 The form of application does not contain a
12 representation of the colour nor does it provide any
13 definition of the colour pink by reference to a colour
14 standard.

15 25. The remaining seven marks (numbered 10 to 16)
16 raise no further issues but consist of various
17 combinations of the elements already identified in
18 this decision.

19 26. In my view none of these marks meet the
20 requirement of section 32(2)(d) of the Act in that
21 none of the sixteen marks applied for are represented
22 with sufficient precision to permit a full and
23 effective examination."

24 Rejection of the application followed inexorably from the
25 assessment contained in these paragraphs.

1 On 27th December 2002 the Applicant gave notice of
2 appeal to an appointed person under section 76 of the Trade
3 Marks Act 1994 contending, in substance, that the
4 descriptions put forward for registration satisfied the
5 requirement for legal certainty as to the identity of the
6 signs to which they related. That contention was maintained
7 and developed in argument at the hearing before me.

8 I do not rule out the possibility of describing visual
9 matter in words sufficient to satisfy the requirement for
10 graphic representation under section 32(2)(d). However, the
11 vice in each of the descriptions in issue in the present case
12 is that they leave room for the differing perceptions of
13 different individuals to be equally applicable bench marks by
14 which to judge whether a particular visual representation
15 falls within the relevant wording, with each individual also
16 being liable to regard the wording of the description as
17 applicable to a multiplicity of different visual
18 representations. This is a recipe for uncertainty.

19 I think it is clear that the registration system
20 proceeds on the basis of filings in relation to single signs
21 capable of functioning as trade marks by virtue of the
22 singularity of significance they individually possess. I do
23 not think it can be right that the Registrar's examiners
24 should have to use their own imagination in order to
25 visualise what a sign looks like for the purpose of assessing

