

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3737746

BY TARGET BRANDS, INC.

TO REGISTER THE FOLLOWING MARK IN CLASSES 3, 4, 5, 6, 7, 8, 9, 11, 12, 14, 18, 20, 21, 22, 24, 25, 27, 28 and 35

EMBARK

Background

1. On 29 December 2021, Target Brands, Inc. (“the applicant”) applied to register the above mark for a broad range of goods and services in Classes 3, 4, 5, 6, 7, 8, 9, 11, 12, 14, 18, 20, 21, 22, 24, 25, 27, 28 and 35.

2. On 18 January 2022 the Intellectual Property Office (“IPO”) issued an examination report in response to the application. In that report, no objection on absolute grounds was raised against the mark itself but a number of classification issues were raised as shown below:

Specification not understood

The list of goods are so vague that they do not constitute a proper list of goods/services, this is because the term lacks the required precision and clarity. There is therefore an objection under Rule 8(2) of the Trade Marks Rules 2008 in respect of the following terms:

1. *‘Camp torch’ in Class 4 – please clarify the goods.*

To overcome this objection, you should list the goods by name and/or restrict them. Alternatively, you should supply information to show that the list of goods accurately describes the range of goods that you are using the mark on, or that you intend to use the mark on. However, you may also delete the term entirely from the application.

Transfer of Goods to a different Class -- no fee required

2. *‘rescue flares’ do not belong in Class 8. The correct Class is 9*
3. *‘telescopes’ do not belong in Class 8. The correct Class is 9.*
4. *‘non-motorized collapsible luggage carts’ does not belong in Class 18. The correct Class 12.*

5. *'sleeping bags, sleeping bag liners' does not belong in Class 20. The correct Class is 24.*
6. *'plastic table coverings and place mats.' Plastic table coverings is proper to Class 24, however Plastic place mats is proper to Class 21.*
7. *'bean bags' does not belong in Class 28. The correct class is 20.*

Retail

There is an objection under Section 1(1) and Rule 8(2)(b) against the following 'retail service'-type terms listed in your class 35 specification:

8. *'Retail and online retail store services featuring outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing.'*

These terms do not meet the legal criteria as set out by the Court of Justice of the European Union in the Praktiker case (see C-418/02). Our classification practice in respect of 'retail service'-type claims is set out in the current edition of the Trade Marks Manual (under the section entitled 'The classification Guide'). For more information on this practice, you can view the Manual via the following hyperlink: <https://www.gov.uk/guidance/trade-marks-manual>

This objection can be overcome by amending the specification as shown below listing the actual goods you are retailing:

Retail services and Online retail services connected with the sale of outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing.

3. In line with standard IPO procedure, a period of two months was allowed for the applicant to respond.

4. On 18 March 2022 Cleveland Scott York (CSY), the attorney acting on behalf of the applicant requested an extension of time in which to respond. This was agreed and a new response date set at 23 May 2022. The examiner advised that if no response was received within the time allowed they would amend the application as set out in the examination report of 18 January 2022 and the amended application would then proceed to publication.

5. On 18 May 2022 the attorney addressed the issues in respect of items 2, 3, 4, 5, and 6 by requesting that the goods be transferred to the correct class. At that time, they also requested that 'camp torch' (item 1) remains in Class 4 and they provided extracts taken from the internet to show that a camp torch is a product that would belong in that class. They also requested that 'bean bags' (item 7) remain in Class 28 because as well as being a piece of furniture to sit on, a bean bag is also a plaything so it should remain in that class. As regards the term in Class 35 (item 8) the attorney requested the following term be added to the specification. This was worded in line with the examiners proposal for overcoming that objection. The examiner adhered to this request and duly added it to Class 35:

Retail services and Online retail services connected with the sale of outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing.”

6. Despite adding the above term to the class, the attorney also argued that the original term (I shall refer to this as the ‘offending term’) should remain because they argued it is in line with the requirements of the *Praktiker Bau v Heimwerkermarkte AG* case where it stated at paragraph 52:

“For the purpose of registration of a trade mark for such services, it is not necessary to specify the actual services(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate.”

7. The attorney submitted that this decision made it clear that it is only details of the types of goods that need to be specified, and then only in order to provide an indication of the nature of the service. They gave the example that it would be sufficient to describe a specialist retailer of bicycles as providing ‘retail services featuring bicycles’ as that would be clear and unambiguous as to the nature of the service and it acknowledges that ancillary goods such as bicycle chains, without prescriptively defining them, would be encompassed in that service. The sole issue for me then is the applicant’s insistence that the offending term ‘*Retail and online retail store services featuring outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing*’ satisfies the requirements for legal certainty and so forth, set out in *Praktiker* and therefore should be retained. In the event the applicant is wrong on this, it has nonetheless reserved its position by also and at the same time adopting the phrase suggested and approved by the examiner.

8. In their letter of 23 May 2022 the examiner confirmed that items 2, 3, 4, 5, and 6 had been transferred to their correct classes and she advised that they would allow ‘camp torch’ (item 1) to remain in Class 4 if it was amended to “wooden fire log camp torches”. They also maintained their stance against the term in Class 35 (item 8) as being unacceptable. On 1 August 2022 the attorney agreed for ‘camp torches’ to be amended to “wooden fire log camp torches” as suggested by the examiner and the application was duly amended. The attorney maintained their position that the wording of item 8 in Class 35 was acceptable and requested that it remain in the specification as it had originally appeared. There were further exchanges of correspondence between the examiner and the attorney concerning item 8 but the examiner was not prepared to allow the term so on 26 September 2022 the attorney requested a hearing.

9. The hearing was held on 12 October 2022 between me and Mr Peter Houlihan of CSY London. At the hearing I allowed the term ‘*bean bags*’ (item 7) to remain in Class 28 because as well as being an item to sit on, a beanbag is also a small cotton or canvas bag filled with dried beans which are used as playthings and so it was correctly classified in Class 28.

10. As regards item 8, it is my opinion that the inclusion of ‘featuring’ within the term “*Retail and online retail store services featuring outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing*” implies that the itemised list of

goods being retailed is not exhaustive and will also include goods that are not listed. Consequently, I consider the term to be unacceptable because it is imprecise.

11. I informed Mr Houlihan at the hearing that the term was not acceptable and this was confirmed in the written hearing report issued on 12 October 2022. At this point the examiner had already allowed the attorney to add the term “*Retail and online retail store services connected with the sale of outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing*” to Class 35. This being the accepted alternative proposed by the examiner in their examination report of 18 January 2022. At this point I required deletion of the offending term, the applicant having complied with the examiner’s suggestion, and therefore allowed a period of two months for Mr Houlihan to take instruction from the applicant. On 12 December 2022 the attorney advised that the applicant was maintaining its view that the original term satisfied the requirement for certainty even though they had also adopted a term which satisfied the registrar. It was an impasse and in order to resolve the situation, on 14 December 2022 I partially refused the application allowing the applicant to challenge the registrar’s position in relation to the Class 35 specification. A period of one month was allowed for the applicant to ask for a statement of reasons.

12. A form TM5 (Request for a statement of reasons for registrar’s decision) was received on 16 January 2023.

13. Having received a request for a statement of reasons for the registrar’s decision, I am now obliged to set out the reasons for my decision.

The Law

14. Section 32 of the Act reads as follows:

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

32(2) The application shall contain

(c) a statement of the goods or services in relation to which it is sought to register the trade mark,

15. Section 34 of the Act reads as follows:

(1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification.

(2) Any questions arising as to the class within which any goods or services fall shall be determined by the registrar, whose decision shall be final.

16. I refer also to the *Trade Mark Rules 2008 (as amended)* and Rule 8(2) and Rule 9 which read:

8(2) Every application shall specify –

(a) the class in the Nice Classification to which it relates; and

(b) the goods or services which are appropriate to the class and they shall be described with sufficient clarity and precision to enable the registrar and other competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought and to allow them to be classified in the Nice Classification.

9 (1) Where an application does not satisfy the requirements of rule 8(2) or (3), the registrar shall send notice to the applicant.

(2) A notice sent under paragraph (1) shall specify a period, of not less than one month, within which the applicant must satisfy those requirements.

(3) Where the applicant fails to satisfy the requirements of Rule 8(2) before the expiry of the period specified under (2), the registrar must reject the application for registration, insofar as it relates to any goods or services which failed that requirement.

17. As noted in paragraph 11 the application was partially ‘refused’ but for the purposes of strict clarification I would like to set out it is clear under Rule 9(3) that the consequence of failure to comply with Rule 8(2) is the ‘rejection’ of the application insofar as it relates to the services which failed that requirement. I should add that for my purposes I see no practical or legal difference between the terms ‘refused’ and ‘rejected’. The issue was that I was refusing/rejecting a particular term in Class 35 which the applicant was insisting was perfectly in order and in accordance with the case law. Moreover, whilst the consequential rule 9(3) was not expressly referred to in correspondence, it is plain that opportunity was provided whereby the applicant could have deleted the offending term.

18. The relevant legal principles

The principle that retail services were capable of protection and in very broad terms how they should be specified were set out in Case C-418/02 in which reference for a preliminary ruling under Article 234 EC from the *Bundespatentgericht* (Germany), was made to the European Court of Justice in relation to an application from *Praktiker Bau-und Heimwerkermarkte AG*, concerning the registration of a trade mark in respect of services provided in connection with retail trade. In reply to the questions asked of it, the Court ruled in its judgement that:

- *The concept of ‘services’ referred to by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the member states relating to trade marks, in particular in Article 2, covers services provided in connection with retail trade in goods.*
- *For the purpose of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details*

must be provided in connection with regard to the goods or types of goods to which those services relate.

19. In *Praktiker* the Court recognised that it is not necessary to specify in detail the retail services for which registration is sought and did not draw any distinction between the various forms of retail services (for example, supermarkets, department stores, mail order etc) but the Court did make it clear that the emphasis made is to be placed on the nature of goods supplied in connection with the services. Consequently, it is necessary to specify the goods or types of goods in all cases.

20. I refer also to the judgment of the Court of Justice of the European Union (CJEU) in *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* (C-307/10), often referred to as the *IP Translator* case. While the judgment relates to the scope of protection afforded by the use of 'Class Headings' in specifications it very clearly sets out the need for 'clarity' and 'precision' within a specification.

21. By way of further background, the international standard for the classification of goods and services is set out under the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957 (as amended)). This was developed and is managed by the World Intellectual Property Office (WIPO) classifying goods and services under 45 different classes, consisting of a 'Class Heading' which used 'General Indications' relating to the fields to which goods and services belong.

22. In the *IP Translator* case the Court was asked three questions as to the significance of these 'General Indications' and their use in a complete class heading. They provided the following answers:

- *Directive 2008/95/EC of the European Parliament and of the Council on 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.*
- *Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, concluded at the Nice Diplomatic Conference on 15 June 1957, last reviewed in Geneva on 13 May 1977 and as amended on 28 September 1979, to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise.*
- *An applicant for a national trade mark who uses all the general indications of a particular class heading of the Classification referred to in Article 1 of the Nice agreement to identify the goods and services for which the protection of the trade mark is sought must specify whether its application for registration is*

intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods and services. If the application concerns only some of those goods and services, the applicant is required to specify which of the goods or services in that class are intended to be covered.

23. While this decision does not relate specifically to retail services per se it is evident from the answer to these questions that there is a clear requirement for 'clarity' and 'precision' in the description of goods and services, such that the scope of the protection is clear to the IPO and businesses operating in the UK.

24. I should say that neither *IP Translator* or *Praktiker* prescribe or predetermine the exact specification terms that EU Member States may accept or reject. In that sense the cases simply represent a 'baseline' of legal certainty, beyond which Member States may make their own detailed provision as to what terms may be acceptable or not. Further, that the Nice Agreement which underpins these matters, whilst striving towards a measure of consistency, harmony and convergence amongst Member States (supported by an ongoing and regularly meeting Committee of Experts), also does not prescribe predetermined acceptable or unacceptable detailed terms. The point here is that Member States and their respective trade mark authorities retain a measure of autonomy and hegemony within the overall constraints of 'legal certainty'. This is perhaps reinforced by section 34 which I have quoted above, which provides for decisions in relation to which Class goods or services may fall, to be a determination solely for the registrar and from which there shall be no appeal. This autonomy inevitably results in a situation whereby a particular term such as the 'offending term' being acceptable in a particular country, such as and for example, the US but not in another, such as the UK. I understand this to be exactly the case in relation to this 'offending term'. But this should not be the result of arbitrary 'rule making' or 'deeming' on the part of Member States, there should at least be a rationale for the rejection of a particular term.

25. In the present case, I consider the term '*Retail and online retail store services featuring outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing*' lacks clarity and precision because of the use of the word 'featuring'.

26. The word 'feature', of which 'featuring' is a derivative, is defined in Oxford Dictionary of English as:

feature: noun – a distinctive attribute or aspect of something. verb – have as a prominent attribute or aspect; have as an important actor or participant; be a significant characteristic of or take an important role.

27. It is clear, or at least suggestive, from these definitions that when using the word 'featuring' it implies that there may be other features in addition to those that are most prominent or important. Indeed, the attorney in their letter of 1 August 2022 defined 'featuring' as 'a significant characteristic' or taking 'an important part in'. In my view, all of these definitions suggest that whatever the feature is, it may not be the 'only' feature but forms part of many. By way of example, if we consider the film TOP GUN which may be promoted as 'featuring' the famous actor Tom Cruise, it will not be understood as meaning that the film includes only Tom Cruise but that he is the most

important of the many actors also appearing in the film. Similarly, when appearing within the term '*Retail and online retail store services featuring outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing*' the retail services on offer will or may be in respect of a range of goods not specified, of which those listed are the most important.

28. As I have said national offices will render their own detailed interpretations of *Praktiker* and *IP Translator* and in that respect the Registrar has consistently and historically rejected the term 'featuring' when appearing within a retail specification because it is not known what those other goods are or may be. It has always been the Registrar's practice to reject the term on all applications and to the Registrar's knowledge this has not been challenged. The registrar is of the view that whilst it understands to a certain extent the applicant's position in this case, it nonetheless sees fairness and consistency as both being legitimate factors in its position.

29. As an aside, but nonetheless pertinent in this decision, is the fact that the EUIPO TM Class database does not include within its list of accepted terms any retail services that include the word 'featuring'. I would therefore conclude that the EUIPO also does not accept 'featuring' within a retail specification.

Conclusion

30. It is unacceptable that any person searching our database should be inconvenienced by specifications which do not make it clear what goods or services are covered. The test to be applied is whether the applicant's descriptions of their goods or services are such that permit an average person engaged in the relevant trade to clearly ascertain the nature of the goods or services for which the applicant seeks to register his trade mark, without the need for further explanation.

31. In the present case, the relevant consumer would not know upon seeing the term precisely what goods are being retailed.

32. The application is therefore rejected in respect of the term '*Retail and online retail store services featuring outdoor recreation gear and clothing for camping, hiking, cycling, water activity, climbing*' because it does not meet the requirements of Rule 8(2) and Rule 9(3).

Dated this 14th day of March 2023

**Helen Davies
For the Registrar
The Comptroller-General**