

O-091-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2269137  
BY GATEWAY, INC  
TO REGISTER A TRADE MARK  
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#### **DECISION AND GROUNDS OF DECISION**

##### **Background**

1. On 3 May 2001 Gateway, In, of 14303 Gateway Place, Poway, California 92064 applied to register a series of seventeen trade marks in classes 9 and 35 in respect of the following goods and services:

Class 9           Computers; computer peripherals and fittings; computer accessories including shaped covers; mouse mats, anti-static screens; and computer software.

Class 35           Retail, mail order and internet selling services relating to computers and computer peripherals, fittings and accessories and the demonstration of other products.

2. The marks applied for are represented at Annex A.

3. By letter of 6 November 2002 the agent requested the deletion of marks F and L of the series and the marks for which registration is now sought are at Annex B.

4. Objection was raised under Section 3(1)(b) of the Act because the mark consists of non distinctive devices and Section 41(2) of the Act because all the marks are visually different. In addition a further objection was raised against class 35 only under Sections 3(6), 34(2) and Rule 8 because terms within the specification applied for were too wide and too vague for classification purposes.

5. At a Hearing, at which the applicants were represented by Mr Brian Dunlop of Wynne-Jones, Laine and James, their trade mark attorneys, the objection under Section 41(2) of the Act was maintained. The objection under Section 3(1)(b) was waived and the objection under Sections 3(6), 34(2) and Rule 8 not addressed and I will make no further reference to them in this decision.

6. Following the Hearing evidence of use of the mark was filed on 13 May 2002. The evidence was submitted to clarify that the trade mark used is the black spot on the white background, rather than any specific configuration and therefore all of the different representations contained within the series are simply particular configurations which fall

within the ambit of the trade mark as used. However, this evidence did not persuade me that the objection could be waived.

7. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

### **The Law**

8. Section 41(2) of the Act reads as follows:

"41.- (2) 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."

### **The Decision**

9. In order to satisfy the requirements of Section 41(2) of this Act all fifteen marks must resemble each other in their material particulars while differing from one another only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark; that is to say its identity with each and every mark in the group propounded as a series.

10. At the Hearing Mr Dunlop stated that the mark represents a style of packaging and identification used by the applicants. He argued that the marks did not differ in their material particulars and that any differences were of a non-distinctive character which did not affect the identity of the mark. The objection was maintained at the Hearing. However, I agreed to allow the applicants time to submit information demonstrating how the application is used in practice.

11. This information was filed on 13 May 2002 and consisted of a Statutory Declaration from Ms Aideen McCracken, a former Director of Product Management and Development of Gateway Europe and sixteen exhibits showing use of the black spot on white background pattern.

12. The evidence demonstrates that the applicants use a variety of configurations and the concept or idea of this range of black spots on white background patterns. However, in my opinion this evidence is simply demonstrating use of a range of marks which have a conceptual similarity but possess material differences.

13. I consider that the variations such as the number of spots, the shape of spots or configuration of spots within each individual mark to be a material particular which affects the visual identity of each mark. The distinctive character of each mark is in the different combination of shapes and elements which make up that particular mark.

14. Professor Ruth Annand acting as the Appointed Person in the Logica Decision BL No. 0/068/03 (unreported) stated that Section 41(2) contains three criteria and to qualify as a series the trade marks must:

1. Resemble each other as to their material particulars (the main elements);
2. Differ only as to matters of a non-distinctive nature;
3. Which do not substantially affect the identity of the trade marks.

15. Turning to the meaning of "non substantially affecting the identity of the trade mark", I believe it would be hard to improve on Jacob J's observation in *Neutrogena Corporation v. Golden Limited* [1996] RPC 473, at 488-489 regarding, in effect, the identical phrase in Section 30(1) of the Trade Marks Act 1938:

"Not substantially affecting its identity' means what it says, both in this section and in other sections of the Act (e.g. Section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test."

16. If there is a difference of substance between the marks, either visually or phonetically they will not qualify as a series.

17. In this application the identity of the marks is substantially affected by the visual differences and the material particulars of the marks therefore vary. In some cases the marks consist of three spots, whereas in others they consist of four spots. In addition the relative size and shape of the spots within the marks creates a visually different identity. I do not consider that any conceptual similarity is sufficient to give the marks a substantially identical character in the face of these significant visual differences.

18. Given the differences between the marks applied for I am satisfied that the marks contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of Section 41(2) of the Act.

19. In this decision I have considered all of the documents filed by the applicants and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act in that it fails to qualify under Section 41(2) of the Act.

Dated this 9<sup>TH</sup> day of April 2003.

Ian Peggie  
For the Registrar  
The Comptroller General

**Annex in paper copy only**