

In the Matter of the Trade Mark Act 1994
and

In the Matter of an Application No.
2125372 by Swizzels Matlow Limited to
register a trade mark in Class 30

DECISION

This is an appeal to the Appointed Person against a Decision of the Officer acting for the Registrar, Roger G. Evans, dated 24th July 1998 in which he refused to register Application No. 2125372 by Swizzels Matlow Limited.

The mark was applied for in Class 30 in respect of non-medicated confectionery and was stated to be a 3-dimensional mark. However no visual image of the mark was included in the Form TM3. The representation of the mark was described as follows:

"The trade mark consists of a circular compressed tablet bearing a raised heart outline on both flat surfaces and containing within the heart outline on one side any one of several different words or phrases".

The application was supported by a Statutory Declaration of Trevor Jack Leslie William Matlow, the Joint Managing Director of the Applicant which manufactures and sells confectionery under the well known trade mark LOVE HEARTS. The Declaration gives evidence of sales since 1955 and details both

the turnover and the advertising expenditure in the four years up to 1996. Exhibits show the packaging and advertising of the Love Hearts products and show clear representations of the product itself.

Mr. Evans held that the mark was unregistrable as being in contravention of Section 3(1)(a), and (b) of the Trade Marks Act 1994. So far as concerns the objection under Section 3(1)(b), he held that the mark was prima facie devoid of any distinctive character and was not satisfied on the evidence that the mark had acquired a sufficient distinctive character as a trade mark in its own right to justify registration under the proviso to section 3.

It is however his decision under section 3(1)(a) which was the subject of more extensive debate at the hearing before me and it is to this sub-section that I shall turn first.

Section 3(1)(a) provides

"The following shall not be registered

(a) signs which do not satisfy the requirements of section 1(1)".

It is however to be noted that the proviso to section 3 does not extend to section 3(1)(a) so that proof of distinctiveness cannot entitle a mark which does not satisfy the requirements of section 1(1) to be registered.

Section 1(1) provides

In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A

trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

It is thus apparent that the shape of goods may be registered but section 1(1) provides no guidance on the form in which the shape is to be described save that it must be "capable of being graphically represented".

The Long Title of the Trade Marks Act 1994 is as follows:

"An Act to make new provision for registered trade marks, implementing Council Directive No. 89/104/ECC of 21st December 1988 to approximate the laws of Member States relating to trade marks; to make provision in connection with Council Regulation (EC) No. 40/94 of 20th November 1993 on the Community trade mark; to give effect to the Madrid Protocol Relating to the International Registration of Marks of 27th June 1989 and to certain provisions of the Paris Convention for the Protection of Industrial Property of 20th March 1883, as revised and amended; and for connected purposes."

Accordingly, when seeking to interpret the provisions of the Trade Marks Act, regard must be had to the European Directive and Regulation in order to achieve the necessary purposive construction.

In particular Section 1 is lifted directly if not literally from Article 2 of the Directive (89/104) ("The Directive") which states:

"A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs,

letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings".

It is thus plain that in considering the meaning of the term "*represented graphically*", as that term appears in the Act, it would be proper, indeed, I believe, essential to have regard to the language of the Directive as an aid to interpretation.

Mr. Evans did not have any submissions made to him on the basis of the language of the Directive and reached his decision by applying the Registrar's practice.

Chapter 6 of the Registry's Work Manual at page 18 states as follows:

"In the Registrar's view a sign is graphically represented when;

- (a) It is possible to determine from the graphical representation precisely what the sign is that the Applicant uses or proposes to use without the need for supporting examples etc;*
- (b) The graphical representation can stand in place of the sign used or proposed to be used by the Applicant because it represents the sign and no other;*
- (c) It is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is".*

The Registrar's practice with regard to descriptions of trade marks is amplified in an extract from a special notice in the Trade Marks Journal of 22nd May 1996 (No. 6126 page No. viii) which states:

"1.3. In general, descriptions in words alone are unlikely to be acceptable as a graphical representation of a trade mark (see 4.2, 5.1 and 6.1 below). However, there may be circumstances where a description in words, if sufficiently precise, would be acceptable (see 3.1 below)".

The reference to paragraph 3.1 below is a reference to colour marks.

Following this guidance, Mr. Evans did not reject the mark on the ground that there was no visual image of the mark but only a description. He rejected the mark on the basis that the description was an inadequate description of the trade mark.

In the Statement of Case in support of the Appeal and at the hearing before me, Ms. Barr of Wildbore & Gibbons contended first, that the description was an adequate description for the purposes of section 3(1)(a) and, secondly, pursued an application made before the Registrar to add a limitation to the description by way of amendment so as to state

"The mark is limited to goods which are 19mm in diameter and 4.76mm in depth".

Ms. Barr contended that if the description as filed was inadequate, there was power to insert this limitation by way of amendment and that, once amended, the description complied with the terms of the Act.

Mr. James who appeared for the Registrar supported the Registrar's decision under section 3(1)(a) in its entirety but also draw my attention to a recent decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) in *Antoni and Alison's Application* (1998 E.T.M.R. 460).

That was a decision of the Boards of Appeal of OHIM, which was the body set up pursuant to Council Regulation 40/94 (Article 2) to administer Community Trade Marks. Regulation 40/94 ("The Regulation") also has its origins in the Directive. Article 4 of the Regulation repeats Article 2 of the Directive.

In *Antoni and Alison's Application*, a question arose as to whether a description of a trade mark in the form "the vacuum-packing of an article of clothing in an envelope of plastic" constituted a representation of the Applicant's mark. The Board of Appeal held that it did not. The relevant part of their reasons reads as follows:

"Article 4 of the CTMR (i.e. the Regulation) provides that a Community trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

This provision contains one of the basic principles of the Community trade mark system, namely that the sign in question must be capable of being represented graphically, for such purposes as examination, publication and file inspection. In the

interest of the general public and the more directly concerned parties, such as proprietors of earlier marks, those interested in determining the scope of protection of the mark or those involved in searching activities, it was considered essential that applicants present a clearly defined image of their mark. (emphasis added).

Articles 26 and 27 of the CTMR reflect the importance attached to these principles by the legislator. The furnishing of a representation of the mark is one of the few elements necessary to obtain a filing date.

Towards this end, the Implementing Regulation (Commission Regulation EC No. 2868/95) sets out how certain marks should be graphically represented. Rule 3(2) of the IR, for example, requires that, when the mark is not a word mark, but a three-dimensional, colour or other type of mark, a reproduction of the mark be submitted on a sheet of paper separate from the sheet on which the text of the application appears.

Therefore the trade mark in question, in order to have been accorded a filing date, should have been reproduced. A mere description, but conveying the clear and precise appearance of the mark itself, cannot be considered to be a reproduction (emphasis added) The point is clear from Rule 3(3) of the IR which expressly states that the application, in addition to the actual reproduction, which is required for marks to which Rule 3(2) of the IR relates, may also contain a description. The Rule enables the applicant to add to the actual reproduction an explanation of the appearance of the mark by means

of words. Other than the qualification given in the application form ("other type of mark") the mark now seems to be considered by the Appellants as being a three-dimensional one, since they invoke Rule 3(4) of the IR. The Board observes that this paragraph concerns one of the special cases within the scope of paragraph 2 where a reproduction is also needed.

The second sentence of Rule 3(4) of the IR provides that the representation shall consist of a photographic reproduction or a graphic representation. The latter term, according to the Board must be understood as meaning a drawing and/or such like representation. (emphasis added).

It will be apparent from this decision that the Board of Appeal interpreted both Article 4 of the Regulation and Rule 3 of the Implementing Regulation. In the case of Article 4, they have held that it was essential that the Applicants presented a clearly defined image of their mark.

So far as concerns Rule 3 of the Implementing Regulations, they have held that in relation to three-dimensional marks it is essential that there must be a drawing or like representation in order to constitute a graphical representation.

Mr. James drew my attention to this decision as being relevant to the question whether the Registrar's practice as to the use of a description was appropriate insofar as it could enable a three-dimensional trade mark to be registered on the basis of a description in words alone which did not contain a drawing or equivalent visual representation.

Since this was an issue which was first raised at the hearing without notice being given to Ms. Barr, I did not consider it appropriate that the matter should be considered at the hearing. I did however consider it a matter of sufficient potential importance to the outcome of the appeal that it was necessary for me to have representations upon it. I therefore heard full argument at the hearing on all aspects of the case and invited Ms. Barr to provide written submissions in relation to this point of law. This she did by letter dated 14th December 1998 to which Mr. James responded on behalf of the Registry by letter dated 4th January 1999.

I am grateful to both parties for their assistance in this matter. At the hearing I invited them to consider whether or not this was a matter which I should refer to the Court pursuant to section 76(3) of the Act. Neither the Registrar nor the Applicant wished to have this matter referred and having considered their written submissions as well as the oral submissions, I have concluded that it would not be appropriate to refer this appeal to the Court since, for the reasons given hereafter, I do not believe that a decision on this point of law is essential for the determination of the appeal.

Nonetheless, the decision *Antoni and Alison's Application* does raise an issue of importance to practitioners in this country. If the Registrar's practice of allowing the possibility a three-dimensional mark being registered on the basis only of a description and not of a representation of the image is correct, it is inconsistent with the view taken by the Board of Appeal of OHIM. I proposed therefore briefly to give my views on this matter.

First, it is common ground that a decision of the Board of Appeal of OHIM is not binding either on the Registrar or on me. It must however carry

considerable persuasive authority having regard to the desirability of avoiding divergent jurisprudence on the interpretation of broadly parallel provisions which exist in the 1994 Act and in the Regulation, both of which have their origins in the Directive (see Lord Oliver of Aylmerton in *Asahi Kasei Kogyo KK's Application* (1991) RPC 485 at 540 line 25 - 29, where similar observations were made in relation to the Patents Act and the European Patent Convention).

Since Article 4 of the Regulation and Section 1 of the Act both have their origin in Article 2 of the Directive, plainly it is desirable that the scope of the provisions should be given equivalent effect both in relation to the Community Trade Mark and in relation to a Trade Mark granted under the Act.

However the Implementing Regulations for the Community Trade Mark are not the same as the rules made under the Trade Marks Act (The Trade Mark Rules 1994 as amended) In particular there is no equivalent in the Trade Mark Rules of Rule 3 of the Implementing Regulations.

The difficulty I find with the decision in *Antoni and Alison's Application* is that whilst the reasoning in relation to the Implementing Regulations is reasonably fully developed, the reasoning in relation to Article 4 is not so well developed. I can well understand on the basis of the Implementing Regulations that the Board of Appeal felt constrained to hold that, in relation to a three-dimensional mark, a visual representation was essential.

Article 4 of the Regulation and Section 1 of the Act are both in very wide terms. It seems to be common ground that it is now possible to apply for a Trade Mark in relation to colour, shape and sound, as well, possibly, as smell.

In the case of sounds, the relevant sound could be represented by musical notation. In such a case, the notation is an accurate description of the notes in question when considered by a person conversant with the practice of musical notation. This is no different, to my mind, from the use of an ordinary English word as a trade mark when the combination of letters conveys a description to an English speaking person. Plainly it will not convey the same meaning to someone not conversant with English and may be wholly unpronounceable to somebody only conversant with, say, Mandarin or Arabic script. Likewise colours can accurately be described by reference to conventional colour charts. It cannot therefore be that the words "represented graphically" of themselves require the representation of the mark to be some form of visual image of it.

Further, I do not think it is helpful in this context to try and determine the meaning of the word "graphically" by reference to English dictionaries. The word has its origin in the Directive and more assistance can be obtained from considering the purpose for which the provision is there.

In *Antoni & Alison's Application*, the Board referred to Articles 26 and 27 of the Regulation as reflecting the importance attached to the principle by the legislator. These provisions, which mirror the provisions of Sections 32 and 33 of the Act, relate to the material necessary to form an application and to obtain a date of filing. These provisions however refer to the word "representation" and, to my mind, both relate back to the expression "graphically represented" in Article 4 and Section 1. I therefore do not believe that any great assistance can be achieved by reference to these latter provisions.

In my judgment, much greater assistance can be obtained by considering the effect of registration. The Directive, the Regulation and the Act all draw a

distinction between the powers of a proprietor of a registered trade mark to restrain infringement where an alleged infringer uses a sign which is **identical** to the registered trade mark as opposed to an alleged infringer who uses a sign which is merely **similar** to the registered trade mark. It will suffice to quote from the Act where section 10 provides

*"10.(1) A person infringes a registered trade mark if he uses in the course of trade a sign which is **identical** with the trade mark in relation to goods or services which are **identical** to those for which it is registered,*

*(2) A person infringes a trade mark if he uses in the course of trade a sign where because - (a) the sign is **identical** and is used in relation to goods or services **similar** to those which the trade mark is registered, or (b) the sign is **similar** to the trade mark and is used in relation to goods or services **identical** with or **similar** to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the trade mark.*

It is thus essential for traders to be able to identify with clarity what the registered trade mark is. The first question that arises when infringement is in issue is whether or not the alleged infringing mark is identical to the trade mark registered. If it is, and is used in relation to the same goods, the trade mark proprietor has an absolute monopoly. Where, however, the mark is not identical but merely similar, the monopoly is restricted to uses which create the necessary likelihood of confusion on the part of the public.

This is a fundamental aspect of the law and it is for this reason that the graphical representation, being the means by which the trade mark is defined, must be adequate to enable the public to determine precisely what the sign is that is the subject of the registration.

Qualification of the word "represented" by the word "graphically" does not, in my judgment, served to restrict the means by which the representation is made, providing it is in graphical form. This can, for example, be by way of writing, drawing, musical notation, written description or any combination thereof.

Neither Ms. Barr nor Mr. James have drawn my attention to any provision in the Directive, the Regulation or the Act or to any relevant antecedent materials which suggests that the qualification by reason of the use of the word "graphically" was intended to limit the right of an applicant to seek to define his trade mark in what ever way he saw fit, providing it was in a graphical form and a description plainly is graphical. To my mind the word "graphically" serves to extend the meaning of the word "represented" rather than to restrict it to some form of purely visual image of the mark itself. In my judgment, therefore, in appropriate circumstances, there can be a representation of a mark which is not a visual image of the mark and the use of musical notation is perhaps the best example of this.

For the above reasons, and with regret since I am differing from the Board of Appeal, I am unable to accept that the true interpretation in Section 1 of the Act of the words "represented graphically" is limited to a representation which provides "a clearly defined image of the mark", if, by the use of that language, the Board of Appeal meant a visual representation which depicts the image of the mark and does not achieve that image by use of other means.

However, since their reasoning for reaching this decision was not fully developed, I am not entirely sure that the Board of Appeal intended to place such a restrictive meaning on Article 4. It seems to me that the ratio of their decision lay in their reference to the Implementing Regulations which, so far as three dimensional marks are concerned, do have a more limited meaning.

For all these reasons, I am of the view that the Registrar's practice set out above, which I shall repeat,

*"1.3. In general, descriptions in words alone are unlikely to be acceptable as a graphical representation of a trade mark
However, there may be circumstances where a description in words, if sufficiently precise, would be acceptable"*

is a correct analysis of the law under section 1 of the Act.

In my Judgment, whilst it is unlikely that a mere description of a three-dimensional article would in practice ever be sufficiently precise to meet the needs of the Act (which are to enable traders to draw a distinction between a sign which is identical to the mark and one which is not), the wording of the Act does not exclude such a possibility in a plain case.

Accordingly I do not believe that the application before me is disqualified from registration merely because the representation of the mark consists of a description.

I turn then to consider whether the representation of the mark, consisting as it does only of a description is a graphical representation which satisfies the requirements of section 1(1). In his decision, Mr. Evans sets out the Registrar's practice on page 2 lines 25-34 and then goes on to seek to apply that

practice to the description in the Form TM3. I believe this is the appropriate approach. For the reasons I have given above, the three criteria of the Registrar's practice: namely,

- (a) that it is possible to determine from the graphical representation precisely what the sign is
- (b) that the graphical representation can stand in place of the sign used because it represents the sign and no other and
- (c) that it is reasonably practicable for persons inspecting the Register to understand from the graphical representation what the trade mark is

are all highly relevant considerations.

In the final event, the question that has to be asked and answered is whether the graphical representation is adequate so as to enable traders to distinguish a sign which is identical to the registered trade mark from one that is merely similar to it.

Ms. Barr suggested that the expression "a circular compressed tablet" was sufficiently clear since the word "compressed" indicated a small size, that the word "tablet" indicated a flat surface and that the word "circular" limited the mark to a spherically defined product. She suggested that the raised heart outline could and would only be taken as being an indication of a heart shape rather than a representation of the actual shape of a heart and that the limitation as to the content of words within the heart shape was merely relating to the placing of the words.

Whilst this may be so, I cannot accept that the description as it stands on the Form TM3 is sufficient to enable a trader to determine precisely what the sign

is. It seems to me that the description pre-supposes a knowledge on the part of the trader of the Love Hearts product as sold over the years and as is shown in Mr. Matlow's declaration. This cannot be a correct approach. The description must stand on its own to identify the trade mark. As it stands the description is not restricted as to the precise diameter nor to the thickness of the tablet nor to the positioning, the thickness or the shape of the raised outline not to the area within that outline that is available for other material.

I have reached the conclusion that Mr. Evans was entirely right in holding that the description of the representation of the mark as contained in the Form TM3 was inadequate to constitute a graphical representation for the purposes of section 1(1) of the Act and that he was accordingly correct in refusing registration having regard to section 3(1)(a) of the Act.

This leads to the question of amendment. Ms. Barr submitted that amendment was permitted by virtue of Section 13(1) of the Act. This Section provides

13.(1) An applicant for registration of a trade mark or the proprietor of a registered trade mark may -

(a) disclaim any right to the exclusive use of any specified element of the trade mark, or (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and, where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.

Mr. James, for the Registrar, contended that the amendment sought was not a limitation within the meaning of Section 13 but was an amendment of the application to which Section 39 (2) applied. This subsection provides

39.(2) In other respects, an application may be amended, at the request of the applicant, only by correcting -

(a) the name or address of the applicant,

(b) errors of wording or of copying

(c) obviousness mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

I am unable to accept Ms Barr's argument. Section 13 plainly relates to disclaimers or limitations on an application. It does not relate to the representation of the mark which is the fundamental definition of the trade mark itself. "Limitation" as it appears in section 13(1)(b) is part of the expression "subject to a specified territorial or other limitation".

I do not believe that the word "other" needs to be construed ejusdem generis with territorial. However to give the word a broad meaning so as to permit amendments by way of limitation to the representation of the mark would enable applicants to circumvent the plain language of section 39. I cannot accept that section 13(1) is a provision by which a coach and horses could be driven through the restrictive provisions of section 39.

Under the old law, in the course of prosecution of an application, there was a wide discretion to allow amendments (See Section 17(7) Trade Marks Act

1938) and amendments were frequently made such that the mark as finally registered bore little resemblance to the mark the subject of the application.

Section 39 is, in my judgment, intended to restrict the ability of an applicant during the course of prosecution to change the application in any significant way so as to retain the priority date of the application and yet achieve registration of a mark of a different character¹. I do not believe that the amendment sought to limit the diameter and depth of the tablet is an amendment which is permissible under the Act. I therefore refuse to allow the amendment.

The question of whether the mark would have been registrable had the description contained the limitation now proposed by way of amendment does not therefore arise. The question was however argued and, in my judgment is simple to answer. It does not. Whilst it limits the size and shape of the tablet, it does nothing to overcome the other difficulties surrounding the description, particularly that of the nature, size and placing of the heart shape.

Mr. Evans went on to consider the question of whether or not, if the mark did qualify under section 3(1)(a), it should be registered having regard to section 3(1)(b), both on the basis that there was no use of the mark and then in the light of the evidence of use. In my judgment this is a course he ought not to have taken. Once he had concluded that the representation of the mark was not adequate to comply with section 1, I do not see how he could go on to assess whether that inadequately defined mark was capable to distinguishing. I believe he must, in so doing, have considered the mark which the Applicant

¹ The section thus gives effect to paragraph 4.09 of the White Paper on the Reform of Trade Marks Law of September 1990 - although I do not believe it is necessary to have regard to the White Paper in reaching my conclusion on the interpretation of the Act.

wanted to register, i.e. the mark represented by the goods as sold as indicated by Mr. Matlow's Declaration. The question of whether or not this mark should be registered, had a proper representation of it been put forward, requires a hypothetical assumption as to the precise nature of the representation of that mark.

Accordingly, in the light of the conclusions I have reached, I do not proposed to consider this question. If the Applicant is minded to make a further application, containing a representation that does comply with the requirements of the Act, then that application should be considered, as of its date, in the light of the evidence filed in support thereof.

I therefore do not express any view as to the correctness or otherwise of the conclusions reached by Mr. Evans under section 3(1)(b).

However, for the reasons given, this appeal will be dismissed. In accordance with the usual practice there will be no order as to costs.

Since writing this Decision, I have become aware that another Appointed Person, Matthew Clarke Q.C., has referred to the Court of Session in Scotland a similar question on the adequacy of a description as constituting a graphical representation (Application No. 2135743 by Jimmy Nicks Property Company Limited). However in that case the Registrar had expressly requested that the appeal should be referred to the Court which Mr. James did not do here. For the reasons given I do not believe it would be right in this case to put the

Applicant to the expense of a reference when I do not believe the application can succeed on the facts.

Simon Thorley Q.C.

29 January 1999