

TRADE MARKS ACT 1994

In the matter of application no. 2159191
by Kabushiki Kaisha Molten
to register a trade mark in Class 28

DECISION AND GROUNDS OF DECISION

On 25 February 1998, Kabushiki Kaisha Molten of 1-8 Yokogawa Shin-machi, Nishi-ku, Hiroshima 733, Japan, applied under the Trade Marks Act 1994 to register the following mark in Class 28 of the Register in respect of "Balls; soccer balls and handballs":-



"The pattern shown repeats symmetrically over the entire surface of the ball."

The applicant indicated on the form of application that the mark was 3-dimensional.

Objection was taken under Sections 3(1)(a), (b), (c) and (d) of the Act on the grounds that the mark was devoid of any distinctive character for balls.

At a hearing at which the applicants were represented by Ms A Cole of Urquhart-Dykes & Lord, the objections were maintained. Following refusal of the application under Section 37(4) of the Act, I am now asked under Sections 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of the decision and the materials used in arriving at it.

No evidence of use has been put before me. I have therefore, only the prima facie case to consider.

Section 3(1) of the Act reads as follows:

"3.-(1) The following shall not be registered -

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

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade.”

5 Section 3(1)(a) bars registration of “signs which do not satisfy the requirements of Section 1(1)”, ie that “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.”

10 Section 3(1)(a) of the Act states that marks which do not meet the requirements of Section 1(1) shall not be registered. Section 37(1) of the Act requires the Registrar to examine applications and to determine whether they meet the requirements of the Act. The combined effect is that an applicant must demonstrate that the sign applied for is capable of being graphically represented by reference to the representation of the mark filed under Section 32(2)(d).

15 It is the Registrar’s view that a sign is graphically represented when:-

20 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 samples etc;

b) the graphical representation can stand in place of the sign used or proposed to be used by the applicant because it represents that sign and no other;

25 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.

30 Having regard to the mark as applied for, firstly I do not believe it is represented with sufficient precision so that it is possible to determine precisely what the mark is from the single view given. In particular, although the circle which forms the boundary of the mark clearly represents a three-dimensional ball, the pattern shown on it is not symmetrical about the horizontal diameter or axis of the circle. It is therefore not possible to repeat the pattern symmetrically over the entire surface of the ball as stated on the form of application.

35 For the same reason, I do not consider that the representation is capable of standing in place of the applicant’s mark because it represents that sign and no other, nor do I believe it is reasonably practicable, for anyone inspecting the register, or reading the Trade Marks Journal, to understand from the representation exactly what the trade mark is.

40 I am fortified in this view by the comments of Mr Simon Thorley, QC, sitting as the Appointed Person in the case of an application for a 3-dimensional shape mark by Swizzels Matlow Limited (application no 2125372 - unreported at the time of writing), when he said:-

45 “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.”

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For all these reasons, I therefore conclude that the representation of the mark as contained in the application form TM3 is inadequate to constitute a graphical representation for the purposes of satisfying Section 1(1) of the Act, and as a consequence it is therefore debarred from registration by Section 3(1)(a) of the Act.

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Because I have concluded that the representation of the mark is not adequate to comply with Section 1 of the Act, I am unable to assess whether that inadequately defined mark fails to satisfy Section 3(1)(b) of the Act. The objections under Sections 3(1)(c) and (d) of the Act do not appear to be appropriate, and are therefore waived.

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I believe there are no grounds for waiving the Section 3(1)(b) objection at this time and it would appear to be appropriate for this matter to be remitted to the Registrar in the event that I am found to be wrong on the graphical representation issue.

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In this decision I have considered all the documents filed by the applicant and all 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 because it is debarred from registration under Section 3(1)(a) of the Act.

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Dated this 25th day of June 1999

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ROGER G EVANS
For the Registrar
The Comptroller General