

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO: 2162950

BY TY NANT SPRING WATER LTD

TO REGISTER A TRADE MARK IN CLASS 32

DECISION

Section 1(1) of the Trade Marks Act 1994 confirms that "*any sign capable of being represented graphically*" can be put forward for examination with a view to registration under the Act. However, the process of examination cannot begin until the Registrar has been provided with "*a representation*" of the sign in question (Section 32(2)(d) of the Act). Thereafter the scope for amendment of the filed representation is strictly limited (Sections 39 and 44 of the Act). Within the limits prescribed by those Sections an amendment to the filed representation may only be made if it "*does not substantially affect the identity of the trade mark*". This indicates that a representation filed under Section 32(2)(d) must, from the outset, disclose the identity of the sign which is said to be registrable and which may in due course be accepted for registration. It must do so graphically because that is the only form of representation that can be entered in the register which the Registrar is required to maintain under Section 63 of the Act.

The degree of precision with which the sign is represented must be sufficient to permit full and effective implementation of the provisions of the Act relating to absolute unregistrability (Section 3), relative unregistrability (Section 5), infringement (Section 10) and public inspection of the Register (Section 63). These provisions call for a fixed point of reference: a graphic representation in which the identity of the relevant sign is clearly and unambiguously recorded. There may be more than one way of representing a sign graphically with that degree of precision. It also seems clear that a sign (such as a sound or an aroma) can be taken to have been represented graphically with the required degree of precision when figuratively represented, even though interpretation or analysis may then be required in order to detect or demonstrate use of it. However, the scheme of rights and liabilities established by the Act cannot be implemented fully and effectively in relation to a graphic representation which fails to disclose the identity of the sign it purports to represent or to do so clearly and unambiguously. Such representations are, in my view, incapable of fulfilling the legal and administrative requirements of the Act and therefore cannot be accepted under Section 32(2)(d).

I find support for this view of the matter in a number of cases decided under the 1994 Act and under parallel Community legislation.

In Creola TM [1997] RPC 507 Counsel appearing for the Registrar submitted that the representation filed as part of an application for registration must be sufficiently clear and distinct to allow all the significant features of the relevant mark to be readily discerned. This submission was made in the context of an application for judicial review of a decision on the part of the Registrar to re-advertise (rather than proceed to registration of) a trade mark which

had been advertised (without opposition) in a form which did not accurately reproduce the representation filed as part of the relevant application for registration. Laddie J. accepted the submission on the basis that "when the Act and the Rules refer to a representation of the mark, they must be taken to mean a representation which clearly depicts the essential features which are sought to be the subject of the rights granted by registration" (p.510). He went on to hold that no sufficient representation of the applicant's mark had yet been advertised in accordance with the requirements of Section 38(1) of the Act and Rules 12 and 65 of the Trade Marks Rules. It followed that the time for opposition to the relevant application under Rule 13 had not yet started to run.

In Case R 4/97-2 Antoni & Allison's Application [1998] ETMR 460 the Second Board of Appeal of the Community Trade Marks Office decided that an application for registration which stated "The trade mark consists in the vacuum packing of an article of clothing in an envelope of plastics" was not sufficient to comply with the requirements of article 26(1)(d) of the Community Trade Mark Regulation (equivalent to Section 32(2)(d) of the 1994 Act) and was therefore not entitled to a date of filing under article 27 of the Community Trade Mark Regulation (equivalent to Section 33(1) of the 1994 Act). The Board observed that "the trade mark in question, in order to have been accorded a filing date, should have been reproduced. A mere description, not conveying the clear and precise appearance of the mark itself, cannot be considered a reproduction". The application was thus rejected for lack of a sufficiently precise graphic representation of a sign capable of being represented graphically in

accordance with the requirements of Article 4 of the Community Trade Mark Regulation (equivalent to Section 1(1) of the 1994 Act).

The question in Case R7/97-3 Orange Personal Communications Ltd's Application [1998] ETMR 460 was whether an application for registration which purported to identify a colour mark by use of nothing more than the word "orange" could be accorded a filing date under article 27 of the Community Trade Mark Regulation (equivalent to Section 31(1) of the 1994 Act). The Third Board of Appeal of the Community Trade Marks Office decided that the word "orange" was not sufficiently precise to be a representation of a colour for the purposes of article 26(1)(d) of the Community Trade Mark Regulation (equivalent to Section 32(2)(d) of the 1994 Act) and that the application did not qualify for a filing date until it had been particularised by the filing of a graphic representation of a particular shade of the colour orange on a separate sheet of paper. The Board observed that the original application was deficient because "an uncountable number of different colour shades, ranging in the specific case from dark to light and from the yellowish to the reddish tones, are conceivable which would all fall under the wide generic term 'orange'".

In Swizzels Matlow Ltd's Application (29 January 1999) Mr. Simon Thorley Q.C. acting as the Appointed Person upheld the Registrar's rejection of an application to register a three-dimensional mark defined only in words in the following terms: "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 of several different words or phrases". Having considered the requirements of the Act, the decision of the Second Board of Appeal in

Antoni & Allison's Application and the Registrar's practice as noted in Chapter 6 of the Registry's Work Manual he concluded that it is a fundamental legal requirement for people to be able to identify with clarity what is registered 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". He accepted that, in appropriate circumstances, there can be a representation of a mark which is not a visual image of the mark. However, he thought it was unlikely that a mere description of a three-dimensional article would, in practice, ever be sufficiently precise to meet the needs of the Act and he declined to accept that the graphical representation in issue in that case could be regarded as sufficient for that purpose. An application to amend the verbal description of the mark was refused on the basis that the proposed amendment was not permissible under Section 39 of the Act and on the basis that it failed to remedy the deficiencies of the application in any event.

The sign put forward for registration in Case R 156/1998-2 Venootschap onder Firma Senta Aromatic Marketing's Application [1999] ETMR 429 was an olfactory mark (for tennis balls) identified by nothing more than the words "the smell of fresh cut grass". The Second Board of Appeal of the Community Trade Marks Office confirmed in paragraph 10 of its decision that a mere description which does not convey a clear and precise indication of a trade mark cannot be considered to be an adequate graphical representation for the purposes of articles 4, 26(1) and 27 of the Community Trade Mark Regulation (equivalent to Sections 1(1),

32(2) and 33(1) of the 1994 Act). With reference to the words "the smell of fresh cut grass" it observed:

- "13. The question then arises whether or not this description gives clear enough information to those reading them to walk away with an immediate and unambiguous idea of what the mark is when used in connection with tennis balls.
14. The smell of freshly cut grass is a distinct smell which everyone immediately recognises from experience. For many, the scent or fragrance of freshly cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experiences.
15. The Board is satisfied that the description provided for the olfactory mark sought to be registered for tennis balls is appropriate and complies with the graphical representation requirement of Article 4 of the CTMR".

The Examiner's objections based upon lack of sufficient precision in the specification of the sign thus appear to have been regarded as unexceptional in point of law, but unsustainable in point of fact.

In the present case Ty Nant Spring Water Ltd ("the Applicant") applied on 1st April 1998 to register a trade mark for use in relation to "bottled water; bottled mineral water; bottled spring water; bottled carbonated water" in Class 32. The application stated that the trade mark was defined in terms of characteristic optical properties. The sign put forward for registration was represented in words in the following terms:

"a blue bottle of optical characteristics such that if the wall thickness is 3mm the bottle has, in air, a dominant wavelength of 472 to 474 nanometres, a purity of 44 to 48%, an optical brightness of 28 to 32%."

According to this wording the sign in question consisted of a blue bottle of any shape or size made from any material which would, if the wall thickness of the bottle was or was adjusted to 3mm, be found to produce readings within the ranges specified when its ability to absorb and reflect white light was measured with the aid of a spectrophotometer. The colour presented to the eye by light radiating within the ranges specified is known as cobalt blue.

It appears to me that the wording of the representation was unsatisfactory for the following reasons:

1. The sign it purported to define was a blue bottle of a particular hue (which it purported to define by reference to the readings that would be obtained if a bottle of the required hue was tested with the aid of a spectrophotometer). That way of defining the relevant hue required readers of the representation to ascertain the identity of the sign by taking steps to find out what such testing would reveal about the colouring of bottles which yielded readings within the ranges specified. Unless and until they took such steps, the actual identity of the sign put forward for registration would remain veiled by the wording of the representation. The representation did not mention the colour cobalt blue or include a graphic example of the relevant colour c.f. Orange Personal Communication Ltd's Application (supra).

2. Someone who wanted to test bottles for compliance with the requirements of the filed representation would have to make measurements (with the aid of a spectrophotometer) to determine the ability of the bottles to absorb and reflect white light in air. However, the test conditions envisaged by the wording of the representation were unspecified and there is no evidence before me to suggest: (a) that there is a standard test using standard equipment under standard conditions for the purpose of measuring the optical properties of bottles in air; or (b) that the use of any such test was necessarily implied by the wording of the representation.

3. The words "*if the wall thickness is 3mm*" added to the uncertainty by providing that bottles made from materials which might appear to be radiating differing shades of blue at the wall thicknesses they actually possessed, should none the less be regarded as manifestations of the sign put forward for registration if it could be established that readings within the ranges specified would be obtained if they possessed a wall thickness of 3mm.

For these reasons, I consider that the Applicant tried but failed to file a graphic representation in which the identity of the sign it purported to represent was clearly and unambiguously recorded.

In a decision issued on 12th October 1998 and reported at [1999] RPC 392 Mr. A.J. Pike acting as hearing officer for the Registrar rejected the application for registration on the ground that it was not possible to determine from the representation filed under Section

32(2)(d) precisely what sign the Applicant was seeking to protect. He concluded that the application should be refused under Section 3(1)(a) of the Act. Section 3(1)(a) prevents the registration of “*signs which do not satisfy the requirements of Section 1(1)*” and thus prevents the registration of signs which are not “*capable of being represented graphically*”. In case he was found to be wrong in that conclusion, he went on to consider whether the use of a blue bottle was capable of distinguishing the goods of interest to the Applicant from those of other undertakings. In the absence of any evidence to support a claim to distinctiveness acquired through use, he decided that the sign put forward for registration was “*devoid of any distinctive character*” and was therefore excluded from registration by Section 3(1)(b) of the Act.

While I agree with the hearing officer in thinking that the representation filed under Section 32(2)(d) was inadequate for the purpose of identifying a sign which the Applicant could legitimately put forward for registration, I am not prepared to conclude from the inadequacy of the representation that the application related to a sign that was not “*capable of being represented graphically*” within the meaning of Section 1(1) of the Act. I am therefore unwilling to uphold the objection to registration under Section 3(1)(a) of the Act. I am also unwilling to uphold an objection to registration under Section 3(1)(b) of the Act in relation to a sign which has not been clearly and unambiguously identified in the form of a graphic representation susceptible of examination in accordance with the statutory requirements.

It nevertheless appears to me that an application for registration of a sign which may be "*capable of being represented graphically*" within the meaning of Section 1(1) of the Act remains incomplete (and therefore subject to the operation of Rule 11 of the Trade Marks Rules 1994) unless and until the applicant has filed a graphic representation of the sign which is sufficiently precise to be susceptible of examination with a view to registration in the form in which it is filed. Rule 11 (as amended) provides that "Where an application for registration of a trade mark does not satisfy the requirements of Section 32(2) the registrar shall send notice thereof to the applicant to remedy the deficiencies and if within two months of the date of the notice the applicant - (a) fails to remedy the deficiency notified to him in respect of section 32(2), the application shall be deemed never to have been made, ...". Section 33(1) of the Act deals with the position where compliance with the requirements of Section 32(2) takes place in stages by providing that: "the date of filing of an application for registration of a trade mark is the date on which documents containing everything required by Section 32(2) are furnished to the registrar by the applicant. If the documents are furnished on different days, the date of filing is the last of those days". I do not accept the submissions made on behalf of the Applicant at the hearing before me to the effect that the filing of an inadequate representation is not a deficiency which an applicant can be required to remedy in accordance with these provisions of the Act and the Rules.

In the circumstances I propose to determine this appeal by directing that the application filed on behalf of the Applicant on 1st April 1998 be remitted to the Registrar for further action

in accordance with this decision and consequently in accordance with the provisions of Rule 11 of the Trade Marks Rules 1994.

In the run up to the hearing before me the Registrar gave notice of intention to seek an award of costs if the appeal was unsuccessful. The Applicant likewise gave notice of intention to seek an award of costs if the appeal was successful. It appears that each party gave notice in anticipation of the possibility that the position adopted by the other might be held to have been unreasonable to an extent that should attract an adverse order for costs.

I do not dissent from the proposition that unreasonableness in connection with an appeal to the Appointed Person from a decision of the Registrar in ex parte proceedings may justify a departure from the usual practice (of making no order for costs on such appeals) and result in the making of an order for costs against the party who has acted unreasonably. However, the present appeal does not appear to me to have involved unreasonable conduct on the part of the unsuccessful appellant.

The purpose of the representation put forward for registration was to define the colour cobalt blue within measurable limits. This was not an unreasonable aim to pursue. There was a need for clarity in that connection. As the Vice-Chancellor Sir Richard Scott observed when dismissing the Applicant's claim for an interlocutory injunction in Ty Nant Spring Water Ltd v. Simon Feeney Associates Ltd (28th April 1998):

“The particular features of the Plaintiff's bottles are that the bottles are glass, coloured cobalt blue. Cobalt blue is not a

colour which necessarily everybody would be able to visualise, but it is a deep, rich and, I think, very attractive shade of blue. Whether there is a spectrum of possible shades, all of which are entitled to describe themselves as cobalt blue I do not know. I dare say someone at the Royal Academy could inform one.”

Although the Applicant failed in its attempt to file a graphic representation in which the identity of the sign it purported to represent was clearly and unambiguously recorded, I am not prepared to condemn the Applicant in costs for appealing from the hearing officer’s decision and arguing before me that the filed representation was sufficient for the purposes of the Act. There will accordingly be no order for costs in relation to the appeal.

Geoffrey Hobbs Q.C.

12th July 1999

Mr. H. Austin of Messrs. Urquhart-Dykes & Lord appeared for the Applicant.

Mr. A. James, Principal Hearing Officer, appeared for the Registrar of Trade Marks.