

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3451062
BY SCANPROBE TECHNIQUES LIMITED
TO REGISTER THE FOLLOWING MARK IN CLASS 9:**

TRAPCAM

Background

1. On 12 December 2019, Scanprobe Techniques Limited (“the applicant”) applied to register the above mark for the following goods:

Class 9: Cameras for inspecting drains, pipes, sewers and other drainage structures; computer software relating to the operation of the aforesaid and the processing of data generated from drainage inspections including images; computer monitors and keyboards.

2. On 17 December 2019 the Intellectual Property Office (“IPO”) issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”) on the grounds that the mark consists exclusively of a sign which may serve in trade to designate the kind and intended purpose of the goods, e.g. cameras used to inspect traps in drainage structures.

3. The examiner supported the objection by providing a definition of the word ‘trap’ taken from The Cambridge Dictionary as being ‘*a device or hole for catching and holding things*’. The examiner further advised that in the field of plumbing a ‘trap’ is a device used within a pipe system that retains fluid, and serves to prevent sewer gases from entering buildings, while at the same time allowing waste materials to pass through. The examiner also reported that ‘cam’ is a well-known abbreviation for ‘camera’. Having noted the conjoining of the words ‘TRAP’ and ‘CAM’, the examiner was of the view that the break between ‘TRAP’ and ‘CAM’ would be readily apparent and consumers would find the meaning immediately intelligible.

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

5. On 10 February 2020 Murgitroyd & Company Limited (“the agent”) acting on behalf of the applicant requested a hearing.

6. At the hearing on 4 March 2020, attended by Ms Puravee Shah of Murgitroyds, the objection under section 3(1)(b)&(c) was maintained against the following goods:

Cameras for inspecting drains, pipes, sewers and other drainage structures; computer software relating to the operation of the aforesaid and the processing of data generated from drainage inspections including images.

7. The objection was waived for “*Computer monitors and keyboards*”.

BLO-266-20

8. On 6 March 2020 I issued the hearing report and a period of one month was granted to allow Ms Shah to consult with the applicant.

9. Although the application had not been formally refused for the goods identified above as the response date had not expired, a form TM5 was duly received on 17 March 2020. As I had made it clear in the hearing report that I was maintaining the objection in relation to the goods set out, to all intents and purposes this drew to a close any further discussion on the issue. Having received a request for a statement of reasons for the registrar's decision, I am now obliged to set out my reasons for my decision.

The Law

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

3(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of 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) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

The relevant legal principles – section 3(1)(c)

11. There are a number of judgements of the Court of Justice of the European Union ("CJEU") which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM*, C-191/01P 'Doublemint', paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*, paragraph 31);

BLO-266-20

- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods and services in question; it is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods and services. The word 'exclusively' in paragraph (c) is not intended to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau*, C-363/99 '*Postkantoor*', paragraph 57);
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA*, C-421/04);
- There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM*, T-67/07);
- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

12. I am also aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)*, [2002], ECT II-5179, stated:

"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods and services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods and services of the owner of the mark from those of a different commercial origin."

13. I have also taken into account the consequences for third parties of granting the applicant a monopoly. In *Linde A.G. v Rado Uhren A.G.* Case C-53/01 the following guidance was given at paragraphs 73 – 74:

"73. According to the Court's case-law "Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as

collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

14. It is clear from the aforementioned case law that I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating the kind or characteristic of the goods being provided. In order to do this, I must assess who I consider the relevant consumer to be. I have mentioned in paragraph 7 that at the hearing I had waived the objection against “*Computer monitors and keyboards*” so I shall consider the relevant consumer of the following goods only:

Cameras for inspecting drains, pipes, sewers and other drainage structures; computer software relating to the operation of the aforesaid and the processing of data generated from drainage inspections including images.

15. The reason for inspecting drains, pipes, sewers and other drainage structures is primarily to check for damage, leaks and blockages, but similar inspections are often included in a property survey on behalf of potential buyers to ensure the structures are sound. I am aware that there are a range of devices available that are specifically designed for inspecting inaccessible areas, for example, between wall cavities or in cramped roof spaces, as well as within drainage systems. These devices incorporate a camera attached to one end of a cable and a computerised visual display screen attached to the other where the photographs or film can be viewed. **Annex A** provides examples of a few devices specifically for use in drainage systems. It is my opinion that the goods in Class 9 specified as ‘*Cameras for inspecting drains, pipes, sewers and other drainage structures*’ will be similar to the devices shown in Annex A.

16. In my view, I consider that the relevant consumer of these products is more likely to be a company whose business it is to carry out drainage inspections on a regular basis and would purchase such goods as a necessary tool of the trade, however, it cannot be ruled out that the general public may also wish to inspect the drainage system of their home and purchase a lower cost product to do so. I therefore consider the relevant consumer of the cameras specified in the application to more typically be commercial businesses operating in the water and drainage industry, and surveyors working in the building and construction industry, as well as the general public who may purchase these products for domestic use. Given the nature of these goods, it is fair to say that the consumers’ attention levels when purchasing the goods will be high.

17. As well as being integral to an indoor sanitary system, for instance on sinks and toilets, traps are also used as part of the external drainage system of a building. The

BLO-266-20

meaning of a 'trap', in the context of the goods, was fully discussed at hearing and the information provided in **Annex B** and **Annex C** showing examples of traps used in external drainage systems and where they can be located within the system merely supports my finding. It is while inspecting traps, particularly external traps, that consumers would use a trapcam.

18. As regards the goods in Class 9 specified as "*computer software relating to the operation of the aforesaid and the processing of data generated from drainage inspections including images*" since the software relates to the 'operation' of the camera and the 'processing' of the data generated by the camera, the software forms part of the computer that operates the camera. It is therefore my opinion that the relevant consumer of this particular software will be the manufacturer of the camera.

19. Having considered the kind of goods encompassed within the specification, identified the relevant consumer, and established the likely level of attention, I must now determine how the average consumer will perceive the mark when used in respect of the goods claimed. I consider the mark TRAPCAM to be a neologism consisting of the words 'TRAP' and 'CAM'. These individual words are defined in Oxford Dictionary as:

trap – noun: [with modifier] A container or device used to collect something, or a place where something collects; A curve in the waste pipe from a bath, basin, or toilet that is always full of liquid and prevents gases from coming up the pipe into the building.

Cam – noun: informal – A camera

20. I acknowledge that the abbreviation CAM may have many meanings, but when used in respect of 'Cameras for inspecting drains, pipes, sewers and other drainage structures' I have no doubt that the relevant consumer will immediately understand it as meaning 'camera'.

21. In my opinion when viewed in the *prima facie* case, the sign 'TRAPCAM' used in respect of cameras and computer software for cameras would be understood as meaning 'trap camera', being a camera for use in or in relation to traps. As such, the sign would be perceived as nothing more than a readily comprehensible sign designating the *kind* and *intended purpose* of the goods. I note that there are other, more usual signs or indications used to designate cameras for use in inspecting traps such as a '*drain camera*', '*drain and duct inspect camera*' or '*plumbing videoscope*' as shown in Annex A, but the word 'exclusively' in section (c) of the Act is not intended to be interpreted as meaning that the sign or indication is the only way of designating the characteristic(s) in question. I am therefore of the opinion that the meaning of TRAPCAM will be readily understood by the average consumer as meaning a trap camera when used in relation to the goods intended for protection.

22. In reaching this conclusion I have considered the decision in the BIOMILD case, C-265/00, which states:

39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive, even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.

23. It is my opinion that the two elements TRAP and CAM are both clearly descriptive of the kind and intended purpose of the goods, and bringing these elements together without introducing any unusual variations, in particular as to syntax or meaning, has not resulted in anything other than a mark consisting exclusively of a sign which may serve, in trade, to designate the kind of goods concerned, namely 'trap cameras' and computer software intended for use in a trap camera. Furthermore, the combination has not created an impression that is sufficiently far removed from that of a trap cam.

24. The next part of my analysis takes in the nature of the goods upon which the sign will be used. I am mindful that refusal is only justified in relation to those goods in respect of which the sign designates its kind or characteristic. In this case, Class 9 includes *Cameras for inspecting drains, pipes, sewers and other drainage structures; computer software relating to the operation of the aforesaid and the processing of data generated from drainage inspections including images*. When used in respect of 'cameras' and the associated 'computer software', the mark TRAPCAM clearly describes the kind and intended purpose of the goods, namely, cameras intended for use in traps, and computer software intended specifically for use in a trapcam.

25. I have considered the guidance set out in relevant case law and I consider that the average consumer of the relevant goods will not perceive the sign as indicating trade origin of the goods. I therefore conclude that the mark consists exclusively of a

sign which may serve, in trade, to designate the kind and intended purpose of the goods. It is, therefore, excluded from registration by section 3(1)(c) of the Act.

The relevant legal principles – section 3(1)(b)

26. The application has been refused under sections 3(1)(b) and 3(1)(c). Any mark found to be unacceptable under section 3(1)(c) will, by inference, also be devoid of any distinctive character, and will therefore also attract an objection under 3(1)(b). In view of the fact that I maintained that the sign 'TRAPCAM' may serve in trade to designate the kind and intended purpose of the goods, that effectively concludes this decision. However, in case I am found to be wrong, I will go on to consider the mark under section 3(1)(b) independently. I approach this ground of objection on the basis of the following principles derived from the CJEU cases referred to below:

- An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- A word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may nonetheless be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought, and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01, paragraphs 72-77);
- The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

27. The perception of a sign as a distinctive trade mark must be one of immediacy and first impression. A sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of

BLO-266-20

a different commercial origin. (*Sykes Enterprises v OHIM* (2002 ECT II-5179 *Real People Real Solutions*).

28. In my opinion, even if the mark falls short of conveying the requisite level of specificity and objectivity to support an objection under section 3(1)(c), I would nevertheless hold that it is not capable of performing the essential function of a trade mark without the relevant consumer being educated into seeing it that way. In my view, consumers would not consider the mark as a designation that the goods belong to any one specific provider because of its direct association with the goods being offered. When considering the mark in relation to the goods claimed in the application, I believe that the relevant consumer will perceive the mark as nothing more than a readily comprehensible, non-distinctive sign which serves to inform them that the camera can be used in a trap.

29. It is my view that conjoining the two words does not add any inherent distinctiveness to the mark. The conjoined presentation would be perceived as nothing more than a minor (and inherently non-distinctive) presentational variation of the term 'TRAP CAM'.

30. The mark is devoid of any distinctive character and is, therefore, excluded from registration by section 3(1)(b) of the Act.

Conclusion

31. For the reasons given above, I consider the sign to be descriptive of the kind and intended purpose of the goods being *Cameras for inspecting drains, pipes, sewers and other drainage structures; computer software relating to the operation of the aforesaid and the processing of data generated from drainage inspections including images* pursuant to section 3(1)(c) and, by inference, also devoid of any distinctive character. In the event of it not being descriptive, I have also presented my reasons as to why the sign is objectionable under section 3(1)(b) in its own right. For the reasons given above, the application is therefore partially refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c).

Dated this 30th day of April 2020

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

Annex A



Rothenberger Rocam 4 Drain Camera 10.3" Colour Screen (7583K)



- 1 x 18V Li-Ion Battery
- 10.3" TFT Touchscreen
- 30m Insulated Flexible Neck Probe



COMPARE



£4,499.99 INC VAT



Not available to Click & Collect



Not available for delivery



Pro-Drain 4 Recordable Drain and Duct Inspect Camera

Be the first to write a review

£2394.00

Product Features:

- Choose from a 40m, 50m or 60m probe
- Optional built-in 512Hz location transmitter Sonde available
- Waterproof 38mm stainless steel self-levelling camera head
- Wireless keyboard and metre counter
- 7" high definition colour LCD monitor

[View Our Full Range Of Digital Inspection Cameras](#)

BLO-266-20

Home < Environmental & Temperature < Environmental Testers < Borescopes

Extech HDV650W Wireless HD Plumbing Videoscope (Probe Length Choice)

SKU: HDV650W-10G/30G ★★★★★ (0)

As low as

£1,989.00 EX VAT

£2,386.80 Inc VAT



Choose Model * Choose an Option...

1

Add to Basket

Price Match Guarantee & Advice >



Drain Pipe Inspection Camera

Be the first to write a review

£375.00 ~~£499.00~~

Product Features:

- Ideal for inspection of drains pipes and wall cavities
- Rechargeable battery for use remotely
- Totally Portable and Battery Powered
- Transfer videos & images to your PC via the SD Memory Card
- 20 Metre Cable Length

[View Our Full Range Of Digital Inspection Cameras](#)

BLO-266-20



5m Industrial Endoscope Waterproof Inspection Borescope Snake Camera 8 LED Light

£28.59

£1.99 postage
or Best Offer

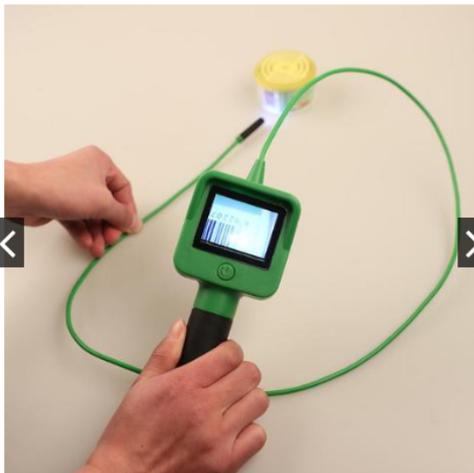
Only 1 left.

6 new & refurbished from £28.53

Flexibility: Flexible

Features: Photo Capture

. > Handheld Waterproof Micro Inspection...



Handheld Waterproof Micro Inspection Camera

£32⁹⁹ ~~£88⁹⁹~~ **SAVE £56**

 Click Add To Cart Now!

Quantity

1

 **Add to cart**

Secure and trusted checkout with

Annex B



110mm Underground 45 Degree Low Trap Gully



110mm Underground Low Back P Trap



FloPlast D500 Universal Gully Trap
(19993)

★★★★★ (4)

- 45° Outlet
- suitable for High Temperature Waste Discharges
- Simple Push-Fit Connection

COMPARE



FloPlast

FLOPLAST SUMP TRAP UNIT & BASKET (5078G)

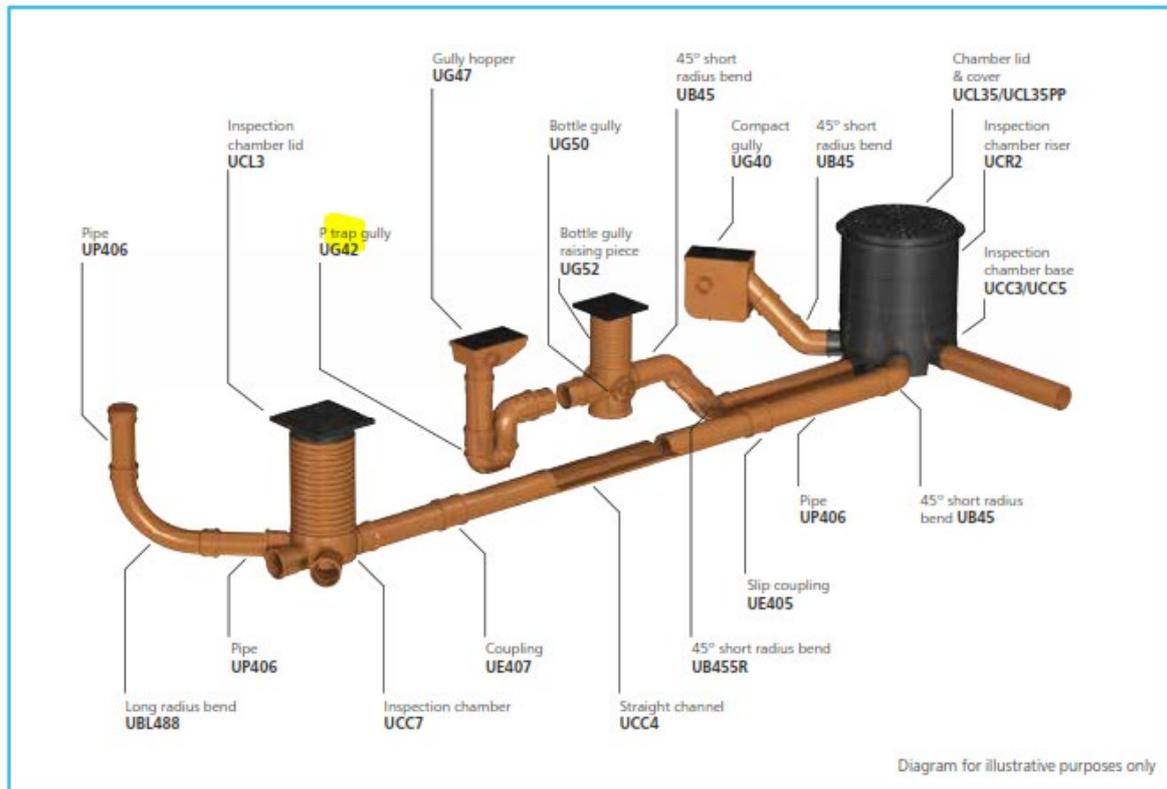
★★★★★ [View review \(1\)](#) [View all Q&A](#)

Traps debris so that the channel drainage can be cleaned. Lightweight and easy to install. Integral water trap releases no odour. Click and secure system with 100mm and 110mm outlets. Rubber seal included for watertight fit to outlet pipe.

Next Good Cost

Annex C

<https://www.marleyplumbinganddrainage.com/media/1191/underground-brochure-july-2015.pdf>



P trap gully

The double socket design of the UG42 P Trap Gully makes it ideal for use in restricted spaces and allows the trap to be orientated to suit the direction of the outlet pipe.

Both the square UG48 and rectangular UG47 hoppers can be connected to the gully using a short length of 110mm pipe cut to suit ground level.

The UG45 gully grating can also be used with the UW401 raising piece to receive waste pipe connections below ground level.

