

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

**THE PATENT OFFICE
VIA TELEPHONE CONFERENCE**

**Tribunal Room 1,
Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.**

Wednesday, 8th November 2006

Before:

**MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)**

- - - - -

In the Matter of the Trade Marks Act 1994

-and-

In the Matter of Trade Mark Application No: 2154261
In the name of
CALOR GAS (NORTHERN IRELAND) LIMITED

- - - - -

**Appeal of the Applicant from the decision of
Mr. A.J. Pike dated 12th May 2006 on behalf of the Registrar.**

- - - - -

(Transcript of the Shorthand Notes of
Marten Walsh Cherer Ltd.,
Midway House, 27/29 Cursitor Street,
London EC4A 1LT.
Telephone No: 020 7405 5010. Fax No: 020 7405 5026.)

- - - - -

MR. MICHAEL EDENBOROUGH (instructed by Messrs Alexander Ramage
Associates) appeared as Counsel on behalf of the
Applicant/Appellant.

MR. ALLAN JAMES (of the Trade Marks Registry) appeared on behalf
of the Registrar.

- - - - -

D E C I S I O N
As approved

- - - - -

1 THE APPOINTED PERSON: This is an appeal from a decision of the
2 Registrar refusing to allow an application for registration to
3 proceed on the ground that it failed to satisfy the legal
4 requirements for graphic representation of the sign for which
5 protection was requested.

6 I shall begin by noting the points of law and procedure
7 which I consider to be germane to the determination of the
8 appeal. I shall then review the filing and the processing of
9 the trade mark application at issue. Having done so, I will
10 state my conclusions on the substance of the appeal.

11 In point of law, an application for registration of a
12 trade mark cannot be allocated a filing date under section
13 33 of the Trade Marks Act 1994 unless and until it complies in
14 full with the requirements of section 32(2) of the
15 Act. The application will, until then, remain liable to be
16 refused a filing date in accordance with the procedure
17 prescribed by rule 11(a) of the Trade Marks Rules.

18 Rule 11(a) effectively provides for an application for
19 registration to be treated as a nullity if the applicant fails
20 to comply with an official notice requiring him to remedy the
21 deficiency or deficiencies affecting it under section 32(2)
22 within a non-extendable period of two months from the date of
23 the relevant notice.

24 If it appears to the Registrar that an application for
25 registration has been allocated a filing date in breach of

1 section 33, he can correct the irregularity by rescinding the
2 allocation and, if the requirements of section 32(2) remain
3 unfulfilled, issuing a deficiency notice under rule 11. He
4 has the power to do so under what is now rule 66 of the Trade
5 Marks Rule; see **Duckham Company's Trade Mark Application**
6 [2004] RPC 28, page 557 at paragraphs 38 to 45.

7 I would add that the power to correct irregularities
8 under rule 66 can, in appropriate cases, be exercised
9 notwithstanding that the irregularly processed trade mark
10 application has proceeded to registration; see **Andreas Stihl**
11 **AG & Co's Trade Mark Application** [2001] RPC 12 page 215. The
12 **Andreas Stihl** case was settled on reference to the High Court,
13 with the Registrar agreeing to act in accordance with the
14 reported decision and permit withdrawal of the registration
15 then in issue. The agreement was recorded in a consent order
16 made by Laddie J. on 17th May 2001.

17 If the Registrar validly exercises his power to refuse
18 or rescind the allocation of a filing date, the person
19 applying for registration will have no alternative but to
20 regularise his position under section 32 in order to get his
21 application up and running under section 33.

22 The applicant cannot resort to the provisions of
23 sections 13 or 39 of the Act. Those sections can be invoked
24 only for the purpose of reducing the scope of the protection
25 claimed by means of a duly filed application and cannot be

1 used to reduce the scope of protection in a manner that is not
2 fully compatible with retention of the filing date allocated
3 to the original application; see **Nestle SA's Trade Mark**
4 **Application** [2005] RPC 5 page 77 at paragraphs
5 16 and 31 to 41 per Mummery LJ.

6 In accordance with section 32(2)(d) of the Act, the
7 Registrar can validly refuse or rescind the allocation of a
8 filing date if the person applying for registration fails to
9 file "*a representation of the trade mark*" for which protection
10 is requested.

11 At this point, it is necessary to observe that the Act:
12 (1) confers protection with effect from the date of filing;
13 (2) centres the protection thus conferred upon use of the
14 identified mark in relation to goods or services of the kind
15 identified in the application; and (3) forbids any amendment
16 after the date of filing that would substantially affect the
17 identity of the trade mark or extend the goods or services
18 originally identified. These basic features of the system for
19 obtaining protection must be implemented with due regard for
20 the principle of legal certainty. More specifically, with
21 regard to the requirements of section 32(2)(d), I adopted the
22 following approach in **Ty Nant Spring Water Ltd's Trade Mark**
23 **Application** [2000] RPC 55 at page 56, line 24, to page 57,
24 line 2:

25 "Section 1(1) of the Trade Marks Act 1994 confirms

1 that 'any sign capable of being represented
2 graphically' can be put forward for examination with a
3 view to registration under the Act. However, the
4 process of examination cannot begin until the
5 registrar has been provided with "a representation" of
6 the sign in question (section 32(2)(d) of the Act).
7 Thereafter the scope for amendment of the filed
8 representation is strictly limited (sections 39 and 44
9 of the Act). Within the limits prescribed by those
10 sections an amendment to the filed representation may
11 only be made if it 'does not substantially affect the
12 identity of the trade mark.' This indicates that a
13 representation filed under section 32(2)(d) must, from
14 the outset, disclose the identity of the sign which is
15 said to be registrable and which may in due course be
16 accepted for registration. It must do so graphically
17 because that is the only form of representation that
18 can be entered in the register which the registrar is
19 required to maintain under section 63 of the Act.
20 The degree of precision with which the sign is
21 represented must be sufficient to permit full and
22 effective implementation of the provisions of the Act
23 relating to absolute unregistrability (section 3),
24 relative unregistrability (section 5), infringement
25 (section 10) and public inspection of the Register

1 (section 63). These provisions call for a fixed point
2 of reference: a graphic representation in which the
3 identity of the relevant sign is clearly and
4 unambiguously recorded. There may be more than one
5 way of representing a sign graphically with that
6 degree of precision. It also seems clear that a sign
7 (such as a sound or an aroma) can be taken to have
8 been represented graphically with the required degree
9 of precision when figuratively represented, even
10 though interpretation or analysis may then be required
11 in order to detect or demonstrate use of it. However,
12 the scheme of rights and liabilities established by
13 the Act cannot be implemented fully and effectively in
14 relation to a graphic representation which fails to
15 disclose the identity of the sign it purports to
16 represent or to do so clearly and unambiguously. Such
17 representations are, in my view, incapable of
18 fulfilling the legal and administrative requirements
19 of the Act and therefore cannot be accepted under
20 section 32(2)(d)"

21 On the basis of that approach, the Registrar issued a
22 practice note confirming that a filing date would be refused
23 in cases where the graphic representation put forward under
24 section 32(2)(d) did not clearly and unambiguously disclose
25 the identity of the sign it purported to represent.

1 Subsequently, in Case **C-273/00 Sieckmann** [2002] ECR
2 1-11737 at paragraphs 46 to 55, the ECJ held that in order to
3 be eligible for registration as a trade mark a sign must be
4 identified graphically by means of a representation which
5 satisfies the following criteria.

6 "46 That graphic representation must enable the sign
7 to be represented visually, particularly by means of
8 images, lines or characters, so that it can be
9 precisely identified.

10 47 Such an interpretation is required to allow for
11 the sound operation of the trade mark registration
12 system.

13 48 First, the function of the graphic
14 representability requirement is, in particular, to
15 define the mark itself in order to determine the
16 precise subject of the protection afforded by the
17 registered mark to its proprietor.

18 49 Next, the entry of the mark in a public register
19 has the aim of making it accessible to the competent
20 authorities and the public, particularly to economic
21 operators.

22 50 On the one hand, the competent authorities must
23 know with clarity and precision the nature of the
24 signs of which a mark consists in order to be able to
25 fulfil their obligations in relation to the prior

1 examination of registration applications and to the
2 publication and maintenance of an appropriate and
3 precise register of trade marks.

4 51 On the other hand, economic operators must, with
5 clarity and precision, be able to find out about
6 registrations or applications for registration made by
7 their current or potential competitors and thus to
8 receive relevant information about the rights of third
9 parties.

10 52 If the users of that register are to be able to
11 determine the precise nature of a mark on the basis of
12 its registration, its graphic representation in the
13 register must be self-contained, easily accessible and
14 intelligible.

15 53 Furthermore, in order to fulfil its role as a
16 registered trade mark a sign must always be perceived
17 unambiguously and in the same way so that the mark is
18 guaranteed as an indication of origin. In the light
19 of the duration of a mark's registration and the fact
20 that, as the Directive provides, it can be renewed for
21 varying periods, the representation must be durable.

22 54 Finally, the object of the representation is
23 specifically to avoid any element of subjectivity in
24 the process of identifying and perceiving the sign.
25 Consequently, the means of graphic representation must

1 be unequivocal and objective.
2 55 In the light of the foregoing observations, the
3 answer to the first question must be that Article 2 of
4 the Directive must be interpreted as meaning that a
5 trade mark may consist of a sign which is not in
6 itself capable of being perceived visually, provided
7 that it can be represented graphically, particularly
8 by means of images, lines or characters, and that the
9 representation is clear, precise, self-contained,
10 easily accessible, intelligible, durable and
11 objective."

12 This exposition of the requirement for legal certainty
13 has been affirmed and reaffirmed in later judgments of the
14 Court down to and including the judgment in Case **C-49/02**
15 **Heidelberger Bauchemie GmbH** [2004] ECR I-6129.

16 The **Sieckmann** criteria are clearly not satisfied by a
17 graphic representation which lacks precision as to the
18 particular colour or colours in which the identity of a colour
19 specific sign resides. That is especially true when the lack
20 of precision is attributable to the inclusion of general
21 designations such as 'red', 'green' or 'blue' in the graphic
22 representation of the sign. Such designations are, in the
23 absence of further clarification, apt to render the
24 representation unacceptable for ambiguity as noted in
25 **Robert McBride Ltd's Trade Mark Application** [2003] RPC

1 19, page 343 at paragraph 9:

2 "....The identity of a colour resides in the hue that
3 it presents to the eye of the observer. A verbal
4 description which fails to identify the hue of the
5 colour it seeks to define is a recipe for uncertainty:
6 it would leave room for differing perceptions of
7 different individuals to be equally applicable
8 benchmarks by which to judge whether a particular hue
9 falls within the relevant wording, with each
10 individual also being liable to regard the wording of
11 the description as applicable to a multiplicity of
12 different colour shades, c.f. *Orange Personal*
13 *Communications Ltd's Application.*"

14 In order to avoid that problem, the graphic
15 representation should contain as much information as people
16 who consult the register would realistically need to know in
17 order to determine how closely a given colour or colour scheme
18 matches the one which the graphic representation is intended
19 to identify. So as to satisfy the **Sieckmann** requirement for
20 durability, the graphic representation should also be recorded
21 with the degree of permanence envisaged by the ECJ in
22 paragraphs 31 to 38 of its judgment in Case
23 **C-104/01 Libertel** [2003] ECR I-3793:

24 "31 A mere sample of a colour does not, however,
25 satisfy the requirements set out in paragraphs 28 and

1 29 of this judgment.

2 32 In particular a sample of a colour may
3 deteriorate with time. There may be certain media on
4 which it is possible to reproduce a colour in
5 permanent form. However, with other media, including
6 paper, the exact shade of the colour cannot be
7 protected from the effects of the passage of time. In
8 these cases, the filing of a sample of a colour does
9 not possess the durability required by Article 2 of
10 the Directive (see **Sieckmann**, paragraph 53).

11 33 It follows that filing a sample of a colour does
12 not per se constitute a graphic representation within
13 the meaning of Article 2 of the Directive.

14 34 On the other hand, a verbal description of a
15 colour, in so far as it is composed of words which
16 themselves are made up of letters, does constitute a
17 graphic representation of the colour (see **Sieckmann**,
18 paragraph 70).

19 35 A description in words of the colour will not
20 necessarily satisfy the conditions set out in
21 paragraphs 28 and 29 of this judgment in every
22 instance. That is a question which must be evaluated
23 in the light of the circumstances of each individual
24 case.

25 36 A sample of a colour, combined with a

1 description in words of that colour, may therefore
2 constitute a graphic representation within the meaning
3 of Article 2 of the Directive, provided that the
4 description is clear, precise, self-contained, easily
5 accessible, intelligible, and objective.

6 37 For the same reasons as those set out at
7 paragraph 34 of this judgment, the designation of a
8 colour using an internationally recognised
9 identification code may be considered to constitute a
10 graphic representation. Such codes are deemed to be
11 precise and stable.

12 38 Where a sample of a colour, together with a
13 description of words, does not satisfy the conditions
14 laid down in Article 2 of the Directive in order for
15 it to constitute a graphic representation because,
16 inter alia, it lacks precision or durability, that
17 deficiency may, depending on the facts, be remedied by
18 adding a colour designation from an internationally
19 recognised identification code."

20 In the present case, Calor Gas (Northern Ireland)
21 Limited applied under number 2154261 on 23rd December 1997 to
22 register a series of two signs as trade marks for use in
23 relation to "*fuel gas in liquid form*" in class 4.

24 The signs in the series were graphically represented in
25 the application in the following manner:

1



7

8

The Trade Mark consists of the colour yellow applied to the outer surface of the cylinder within which gas is contained.

10

11

12

The Trade Mark consists of the colour yellow applied to the outer surface of a cylinder within which gas is contained.

13

14

15

16

17

The representations were filed in black-and-white. The dotted shading on the diagram of the gas cylinder represented the colour yellow in accordance with the so-called heraldic convention for the representation of colours; see **Kerly's Law of Trade Marks & Trade Names**, 14th Edition 2005, Appendix 30. In Box 3 of the application form, it was confirmed that the applicant was seeking protection for signs consisting of "colour as described".

18

19

20

21

22

23

24

25

In an official letter dated 20th January 1998, the

1 Registrar notified the applicant that its application for
2 registration was considered to be unacceptable under section
3 3(1)(a) of the Act "because it is not capable of functioning
4 as a trade mark."

5 The applicant interpreted this objection, correctly, as
6 being directed to the form of graphical representation. It
7 maintained in a letter to the Registry dated 3rd March 1998
8 that the graphical representation was sufficient to satisfy
9 the requirements of the Act and the Rules.

10 On 29th April 1998, the Registry responded stating that
11 the graphical representation "does not show how much of the
12 surface is coloured yellow and in that respect the mark is not
13 graphically represented."

14 In subsequent communications between the applicant and
15 the Registry, it was agreed that the objection would be waived
16 in respect of the first sign in the series, i.e. the sign
17 which included the diagram of a gas cylinder, if the applicant
18 added a clarifying statement to the effect that the colour in
19 question is applied to the whole outer surface of the
20 cylinder. The Registry continued to object to the second sign
21 in the series on the basis that it contained no accompanying
22 line drawing and "the description alone is insufficient as gas
23 cylinders come in varying shapes and sizes."

24 On 3rd September 1999, the Registry issued a deficiency
25 notice under rule 11 on the ground that the graphic

1 representations on file did not clearly and unambiguously
2 disclose the identities of the signs put forward for
3 registration. An unextendable deadline of two months,
4 expiring on 3rd November 1999, was set for the purpose of
5 allowing the applicant to remedy the deficiencies.

6 In the course of further communications between the
7 applicant and the Registry, the applicant agreed to delete the
8 second sign in the series and amend the wording of the first
9 sign in the series to make it read: *"The trade mark consists
10 of the colour yellow applied to the whole visible surface of
11 the cylinder within which gas is contained."*

12 On that basis, the Registry waived the deficiency notice
13 and allowed the application to proceed in respect of the first
14 sign in the series with its original filing date of
15 23rd December 1997. Thereafter, the debate between the
16 applicant and the Registry centred on the question whether the
17 remaining sign was caught by the exclusion from registration
18 contained in section 3(1)(b) of the Act.

19 However, in August 2003 the Registry returned to the
20 question of graphical representation. In an official letter
21 dated 7th August 2003, the Registry wrote to the applicant in
22 the following terms.

23 **"Graphical representation**

24 2. Before I go on to discuss the evidence filed, I refer to
25 my telephone conversation yesterday with

1 Ms Natalie Ramage, your assistant. This raised with
2 her an issue which has never previously been detected
3 on this application as far as I can tell. It is the
4 question of specific depiction of the colour 'yellow'
5 as described on the application. Although an early
6 graphical representation objection was raised, it
7 concerned the wording on the TM3 in so far as it
8 related to the colour applied to the *whole* surface of
9 the cylinder. The precise form of wording agreed was
10 confirmed to you in the official letter of 13th
11 September 1999. It seems to me in dealing with that
12 issue, the equally applicable objection should have
13 been raised to the effect that the colour yellow in
14 the mark should either have been represented in colour
15 or the wording should have provided a specific Pantone
16 reference for the colour intended. That was the
17 practice when the case was examined, and although
18 there has been much debate on the issue over the
19 years, it is still essentially the same practice today
20 (see PAC 2/00) and of course has recently been
21 commented on in the ECJ decision in "Libertel".
22 3. As you know, it is not possible to amend the mark
23 without losing the application date, and now filing a
24 colour copy or adding the Pantone reference would
25 clearly constitute an amendment (as opposed to a

1 clarification) to the application. As the date of
2 application was close to six years ago, losing the
3 original date I'm sure would not be an attractive
4 option to you or the applicants. However, there is a
5 way forward.

6 4. I notice that the representation of the cylinder
7 on the Form of application was in what I recognised as
8 heraldic shading. Looking up my records of what the
9 shading represented (in an old version of the Registry
10 Practice Guide from 1992!) I see that 'dotted ground'
11 as in the application is indeed a depiction of "yellow
12 or gold". That to me suggests that it can be
13 interpreted that the application has been made in the
14 colour yellow. The colour yellow per se is not
15 specific enough according to practice or the guidance,
16 but I think a clarification of that colour by the
17 addition of the relevant Pantone reference would
18 constitute no more than an *acceptable clarification*,
19 **without the loss of the original filing date.**

20 5. This will of course require you to find out the
21 correct reference and submit the clarification, but I
22 hope you agree it is preferable to the alternative.
23 The time to do this is stipulated at the end of this
24 letter."

25 The Registry allowed a period of two months, expiring on

1 7th October 2003 for the applicant to respond. The applicant
2 responded on 7th October 2003 stating:

3 "First, with regard to the issue of graphical
4 representation, we agree that the overall impression
5 given by the Form TM3 is that yellow as designated by
6 the standard heraldic shading used, is claimed as
7 represented on the original TM3. With that in mind,
8 our Client will be happy to clarify the issue further
9 as required. Unfortunately, so far as we can tell,
10 the Pantone reference with which we were supplied does
11 not relate to the colour in hand. Presumably, there
12 has been some clerical error in transmitting it to us,
13 and we are attempting to clarify the precise
14 reference."

15 Then on 3rd November 2003, the Registry sent a letter
16 maintaining on the basis of the **Libertel** judgment in the ECJ
17 that the representation of the mark currently on file did not
18 satisfy the relevant requirements for graphical representation
19 and that the applicant could therefore not be allowed to
20 proceed until the deficiency in the application had been
21 remedied.

22 The applicant was again allowed a period of two months
23 in which to remedy the deficiency. The letter did not
24 explicitly refer to rule 11 or section 32(2)(d) and it is not
25 immediately apparent that the writer of the letter was fully

1 mindful of the operation of rule 11(a).

2 Moreover, on 18th November 2003 the Registry wrote to
3 the applicant stating that if the requirements for graphic
4 representation were met within the specified period of two
5 months, expiring on 3rd January 2004, the application for
6 registration would retain its original filing date of
7 23rd December 1997. That was entirely inconsistent with the
8 way in which section 32(2)(d), section 33(1) and rule 11(a)
9 are intended to operate.

10 Since 3rd January 2004 was a Saturday, the date for
11 compliance with the requirements of the official letter of 3rd
12 November 2003 was automatically extended to
13 Monday, 5th January 2004.

14 On 5th January 2004, the applicant filed a letter and
15 supplied an attachment with a view to remedying the
16 deficiencies in its graphic representation. The letter stated
17 as follows:

18 "We refer to our telephone conversation with the
19 Examiner (Gareth Hicks) today. As discussed we are
20 sending herewith as an attachment a JPEG (which has
21 been copied onto a floppy disc and accompanies the
22 confirmation copy of this letter) showing the colour
23 yellow represented on the Application form, the
24 reference values for which are R255, G160, B22. In
25 our telephone conversation the Examiner said that to

1 meet the requirements of PAN 3/03 the colour had to be
2 clearly defined by a recognised standard. He
3 indicated that the information we were providing
4 should meet the requirements of PAN 3/03 as RGB is an
5 internationally recognised colour identification
6 system, albeit a lesser known identification system.
7 We understand that the information we have provided
8 will allow the Application to retain its original
9 filing date."

10 The Registry responded on 24th March 2004 in the
11 following terms:

12 "As discussed in our telephone conversation of 10
13 February, the image that you submitted on 5 January
14 has been passed to our technical expert who has
15 analysed it using an editing package.
16 He has informed me that the image is an
17 unambiguous electronic representation of a specific
18 colour. However, the problem we have is that the
19 colour is not close to pure yellow (the colour of the
20 cylinder applied for) but sits between yellow and red
21 in the orange region. The 'Photoshop' package
22 indicates the closest Pantone colours in the "Coated"
23 inks to be Pantone 1375C, which comprises 81.3%
24 Pantone Yellow and 18.7% Warm Red. The closest in the
25 "Uncoated" inks is Pantone 123U, which comprises 93.8%

1 Pantone Yellow and 6.2% Warm Red. In essence, the
2 colour of the image is orange which of course is
3 contrary to the mark applied for which states the
4 colour yellow.

5 It would appear that the way forward would be
6 for a further image to be submitted in the same format
7 but in the colour intended. It is imperative that the
8 image is precisely the colour of the cylinder your
9 client wishes to register.

10 If you are able to submit an acceptable image and
11 overcome the section 3(1) objection, it would be our
12 intention to publish a colour sample of the mark
13 alongside the cylinder with the following wording:
14 "*The trade mark consists of a colour yellow applied to
15 the whole visible surface of the cylinder as shown
16 within which the goods are contained. The applicant
17 has provided the Registrar with a digital image which
18 contains an embedded sRGB colour management profile.
19 The precise colour yellow can be viewed in a
20 controlled environment at the Patent Office.*"

21 I would confirm that the extension of time to 7 June
22 2004 previously requested has been allowed and look
23 forward to hearing from you. This extension relates
24 to both the evidence and graphical representation
25 issues.

1 Please note that if nothing further is received from
2 you by the above date, the application will be
3 refused."

4 If, as might have been intended, the Registry letter
5 sent on 3rd November 2003 had imposed a two month
6 non-extendable deadline under rule 11 for compliance with the
7 requirements of section 32(2)(d), as interpreted in the case
8 law I have noted above, the Registrar should not have invited
9 the applicant to file further information as to the identity
10 of the colour yellow it was seeking to register and should
11 instead have treated the application as a nullity under
12 rule 11(a). The applicant would then have been able to appeal
13 against the rule 11 notice if it wished to do so.

14 What actually happened was that further correspondence
15 and communications took place between the applicant and the
16 Registrar relating to the question whether the particular
17 colour represented in the JPEG file delivered to the Registry
18 on 5th January 2004 was clearly and unambiguously describable
19 by the word "yellow" which continued to form part of the
20 verbal element of the graphic representation of the relevant
21 sign.

22 At this point, I think it is appropriate to observe that
23 this debate was, in and of itself, proof of the ambiguity
24 inherent in the use of the broad term "yellow" in the wording
25 of the graphic representation.

1 A fairly substantial volume of evidence had by this
2 stage been filed on behalf of the applicant with a view to
3 persuading the Registrar that the sign in issue possessed a
4 distinctive character acquired through use. The evidence
5 included the results of some survey work carried out by
6 Millward Brown (Ulster) Limited in August 2004. The evidence,
7 including this and earlier survey evidence, was said to
8 establish public recognition of the particular colour
9 represented in the JPEG file as yellow.

10 Having read and considered all the evidence on file, I
11 am unable to agree with the suggestion that it shows the
12 colour in question being affirmatively identified by people in
13 the world at large as yellow.

14 On 5th May 2005, the Registry issued a deficiency notice
15 in the following terms:

16 "The content of your letter has been considered by the
17 Hearing Officer. However, the Registrar is of the
18 view that the application does not meet the
19 requirements of Section 32(2)(d) of the Trade Marks
20 Act 1994 in that it does not contain a representation
21 of the mark which meets the *Sieckmann* criteria as
22 being precise, due to the fact that the claim has been
23 made to the mark consisting of the colour *yellow*
24 whereas the colour submitted is clearly the colour
25 *orange*. Furthermore, this makes it difficult for the

1 Hearing Officer to undertake a realistic assessment of
2 the evidence of use submitted thus far when the mark
3 in question on which such evidence is based, in his
4 view, differs from that filed.
5 In view of this conflicting information, I
6 therefore send notice under Rule 11 of the Trade Marks
7 Rules 2000 for the applicant to remedy this deficiency
8 within two months of the date of this letter.
9 If, within this time, this deficiency fails to be
10 remedied, the application shall be deemed never to
11 have been made. In line with Practice Amendment
12 Notice 3/03, if matters are rectified within this two
13 month period, the date of filing given to the
14 application is the date upon which everything
15 required by Section 32(2) is furnished to the
16 Registrar. We cannot extend the two month period.
17 I would also remind the applicant of their right to be
18 heard in respect of this matter."
19 This letter did succeed in correlating the procedure
20 under rule 11 with the requirements of sections 32(2)(d) and
21 33(1) of the Act. However, despite imposing an unextendable
22 period of two months, expiring on 5th July 2005, for the
23 applicant to remedy the notified deficiency, the letter ended
24 with the words: "*I would also remind the applicant of their*
25 *right to be heard in respect of this matter.*" That was, as

1 one would have expected, interpreted by the applicant as an
2 invitation to consider whether a hearing should be convened
3 for the purpose of discussing whether the deficiency notice
4 issued under rule 11 on 5th May 2005 had been validly issued.

5 On 1st July 2005, the applicant wrote to the Registry
6 requesting a hearing. It is possible that at some point,
7 prior to 3rd June 2005, a Registry official may have told the
8 applicant informally that the deficiency notice would be held
9 in abeyance if a hearing was requested.

10 On 26th November 2005, that is to say, more than four
11 and a half months after the unextendable deadline set by the
12 deficiency notice issued on 5th May 2005 had expired, the
13 Registry informed the applicant that the hearing it had
14 requested would take place on 18th January 2006 before
15 Mr. Alan Pike, acting as hearing officer on behalf of the
16 Registrar. Nothing was said about the status of the trade
17 mark application under rule 11(a).

18 In his decision letter issued on 30th January 2006,
19 Mr. Pike informed the applicant that he regarded the
20 deficiency notice issued on 5th May 2005 as valid under
21 section 32(2)(d) and rule 11 with the result that trade mark
22 application number 2154261 was "*deemed never to have been*
23 *made*" under rule 11(a) on expiry of the relevant two month
24 period, that is to say on 5th July 2005.

25 Then, on 1st March 2006, the applicant filed a

1 Form TM5 requesting a statement of reasons under rule 62 of
2 the Trade Marks Rules in respect of the decision notified by
3 Mr. Pike in his letter of 30th January 2006. The requested
4 reasons were provided in a written decision issued on
5 12th May 2006 under reference BL 0-124-06. In that decision,
6 Mr. Pike referred to the Oxford Concise Dictionary (Ninth
7 Edition) definitions of the word 'yellow' as a colour between
8 green and orange and the word 'orange' as a reddish yellow
9 colour. He summarised the basis of the Registrar's objection
10 to the applicant's graphic representation in the following
11 terms.

12 "While I accept the dictionary definitions of the
13 words yellow and orange it does not necessarily follow
14 that the colour identified as R 255, G 160, B 22 is a
15 shade of yellow. I accept that there are numerous
16 shades of yellow but I do not accept that the colour
17 represented by the RGB reference is a representation
18 of the colour yellow. I order to comply with the
19 requirements of Section 32(2) of the Act the written
20 description of the trade mark applied for must
21 correspond to the visual representation of it. The
22 Registrar regards the written statement as forming a
23 part of the graphical representation of the mark. A
24 person inspecting the register would not regard the
25 visual representation of the mark filed as being

1 yellow. Thus there is ambiguity caused by the tension
2 between the written description and the colour
3 representation in the JPEG file."

4 On 9th June 2006, the applicant gave notice of appeal to
5 an Appointed Person under section 76 of the Trade Marks Act
6 1994. The grounds of appeal were stated as follows:

7 1. The Hearing Officer erred as a matter of law when
8 construing section 32(2)(d) of the TMA 1994. The JPEG
9 file that was submitted on the 5th January 2004 was a
10 true and proper graphical representation of the
11 Application, and should have been accepted as such.
12 Accordingly, the Hearing Officer erred by refusing to
13 accord the Application its original filing date, or
14 alternatively a deemed filing date of the 5th January
15 2004.

16 2. The Hearing Officer was wrong as matter of law to
17 substitute his own perception of the colour of the
18 Application. The purpose of the criteria promulgated
19 by the ECJ in the case of *Sieckmann* (Case C-273/00) is
20 to ensure that the colour of a application is defined,
21 *inter alia*, objectively, and so is not vulnerable to
22 the vagaries of a subjective perception, which
23 characterised the flaw in the Hearing Officer's
24 approach in this Application.

25 3. Further, or alternatively, the Hearing Officer

1 was wrong as a matter of fact to substitute his own
2 perception of the colour of the Application in the
3 face of the unchallenged evidence from consumers and
4 the trade, who all (without exception) described the
5 Application as "yellow".

6 4. The Hearing Officer was wrong to disregard the
7 undisputed fact that in the decision of the Second
8 Board of Appeal of OHIM, dated the 6th October 2005,
9 in Case R 255/2004-2, a very similar colour was
10 consistently, and without any criticism relating to
11 the characterization of its colour, referred to as
12 "yellow".

13 5. The Hearing Officer was wrong to disregard the
14 evidence of its own technical expert who concluded
15 that the colour in question comprised at least 81.3%
16 Pantone Yellow, as reported in the Patent Office's
17 letter dated the 24th March 2004. Clearly, such a
18 characterization indicates that the colour in question
19 is predominantly yellow."

20 These contentions were developed in argument at the
21 hearing before me.

22 As a matter of form, the appeal is directed to the
23 hearing officer's decision to confirm the correctness of the
24 deficiency notice issued on 5th May 2005.

25 In substance and reality, it is an appeal against the decision

1 to issue that notice. I have considerable doubts as to the
2 legitimacy of conducting a hearing in the Registry for the
3 purpose of deciding whether the Registrar should or should not
4 confirm the correctness of a decision which he has already
5 made and carried into effect. I recognise that there can
6 sometimes be vitiating circumstances which allow a decision
7 taker to set aside a decision he has made on the basis that it
8 was irregular or misdirected because it was taken in ignorance
9 of the true facts or as a result of receiving materially false
10 information. Rule 66 goes at least some of the way to
11 providing a remedy in such cases. So does section 64 of the
12 Act. However, the general rule as I understand it is that a
13 decision taker at this level of decision taking has the power
14 to decide once and once only; see **Andreas Stihl** at pages 221
15 and 222. As a corollary of that, it would appear to be wrong
16 in principle for a decision taker to act as if he had the
17 power to sit on appeal from his own decisions.

18 If I were to apply the logic of this approach in the
19 present case, it would lead me to the view that the hearing
20 which resulted in the decision under appeal was irregular and
21 that the applicant is well out of time for appealing against
22 the decision to issue the deficiency notice sent to it on 5th
23 May 2005. However, I have not heard full argument on the
24 point. I also think it would be an arid and unsatisfactory
25 way of dealing with the appeal.

1 In the exceptional circumstances of the present case, it
2 appears to me that the just and fair way of proceeding is to
3 treat the Registrar as having de facto exercised his power
4 under rule 68 to extend the applicant's time for appealing to
5 an Appointed Person against the issue of the deficiency notice
6 over until 9th June 2006. That effectively enables me to
7 treat the appeal as an appeal against the decision to issue
8 that notice on 5th May 2005.

9 With regard to the substance of the appeal as thus
10 defined, I consider that the Registrar was right to regard a
11 representation of colour expressed in terms of an sRGB profile
12 as being in principle satisfactory for the purpose of
13 fulfilling the **Sieckmann** and **Libertel** requirements for graphic
14 representation. That leads me to think that the wording of
15 the graphic representation of the sign in issue in the present
16 case might appropriately have been reworded to something along
17 the lines of: *"The trade mark consists of the sRGB (IEC*
18 *61966-2.1) colour R255 G160 B22 applied to the whole visible*
19 *surface of the cylinder within which gas is contained."*

20 On the other hand, I am not satisfied that the form of
21 wording suggested in the Registry letter of 24th March 2004
22 was an appropriate way of bringing the wording of the existing
23 graphic representation into conformity with the **Sieckmann** and
24 **Libertel** criteria. That is because the suggested wording
25 appears to me to leave altogether too much information as to

1 the precise identity of the sign off the register. By doing
2 so, it falls short, in my view, of providing the clear,
3 precise, self-contained, easily accessible, intelligible,
4 durable, unequivocal and objective record of the sign that the
5 case law requires.

6 In addition, it perpetuates what I regard as the flaw
7 inherent in the use of the word "yellow" in the wording of the
8 initial and the amplified graphical representations. That
9 word is ambiguous and the ambiguity is not removed by coupling
10 it with references to a colour which, when presented to the
11 eye of the observer, would often, if not predominantly, be
12 thought of as orange.

13 As I have said, I do not accept that the evidence on
14 file establishes public recognition of the particular colour
15 represented in the JPEG file as yellow. Even if some people
16 are liable under some conditions to classify it as a shade of
17 yellow, I have no doubt that there are plenty of other people
18 who would be liable under the same or similar conditions to
19 classify it as a shade of orange. And there lies the problem.
20 People addressing themselves to the graphic representation of
21 the sign with the assistance of the visual information
22 provided by the JPEG file would, in my view, be left thinking
23 that, if the visual information provided by the JPEG file is
24 intended to demonstrate what the applicant means by use of the
25 word "yellow", it is not clear how far the coverage of the

1 word and the visual information in combination should then be
2 taken to extend.

3 I do not see this as a case like **Robert McBride's**
4 **Application** where the word "yellow" and the reference to
5 Pantone 101 succeeded in combination in precisely identifying
6 a single shade of colour. Rather, it is a case in which the
7 wording and visual imagery combine to leave room for doubt as
8 to whether the applicant is referring to a single shade of
9 colour and, if so, precisely what shade and which colour.

10 That leads me to conclude that the original and the
11 amplified graphic representations of colour were not clear,
12 precise, self-contained, easily accessible, intelligible,
13 durable, unequivocal and objective to the standard required.
14 The appeal will therefore be dismissed. In accordance with
15 the usual practice in relation to appeals such as the present,
16 it will be dismissed with no order for costs.

17 At the hearing before me, it was suggested on behalf of
18 the applicant that the processing of its trade mark
19 application in the Registry had been substantially inadequate
20 and unsatisfactory and that it would be appropriate for me to
21 make an order for costs in favour of the applicant to
22 compensate it for the expense and delay occasioned by the way
23 in which its application had been handled.

24 I do not accept that this would be an appropriate
25 exercise of my power to award costs in respect of the appeal

1 that has been brought before me. In so far as there have been
2 shortcomings on the part of the Registry in the processing of
3 the application for registration, they appear to me to have
4 been the result of attempts on the part of Registry officials
5 to be helpful in preference to being strict with regard to
6 implementation of the applicable legislative provisions. I
7 also bear in mind that section 70 of the 1994 Act provides a
8 statutory exclusion of liability for the benefit of Registry
9 officials in circumstances of the kind I am now considering.

10 However, I am prepared to say that I think this is a
11 case in which the Registrar might very properly give
12 sympathetic consideration to any request for ex gratia
13 compensation that might be made on behalf of the applicant.
14 Beyond that, I am not prepared to go. That concludes my
15 determination of this appeal.

16 MR. JAMES: Thank you, sir.

17 THE APPOINTED PERSON: Does that conclude everything that we need
18 to discuss? I believe that it does.

19 MR. EDENBOROUGH: Yes, sir, I think it does.

20 THE APPOINTED PERSON: Mr. James, nothing else?

21 MR. JAMES: Just one point for Mr. Edenborough. I hope he can
22 hear me clearly. If your client is minded to take up the last
23 point with the Registrar, then the person to direct those
24 submissions to would be myself.

25 MR. EDENBOROUGH: Thank you very much for that indication. I know

