

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION No. 2162087

TO REGISTER A SERIES OF TRADE MARKS

IN CLASS 3

IN THE NAME OF ROBERT McBRIDE LTD

DECISION

1. This appeal touches upon several different aspects of the law and practice relating to registration of trade marks under the Trade Marks Act 1994. I propose to address each of these aspects separately before turning to consider their impact upon the particular application for registration that is now before me.

Obtaining a filing date

2. Sections 32 and 33 of the Trade Marks Act 1994 provide as follows:

Application for registration

32. (1) An application for registration of a trade mark shall be made to the registrar.

(2) The application shall contain –

- (a) a request for registration of a trade mark,
- (b) the name and address of the applicant,
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
- (d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in

relation to those goods or services, or that he has a *bona fide* intention that it should be so used.

(4) The application shall be subject to the payment of the application fee and such class fees as may be appropriate.

Date of filing

33. (1) 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.

(2) References in this Act to the date of application for registration are to the date of filing of the application.

Sections 32(2) and 33(1) match the provisions of Articles 26(1) and 27 of Council Regulation 40/94 of 20th December 1993 on the Community trade mark (“*the CTMR*”). They make it clear that an application for registration cannot be given a filing date unless and until it is complete in terms of the specified filing requirements.

Representation of the trade mark

3. In Ty Nant Spring Water Ltd’s Application [2000] RPC 55 I considered the scope of the requirement for “*a representation of the trade mark*” to be filed under Section 32(2)(d). Having regard to the provisions of the Act noted at pp.56 and 57, I concluded that a representation must not only disclose the identity of the mark put forward for registration, but must do so clearly and unambiguously from the outset in order to receive a filing date under Section 33(1).

4. This accords with the position adopted by the Third Board of Appeal of the Community Trade Marks Office in Case R7/97-3 Orange Personal Communications Ltd's Application [1998] ETMR 460. The question in that case 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 CTMR (equivalent to Section 31(1) of the 1994 Act). It was held that the word "orange" was not sufficiently precise to be a representation of a colour for the purposes of Article 26(1)(d) CTMR (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'"***.

5. The need for precision at the outset gives effect to the change of practice foreshadowed in paragraphs 4.08 and 4.09 of the White Paper on Reform of Trade Marks Law Cmnd 1203 (September 1990):

4.08 At present, if a mark as filed is found to be unregistrable then, if the Registrar agrees, it may be amended during examination or opposition. A great deal of time can be taken up in negotiations in the Registry when an applicant seeks to take advantage of this possibility. Moreover the mark eventually registered may be quite different from that contained in the original application; sometimes what had initially been claimed as the trade mark is later disclaimed as non-distinctive.

4.09 It seems reasonable that someone seeking to register a trade mark should declare at the outset what his mark is. Amendment of a trade mark after

registration has been applied for will not in general be possible under the proposed Community trade marks system, nor is it possible under the Madrid Agreement. Under the new law therefore it will not be possible to make such amendments. If the mark as filed is unregistrable it will be necessary to file a fresh application in order to register any amended version of the mark. Nor will it be possible to amend a mark already on the register. As a limited exception, it will be possible to alter the name or address of the proprietor where that forms part of the mark.

6. The decision to depart from the previous practice related to an aspect of procedure on filing which the UK remained free to determine for itself: see the fifth recital in the preamble to Council Directive 89/104/EEC of 21st December 1988. Precision in the representation of marks put forward for registration is necessary in the interests of legal certainty. Legal certainty is a general requirement of Community law.

Series of trade marks

7. An applicant may apply for registration of “*a series*” of trade marks in accordance with the provisions of Section 41 of the 1994 Act. In order to be acceptable, the application must contain “*a representation of each mark claimed to be in the series*” and the Registrar must be satisfied that the marks thus represented “*resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark*”: Section 41(2) of the Act and Rule 21(1) of the Trade Marks Rules 2000 (formerly Rule 21(1) of the Trade Marks Rules 1994). The Registrar cannot be satisfied of that fact unless and until the applicant has filed graphic representations in which the identity of each mark in the series is clearly and unambiguously recorded.

Applying for registration in colour

8. An application for registration can be made subject to: (i) a colour claim confirming that a specified colour or colour scheme forms part of the trade mark to which the claim relates; or more restrictively: (ii) a colour limitation confirming that a specified colour or colour scheme is indispensable to the identity of the trade mark to which the limitation applies. Both possibilities involve the voluntary adoption of a 'limitation' within the meaning of that expression as used in Section 13 of the Act.

9. It is clearly not possible to define the scope of a colour claim or limitation without identifying the particular colour(s) concerned. The identity of a colour resides in the hue it presents to the eye of the observer. A verbal description which fails to identify the hue of the colour it seeks to define is a recipe for uncertainty: it would leave room for differing perceptions of different individuals to be equally applicable benchmarks by which to judge whether a particular hue falls within the relevant wording, with each individual also being liable to regard the wording of the description as applicable to a multiplicity of different colour shades c.f. Orange Personal Communications Ltd's Application (above).

10. The Registrar's published statements of practice have accordingly emphasised that an application for registration in colour should be based upon a graphic representation of the relevant trade mark filed in the relevant colour(s) or filed in black-and-white with the relevant colour(s) precisely defined by reference to a Pantone or other widely known and readily available colour standard: see pp. 19 and 20 of Chapter 6 of the Trade Marks Registry Work Manual (June 1996); Practice Amendment Circular 9/97 (April 1997) and Practice Amendment Circular 2/00 (February 2000).

11. The Trade Marks Journal and the Register of Trade Marks have hitherto contained black-and-white representations of marks filed in colour. This is an area of the Registrar's practice in which changes are expected to occur.

12. The current position was summarised in the decision of the Registrar's hearing officer, Mr. G.W. Salthouse, in the matter of Application No. 9704 for a declaration of invalidity and/or rectification in respect of Trade Mark No. 2114332 (SRIS 0-246-02, 18th June 2002):

“Anyone inspecting the register who wishes to see the marks as originally filed in colour may do so on request, or they can request a coloured copy of the mark. Advances in technology mean that electronic trade mark registers can now record colour. Accordingly, all new coloured trade marks are being registered in colour and an exercise is under way to record all existing colour marks on the register in the colours filed.”

13. In relation to applications for the registration of colours *per se*, the practice in the Community Trade Marks Office, as described in paragraph 18 of the decision of the Third Board of Appeal in Case R 122/98-3 Wm. Wrigley Jr. Company's Application [1999] ETMR 214 would seem to be acceptable under the 1994 Act:

“A colour *per se* may be represented graphically, within the meaning of Article 4 of the CTMR, by means of a two-dimensional optical reproduction of the shade claimed, such as a strip of colour, as in the present case, on a sheet of paper separate from the sheet on which the text of the application appears, ... A specimen of the colour thus submitted would clearly define the subject-matter of trade mark protection. Since data may nowadays be stored electronically, it is now no longer necessary to specify a colour code, which would otherwise be needed, in order to preserve the colour shade indefinitely without deterioration over time. ...”

However, the vicissitudes of moving backwards and forwards between electronic and physical representations of colour may make it prudent to continue including Pantone or similar references in colour-specific applications for the time being.

Absence of colour claim or limitation

14. It is assumed, unless otherwise stated, that trade mark registration has been requested and conferred on the basis that use of the relevant mark in colour is neither claimed nor disclaimed. The absence of a colour claim or limitation effectively makes it a condition of registration that no colouring is necessary for the mark in question to possess a distinctive character: Cases T-128/00 and T-129/00 Procter & Gamble Company v. OHIM (19th September 2001) paragraph 55. A mark validly registered without a colour claim or limitation may therefore be taken to have been used when it appears in colour no less than when it appears in black-and-white, if the representation conforms to the template or pattern of the mark as registered.

Adding a colour claim or limitation

15. Section 13 of the Act confirms that an applicant for registration or the proprietor of a registered trade mark may ***“agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation”***. In order to be free of the restrictions on amendment contained in Sections 39 and 44 of the Act (equivalent to the restrictions on amendment contained in Articles 44 and 48 of the CTMR), the proposed limitation must leave the existing graphic representation of the relevant mark intact: cf. Swizzels Matlow Ltd’s Application [1999] RPC 879 at pp. 887, 888, Bud and Budweiser Budbrau Trade Marks [2002] RPC 38, p.747 see paragraphs 12, 13 and 24. The inability to add or subtract detail outside the scope of Sections 39 and 44 appears to lead inevitably to the conclusion that a limitation added

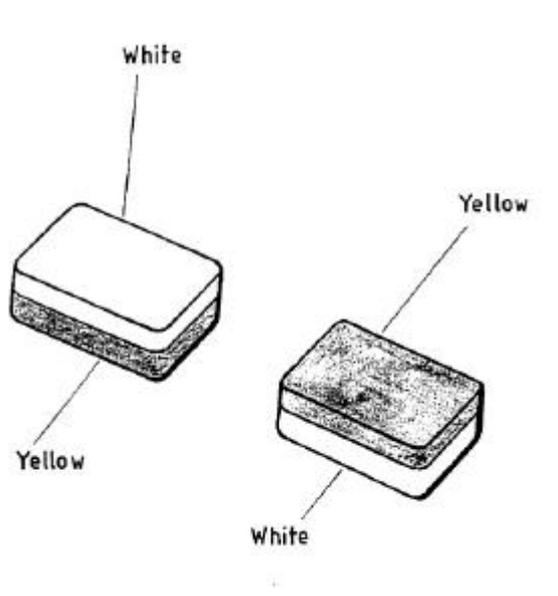
under Section 13 must operate simply and solely as a renunciation of protection that registration of the mark in question might otherwise have provided. So the template or pattern of the mark recorded in the antecedent application or registration must remain recognisably unaltered within the residue defined by a supervening colour claim or limitation. And the colour claim or limitation must be defined with as much precision as would have been required if the relevant mark had been subject to it from the outset.

16. The effective date of a limitation added under Section 13 would appear to be the date upon which it is entered in the Register under Rule 24 of the Trade Marks Rules 2000. The addition of a limitation within the constraints noted in the preceding paragraph may nonetheless be regarded as sufficient in current practice to neutralise an objection to the validity of the application or registration to which the limitation is added. As examples of this, see Bach and Bach Flower Remedies Trade Marks [1999] RPC 1 at pp.45 line 35 to 46, line 21 (Neuberger J); Opposition No. 47740 in the name of Slim Images Ltd to Application No. 2026289 in the name of Goldenglow International (Registry 23rd March 2000); Application No. 2199175A in the name of Compass Group Plc (Appointed Person SRIS 0/325/00 28th July 2000). However, uncertainty as to the actual identity of the mark recorded in the antecedent application or registration does not appear to me to be curable with retrospective effect by means of a limitation added within the constraints applicable to the operation of Section 13.

The present application for registration

17. In the present case, Robert McBride Ltd (“*the Applicant*”) applied on 24th April 1998 to register a series of two signs as trade marks for use in relation to “cleaning preparations; bleaching preparations; dish washing powders; textile

washing powders; rinsing agents; all in tablet form” in Class 3. The signs in the series were graphically represented in the application for registration in the following form:



The application stated that the signs were put forward for registration as three dimensional marks, with a claim to the colours yellow and white as indicated.

Examination of the application

18. An objection to the effect that the relevant signs were inadequately represented in the application was raised by the Trade Marks Registry under Section 3(1)(a) of the Act in an examination report issued on 23rd April 1998. The objection was subsequently waived in an official letter dated 18th November 1998.

19. On 7th October 1999 the Applicant’s trade mark attorneys wrote to the Registry in the following terms:

“Whilst we have not received an Official letter in respect of the above application claiming that the representation of the mark filed fails to satisfy the requirements of Section 32(2)(d) on the basis that the mark has not been clearly and unambiguously recorded, we have received such official letters from the Registrar

in relation to two associated trade mark applications of the applicant, numbers 2165276 and 2169735.

In the event that the Registrar is minded to reject the original application date of the above application on this basis, we hereby confirm that the Pantone reference of the colour yellow of the mark applied for is number 101, and we request an amended filing date of today's date, given that the Pantone reference clearly and unambiguously defines the colour of the mark as filed.

The foregoing is without prejudice to the applicant's contention that the Registrar's refusal of the original filing date for this application is unlawful, and, in the event that the Registrar does reject the original filing date of the application, the applicant hereby requests a hearing at which to argue that the application should retain its original filing date."

20. The Registry responded on 12th October 1999 stating:

"... The representation currently on file fails to satisfy the requirements of Section 32(2)(d), the identity of the sign it purports to represent has not been clearly and unambiguously recorded. The degree of precision with which the sign is represented is not sufficient to permit full and effective examination.

In the present case the colour yellow was not sufficiently defined. I note that you have stated, in your letter of 7 October 1999, that the colour yellow can be clearly and unambiguously defined by Pantone reference number 101. Subject to your right to discuss this matter at a hearing, the date of filing will become that date upon which the Registrar received an acceptable representation of the mark, in this case 7 October 1999.

It is noted that the contents of your letter are without prejudice to the applicant's contention that the Registrar's refusal of the original filing date is unlawful, and that the applicant requests a hearing at which to argue that the application should retain its original filing date.

I have now passed this application to the hearings clerk to await the allocation of a hearing ..."

The hearing officer's decision

21. A hearing was appointed to consider the Applicant's contention that its application for registration complied (or could be amended so as to comply) with the requirements of Section 32(2)(d) of the Act as of 24th April 1998 and ought therefore to be treated as filed on that date for the purposes of Section 33(1) of the Act.

22. The hearing took place before Mr. C. Hamilton acting on behalf of the Registrar of Trade Marks. In a written decision issued on 8th February 2001 the hearing officer held that the Applicant was not entitled to a filing date for its application under Section 33(1) of the Act until it had further defined the colour of the elements described in the graphic representations as "yellow", as it did by adding a reference to Pantone 101 on 7th October 1999.

23. He considered that no question of amendment could arise until the Registrar was seized of a duly filed application for registration.

24. On the basis that Section 33(1) required the date of filing of an application to be "***the date on which documents containing everything required by section 32(2) are furnished to the registrar by the applicant***", he considered that the question whether the application could be taken to have been duly filed on 24th April 1998 depended entirely upon whether the documents filed on that date had or had not contained "***everything***" required by Section 32(2).

25. As to that, he concluded that the graphic representations filed on 24th April 1998 were insufficiently precise to satisfy the requirement for legal certainty under Section 32(2)(d):

“However, I take the view that the registrar had no option other than to require the applicant to further define the subject matter of the proposed registration. The colour yellow is imprecise and open to subjective analysis of the beholder. It could be applied to some colours that others could interpret as cream, lemon or even orange. This is particularly important where, as here, colour is a main feature of the mark.”

26. He was not swayed by the suggestion that the Applicant might be prejudiced by filings on behalf of other parties in the period between 24th April 1998 and 7th October 1999: (a) because he took the view that the Registrar had no power to waive or vary the requirements of Sections 32 and 33 of the Act; and (b) because he took the view that the risk of such prejudice arising would have been avoided if the Applicant had followed the Registrar’s published practice relating to applications for registration in colour (see paragraph 10 above).

27. Finally, he noted that the Registrar’s position with regard to the shortcomings of the word “yellow” for use as a means of representing the identity of a key feature of the marks in issue was consistent with the decision of the Third Board of Appeal of the Community Trade Marks Office in Orange Personal Communications Ltd’s Application (above).

The appeal and grounds of appeal

28. The Applicant gave notice of appeal to an Appointed Person under Section 76 of the Act, contending in substance:

- (i) that the graphic representations filed on 25th March 1998 were sufficiently precise to satisfy the requirements of Section 32(2)(d) of the Act;

- (ii) that the practice adopted by the Registrar on the basis of the decision in the Ty Nant case was not permitted or required by Council Directive 89/104/EEC of 21st December 1988 or any provisions of the Trade Marks Act 1994;
- (iii) that the practice adopted by the Registrar on the basis of the decision in the Ty Nant case amounted, in general and in the particular circumstances of the present case, to a breach of natural justice.

Ground (iii) was not pursued at the hearing of the appeal.

29. It was at one point suggested that if I was not minded to allow the appeal, the issues arising should be referred to the Court for determination under Section 76(3) of the Act. The suggestion was withdrawn in subsequent correspondence and it was confirmed at the hearing before me that the Applicant and the Registrar wished me to determine the appeal upon its merits.

30. A point addressed in argument at my request was whether, as appeared to have happened in Glaxo Group Ltd's Trade Mark [2001] ETMR 96, a lack of precision as to the colour claimed in an application for registration could be cured, with retrospective effect, by subjecting the graphic representation of the relevant mark to a voluntary disclaimer of all except one Pantone shade under Section 13 of the Act. I received helpful submissions on this point. My understanding of the operation of Section 13 in relation to the addition of colour claims and limitations is summarised in paragraphs 15 and 16 above.

Decision

31. If the graphic representations shown in paragraph 17 above had simply been filed in black-and-white, without any references to “yellow” and with no colour claim

in the application for registration, the application would legitimately have been accorded a filing date in accordance with the provisions of Sections 32(2) and 33(1) of the Act. The application would then have proceeded on the basis that use of the relevant marks in colour was neither claimed nor disclaimed (see paragraph 14 above). That would have remained the position unless and until an acceptable colour claim or limitation was voluntarily adopted under Section 13 of the Act (see paragraphs 15 and 16 above).

32. The Applicant submitted that the position should be the same if (which was not conceded) the references to “yellow” and the colour claim in the application for registration failed to define an acceptable limitation for the purposes of Section 13. It maintained that to go further and treat the presence of an ill-defined limitation as a reason for denying the application a filing date would be to elevate the administrative requirements of Sections 32(2) and 33(1) to the status of substantive grounds for refusal without any proper basis for doing so under the Act or the Directive. It contended that a curably deficient application is nonetheless an effective application for the purposes of Sections 32(2) and 33(1). Any deficiency with regard to the identification of colour could, it was submitted, be cured under Section 13 of the Act in the present case.

33. It appears to me that the requirement for legal certainty must inevitably extend to the identification of any colour that is said to form part of the mark that an applicant has put forward for registration. That means in a case such as the present that each graphic representation should contain as much information as people who consult the Register would realistically need to know in order to determine how closely a given colour or colour scheme matches the one which the graphic

representation is intended to identify. Although the graphic representations shown in paragraph 17 identified the presence of colour, they did not do so clearly and unambiguously and therefore failed to achieve the degree of precision required for the allocation of a filing date under Section 31(1). I agree with the hearing officer in thinking that the effective date of filing was 7th October 1999 when the Applicant resolved the uncertainty by notifying the Registrar that the relevant shade of yellow was Pantone 101.

34. A deficiency is not any the less a deficiency because it might be cured. The question is whether the existence of the deficiency, while it subsists, affects the status of the application or registration under the Act. If so, there may or may not be a sustainable application or registration for Section 13 to bite upon.

35. In this case, the deficiency was lack of precision attributable to the presence of an ill-defined colour claim. While it subsisted, the deficiency affected the status of the relevant application by creating uncertainty as to the identity of the colour-specific mark that the Applicant was seeking to register. The uncertainty was sufficient, in my view, to render the application unacceptable under Sections 32(2) and 33(1). If the Applicant had simply applied for registration in black-and-white, there would have been no uncertainty as to the identity of the mark submitted for examination of Procter & Gamble Company's Applications (above). The application would then have satisfied the requirements of Sections 32(2) and 33(1). I do not think it can be right to regard certainty and uncertainty of representation as equally acceptable under those provisions of the Act.

36. The words “administrative” and “substantive” are both apt to describe the requirement for certainty as to the identity of the mark that an applicant has put

forward for registration. Failure to comply with that requirement might be attributable to the fact that the applicant is attempting to register something that is excluded from registration by Section 3(1)(a) of the Act because it is not “*capable of being represented graphically*”. On the other hand, it might be attributable to the fact that the mark of interest to the applicant has not been represented with the required degree of precision even though it is “*capable of being represented graphically*” and is therefore unobjectionable under Section 3(1)(a). Either way the result is the same so far as the obtaining of a filing date is concerned.

37. The Trade Mark Rules have provided, in relation to applications for registration filed after 26th April 1998, that “*Where colour is claimed as an element of the trade mark, it shall not be treated as such unless the application contains a statement to that effect and specifies the colour*”: see, now, Rule 5(3) of the Trade Marks Rules 2000. It appears to me that the purpose of this provision is to state the requirements that must be met before a colour claim can be regarded as effective, even in relation to a representation filed in colour. I do not consider that the Rule requires the Registrar to disregard the existence of an ill-defined colour claim when determining whether a representation clearly and unambiguously records the identity of a mark susceptible of examination under Section 37 of the Act. Still less do I consider that it could do so in relation to an application filed (as in the present case) prior to 27th April 1998.

38. I was invited to consider whether the Community Trade Marks Office would have adopted the same position as the Registrar in relation to the present application for registration. I believe that it would on the basis of: the provisions of Articles 26(1) and 27 CTMR; the decision of the Third Board of Appeal in Orange Personal

Communications Ltd's Application (above); and the provisions of Rule 3(5) of the Implementing Regulation under the CTMR:

“Where registration in colour is applied for, the application shall contain an indication to that effect. The colours making up the mark shall also be indicated. The reproduction under paragraph 2 shall consist of the colour reproduction of the mark.”

However, I do not consider that a contrary conclusion would have indicated that the Registrar's determination in the present case was wrong.

Conclusion

39. The appeal will be dismissed for the reasons I have given above. As agreed at the hearing, there will be no order as to costs.

Geoffrey Hobbs Q.C.

7th October 2002

Mr. James Mellor instructed by Messrs. Marks & Clerk appeared as Counsel on behalf of the Applicant.

Mr. Allan James, Principal Hearing Officer, appeared on behalf of the Registrar.