

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3204742
IN THE NAME OF FREEFORMERS HOLDINGS LIMITED
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 9, 16, 28, 35, 38, 41, 42
AND 45:**

UPLOAD LIVE



(Series of two)

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Background

1. On 3 January 2017, Freeformers Holdings Limited ('the applicant') applied to register the above trade marks, as a series of two, for the following goods and services:

Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; mobile apps and software; computer software in the field of digital marketing and training; computer software development tools; website development software; computer software for use as an application programming interface (API) which facilitates online services for social networking; downloadable publications; computer application software for mobile phones; computer graphics software; teaching and instructional apparatus and instruments; communications apparatus; telephone apparatus; communications equipment; data communications apparatus; SIM cards; parts and fittings for the aforesaid goods.

Class 16: Paper and cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers' type; printing blocks; books; magazines; journals; printed publications; printed educational materials; printed teaching materials; cards; collectable trading cards; flash cards.

- Class 28: Games and playthings; gymnastic and sporting articles; decorations for Christmas trees; educational games; playing cards; game cards.
- Class 35: Advertising; business management; business administration; office functions; recruitment advertising and services; rental of advertising space; advertising services; publicity services; marketing services; business advice in the field of digital marketing; advice and consultancy relating to digital transformation in the field of business; marketing consultancy, advice, research and studies; marketing agency services; advice and consultancy relating to digital marketing; management consulting, advice and assistance; personnel management consultation; management assistance in promoting business; analysis of business management systems; administration relating to marketing; providing marketing consulting in the field of social media; providing business information and business advice in the field of social media; office administration services; business networking services; online business networking services; rental of office machines and equipment; advertising, marketing and promotion services for businesses; compilation of information into computer databases; career information and advisory services; career networking services; career planning consultancy; providing an online searchable database featuring employment and career opportunities and business, employment and professional information; providing information relating to business networking; organising and conducting job fairs; business research services; market research services; organising and conducting business exhibitions; arranging of business introductions; provision of business information; business administration and management; business advice; business consultancy; business mentoring services; business data analysis; analysis of market research data; developing promotional campaigns for business; information, advisory and consultancy services relating to the aforesaid.
- Class 38: Telecommunications; communications by mobile phones; broadcasting services; audio, video and multimedia broadcasting via the Internet and other communications networks; online messaging services; providing online forums; providing online chatrooms for the transmission of messages, comments and multimedia content among users; providing access to multimedia content online; providing access to content, websites and portals; chat room services for social networking; dissemination, provision and transmission of computer programs, information and materials in audio, audio-visual, interactive and print formats; information, advisory and consultancy services relating to the aforesaid.
- Class 41: Education; providing of training; entertainment; sporting and cultural activities; education and training in the field of digital marketing; education and training in the field of business and digital business; education and training in the field of digital transformation for businesses; organising and arranging educational events; training courses relating to advertising, promotion, marketing and business; organising and facilitating meetings

and seminars; entertainment services in the nature of arranging social entertainment events; publication of documents in the field of training; computer training; personnel training; sales training services; training and further training consultancy; personal development training; staff training services; management training services; computer training services; conducting workshops; training relating to computer software and coding; training in the design of software systems and computer programs; career advisory services; career counselling and coaching; career information and advisory services; providing computer, electronic and online databases for educational, recreational and amusement use; photo sharing and video sharing services; providing information regarding news, cultural and academic matters; providing and hosting seminars; electronic and online publishing services; hosting of exhibitions, conferences, seminars, workshops and networking events; publishing services; electronic publishing services; rental of projection equipment; rental of audio/visual equipment; arranging, conducting and hosting of exhibitions, conferences and seminars; information, advisory and consultancy services relating to the aforesaid.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; information technology consultancy; telecommunications technology consultancy; compilation of information relating to information technology; development of new technology for others; information technology support services; research in the field of information technology; hosting an online website community for registered users to share information, photos, audio, and video content; software, database and website design; computer software research; research to develop new products; software research; software maintenance; hosting virtual online communities; hosting of digital content online; hosting an interactive website and online non-downloadable software for uploading, downloading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, images, text, information, and other user-generated content; creating, hosting and maintaining websites; hosting computer software applications of others; rental of computer hardware; rental of computer software; rental of computers; internet café services; technical data analysis services; computer services for the analysis of data; information, advisory and consultancy services relating to the aforesaid; scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; information technology consultancy; telecommunications technology consultancy; compilation of information relating to information technology; development of new technology for others; information technology support services; research in the field of information technology; hosting an online website community for registered users to share information, photos, audio, and video content; software, database and website design; computer software

research; research to develop new products; software research; software maintenance; hosting virtual online communities; hosting of digital content online; hosting an interactive website and online non-downloadable software for uploading, downloading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, images, text, information, and other user-generated content; creating, hosting and maintaining websites; hosting computer software applications of others; rental of computer hardware; rental of computer software; rental of computers; internet café services; technical data analysis services; computer services for the analysis of data; information, advisory and consultancy services relating to the aforesaid.

Class 45: Legal services; security services for the protection of property and individuals; hosting an online website community for registered users to share information, photos, audio, and video content; social introduction and networking services; licensing of computer software and other technology; licensing of technology; online social networking services; information, advisory and consultancy services relating to the aforesaid.

2. On 12 January 2017, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, objections were raised under section 41(2), and sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act').
3. The section 41(2) objection was based on material differences between the two marks, where the first is clearly word-only, and the second contains stylisation and figurative elements. As a result of these visual differences, the examiner found that the two signs could not be considered an acceptable series.
4. The section 3(1)(c) objection was raised by the examiner on the grounds that the expression 'Upload Live' was deemed to be *"a sign which may serve in trade to designate the intended purpose of the goods and services e.g. software, telecommunications services and providing websites that enable the user to upload live photos videos or data"*. As a result of the objection under section 3(1)(c), which was directed towards the goods and services claimed in classes 09, 16, 38, 41 and 42 only, the mark was also found to be objectionable under section 3(1)(b) on the basis of it being devoid of any distinctive character.
5. The Examination Report confirmed that the objection under sections 3(1)(b) and (c) applied to the first (word-only) mark in the series *only*; the second (figurative) mark was considered acceptable. It also confirmed that the section 3(1) objection could be overcome by removal of the word-only mark (thereby also overcoming the section 41(2) series objection), and that, in accordance with standard procedure, failure to reply within the stipulated response period would result in the application being refused under section 37(4).
6. On 13 March 2017, the applicant requested a one-month extension of time which, after being duly granted, established a new deadline of 22 May 2017. The examiner's

confirmation letter of 20 March 2017 reiterated that failure to respond would result in the application being refused.

7. On 5 June 2017, fourteen days after expiry of the deadline, the examiner issued a 'Failure to Respond' letter. This letter confirmed that the Registrar had not received any response relating to the objections taken under sections 41(2), 3(1)(b) or 3(1)(c), and that, as a result, the application was being refused under section 37(4).
8. On 5 July 2017, the applicant filed a Form TM5, requesting a written statement of reasons for the Registrar's decision. Under section 76 of the Act 1994, and rule 69 of the Trade Marks Rules 2008 ('the rules'), I am now asked to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore I have only the *prima facie* case to consider.

Decision

9. In both the examination report of 12 January 2017 and the 'extension of time' letter of 20 March 2017, it was explained that failure to reply to the section 41(2), 3(1)(b) and 3(1)(c) objections by the set date would result in the application being refused in accordance with section 37(4) of the Trade Marks Act 1994.
10. Section 37 sets out provisions which govern the examination of trade mark applications, with sub-section (4), in particular, providing the Registrar with grounds for refusing such an application where it fails to meet the requirements for registration. The provision reads as follows:

"If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application."
11. Although the initial examination report confirmed that the figurative mark (i.e. the second trade mark) was acceptable, the applicant provided the Registrar with no subsequent instructions. No request to publish the application in respect of the second (figurative mark) was ever received, and the Registrar did not interpret non-response on the applicant's part as being an 'implied' instruction to proceed with an acceptable mark (the Registrar does not deem it to be within his discretion to 'select' a mark from an unacceptable series, on behalf of an applicant, in order to facilitate publication).
12. This is in line with the *Eurolamb* judgment ([1997] R.P.C 279). In that decision, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considered the extent of the Registrar's discretionary powers in relation to publishing marks which are *prima facie* acceptable without direct instruction:

"With reference to the point which has been argued before me relating to the question of burden - whether the Registrar is obliged to register marks unless he can demonstrate that they are ineligible for registration - I take the view that the position in relation to applications under the new Act is neutral; i.e. that there is

generally no presumption in favour of registration and no presumption against registration.

The procedure for refusal envisaged by section 37 appears to me to involve two stages. In the first stage, the Registrar is obliged under section 37(3), if he thinks that the requirements for registration are not met, to inform the applicant and give him an opportunity to make representations or to amend the application. The second stage is reached if (notwithstanding that the applicant has availed himself of that opportunity) the Registrar remains dissatisfied that the mark meets the requirements for registration: in that case he is obliged to refuse it under section 37(4).

On the other hand, if he is satisfied that the requirements for registration are met, he must accept the application under section 37(5). I think that the combined effect of subsections (4) and (5) of section 37 is to eliminate the discretion which the Registrar previously had with regard to registration under the 1938 Act and to put him in the position of having to make a judgment, yes or no, upon the materials before him as to the registrability of a mark put forward for registration.”

13. Consequently, the Registrar believes that the examiner’s decision to refuse the mark as a result of the applicant’s failure to respond within a clearly-communicated time frame was correct, and in full accordance with established law and practice.
14. Had the need for an applicant’s response been prompted by *ex officio* objections which were subsequently deemed to be unfounded, then the Registrar’s refusal pursuant to section 37(4) may be called into question. For the avoidance of any doubt, and in the interests of legal certainty, I have, therefore, presented below a brief review and confirmation of the examiner’s original objections taken under sections 3(1)(b) and (c) and section 41(2).

Section 41(2)

15. In order to function as a series in accordance with section 41(2), trade marks must resemble each other as to their material particulars. Differences must only be of a non-distinctive character, and must not substantially affect the overall identity of the signs. This concept of ‘overall identity’ was considered by Jacob J in *Neutrogena Corporation v Golden Limited* [1996] RPC 473:

“Not substantially affecting its identity’ means what it says, both in this section and in other sections of the Act (e.g. section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test.”

16. Having compared the two marks applied for in this application, it is clear to me that their visual and conceptual identities are substantially different from one another, due primarily to the presence of figurative elements in only one of the two signs. Whilst the two marks may be considered to be identical from an aural perspective, they each display striking visual differences which also irrevocably affect their conceptual

identities. In light of these differences, I agree with the examiner that the marks do not meet the criteria for acceptance as a series of marks, and so the objection taken under section 41(2) objection was correctly raised.

Sections 3(1)(b) and (c)

17. The partial section 3(1) objection, taken against the word-only mark, was based on the examiner's finding that the phrase 'Upload Live' designates the *intended purpose* of the goods and services i.e. that they enable users to upload live photos, video, or data. I believe that his conclusion in this regard reflects a well-reasoned assessment of how the mark will be perceived when used in respect of goods and services claimed in classes 9, 16, 38, 41 and 42, all of which relate to the recording, storage, uploading and dissemination of (potentially) live data feeds and/or events.
18. The word-only sign comprises of the two words 'Upload' and 'Live'. Considered independently, each term is frequently used in those sectors reflected in the offending classes. The word 'Upload' refers to the transfer of data from one device or server to another. Not only does this directly describe a characteristic of those objectionable goods and services identified by the examiner in the original report, but the term is itself descriptive of a service proper to class 42. In addition, the word 'Live' refers to a process or event that is occurring in current time, i.e. not a recording. It is also descriptive of a characteristic of the goods and services, in so far as their action and functions occur/are available in real time.
19. Whilst an examination of the mark's individual elements is not incompatible with the assessment of its distinctiveness (see T-118/00 *Tablette carrée blanche, tachetée de vert, and vert pâle*', paragraph 59), in order to fairly and truly examine a compound mark's acceptability, one must consider the concept of the mark as a *whole*. Although the individual elements of a mark may be descriptive in relation to the goods and services, this does not automatically equate to a finding of overall descriptiveness when the words are placed together.
20. However, if the individual elements of a compound mark are in fact descriptive, then in order for the totality to be considered distinctive, it must create a new concept which possesses a perceptible difference between itself and the sum of its descriptive parts. In other words, the new concept must create 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 (see joined cases T-367/02, T-368/02 and T-369/02 '*SnTEM*' at paragraph 32).
21. My primary assessment is that this is not the case. The combination of individually descriptive terms is itself purely descriptive of the goods and services identified, as no new concept has been produced. The combination of descriptive terms is not a play on words, nor does it constitute an odd configuration. It is a simple amalgamation of descriptive words which are true to the grammar rules of the English language, and which create a descriptive reference to something that is able to be uploaded in real time.

22. The lack of any submissions from the applicant arguing to the contrary means that there is no evident reason to find that the examiner was incorrect. It is my opinion that he was perfectly entitled to reach the conclusion he did, at the juncture he did. Had the applicant filed arguments to the contrary, the examiner may have reviewed the objection in light of some of the goods and services. However, as this opportunity did not present itself, I can find no reason to conclude that the examiner erred in his initial judgment.
19. The lack of submissions from the applicant has restricted this decision to an evaluation of purely administrative actions, i.e. in light of objections being raised, a deadline for reply was set; that deadline was not adhered to; subsequently resulting in an inexorable refusal under section 37(4) (being a consequence of non-action which had been communicated to the applicant on two occasions).

Conclusion

20. In this decision, I have considered all correspondence issued by the examiner. Ordinarily I would have also considered all documentation filed by the applicant, and their arguments submitted therein. However, neither an alternative argument against the objection was raised, nor was a positive indication to pursue the acceptable figurative mark provided before the ultimate deadline of 22 May 2017. It is therefore found, for the reasons given above, that the application is refused due to a failure to respond under 37(4), for all of the goods and services claimed.

Dated this 13th day of September 2017

**Dafydd Collins
For the Registrar
The Comptroller-General**