

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO: 3231655  
BY THE OFFICIAL UK CHARTS COMPANY LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 35:**

**OFFICIAL [ ] CHART**

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**Background:**

1. On 16 May 2017, THE OFFICIAL UK CHARTS COMPANY ('the applicant') applied to register the above trade mark for the following services:

Class 35:

*Business information services; systemisation of information into databases; compilation, management, provision and marketing of databases and business, sales and marketing information; sales and market research for the music, video, film and entertainment industries; compilation, analysis and presentation of information about marketing and sales, in particular of music and of films, recordings and streams; opinion polling; promotion services; publicity services; publication of publicity texts; provision of space on web sites for advertising goods and services; compilation of databases; compilation of directories on the Internet; retailing services connected with the sale of recordings, streams, magnetic data carriers, recording media, sound recordings, compact disks, records, tapes, disks, minidisks, CD-Roms, DVD's, laser discs, video recordings, films, music sound recordings, audio-visual recordings, electronic publications, music provided from MP3 sites on the Internet, printed matter, books, booklets, magazines, newspapers and periodicals, stationery, writing instruments, promotional literature, flyers, posters, tickets, postcards, souvenir programmes, photographs, photograph albums, stickers, sticker albums, T-shirts, sweatshirts, jackets, caps, clothing, footwear, headgear, board games, toys, and playthings; information, assistance and advice relating to any of the aforesaid services.*

2. The application included the following mark description/limitation:

*The mark consists of the word OFFICIAL and the word CHART between which is a word or words descriptive of a genre(s) of, or a method of delivery of or broadcast of, music, videos, films, television programmes, radio programmes and/or other audio, visual or audio-visual content. The square brackets shown in the representation of the mark do not form part of the mark but indicate the blank space in which the descriptive words noted in the foregoing appear in the mark.*

3. On 25 May 2017, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under Section 3(1)(b) of the Trade Marks Act 1994 ('the Act'), as it was considered that the mark was devoid of any distinctive character. This was because it was considered that the mark was a non-distinctive sign which simply informs the consumer that the business services are or relate to producing official charts. The examination report also suggested a minor amendment to the specification as well as the examiner's intention to remove the mark description. The examiner intended to remove the mark description as additional wording could not be claimed as part of the mark. In the examination report, the examiner stated that if protection was required for the words

OFFICIAL CHART and the notional descriptive words listed in the mark description, then separate applications would need to be filed.

4. On 25 July 2017 the applicant responded to the examination report and agreed to the suggested specification amendment. The applicant also proposed filing evidence of acquired distinctiveness to overcome the non-distinctiveness objection. No response was made to the examiner's proposal to remove, or amend, the mark description but an extension of time request was submitted. This was allowed until 25 September 2017. On 25 September 2017 the applicant requested a further extension of time. This was allowed until 28 November 2018.
5. On 27 November 2017 an ex parte hearing was requested, and this was held on 17 January 2018, where the applicant was represented by Mr Bartlett of Beck Greener.
6. At the hearing, a further objection was raised under Section 3(1)(a) of the Act as the Hearing Officer, Mrs Linda Smith, felt that the mark with the description, was not clearly and unambiguously recorded as it did not provide a fixed point of reference. A period of two months was allowed for the applicant to respond to the late objection raised.
7. The applicant requested an extension of time on 23 March 2018 and this was allowed until 29 April 2018.
8. On 30 April 2018 the applicant requested a further hearing in respect of the Section 3(1)(a) objection, and this was held on 2 July 2018.
9. At the hearing, the Section 3(1)(a) objection was maintained by the Hearing Officer, Mrs Carol Bennett. The objection under Section 3(1)(b) was not discussed but was suspended until the outcome of the Section 3(1)(a) objection had been decided.
10. On 9 October 2018 the application was refused under Section 37(4) of the Act and a Form TM5 requesting a full statement of reasons for the Registrar's decision was received on 9 November 2018. As a result, I am now required to set out the reasons for refusal.

## The Law

11. The law as applied at the date of application reads as follows:

Sections 1(1)(a) and 3(1)(a) of the Act reads as follows:

1. Trade Marks

*(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.*

*A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging*

3. Absolute grounds for refusal of registration

*(1) The following shall not be registered –*

- (a) Signs which do not satisfy the requirements of section (1)(1),  
(b) ...

12. The Trade Marks Regulations 2018, which formally implemented the European Directive (EU 2015/2436) into UK law came into force on 14 January 2019, at which the wording of Section 1(1) of the Act was amended to read as follows:

1. Trade Marks.

(1) In this Act “trade mark” means any sign which is capable—

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.

13. For the purposes of this decision, in my opinion the change in wording of Section 1(1) of the Act does not have any material effect on the outcome as the mark did not meet the requirements of Section 1(1) at the time the application was made, nor does it meet the requirement of the revised Section 1(1)(a) as it currently stands. This will be explained below in my decision.

### The applicant’s case for registration

14. Prior to refusal of the application, the applicant’s representative, Mr Bartlett made the following submissions:

- The wording of the mark description explained precisely what the mark was, and the words fulfilled the ‘Sieckmann Criteria’. In the Sieckmann decision (ECJ C-273/00) it was stated that for a mark to be represented graphically the mark must be presented in a way that is “*clear, precise, self-contained, easily accessible, durable and objective*”. Although these criteria usually relate to non-conventional marks the same criteria must apply for word marks.
- The mark with the description complied with the new requirements under the EU Trade Mark Directive where the requirements for the representation of the mark is less restrictive
- The mark was likened to those marks where, under the 1938 Trade Marks Act, a blank space condition was imposed on label marks with spaces within the mark. This blank space condition usually read “*the blank spaces in the mark shall, when the mark is in use, be occupied only by matter of a wholly descriptive non-trade mark character.*” If that was good enough under the old Act it must be acceptable under the 1994 Act.

- The description provides an indication of what will be in the space between the words and that the square brackets are not part of the mark. The space would not include distinctive matter.
- The brackets within the mark are like the entry in our Trade Marks Manual regarding decorative images appearing on footwear, where it says: *“Where a trade mark consists of decoration to be applied to a shoe, the applicant may wish to show it in context i.e. showing its actual position on a shoe. It is commonplace for those elements which are not intended to be part of the trade mark to be shown in broken lines, which is an acceptable form of presentation. Alternatively, this can be supported by inserting a mark text on the application form, for example- The mark consists of five parallel stripes placed on the side of footwear as shown in the attached representation. The dotted lines do not form part of the mark and are entered to show the position of the mark on the goods.”* This is therefore essentially a position mark which indicates that when the words ‘Official’ and ‘Chart’ are used together with a descriptive word in the middle, then the totality is covered.
- This application is for a plain word mark, it is not an abstract concept, but is shown without the addition of stylisation, typeface or colour. The description provides an indication of what will be in the space between the words and that the square brackets are not part of the mark. The space will include the genre or type of music delivery e.g. ‘Official MP3 chart’. It would not be to include distinctive matter such as e.g. ‘The Official BBC Chart’
- The context of self-containment is not part of the new Directive and this is essentially a positional mark which indicates that when the words ‘Official’ and ‘Chart’ are used together with a descriptive word in the middle, then the totality is covered. This application is different from those cases quoted in the original hearing report e.g. ‘Zynga’, ‘Cadbury’ and ‘Libertel’ and it is submitted that the mark as described is sufficiently clear for the Section 3(1) (a) to be waived. It is also submitted that the applicant be allowed to file evidence of use to overcome the Section 3(1) (b) and (c) objection.

## Decision

15. The provisions of section 1 and 3 of the Trade Marks Act 1994 were taken from Article 2 and 3 of the Trade Mark Directive 2008/95/EC. When considering the coverage of these sections I am aware of the guidance provided in *Cadbury Ltd v Societe Des Produits Nestle S.A.*, [2013] EWCA Civ 1174, England and Wales Court of Appeal by Sir John Mummery. The requirements of Article 2 were summarised at paragraph 15:

*15. Some general points relating to the requirements of Article 2 of the Directive, which are relevant to this case, can be picked out of the judgments:-*

*The conditions*

*(1) An application to register a trade mark must satisfy three conditions for the purposes of Article 2:-*

- (i) there must be a sign;*
- (ii) it must be capable of graphical representation;*

*(iii) it must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.*

#### *Purpose*

*(2) The purpose of the requirements is to prevent abuse of trade mark law in order to obtain an unfair competitive advantage.*

#### *Identification*

*(3) Identification requirements for entry of a trade mark on the public register of trade marks include clarity, intelligibility, specificity, precision, accessibility, uniformity, self-containment and objectivity.*

#### *Multitude of forms*

*(4) The identification requirements are not satisfied, if the mark could take on a multitude of different appearances, which would create problems for registration of the mark and give an unfair competitive advantage over competitors.*

16. In the same decision at paragraphs 50 and 51 it states:

*“50. The crucial point stems from the misinterpretation of the verbal description of the graphic representation of the mark for which application is made. The description refers not only to the colour purple as applied to the whole visible surface of the packaging of the goods, but also to an alternative i.e. "or being the predominant colour applied to the whole visible surface..."The use of the word "predominant" opens the door to a multitude of different visual forms as a result of its implied reference to other colours and other visual material not displayed or described in the application and over which the colour purple may predominate. It is an application for the registration of a shade of colour "plus" other material, not of just of an unchanging application of a single colour, as in Libertel.*

*51. In my judgment, that description, properly interpreted, does not constitute "a sign" that is "graphically represented" within Article 2. If the colour purple is less than total, as would be the case if the colour is only "predominant", the application would cover other matter in combination with the colour, but not graphically represented or verbally described in the specific, certain, self-contained and precise manner required. The result would not be an application to register "a sign", in the accepted sense of a single sign conveying a message, but to register multiple signs with different permutations, presentations and appearances, which are neither graphically represented nor described with any certainty or precision, or at all.”*

17. In *Libertel Groep BV and Benelux-Merkenbureau*, Case C-104/01, the Court of Justice of the European Union held that:

*“28. Furthermore, as the Court has held, a graphic representation within the meaning of Article 2 of the Directive must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified (Case C-273/00 Sieckmann [2002] ECR I-11737, paragraph 46).*

*29. In order to fulfil its function, the graphic representation within the meaning of Article 2 of the Directive must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (Sieckmann, paragraphs 47 to 55)."*

18. In *Heidelberger Bauchemie GmbH*, Case C-49/02, the Court of Justice of the European Union held that:

*"33. Accordingly, a graphic representation consisting of two or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way.*

*34. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', as is the case with the trade mark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive, as construed in paragraphs 25 to 32 of this judgment.*

*35. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark*

19. The above cases refer to the basic requirements of a trade mark under Section 1(1) and Section 3(1) (a) of the Act, namely to enable a sign to be represented on the register in a *clear, precise, self-contained, easily accessible, intelligible, durable and objective* manner which enables the competent authorities and the public to determine the precise scope of protection afforded to its proprietor. The reason for this is also confirmed in Kerly's Law of Trade Marks and Trade Names (15<sup>th</sup> Edition) under 2. 034 where it states:

*"The requirement that a mark be capable of being represented graphically arises from important practical considerations concerned with certainty. First, the relevant trade mark office must know with certainty what is comprised in the sign in question, so that it can maintain an accessible Register of Trade Marks and fulfil its functions of examination and publication of applications. Secondly, and of greater importance, other traders must be able to ascertain with certainty exactly what their competitors (actual or potential) have registered or have applied to register"*

20. This reasoning was also reflected in the comments of Geoffrey Hobbs QC in his capacity as the Appointed Person in *Ty Nant Spring Water Ltd's Application* [2000] RPC 55:

*"The degree of precision with which the sign is represented must be sufficient to permit full and effective implementation of the provisions of the Act relating to absolute unregistrability (Section 3), relative unregistrability (Section 5), infringement (Section 10) and public inspection of the Register (Section 63). These provisions call for a fixed point of reference: a graphic*

*representation in which the identity of the relevant sign is clearly and unambiguously recorded.”*

21. The application is for the text ‘OFFICIAL [ ] CHART’ and the mark description which reads ‘*The mark consists of the word ‘OFFICIAL’ and the word ‘CHART’ between which is a word or words descriptive of a genre(s) of, or a method of delivery of or broadcast of, music, videos, films, television programmes, radio programmes and/or other audio, visual or audio-visual content. The square brackets shown in the representation of the mark do not form part of the mark but indicate the blank space in which the descriptive words noted in the foregoing appear in the mark*’ This is not a sign that, in my opinion, possesses a fixed point of reference where the identity is clearly and unambiguously recorded.
22. The mark description is integral to the claimed subject matter of protection and needs to be considered carefully. It introduces elements into the mark that cannot be discerned by a mere inspection of the mark as filed. The use of the phrase ‘between which is a word or words descriptive of’ introduces elements into the mark which are not identified or recorded and cannot be searched by third parties.
23. In my opinion, the description as presented is vague and would generate uncertainty as many of the terms are not precisely defined and the scope of such vague terms could vary over time. It would not be possible to determine the scope of protection of a ‘genre of music’ as I am not aware of any official list or definition of this term that would not vary with time. Furthermore, it is unclear what is meant by the phrase ‘method of delivery’. This could mean for example, the physical delivery, printed matter, CD’s, MP3’s, postal services or data transfer. Again, it is not possible to determine the exact subject matter nor the relevant date for its determination. The same consideration must be applied in respect of the term ‘broadcast’ as this could cover any possible combinations that are currently used or yet to be introduced. This description must be regarded as being inherently vague as it is a request for protection of numerous signs in which the scope of protection would move with time.
24. The use of square brackets between the words ‘Official’ and ‘Chart’ are symbols used in writing to emphasise, correct or add information, square brackets are not normally used as a means of indicating a blank space where descriptive information can be inserted. The square brackets in the mark do not have any perceptible space or indication between the opening bracket and the closing bracket which would lead the average consumer to view it as being similar in concept to the broken line used to denote the position of a mark, such as decoration on, a shoe. The image or mark text in such positional marks would also state the purpose of the broken lines, thereby clarifying the scope of the mark. That is not the case in this application as no self-contained identity of the sign is recorded.
25. When the mark, is considered in conjunction with the accompanying description, it does not provide a fixed point of reference where the mark is clearly or unambiguously recorded. The description would allow for a wide range of wording or descriptive matter to be added into the mark. Such ambiguity in a mark description was considered in the *J.W Spear & Sons Limited & Ors v Zynga Inc* [2012] EWHC 3345 (Ch) ‘Scrabble Tile’ invalidity decision where The Hon Mr Justice Arnold stated at paragraph 47 and 48

*“47. In my judgment the Tile Mark does not comply with the first condition for the following reasons. As Zynga rightly contends, the Tile Mark covers an infinite number of permutations of different sizes, positions and combinations of letter and number on a tile. Furthermore, it does not specify the size of the tile. Nor is the colour precisely specified. In short, it covers a multitude of different appearances of tile. It thus amounts to an attempt to claim a perpetual monopoly on all conceivable ivory-coloured tile shapes which bear any letter and number combination on the top surface. In my view that is a mere property of the goods and not a sign. To uphold the registration would allow Mattel to obtain an unfair competitive advantage.*

*48. Even if the Tile Mark complies with the first condition, in my judgment it does not comply with the second condition since the representation is not clear, precise, intelligible or objective. As discussed above, the representation covers a multitude of different combinations. It does not permit the average consumer to perceive any specific sign. Nor does it enable either the competent authorities or competitors to determine the scope of protection afforded to the proprietor, other than that it is very broad*

26. It is my view that the mark description in this application is equally as imprecise as in the ‘tile’ mark referred to above. The mark description would introduce an infinite number of permutations of wording that could be inserted between the words ‘Official’ and ‘Chart’ and this lack of clarity, precision, objectivity and self-containment would not allow a determination of the scope of protection of the mark. The mark would not permit the average consumer to perceive a specific sign nor enable authorities to determine the scope of protection afforded to the proprietor. I have considered the mark in line with provisions of section 1(1) (a) of the Trade Marks Act 1994 at the time of filing and also in accordance with provisions of section 1(1) (a) amended by Trade Marks Regulations 2018 which came into force on 14 January 2019. Both require the matter applied for to be a ‘sign’ and in my opinion, it is neither graphically represented, as required at the time of filing, nor is the subject matter of protection clear and precise to use the terminology of the amended Trade Marks Regulations 2018
27. The use under the 1938 Trade Marks Act of ‘registration clauses’, including the ‘blank space clause’ referred to in Mr Bartlett’s submissions, was a means of clarifying the extent of the proprietor’s rights. This practice was not transferred into the ambit of 1994 Trade Mark Act as the wording of section 1(1) introduced the meaning of a sign. A ‘sign’ as defined by Section 1(1) must be clear, precise and self-contained. This negates the requirement to refer to matter that does not form part of the mark as applied for. Therefore, it is my view that the comparison to requirements imposed under previous legislation cannot be a precedent for the acceptance of the wording contained in the description of this mark.
28. Similarly, the submission that this is no more than a ‘position mark’ is equally flawed. A position mark, as I understand it, would commonly comprise for example a 3D shape such as a shoe, indicating both the subject matter of protection where a particular mark may appear and possibly disclaiming certain elements of the shoe. Importantly, the crucial scope of protection which may include the position can be determined. This mark simply identifies a blank space which will contain matter which is in fact claimed but without the degree of (or any) precision necessary to determine the scope of protection.

## **Conclusion**

29. In this decision I have considered all the papers filed and submissions made. For the reasons given above, the application is refused under sections 1(1) and 3(1) (a) in relation to all services.

Carol Bennett

Acting for the Registrar  
The Comptroller General  
Dated: 30<sup>th</sup> July 2019