

**IN THE MATTER OF AN APPLICATION
BY TELECOM PLUS Plc
TO REGISTER A SERIES OF TRADE MARKS
IN CLASSES 1, 4, 9, 36, 38 and 39**

BACKGROUND

1. On 14 February 2002 Telecom Plus Plc of Dryden House, The Edge Business Centre, Humber Road, London, NW2 6EW applied for registration of a series of sixteen trade marks in respect of the following goods and services:

Class 01 Electricity.

Class 04 Gas.

Class 9 Telephone apparatus; mobile telephones; telephone receivers; telephone transmitters; telecommunication apparatus and instruments; parts and fittings for all the aforesaid goods.

Class 36 Insurance; accident insurance underwriting; property insurance services; health insurance underwriting; health insurance services; life insurance underwriting; life assurance services; investment; capital investment; unit trusts and investment funds services; stocks and bonds brokerage; brokerage; share dealing and broking; banking; deposits and loans; payment services; credit card services; issuance of credit cards; exchanging money; foreign exchange services.

Class 38 Telecommunications; telecommunications of information (including web pages); electronic mail services; providing user access to the internet; providing telecommunications connections to the internet or data bases; telecommunication gateway services.

Class 39 Water distribution; water supplying; electricity distribution services and fuel gas distribution and supply services.

2. The marks for which registration is sought are represented at Annex A.

3. On 18 February 2002 the Registrar advised Boulton Wade Tennant, the trade mark attorneys representing the applicants, that the application fails to meet the requirements of Section 32(2)(d) of the Trade Marks Act 1994 in that none of the sixteen marks applied for are represented with sufficient precision to permit a full and effective examination. The applicants were allowed a period of two months from 18 February 2002 in which to remedy this deficiency.

4. On 17 April 2002 Mr Stobbs of Boulton Wade Tennant contested this decision and requested a hearing which was eventually held on 10 June 2002. During the hearing Mr Stobbs referred me

to paragraph 2-13 of Kerly's Law of Trade Marks and Trade Names (thirteenth edition) which quotes the comments of Geoffrey Hobbs QC in *Ty Nant Spring Water Ltd's Trade Mark Application* [2000] RPC 55 where he refers to the requirement that a sign must be represented graphically:

"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)."

5. Mr Stobbs suggested that the representations of the sixteen marks as set out on form TM3 clearly satisfy the requirements relating to Section 3, Section 5 and Section 10 of the Act and made further submissions in an attempt to persuade me that the representations of the sixteen marks also satisfied the requirements relating to Section 63 of the Act. I concluded that none of the sixteen marks applied for meet the requirements of Section 32(2)(d) of the Act and determined that this application is deemed never to have been made.

6. I am now asked under Section 76(1) of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

7. Section 76 of the Act states:

"An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules.

For this purpose "decision" includes any act of the registrar in exercise of a discretion vested in him by or under this Act."

8. It appears clear that Section 76 is wide enough to include a decision by the Registrar about the sufficiency of a representation of a trade mark for the purposes of section 32(2)(d). The applicant is entitled to challenge the Registrar's decision on this point.

THE LAW

9. Section 32(2) of the Trade Marks Act 1994 reads as follows:

- "32.- (1)
- (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."

10. Rule 11 of the Trade Marks Rules 2000 reads as follows:

“11. Where an application for registration of a trade mark does not satisfy the requirements of section 32(2), (3) or (4) or rule 5(1) or (8)(2), the registrar shall send notice thereof to the applicant to remedy the deficiencies or, in the case of section 32(4), the default of payment and if within two months of the date of the notice the applicant-

(a) fails to remedy any deficiency notified to him in respect of section 32(2), the application shall be deemed never to have been made;

(b) fails to remedy any deficiency notified to him in respect of section 32(3), or rule 5(1) or 8(2) or fails to make payment as required by section 32(4) the application shall be treated as abandoned.”

DECISION

11. In determining whether this application contains representations of the marks within the meaning of the Act I am guided by the decision of Geoffrey Hobbs QC sitting in his role as the Appointed Person in the *Ty-Nant Spring Water Ltd's trade mark application* [2000] RPC 55. After considering related decisions in *CREOLA trade mark* [1997] RPC 507, Case R4/97-2 *Antoni & Allison's Application* [1997] ETMR 460, Case R7/97-3 *Orange Personal Communications Ltd's Application* [1998] ETMR 460 and the decision of Mr Simon Thorley QC (also sitting as the Appointed Person) in *Swizzels Matlow Ltd's Application* [1999] RPC 879 and Case R156/1982-2 *Venootschap onder Firma Senta Aromatic Marketing's Application* [1999] ETMR 429, Mr Hobbs concluded:

“(1) that the process of examination cannot begin until the registrar has been provided with a “representation” of the sign for which registration is sought (Section 32(2)(d));

(2) thereafter the scope for amendment of the filed representation is strictly limited, and can only be made if the amendment does not substantially affect the identity of the trade mark (Sections 39 and 44 of the Act refer);

(3) this indicates that a representation filed under Section 32(2)(d) must, from the outset, disclose the identity of the sign which is said to be registrable and which may in due course be accepted for registration;

(4) it must do so graphically because that is the only form of representation that can be entered in the register which the registrar is required to maintain under section 63 of the Act;

(5) 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;

(6) that the scheme of rights and liabilities established by the Act cannot be implemented fully and effectively in relation to graphic representation which fails to disclose the identity of the sign it purports to represent or to do so clearly and unambiguously.”

12. Mr Hobbs QC concludes that where a sign fails to satisfy the requirements of (3) to (5) above:

“Such representations are, in my view, incapable of fulfilling the legal and administrative requirements of the Act and therefore cannot be accepted under Section 32(2)(d).”

13. I note that this matter has more recently been considered by Advocate General Colomer in case C-273/00 Ralf Sieckmann v Deutsches Patent und Markenamt, whose opinion (not yet determined by the full ECJ) on the requirement for graphical representation appears broadly in line with the English cases referred to earlier in this decision.

14. The sixteen marks in question are similar to each other in that although they are all intended to be a description of the same thing they differ from each other in the amount of information that they provide. As an inevitable consequence of this practically all of the words which constitute the first mark are incorporated within the other fifteen marks. To an extent this pattern continues so that the marks contain various amounts of information but nevertheless appear to be an attempt to describe the same thing.

15. In order to determine whether or not these marks satisfy the requirements of Section 32(2)(d) of the Act I consider it necessary to conduct a detailed examination of their content. The first words in all sixteen marks are *“The mark consists of a pictorial representation of a pig, not being a photographic representation”*. The first three definitions of the word “pictorial” in Collins English Dictionary are as follows:

“Adj. 1. relating to, consisting of, or expressed by pictures. (Of books, newspapers, etc.) containing pictures. 3. of or relating to painting or drawing.”

16. I note that the same dictionary defines a picture as:

“n. 1.a. a visual representation of something, such as a person or scene, produced on a surface, as in a photograph, painting, etc.”

17. It is clear from these dictionary definitions of the words “pictorial” and “picture” that it is not possible to determine with any degree of certainty what the nature of the pictorial representation is intended by these marks. Is it a painting? Is it a line drawing? In my view it is impossible to answer these questions with any degree of certainty as it is not possible to determine what type of pictorial representation it is.

18. The pictorial representation is “*of a pig*”. In my view there are further difficulties with this aspect of the marks. Is it a representation from head on, from behind or from the side? If from the side is the pig facing left or right? Is the pig lying down or standing up? What breed of pig is it? I am aware from my personal knowledge that there are many breeds of pigs which are very different to each other ranging from the breed made famous in the well known film “Babe” to breeds such as Tamworth and the Vietnamese Pot Bellied pigs.

19. As a result of the lack of preciseness in these words it is not possible to determine the nature of the mark. There is no certainty as to its precise nature.

20. As these words are common to all sixteen marks that effectively decides the issue before me but in case I am wrong in my findings I will go on to consider the other elements of the marks. The second mark contains the additional words “*with a slot in its back*”. There is perhaps a tendency to expect the slot to run lengthways down the back of the pig but this is not the only possibility covered by these words. The slot could just as easily run across the back at ninety degrees to the length of the back or even across the back at a diagonal angle. There is also no indication as to the length or width of the slot.

21. The third mark contains the words “*presented generally in profile*”. There is no indication as to what is meant by the word “generally”. The fourth mark contains the words “*with a curly tail*”. Again there is no indication as to the size or position of the tail.

22. The fifth mark contains the words “*with a curly tail in the form of a telephone wire*”. The first point I will make is that I consider that a tail in the form of a telephone wire is not an image that I would understand when encountering the fourth mark. However, the same problems exist; there is no indication as to the size or position of the tail.

23. The sixth mark consists of words upon which I have already commented. My comments regarding this mark are simply a combination of those for the second and fourth marks. The same applies to the seventh mark which is a combination of the words contained in the second and fifth marks. The eighth mark contains words which are a combination of the third and fifth marks.

24. The ninth mark is the same as the first mark but with the additional words “*portrayed generally in the colour pink*”. Firstly I note the presence of the word “generally” . This again demonstrates the imprecise nature of the mark. The second point is that the colour pink is not precisely defined. Following on from the *Ty-Nant* decision the registry issued guidance on acceptable forms of graphical representation. The appropriate section is reproduced below:

“Device or “get-up” marks consisting partly of colour(s)

11. Where colour is claimed as an element of a device or pictorial mark, the representation of the mark should be filed in colour. A black and white representation will not be accepted unless each part of the mark is clearly identified as such, and the colour(s) defined by a widely available colour standard. This will not be necessary where a colour representation of the mark is filed.”

The form of application does not contain a representation of the colour nor does it provide any definition of the colour pink by reference to a colour standard.

25. The remaining seven marks (numbered 10 to 16) raise no further issues but consist of various combinations of the elements already identified in this decision.

26. In my view none of these marks meet the requirements of Section 32(2)(d) of the Act in that none of the sixteen marks applied for are represented with sufficient precision to permit a full and effective examination.

27. The problems associated with marks consisting of a description of a three-dimensional article is that a mere description is unlikely to ever be sufficiently precise to meet the needs of the Act. This was confirmed in Swizzels Matlow's application [1999] RPC 879 where Simon Thorley QC in his role as The Appointed Person said:

“For all these reasons, I am of the view that the Registrar's practice set out above, which I shall repeat,

*“1.3. In general, descriptions in words alone are unlikely to be acceptable to be a graphical representation of a trade mark.....
However, there may be circumstances where a description in words, if sufficiently precise, would be acceptable”*

is a correct analysis of the law under section 1 of the Act.

In my judgment, whilst it is unlikely that a mere description of a three-dimensional article would in practice ever be sufficiently precise to meet the needs of the Act (which are to enable traders to draw a distinction between a sign which is identical to the mark and one which is not), the wording of the Act does not exclude a possibility in plain case.”

28. Having taken all of these facts into account I have concluded that the sixteen representations of the marks filed on 14 February 2002 do not satisfy the requirements of Section 32(2)(d) of the Act and given the applicant's failure to remedy the defects within the period allowed under Rule 11, I determine that this application is deemed never to have been made.

Dated this 26th day of November 2002.

A J PIKE

For the Registrar

The Comptroller General

ANNEX A