o/0750/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBERS:

WO0000001772774

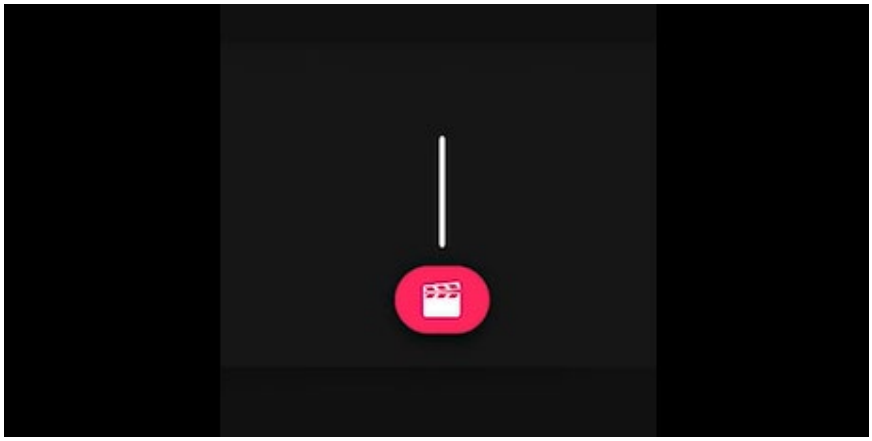
WO0000001772960

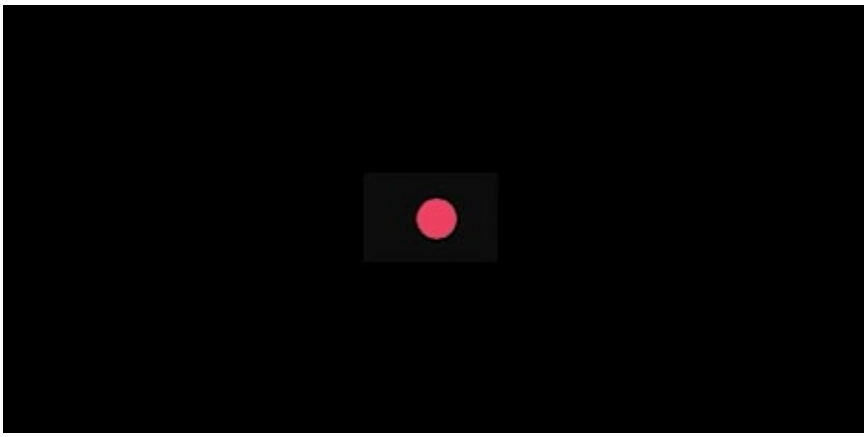
WO0000001772961

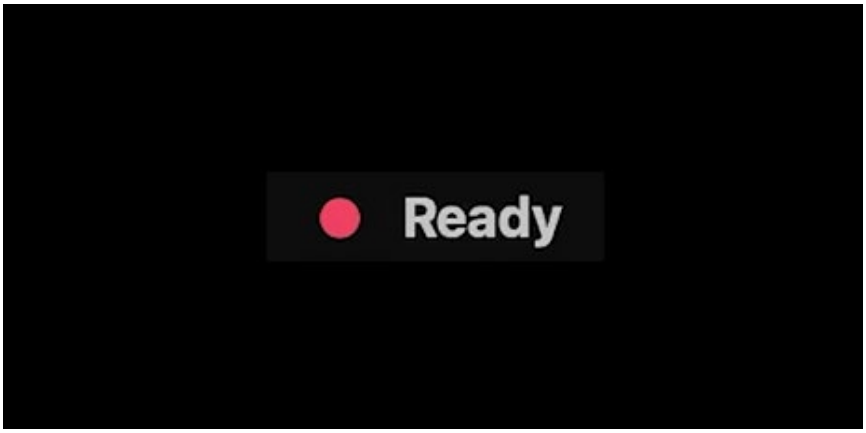
WO0000001772962

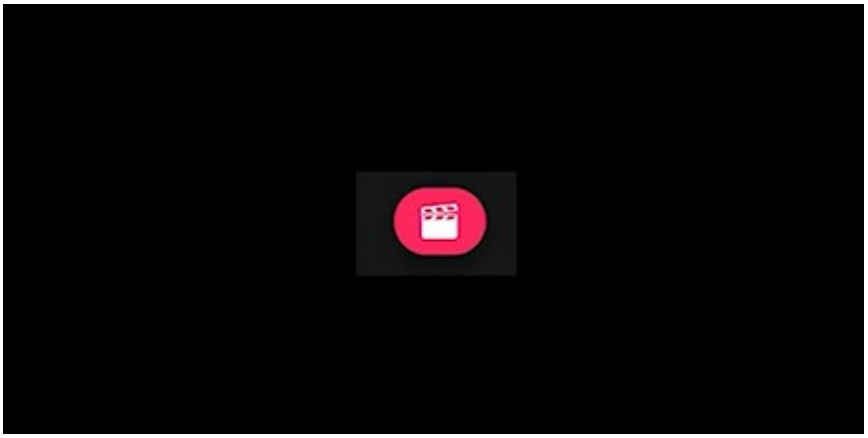
BY SAVAGE INTERACTIVE PTY LTD

TO PROTECT THE FOLLOWING TRADE MARKS IN CLASSES 9, 42:









THE TRADE MARKS ARE MULTIMEDIA MOVEMENT MARKS AND MAY BE VIEWED IN FULL AT THE UKIPO'S WEBSITE USING THE LINKS PROVIDED BELOW – THE MARK DESCRIPTIONS ARE ALSO INCLUDED:

WO0000001772774 – The trade mark is an animated motion mark which consists of an image of a pink fill shaped icon containing a film clapper which transitions from the clapper being partially open to being fully open and then to being closed and finally to returning to the original position. The trade mark also includes a vertical line which represents a playback needle.

WO0000001772960 – The trade mark is an animated motion mark which consists of a flashing red dot which transitions to a smaller sized red dot with a line element rotating around the circumference as illustrated in the video attached to the application form.

WO0000001772961 – The trade mark is an animated motion mark which consists of a flashing red dot with the word READY to the right-hand side which then transitions to a red dot of decreased size with a line element rotating around the outside of the circle and the word changing to ACTION as illustrated in the video attached to the application form.

WO0000001772962 – The trade mark is an animated motion mark which consists of an image of a pink pill shaped icon containing a film clapper which transitions from the clapper being partially open to being fully open and then to being closed and finally to returning to the original position.

TRADE MARKS ACT 1994
IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBERS: WO0000001772774 AND WO0000001772960 AND WO0000001772961 AND WO0000001772962
BY SAVAGE INTERACTIVE PTY LTD
TO PROTECT THE ABOVE MULTIMEDIA TRADE MARKS IN CLASSES 9, 42

Background

1. On 8 September 2023, Savage Interactive Pty Ltd ('the holder') designated the United Kingdom to protect the above marks for the same list of goods and services, as follows:

   Class 9:
   Computer hardware, firmware and software; animation software; computer hardware and software for graphic design applications, art generation, creating animations and cartooning; application software for use on tablet devices, mobile telecommunication devices and other mobile electronic devices; electronic publications; computer software for creating and editing video, digital movies, video images, audio recordings, animations, still images, graphics, and multimedia content; computer software for use in creating, editing, importing, exporting, publishing and sharing video, digital movies and multimedia content; computer software for colour correction of video and multimedia content; smart phones; wireless communication devices for the transmission of voice, data, images, audio, video, and multimedia content; network communication apparatus; handheld digital electronic devices capable of providing access to the internet and for the sending, receiving, and storing telephone calls, electronic mail, and other digital data; wearable digital electronic devices capable of providing access to the internet for accessing application software; electronic book readers; computer software; computer software for setting up, configuring, operating or controlling mobile devices, mobile telephones, wearable devices, computers, computer peripherals, set top boxes, televisions, and audio and video players; application development software; downloadable pre-recorded audio, video and multimedia content; computer peripheral devices; monitors, display screens, head mounted displays, and headsets for use with computers, smart phones, mobile electronic devices, smart glasses; 3D spectacles; eyeglasses; sunglasses; spectacle lenses; optical glass; optical goods; optical apparatus and instruments; display screens for computers, mobile telephones, mobile electronic devices, wearable electronic devices; augmented reality computer hardware; augmented reality glasses; augmented reality headsets; augmented reality software; augmented reality software for creating and accessing augmented reality experiences; augmented reality software for interactive entertainment; augmented reality software for object tracking, motion control and content visualization; augmented reality software for

operating augmented reality headsets; augmented reality software for use in enabling computers; augmented reality software for users to experience augmented reality visualization, manipulation and immersion; computer hardware and software for augmented reality systems; computer hardware and software for detecting objects, user gestures and commands; computer hardware and software for operating sensor devices; computer hardware and software used in eye tracking and gesture recognition; computer hardware; computer peripheral devices; computer software and firmware for enabling electronic devices to share data and communicate with each other; computer software for controlling the operation of audio and video devices; computer software for processing digital images; computer software for recording, storing, transmitting, receiving, displaying and analysing data; computer software for the collection, editing, organising, modifying, transmission, storage and sharing of data and information; computer software for tracking motion in, visualising, manipulating, viewing, and displaying augmented and virtual reality experiences; computer software for virtual reality and augmented reality equipment, namely, software for user interface; digital media streaming devices; downloadable computer software and mobile application software for planning activities with other users, making recommendations; downloadable computer software for modifying the appearance and enabling transmission of images, audio visual and video content; downloadable e-commerce computer software to allow users to perform electronic transactions via the internet and communication networks; electronic sensor devices, cameras, projectors, and microphones for capturing gesture, facial, and voice recognition; gesture recognition software; goggles for enabling virtual reality, augmented reality world experiences; handheld augmented reality controllers; handheld virtual reality controllers; headphones; headsets; headsets for use with computers; interactive entertainment software; motion tracking sensors for augmented reality technology; motion tracking sensors for virtual reality technology; portable digital electronic devices for recording, organising, transmitting, manipulating, reviewing, and receiving text, data, and digital files; software for sending and receiving electronic messages via the internet; software for integrating electronic data, artworks and entertainment for the purposes of entertainment, education, communicating, and social networking; software for navigating a virtual reality environment; software for navigating an augmented reality environment; software for processing images, graphics and text; software for use in enabling creation of animations, computers, tablet computers, mobile devices, and mobile telephones to provide virtual reality and augmented reality experiences; software for use in creating and designing virtual reality and augmented reality software; software for wireless content delivery; software tools for creating and accessing virtual reality experiences; software tools for creating and accessing augmented reality experiences; video display hardware, namely, video drivers for video eyewear; video display software; virtual reality computer hardware; virtual reality glasses; virtual reality headsets; virtual reality software; virtual reality software for creating and accessing virtual reality experiences; virtual

reality software for interactive entertainment; virtual reality software for object tracking, motion control and content visualization; virtual reality software for operating virtual reality headsets; virtual reality software for use in enabling computers, tablet computers, mobile devices, and mobile telephones to provide virtual reality experiences; virtual reality software for users to experience virtual reality visualization, manipulation and immersion; configurable head-mounted displays.

Class 42:
Computer services, namely, the design and development of computer software; graphic design services; provision of online non-downloadable computer software (application service provider); provision of non-downloadable software hosted in an online or cloud-based environment (application service provider); research and design services in relation to computer software, hardware and firmware; software as a service, platform as a service and infrastructure as a service in relation to creating and editing video, digital movies, video images, audio recordings, animation, still images, graphics, and multimedia content; computer services, namely, the design and development of computer software; graphic design services; application service provider, namely, hosting, managing, developing, analysing, and maintaining applications, software and web sites of others in the fields of graphic design, art and electronic art; application service provider, namely, hosting, managing, developing, analysing, and maintaining applications, software, and web sites, in the fields of personal productivity, wireless communication, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobile electronic devices; application service provider (ASP), namely, hosting computer software applications of others; application service provider (ASP) featuring software for use in relation to artworks, art, graphic design and electronic art; internet-based application service provider, namely, hosting, managing, developing, analysing, and maintaining the code, applications, and software for web sites of others; computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the purpose of drawing, graphic design, making electronic art and animation; computer services, namely, cloud hosting provider services; information, advisory and consultancy services in relation to the aforementioned.

2. On 13 February 2024, in relation to WO0000001772774 (‘774), the Intellectual Property Office (‘IPO’) issued a Notification of Provisional Total Refusal of Protection to WIPO. In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 (‘the Act’) which read as follows:

Absolute grounds for refusal

Section 3(1)(b)

The designation is not acceptable in Classes 9 and 42. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of a motion/animation of a film clapper board which would be recognised as indicating the starting of video content recordings and is unlikely to be perceived as a trade mark in respect of video editing and video recording.

It is felt your mark would not allow consumers to identify the brand origin of the goods and services being offered and therefore cannot act as a trade mark.

On 7 February 2024, in relation to WO0000001772960 ('960), the IPO issued a Notification of Provisional Total Refusal of Protection to WIPO. In that report, an objection was raised under section 3(1)(b) of the Act which read as follows:

Absolute grounds for refusal

Section 3(1)(b)

The designation is not acceptable in Classes 9 and 42. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of a simplistic flashing dot, likely to be perceived as a flashing recording indication which would merely inform the relevant consumer that multimedia and video software is running.

It is felt your mark would not allow consumers to identify the brand origin of the goods and services being offered and therefore cannot act as a trade mark.

On 7 February 2024, in relation to WO0000001772961 ('961), the IPO issued a Notification of Provisional Total Refusal of Protection to WIPO. In that report, an objection was raised under section 3(1)(b) of the Act which read as follows:

Absolute grounds for refusal

Section 3(1)(b)

The designation is not acceptable in Classes 9 and 42. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark would merely inform the relevant consumer how the programme is operating, the software is ready for use, the mark is merely an indication that the software is to be initiated.

It is felt your mark would not allow consumers to identify the brand origin of the goods and services being offered and therefore cannot act as a trade mark.

On 7 February 2024, in relation to WO0000001772962 ('962), the IPO issued a Notification of Provisional Total Refusal of Protection to WIPO. In that report, an objection was raised under section 3(1)(b) of the Act which read as follows:

> ***Absolute grounds for refusal***
>
> ***Section 3(1)(b)***
>
> *The designation is not acceptable in Classes 9 and 42. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of a motion/animation of a film clapper board which would be recognised as indicating the starting of video content recordings and is unlikely to be perceived as a trade mark in respect of video editing and video recording.*
>
> *It is felt your mark would not allow consumers to identify the brand origin of the goods and services being offered and therefore cannot act as a trade mark.*

3. Following an extension of time of two months, on 7 June 2024, the holder's representative (Stobbs) filed written substantive arguments in favour of acceptance of all four designations in the *prima facie*. The examiners considered the submissions and responded on 15 July 2024 ('960, '961, '962) and 26 July 2024 ('774) and maintained the section 3(1)(b) objections for all goods and services contending that none of the signs are inherently distinctive.

4. On 13 September 2024, an official form TM33 was filed appointing D Young & Co LLP as the holder's new representative.

5. As D Young & Co LLP had been newly appointed in respect of all four designations, they requested an extension of time of two months which was duly granted.

6. On 26 November 2024, the holder requested an *ex parte* hearing in relation to all four UK designations which were to be heard at the same time due to the obvious similarities between the marks.

7. The hearing was held before me on 17 December 2024 with the holder's representative Ms Jackie Johnson of D Young & Co LLP in attendance.

8. From the outset, Ms Johnson stated that given the nature of the marks and their similarities, her arguments in favour of the acceptance of all four designations would, in essence, be the same. At the hearing, Ms Johnson's principal arguments may be summarised as follows:

- Whilst these may be unconventional signs, they are not on a par with shape marks for example, so they do not need to 'depart significantly from the norms and customs'

- There is only a minimum threshold for distinctiveness

- The marks '962 and '774 for example contain film clapperboards which are well-known, but this does not mean that the signs cannot function as badges of trade origin. If elements within a sign are recognisable that does not automatically mean that it cannot function as a trade mark

- A sign does not need to be a work of invention before it can function and no creativity or imagination is required, according to the case law

- Regarding the consumer of the goods and services, Ms Johnson argued that they are rather specialised, involved with animation and graphics and illustration design – they have a serious aptitude for animation, and they will see all of the signs as trade marks. She contended that we are not dealing with the general public at large

- Ms Johnson addressed each mark individually:

  '774 – it was argued that there is an unusual combination of elements and on its own it is unusual, let alone as part of a movement. She contended that the sign consists of fanciful elements, the colours are striking, and the totality is distinctive

  '960 – it was argued that the sign is dynamic, and it is complex, and it is eye-catching. The movement is memorable and contains strong colours. Consumers will see the mark as being striking and imaginative

  '961 – it was argued that the "fading comet-like tail" in red is engaging and the words in the mark are unusual because it is not in relation to filming, rather it is for creating a design. It was contended that the mark is altogether unusual

  '962 – it was argued that it is eye-catching and the lozenge-shape around the clapperboard is unusual, and the colours will stand out. The mark is memorable and will be recognisable as a trade mark

- The colouring (black and red) is significant, and these particular colours are part of the holder's branding

- The visual nature of the marks is relevant for this particular sector and consumers have become familiar with these types of signs and consumers see them as trade marks

- The relevant consumers, particularly in this field, are open to different types of signs functioning as trade marks and consumer perception in general has moved away from just seeing the most conventional of marks as badges of trade origin

- Many other countries see these signs as being distinctive in the *prima facie* and the designations have, in fact, been accepted by several other jurisdictions, such as, Australia

- All the marks contain lots of different elements, the colour scheme is significant and eye-catching, and, in their totality, they are distinctive

- The marks are not in respect of recording *per se*, they all relate to graphic design which is very different in the holder's view

9. I deferred my decision at the hearing to undertake further research and to fully consider the arguments put forward. I subsequently issued my hearing report maintaining all the section 3(1)(b) objections against all of the services and against the majority of the goods, apart from the following:

   Class 9
   Electronic publications; 3D spectacles; eyeglasses; sunglasses; spectacle lenses; optical glass; optical goods; optical apparatus and instruments.

   Given my overall rationale for maintaining that the signs are devoid of any distinctive character in my hearing report, I did not believe that it could apply to those products above as I felt that they were unconnected and not closely allied.

   I allowed two months for a response.

10. The holder did not respond within the specified timeframe, so on 31 March 2025, I issued refusal letters for all four designations in respect of the objectionable goods and services, in accordance with section 37(4) of the Act.

11. On 28 April 2025, the IPO received form TM5 requesting a statement of reasons for the registrar's decision for all four UK designations.

12. Due to the overriding similarities regarding the nature of the marks for which protection is sought and the identicality of the goods and services, and the fact that

they were all dealt with at the same hearing, I am dealing with all four UK designations in this statement of grounds. I believe that the differences between the marks does not present as a material reason to suggest that the marks need to be treated differently.

13. I am now asked under section 76 of the Act and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds for 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, in respect of the goods and services listed at paragraph 1 (apart from the acceptable goods listed in paragraph 9), I have only the *prima facie* case to consider.

The Law

14. The relevant part of section 3 of the Act reads as follows:

> ***3 Absolute grounds for refusal of registration***
>
> *(1) The following shall not be registered—*
>
> *(a) […]*
>
> *(b) trade marks which are devoid of any distinctive character,*
>
> *(c) […]*
>
> *(d) […]*

Relevance of EU Law

15. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision may refer to decisions of the EU courts which predate the UK's withdrawal from the EU.

The relevant legal principles

16. It is clear that in respect of word and/or device marks, and even shape marks, there is an abundance of case law regarding signs that are devoid of any distinctive character, or descriptive, or generic, or purely promotional formulas etc. I think that in relation to multimedia movement marks it is probably fair to say that relevant case law is rather light and scarce, especially in the UK. Nevertheless, the

overarching legal principles regarding section 3(1)(b) are of course still relevant here.

17. The Court of Justice of the European Union ('CJEU') has repeatedly emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P paragraph 59 and the case law cited there and *Celltech R&D Ltd v OHIM*, C-273/05P).

18. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "…the public interest… is, manifestly, indissociable from the essential function of a trade mark", *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. Marks which are devoid of distinctive character are incapable of fulfilling that essential function.

19. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating trade origin. In terms of assessing distinctiveness under section 3(1)(b), the ECJ provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Postkantoor) C-363/99) where, at paragraph 34, it stated:

> *A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 Linde and Others [2003] ECR I- 3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75).*

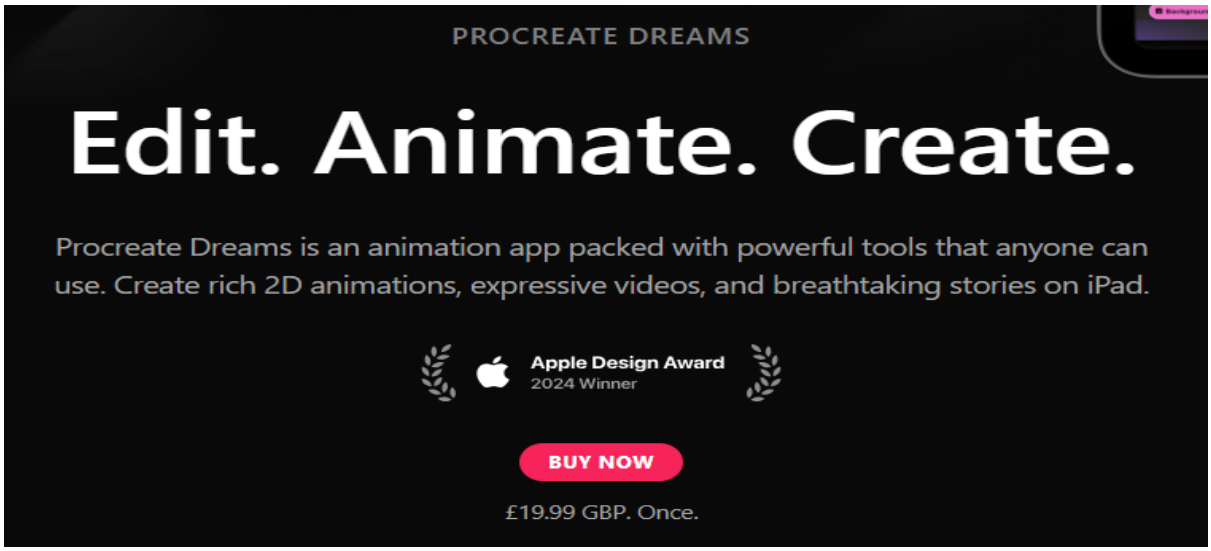
20. Since the inception of the EU Directive (2015/2436) in 2019 which removed the mandatory graphical representation requirement and allowed for the filing of MP3 and MP4 file formats, it is reasonable to say that multimedia movement marks, such as the marks in suit, are relatively rare.

The application of legal principles

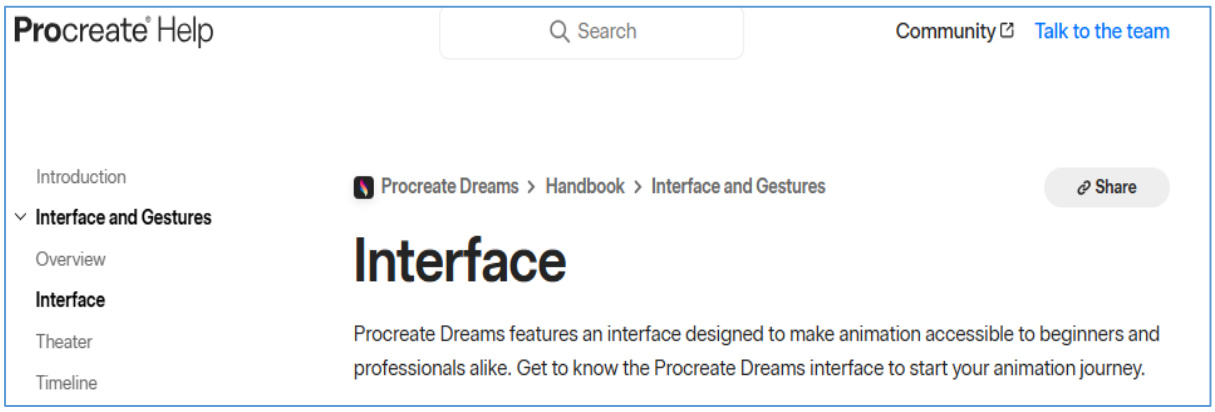
The Consumer

21. In relation to identifying the relevant consumer, at the hearing Ms Johnson argued that they are rather specialist and have a serious aptitude in respect of animations and graphic design – she contended that we are not dealing with the public at large.

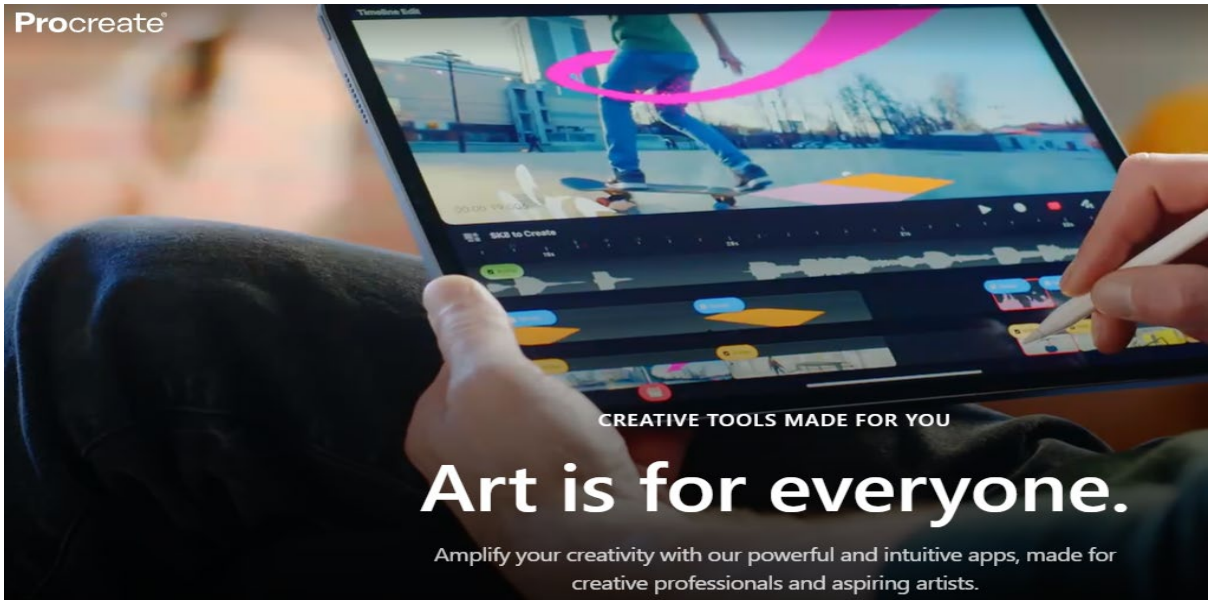
22. I accept the point that Ms Johnson was making however after conducting research it transpired, and became apparent to me, that the holder's goods/services are available to the public at large, as well as professional consumers. In fact, while perusing the holder's own website I happened across the statement '*Procreate Dreams* (one of the holder's primary products) *is an animation app packed with powerful tools that anyone can use*':



Additionally, the holder clearly states that their interface makes animation accessible to beginners and professionals alike:



Indeed, one of the holder's own straplines is 'Art is for everyone.', and they advertise that their products and services are made for professionals and aspiring artists:



23. Thus, I cannot solely assess the marks from the perspective of a professional or specialist consumer here. I must also determine the perceptions and recollections of the average UK consumer who may be an amateur or hobbyist. In any case, the goods and services applied for, especially the goods, could be purchased by any member of the general public and they are not *per se* specialist goods and services in my view.

24. From my research, it is clear that the holder's software app for example, could be purchased by anyone with an interest in animation or creating videos and, in my view, this is not something that would be undertaken on a whim or purchased impulsively given the nature of the goods and services concerned. Whether the relevant consumer here is a professional, or expert, or beginner, or aspiring artist or animator, they will be highly aware and attentive in their consideration and selection of such products and services. Therefore, they're likely to display an above average to high level of attention or knowledge. In respect of a professional consumer, who may be likely to engage more with the services in question, I am mindful that it was held by the CJEU in Case C-311/11 P *Smart Technologies ULC v. OHIM* at paragraph [48]:

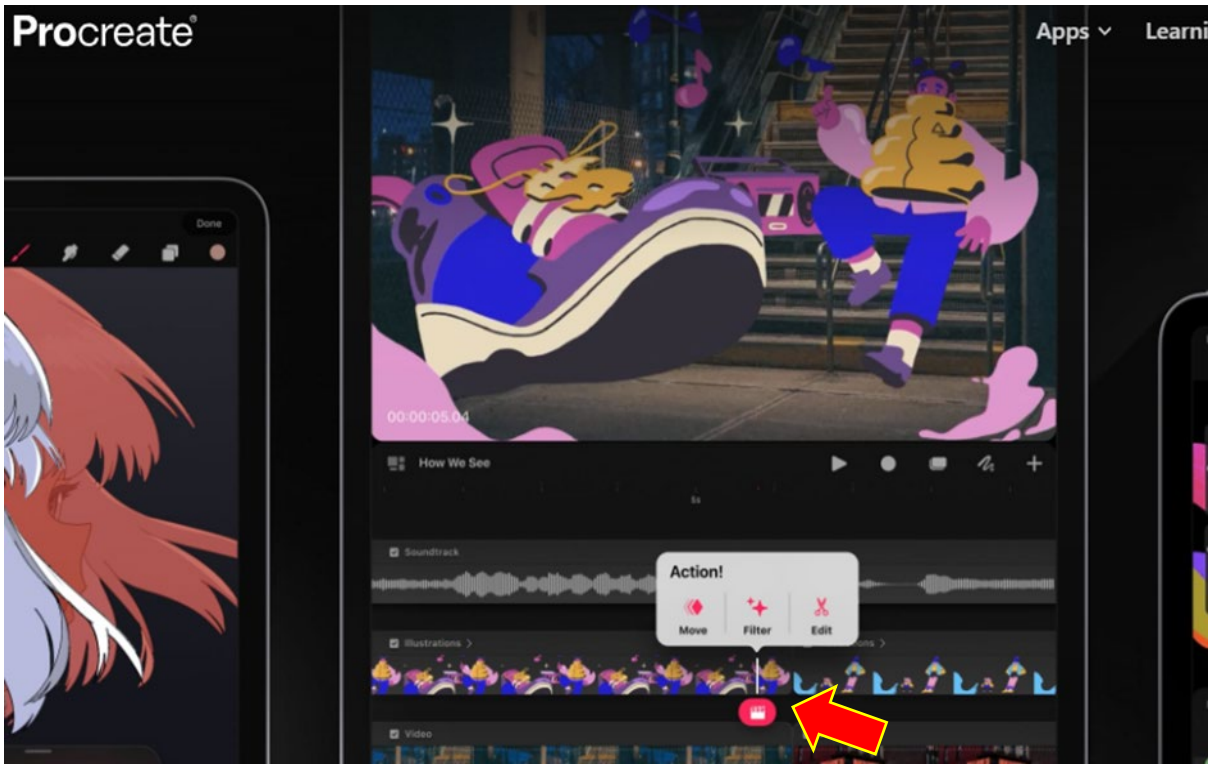
> *…the fact that the relevant public is a specialist one cannot have a decisive influence on the legal criteria used to assess the distinctive character of a sign. Although it is true that the degree of attention of the relevant specialist public is, by definition, higher than that of the average consumer, it does not necessarily follow that a weaker distinctive character of a sign is sufficient where the relevant public is specialist.*

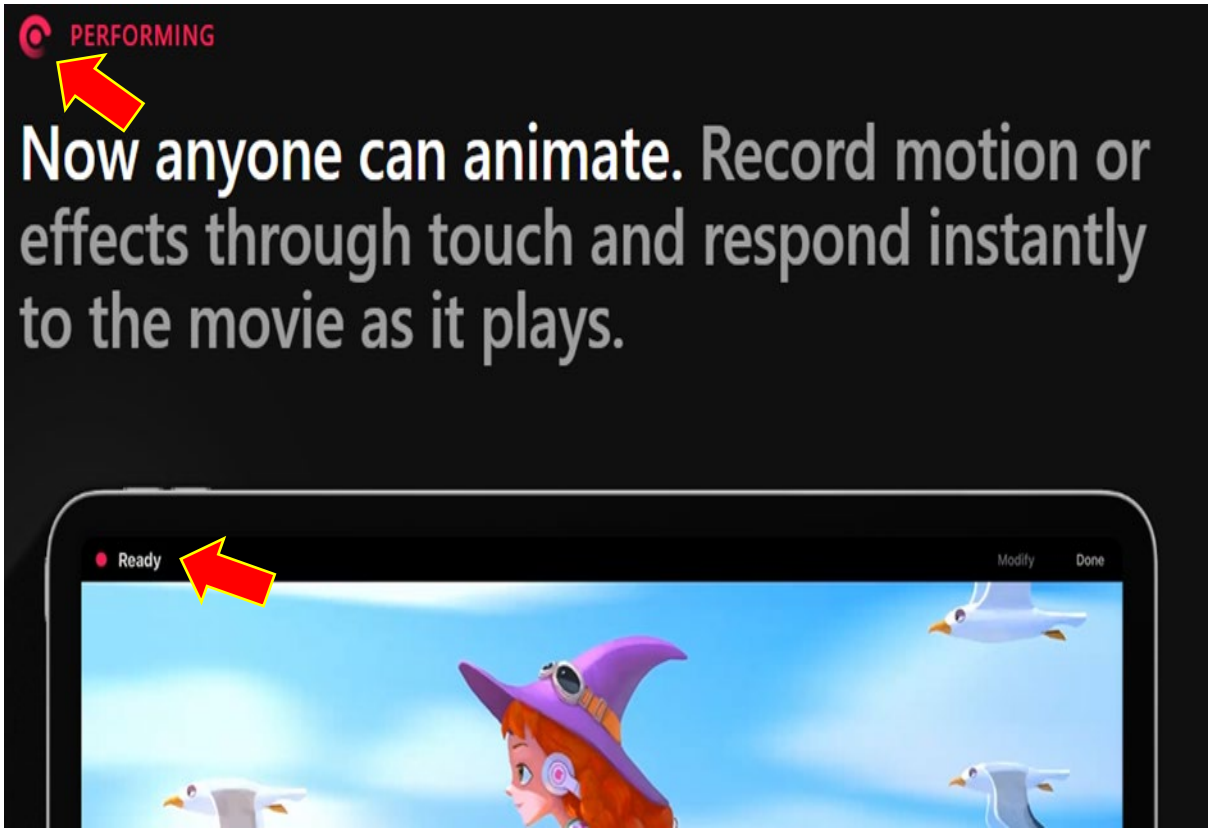
Consumer Perception

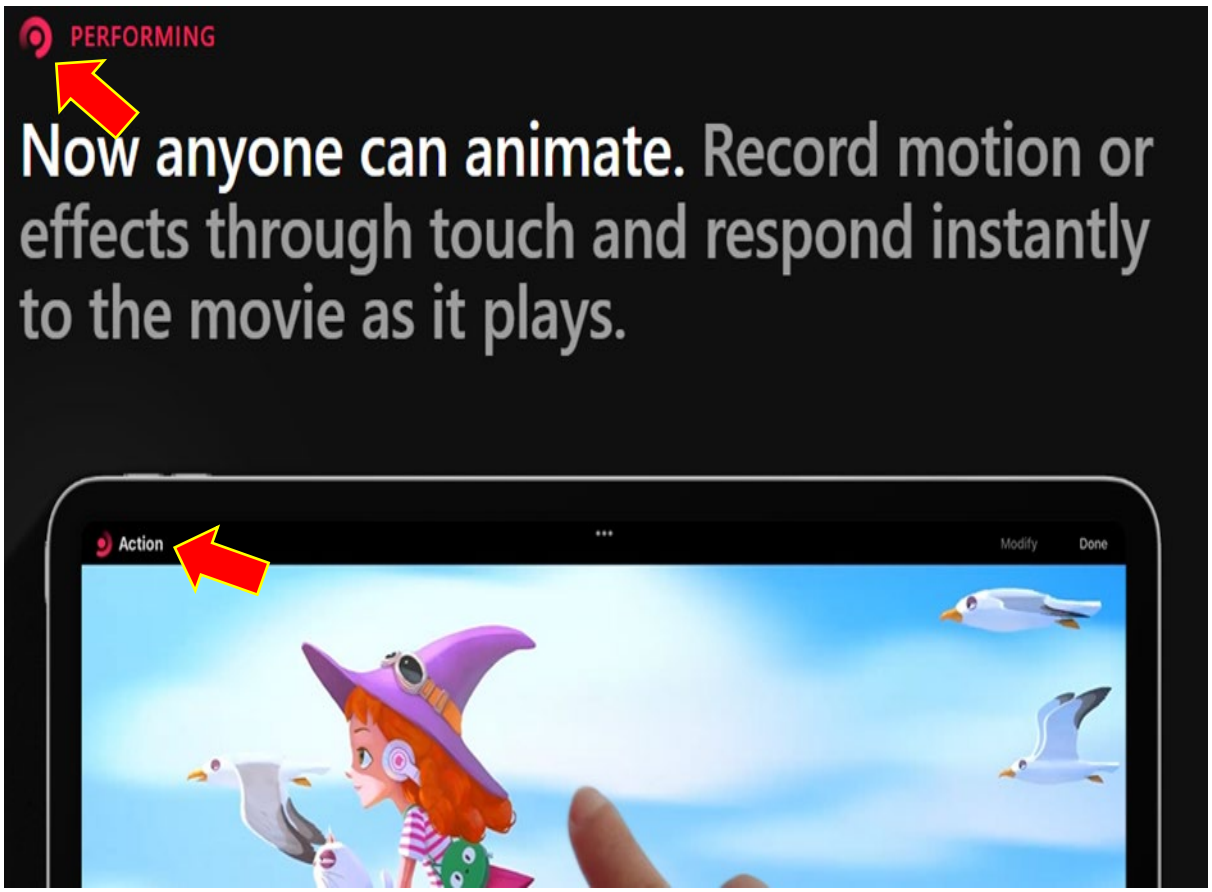
25. The assessment of an application or designation must of course be stringent and full (according to case law). Prior to the hearing and following the hearing, I deemed it necessary, as I have already shown, to peruse the holder's website, and the internet more generally, to identify any use of the signs for which protection is sought, in trade. I believe that conducting further research into the holder's actual product which utilises the marks claimed is justified as part of a stringent analysis – marks such as these need to be viewed in the context in which they are actually found and not in a trade mark examination "vacuum" or "bubble". I considered this to be important, especially in connection with what may be regarded as 'non-traditional' signs such as these, as it is prudent for me to have a picture of what they represent to aid visualisation and to ascertain how they will be exposed to consumers and how consumers may be confronted by them.

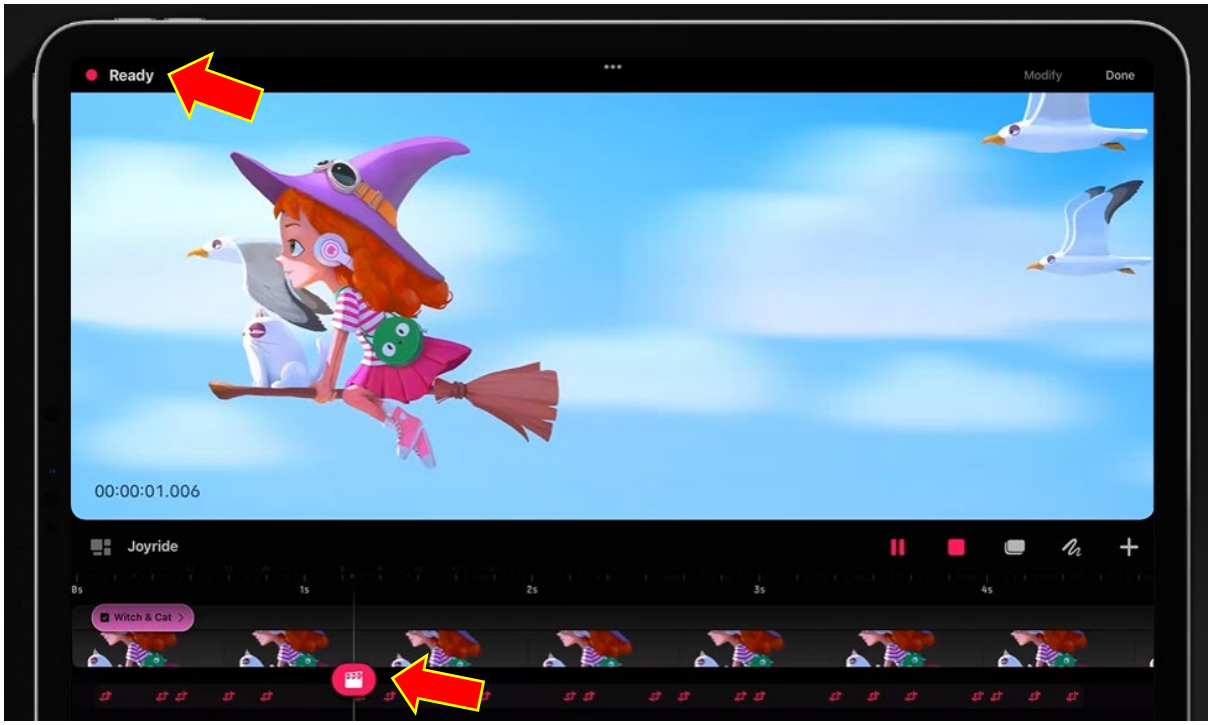
26. I should point out that I am fully aware of the fact that the material particulars of each of the marks are different, nevertheless they are all graphics used in the editing of videos which would convey information about the editing process rather than serve as trade marks.

27. As mentioned above, I feel that it is necessary to fully consider the holder's specific business activities and commercial exploits that have indeed assisted me in terms of reaching the conclusion that I did in my hearing report and in the end helped reinforce and fortify my appraisal. I provide below a series of screenshots from the holder's website showing the content of each of the movement marks in use, which may be useful:




PERFORMING
Now anyone can animate. Record motion or effects through touch and respond instantly to the movie as it plays.
Ready
Modify
Done


PERFORMING
Now anyone can animate. Record motion or effects through touch and respond instantly to the movie as it plays.
Action
Modify
Done



28. In my opinion the multimedia movement marks consist of icons forming part of the aesthetics of the holder's graphical user interface (GUI).

29. I of course accept Ms Johnson's submission at the hearing that signs other than 'traditional' words and/or devices can, in principle, be seen as trade marks; however, this does not mean that *all* 'non-traditional' marks are inevitably distinctive. Given the use above (as indicated by the red/yellow arrows), it is entirely clear that the marks applied for are simply symbols and graphic representations that merely indicate some sort of functionality:

    '774 – a clapperboard opening and shutting with a white vertical line above, which may serve to indicate to the user which particular frame of animation is being shown

    '960 – a flashing red dot with a 'throbber', or 'loading icon', which may signify to the user that the program is performing an action or task

    '961 – a flashing red dot along with the word 'Ready' and then a loading icon appears around the red dot along with the word 'Action' – this may merely show that the system is ready and when the word 'Action' appears the video or animation might play or capture real-time movements for example

    '962 – a clapperboard opening and shutting which might indicate, for example, the current frame of animation

30. All the movement marks consist of symbols, wording or icons that feature within the holder's application program interface, and they all perform a particular function which in my opinion would mitigate against simultaneous perception as trade marks. From the perspective of the consumer, and absent education, they are simply not trade marks and I do not believe that they will be perceived as such.

31. As referenced above, I accept entirely that each of the marks are different in some way. Nevertheless, the rationale for refusal is consistent between all four designations and they are devoid of any distinctive character for the same reasons. When the consumer is utilising the program, those features and icons as presented within the marks in suit will not be interpreted as brand identifiers, in and of themselves.

32. Additionally, I believe that it is fair to say, in accordance with the law, that the holder's use here is not in a manner commensurate with trade mark use and during the user experience there is nothing about the signs that will communicate a trade mark message. In the *prima facie*, the consumer will see the words and/or symbols as functional icons and as simply being a part of the functionality of the program that they are using.

33. It was argued by Ms Johnson at the hearing that the use of a clapperboard in '774 and '962 is not used extensively by other traders for such products and services and therefore this renders those signs as being unusual and fanciful. However, when viewing the marks in use, as demonstrated above, I do not consider a clapperboard to be arbitrary to the point that it will be seen immediately as a trade mark of a single undertaking. It remains a highly recognisable symbol that is entrenched in the concept of filmmaking and video production and moreover the holder's goods and services are specifically for the creation of "*…animations, expressive videos, and breathtaking stories…*" (according to the holder's website). Therefore, consumers will not attribute such an appropriate icon, during the use of the software concerned, as indicative of commercial origin. It may simply be, for example, a feature of the slider or scroll bar used in editing software or as an editing tool for the creation of animations etc.

34. What matters here, of course, is the nature of the marks concerned. The words and icons represented within the movement marks are simplistic and are completely connected to the functioning features of the software: they could indicate which frame of the animation is being played; they could indicate that the system is 'Ready' for use and the word 'Action' may indicate that the video is recording or that capturing or editing is taking place; the clapperboard is an element of the holder's scroll bar that forms part of the graphical interface which allows users to navigate through the content, for example. Therefore, I reiterate that the movement marks do not consist of or contain badges of trade origin. They are

generic and simplistic aspects of the holder's software interface that relate in some way to its functionality.

35. At the hearing, Ms Johnson contended that whilst the holder does not concede that the signs are devoid of any distinctive character in respect of any of the goods or services, it is inconceivable that goods such as '*eyeglasses*' could fall foul of section 3(1)(b) of the Act. Ms Johnson expressed that the examiners did not assess the marks against the individual terms. I agreed with the principle, although I pointed out that the registrar is entitled, based on the case law, to give general reasoning where the goods/services are similar or intrinsically linked and the rationale for objecting is the same (CJEU in Case C-437/15P *EUIPO v Deluxe Entertainment Services Group Inc.* at paragraphs 26 to 45).

    Against this backdrop, subsequent to the hearing, I duly assessed the marks by reference to the individual goods and services and I concluded that the very narrow list of goods at paragraph 9 above were acceptable. I found those goods to be discrete and sufficiently detached from the content of the marks and the types of goods and services that are actually provided by the holder. I felt that it would be difficult to substantiate the objection for such goods as they bore no relationship with the marks applied for.

36. For the remaining goods and all the services, I consider there to be a very strong nexus between them and they are all directly related to the marks for which protection is sought as, in general terms, they cover *computer hardware and software for graphic design applications, art generation, creating animations and cartooning* and *software as a service, platform as a service and infrastructure as a service in relation to creating and editing videos, digital movies, video images, audio recordings, animation, still images, graphics, and multimedia content*. Therefore, I consider the marks to be devoid of any distinctive character in relation to any software or hardware and any services capable of such purposes.

37. The technology used in the creation of any animations, graphic designs and videos would clearly involve the objectionable goods and services and this stands to reason as this is exactly what the holder does by way of business.

38. I believe that the goods and services have an innate association with each other as they allow users to create animations, videos and stories, and the holder designs and develops the software or platforms for creating such motion graphics. Whether being downloadable or provided online, the software and hardware is for recording sounds and videos and the software and hardware is for editing videos and animations; the created films and animations may then be shared, posted, uploaded or downloaded, however the user requires. Therefore, to my mind, there is a clear connection and close link between the marks and the objectionable goods and services that is sufficient to deprive the marks of a distinctive character.

39. I am maintaining the objection to the 'hardware'-type goods because one cannot function without the other and whilst utilising the software that is downloadable or non-downloadable, the consumer inevitably requires hardware. In essence, they are so intrinsically linked that they are devoid of any distinctive character, in my view.

40. I should make clear once again that I am fully aware that no higher test is to be applied in respect of different mark types, and I am not maintaining the objections under section 3(1)(b) of the Act simply because the signs in question are multimedia motion marks. It is not the mark type that is the issue; it is the content.

41. A multimedia mark can of course be distinctive or non-distinctive, like any other type of sign. In this case, I consider the content to be non-distinctive because it is merely visual and functional features of the holder's graphical user interface. Had the movement marks incorporated, for example, the words *Procreate Dreams* (one of the holder's distinctive brand names) the designations would undoubtedly have met the requirements for acceptance under section 3(1)(b) of the Act. However, in the absence of an element sufficient to imbue the signs as a whole with a distinctive character, the multimedia marks as filed could apply to any undertaking.

42. I believe that it is fair to say, and I'd take on judicial notice, that there are many software and software service packages available on the market for the creation of videos or animations, where recording and playback functions are present as well as features such as keyframing and real-time rendering, which would also incorporate a scroll bar etc. Therefore, the likelihood that consumers would identify the content of the multimedia marks, as displayed on a computer program, as being trade marks of a single undertaking is extremely unlikely to be the case, absent education.

43. I do not believe that it is necessary for me to identify, categorically, what the icons actually symbolise or what their particular function and purpose may be, as my interpretation of them, as opposed to the holder's, may differ slightly. Nevertheless, I feel that it is sufficient, given the holder's manner of use identified above, that I deem the movement marks to be merely representative of functional features of the software, hardware and services for the reasons I have given. In other words, I have formed the conclusion that whatever their function, they are not, in the *prima facie*, trade marks. This is due to the likely practical or utilitarian nature of the individual elements that constitute the motion marks which in my view diminishes the signs capacity to function as badges of trade origin.

44. In respect of the content within each of the multimedia marks (whatever their specific purpose or function), consumers would not rely on those elements alone as indicators of single commercial origin. In my opinion, the question is not, will those words and icons be noticed by the consumer because they certainly will be

given their function and purpose; the question is, will those elements alone be perceived as performing the function of a trade mark. I would posit that from the perspective of the consumer they will not attribute any trade mark significance to those particular features and therefore the signs are incapable of distinguishing goods and services of one undertaking from those of other undertakings.

45. In relation to the colours appearing in the marks, namely black and red, it was argued that this colour combination was also a distinguishing feature. In my view, the colours are not significant and striking and the colours add nothing to the marks as a whole. It is clear that computer applications and program interfaces are available in a plethora of different styles and colours. Therefore, the colours black and red do not imbue the signs with distinctiveness and the marks remain incapable of guaranteeing single commercial origin.

46. At the hearing, Ms Johnson submitted that other designated countries have already protected the designations in suit. In this regard, I am mindful of the comments made by the ECJ in *POSTKANTOOR* C-363/99 where it was stated:

> *43. Therefore, the fact that a mark has been registered in one Member State in respect of certain goods and services cannot have any bearing on whether or not any of the grounds for refusal set out in Article 3 of the Directive apply to a similar mark, registration of which is applied for in a second Member State in respect of similar goods or services.*

I recognise that these comments, which have long been established in trade mark law, refers to other 'Member States'. Nevertheless, I believe that the same must, in principle, be true of the position of the registrar with regard to the decisions made by other countries party to the Madrid Protocol.

The protection of the marks in any other designated countries bears no impact on the examination of the same marks in the United Kingdom.

47. The movement marks applied for are simply representative of interface aesthetics and functionality rather than trade marks of a single undertaking, and therefore they are unpossessed of a distinctive trade mark character.

Conclusion

48. All four UK designations are acceptable in respect of the goods listed at paragraph 9 above.

49. For the remaining goods and all the services, all four UK designations are considered in the *prima facie* case to be devoid of any distinctive character and subsequently fail under section 3(1)(b) of the Act.

50. For the reasons given above, I consider the signs to be entirely devoid of any distinctive character pursuant to section 3(1)(b). In respect of the objectionable goods and services, all four UK designations are therefore refused under the terms of section 37(4) of the Act because they fail to qualify under section 3(1)(b).

Dated this 12th day of August 2025

Matthew Davies
For the Registrar,
The Comptroller-General