

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF**

**APPLICATION NO.2176423**

**BY PRECIS (1615) LIMITED**

**TO REGISTER A TRADE MARK IN CLASSES 3,4,5,6,8,9,11,12,14,15,16,17,18,20,21, 22,23,24,25,26,27,28,29,30,31,32,33,34,36,37,39,41 and 42**

### **DECISION AND GROUNDS OF DECISION**

On 3 September 1998 Precis (1615) Limited of Sir John Moores Building, 100 Old Hall Street, Liverpool L70 1AB applied under the Trade Marks Act 1994 to register a series of six marks shown at annexes A and B.

The marks were applied for in all the classes listed above. The application form indicated that protection was sought for all goods and services that are proper to each of these classes. Colours blue, orange and white were claimed as an element of the fourth and sixth marks.

Objections were taken to the application under sections 3(1)(b) and (c), 3(6), 5(2) and 41(2) of the Act.

At a hearing at which the applicants were represented by Mr McCall of W.P Thompson & Co, their trade mark agents, I waived the objections raised under section 5(2) and consequently I need say no more about them. However, I maintained the remaining objections and following refusal of the application I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds for my decision.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

#### Objection raised under sections 3(1)(b) and (c).

Objections were raised under paragraphs (b) and (c) of Section 3(1) of the Act on the grounds that the first four marks consist essentially of the word "Shop" being a sign that other traders may legitimately wish to use on, for example, goods and services provided by a shop. Objection was also taken under paragraphs (b) and (c) of Section 3(1) of the Act on the grounds that the fifth and sixth marks consist essentially of the words "Shop The Home Shopping Channel" being a sign that other traders may legitimately wish to use on, for example, goods and services offered for sale via electronic media.

As I have already stated, the application is for a series of six marks. I will deal with the sixth mark first of all because it represents the applicant's best case.

Sections 3(1)(b) of the Act reads as follows:-

3(1) The following shall not be registered -

(b) trade marks which are devoid of any distinctive character.

Mr McCall did not seek to argue that the word “Shop” or the words “The Home Shopping Channel” are distinctive. His argument that the mark is distinctive was based on the combination of these words, the presence of the device together with the colour element; in other words the presentation of the mark as a whole.

The mark consists of several elements. Firstly there is the word “Shop” presented in a large typeface and to the top right of this word is a device that, in my view, closely resembles an exclamation mark. Directly below this word are the words “The Home Shopping Channel” which are presented in a smaller typeface. The mark is presented in three colours which are claimed as an element of the mark.

In my view the words contained in the mark are the most prominent feature of it and the meanings of them are well known. It seems to me that the combination and presentation of these words is one that indicates that the applicant provides or intends to provide a television shopping channel from which the public can purchase goods and services. The enlargement of the word “Shop” is likely to be taken as an exhortation to shop via the applicant’s home shopping channel. It follows from this, in my view, that other traders may also wish to use such a combination in relation to goods and services which are sold or provided by such a television channel, for example, on promotional material.

However, I must, of course, consider the mark as a whole before deciding whether it is devoid of any distinctive character. In doing so I need to take account of the presence of the device and colour elements and whether the combination of these and the words result in a distinctive trade mark.

Turning first to the device element, this, as I have already mentioned, appears to me to closely resemble an exclamation mark and I think it extremely likely that this is how it would be regarded by anyone looking at the mark. Indeed this is how the device was described by Mr McCall at the hearing. An exclamation mark is, of course, commonly used after exclamations. In the context of this mark, it is my view that this sign is being used to emphasise that the purpose of the services being provided is to enable people to shop. I do not consider that the raised position of this device detracts from this.

As regards the colours contained in the mark, I do not consider that there is anything particularly distinctive about these colours or about the way in which they are presented. Advertisements in promotional material or for that matter on television are often in colour. The colours blue and orange (the white being mere background) are no more distinctive than any other two colours. Further, the colours as presented are mere background to the words.

The question that now remains is whether in view of the presence and combination of the aforementioned components, it can be held that the mark as a whole is devoid of any distinctive character? The meaning of “devoid of any distinctive character” was addressed by Lord Justice Robert Walker in a recent appeal by Proctor & Gamble Limited in relation to their bottle marks (unreported at the time of writing) who commented as follows:

“Despite the fairly strong language of s.3(1)(b), “devoid of any distinctive character” - and Mr Morcom emphasised the word “any” - that provision must in my judgement be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product - in this case an ordinary, inexpensive household product - from that of another competing trader”.

Taking the four elements together - the word “Shop”, the words “The Home Shopping Channel”, which dominate the mark in my view, the device closely resembling an exclamation mark which I consider only serves to add emphasis to the word “Shop” as mentioned earlier, and the colours, I do not consider that this is a combination of signs that can readily distinguish one trader’s product. I therefore find that the mark to be unacceptable under section 3(1)(b).

Having found that the sixth mark in the series fails under the provisions of section 3(1)(b), it follows, in my view, that I must reach the same conclusion in relation to the other five marks which contain fewer elements than the sixth mark.

Following further consideration of the marks, I am of the view that the objection raised under section 3(1)(c) is not valid in respect of the fourth, fifth and sixth marks in the series.

#### Objection raised under section 3(6) of the Act.

An objection was raised under section 3(6) of the Act in relation to Classes 3, 5, 6, 9, 11, 12, 16, 17, 20, 21, 29, 30, 36, 37, 39, 41 and 42 in respect of the breadth of the specifications in these classes. Furthermore it was requested that the goods and services be listed. No objection was raised under section 3(6) in relation to classes 4, 8, 14, 15, 18, 22, 23, 24, 25, 26, 27, 28, 31, 32, 33 and 34, but the agent was advised that the specifications were not acceptable because they did not list the goods applied for. In a letter dated 5 November 1998, the applicant’s agent provided the Registry with some clarification as to the goods and services which are apparently of primary interest to the applicant. These were set out as follows:

**Class 3:** Cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 4:** Lubricants.

**Class 5:** Dietetic substances adapted for medical use.

**Class 6:** Ironmongery, small items of metal hardware.

**Class 8:** Hand tools and implements (hand-operated); cutlery; razors.

**Class 9:** Electric, photographic, cinematographic, optical, weighing and measuring instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

**Class 11:** Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

**Class 12:** Vehicles; apparatus for locomotion by land, air or water.

**Class 14:** Jewellery, precious stones; horological and chronometric instruments.

**Class 15:** Musical instruments.

**Class 16:** Printed matter; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites; playing cards.

**Class 17:** Packing, stopping and insulating materials; goods made from rubber and not included in other classes.

**Class 18:** Goods made of leather and imitation of leather and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks.

**Class 20:** Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, shell, amber, mother of pearl, meerschaum and substitutes for all these materials, or of plastics.

**Class 21:** All.

**Class 22:** Ropes, nets, tent awnings, sacks and bags (not included in other classes).

**Class 23:** All.

**Class 24:** All.

**Class 25:** All.

**Class 26:** All.

**Class 27:** All.

**Class 28:** All.

**Class 29:** All.

**Class 30:** All.

**Class 31:** Horticultural products; seeds, natural plants and flowers; malt.

**Class 32:** All.

**Class 33:** All.

**Class 34:** All.

**Class 36:** All.

**Class 37:** Installation services.

**Class 39:** Travel arrangement.

**Class 41:** Providing of training; entertainment; sporting and cultural activities.

**Class 42:** Temporary accommodation; hygienic and beauty care; services that cannot be classified in other classes (e.g. lotteries, gambling).

The revised specifications as set out above were not discussed in any detail at the hearing so I will set out my position here. The key question that has to be asked is - is it plausible that the marks are being used by the applicant or with his or her consent in relation to these goods and services or that there is a bona fide intention that they will be so used ?

Section 3(6) of the Act states :

“A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

It is a settled principle of trade mark law that “bona fide intention” means a definite and present intention.

It is Registry practice to, in the first instance, raise an objection under section 3(6) of the Act where it is considered that there is self evidently some doubt about the accuracy of the statement of the application form that “The trade mark is being used by the applicant or with his or her consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used”. However such objections are reviewed in light of any submissions made by the applicant. It is also Registry practice to ask that goods and services being applied for in each class are specified as required by Section 32 of the Act and Rule 8 of the Trade Mark Rules 1994.

The fifth and sixth marks indicate that at least those marks (and possibly the others) are to be used in relation to a television shopping channel. Bearing this in mind (and despite the absence of any submissions from the applicant on this point), I think it reasonable to accept that the applicants may well trade in wide ranging goods and services. On the assumption that the applicant is prepared to limit the goods and services as listed above, the Registrar’s position would be as follows :

The specifications listed in relation to classes 3, 4, 5, 6, 8, 11, 14, 15, 16, 17, 18, 20, 22, 31, 37, and 39 are acceptable.

This leaves the following classes:

#### **Class 9**

The specification includes the term “Electric.....instruments”. It seems to me unlikely that the applicant is justified in applying for such wide ranging goods.

#### **Class 12**

This specification includes vehicles at large as well as apparatus for locomotion by land, air or water. It would appear to me unlikely that the marks are or will be used in relation to all of these goods.

#### **Class 21**

It may well be the case that the applicant is justified in applying for all the goods that are proper to this class but in line with the Act and Rules, the goods need to be specified.

**Classes 23, 24, 25, 26, 27, 28, 29, 30, 32, 33, 34 and 36**

In line with Registry practice, I am able to accept wide claims in these classes but the goods need to be specified as required by the Act and Rules.

**Classes 41 and 42**

These specifications cover wide ranging services which, in my view, are unlikely to be provided under the marks.

Objection raised under section 41(2) of the Act.

Section 41(2) of the Act reads as follows:

“A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark”.

A series objection was raised under section 41(2) of the Act (the Examiner in his examination report indicated that the first and second mark constitute a series of two marks as do the third and fourth marks as well as the fifth and sixth marks. Mr McCall did not seek to argue against this point at the hearing).

It seems to me that in view of the different presentations of the marks and the additional wording in the fifth and sixth marks that I must concur with the Examiners view that marks one and two are a series of two marks as are marks three and four as well as marks five and six. However, I do not consider the marks to be a series of six marks.

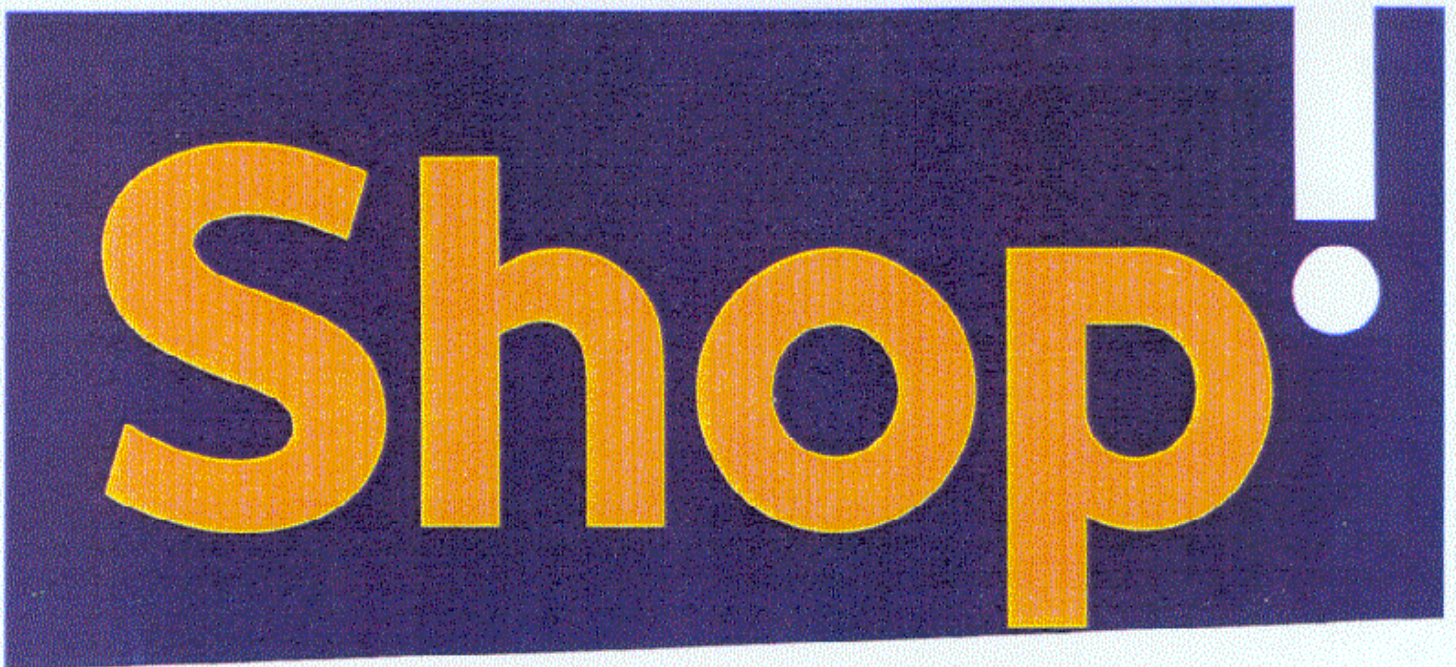
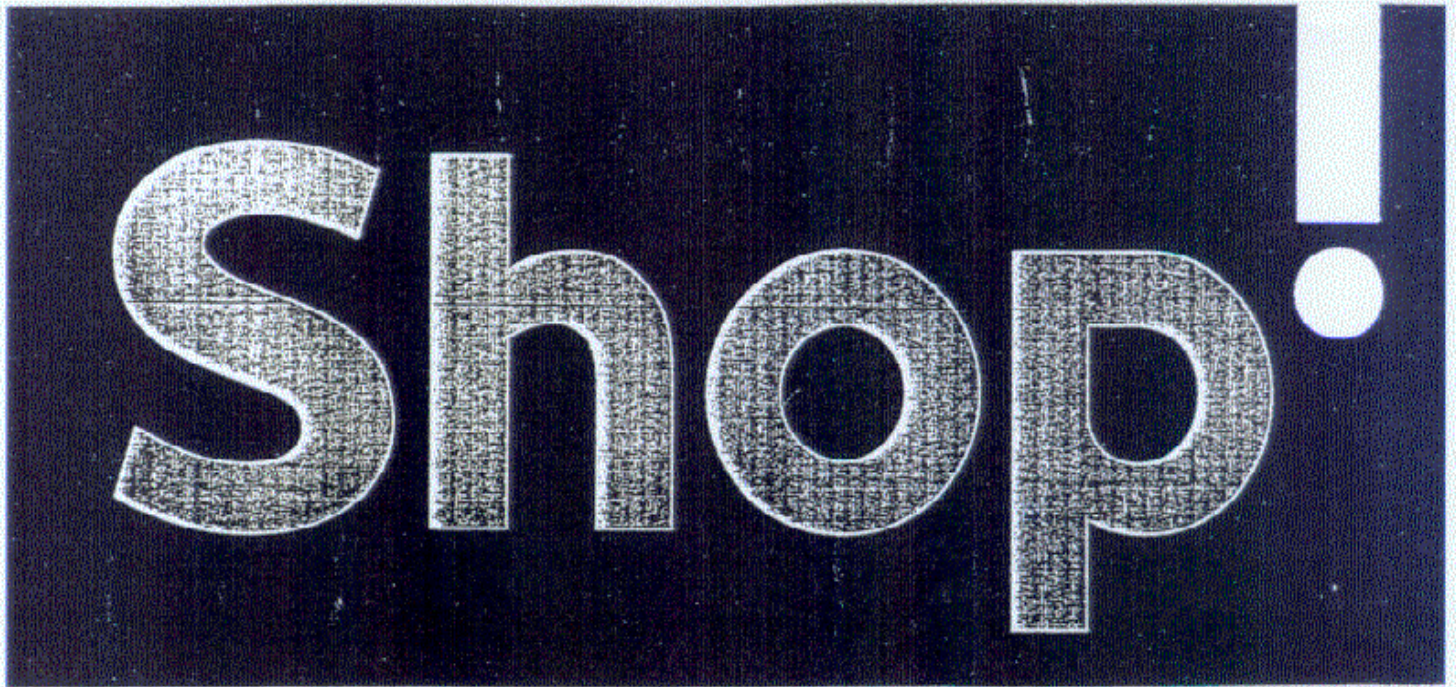
In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons I have given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c), 3(6) and 41(2) of the Act.

Dated this 21 day of June 1999

**JOHN HAMILTON-JONES**  
**For the Registrar**  
**The Comptroller General**

Shop!

Shop!



**Shop!**

**The Home Shopping Channel**

**Shop!**

**The Home Shopping Channel**