

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 713149
AND THE REQUEST BY SIEMENS AKTIENGESELLSCHAFT
TO PROTECT A TRADE MARK IN CLASSES 9, 38 AND 42**

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TO PROTECT A TRADE MARK IN CLASSES 9, 38 AND 42**

1. On 26 June 1998, Siemens Nixdorf Informationssysteme AG of 1, Heinz-Nixdorf-Ring, D-33106 Paderborn, Germany, on the basis of international registration no. 713149, requested protection in the United Kingdom, for the mark “TrustedMIME” under the provisions of the Madrid Protocol. The international registration was subsequently transferred to Siemens Aktiengesellschaft. Protection is sought in respect of :

Class 9

Chipcards; data processing programs.

Class 38

Electronic services, in particular transmission and distribution of data, information, images, video and audio sequences; provision and communication of information stored in a database, especially also using (computer) systems communicating interactively.

Class 42

Electronic services, in particular translation of data, information, images, video and audio sequences; development, generation and renting of data processing programs.

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from registration by Section 3(1)(b) and (c) of the Trade Marks Act 1994. This is because it consists exclusively of the word “Trusted” conjoined with “MIME” (multipurpose Internet messaging extensions), being a sign which may serve in trade to designate the type of goods or services.

3. A further objection was raised under Section 5(2) of the Act as it was considered that the mark was confusingly similar to an earlier mark, the details of which are as follows :

<u>Number</u>	<u>Mark</u>	<u>Goods</u>
1457072	MIME	Apparatus and instruments, all for use with computers; computing apparatus and instruments; computer firmware; computer software; parts and fittings for all the aforesaid goods; all included in Class 9; but not including any such goods relating to mime.

4. In a letter of 2 February 2000, the holder's representatives, Haseltine Lake Trademarks, requested clarification as to what specific goods and services the objection related to and suggested that the mark may be acceptable for computer goods not involved in sending e-mail.

5. The Examiner responded in a letter of 8 February 2000 and explained that the objection related to all the goods and services applied for as they all incorporate, or could incorporate, communications via e-mail.

6. On 12 April 2000, an extension of time of three months was requested for the following reason : "Our clients are investigating the use of this mark in the United Kingdom. Further time is required to assess the strength of the evidence available to see if it is sufficient to support this designation".

7. However, in a letter of 14 June 2000, the holder's representative put forward arguments for prima facie acceptance of the mark and, notwithstanding the suggestion referred to at point 4 above, requested that the goods and services be limited to "; all for use in the encryption and authentication of e-mails".

8. In this letter, it was accepted in that "Trusted" indicates security and that the acronym MIME is an industry standard and "offers a standardised way to represent and encode a wide variety of media types for transmission via Internet mail". However, it was argued that "although the combination may allude to various elements connected with the goods and services claimed, it does not describe the goods and services themselves, which are used in the encryption (putting into a coded form) and authentication (verifying the identity of potential users) of e-mail". It was also argued that "the whole is not a term which serves to designate characteristics (other than origin) which could be used with equal truth by traders whose goods are possessed of the relevant characteristics, as it is not a generic or descriptive term for the goods and services claimed. The term for secure mail over the Internet is S/MIME, not TrustedMIME". Arguments were also submitted in relation to the objection raised under relative grounds.

9. The Examiner was not persuaded by these submissions and in a letter to the holder's representatives of 27 June 2000, the objections were maintained.

10. At a hearing, at which the holder was represented by Mr Martin Krause of the trade mark attorneys referred to above, the objections were maintained. Mr Krause advised me that there had been use of the mark and enquired whether filing evidence of such use would assist. I indicated that filing evidence of use may enable me to accept the mark and, at the request of Mr Krause, allowed a period of three months for such evidence to be submitted.

11. However, no evidence of use was submitted and a notice of final refusal was issued on 26 October 2001. I am now asked under Section 76 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.

12. In view of the above, I have only the prima facie case to consider.

13. Section 3(1)(b) and (c) of the Act read as follows :

3(1) The following shall not be registered -

- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

14. The mark consists exclusively of the word “Trusted” conjoined with the acronym “MIME”.

The “Macmillan Dictionary of Information Technology” defines “Trusted” as :

“In data security, pertaining to software and hardware systems that have been designed, and verified, to avoid compromising, corrupting or denying sensitive information”.

The Oxford Dictionary of Computing defines “MIME” as :

“*Acronym for* multipurpose Internet messaging extensions. A system designed to support the encoding of information other than straightforward text, such as digitized audio or video signals, so as to allow the signals to be transferred as the contents of e-mail messages”.

15. From the proposed limitation referred to in point 7 above, it is clear that the goods and services relate to the encryption and authentication of e-mails for security purposes. In my view, the sign “TrustedMIME”, when used in relation to such goods and services, would convey to the purchasing public that they relate to a product, the purpose of which is to ensure the secure transmission of mail sent via the Internet using the MIME system. The term “secure”, in this context, meaning mail that is, for example, encrypted to avoid the compromising or corruption of information contained within it.

16. In my view, the sign is highly descriptive of the intended purpose of the goods and services and I do not consider that the conjoining of the word and acronym would lead the purchasing public to see the mark as an indication of origin.

17. The European Court of Justice has recently given further guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1) of the Trade Marks Act) in the “Baby-Dry” case C-383/99 P. I set out the guidance given at paragraph 37 of this judgement:

“It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function”.

And the guidance given at paragraph 39:

“The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods

or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”

18. This indicates that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). In my view, the word and acronym “TrustedMIME” would be regarded by the purchasing public as a normal way of designating that the goods and services are for the intended purpose that I have set out above.

19. Although this guidance was not available at the time of my decision, it does not alter the view that I have stated.

20. As regards the objection raised under Section 5(2), I do not consider that objection can be sustained and I therefore waive that objection.

21. In this decision, I have considered all the documents filed by the holder and all the arguments submitted to me and, for the reasons given, the notice of refusal is upheld.

Dated this 12 day of March 2002

John Hamilton-Jones
For the Registrar
The Comptroller General