

O/393/18

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3254923**

**BY SUN MARK LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 33**



## **BACKGROUND**

1. On 6 September 2017, Sun Mark Limited ('the applicant') applied to register the above trade mark for the following goods:

Class 33: Vodka.

2. On 22 September 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(5) of the Trade Marks Act 1994 ('the Act') which reads:

*'The application is not acceptable as there is an objection under Section 3(5) of the Act. This is because the mark contains a representation of the Royal crown.'*

3. The examiner stated that the objection under section 3(5) could be overcome by obtaining consent from the Lord Chamberlain's Office:

*'The right to use devices of the Royal crown or closely resembling devices falls under the remit of Lord Chamberlains Office, who can be contacted at the following address:*

*Lord Chamberlains Office  
Buckingham Palace,  
London,  
SW1A 1AA'*

4. The examiner also brought the applicant's attention to the IPO's guidance in relation to 'Marks Containing Arms', the jurisdiction under which they fall and the contact details of the relevant bodies are provided:

*'Marks containing Arms*

*As it appears your marks consists of or contain arms, you should be aware that the right to use a Coat of Arms falls under the jurisdiction of the following and you may wish to contact the appropriate body for guidance:*

*For England, Wales and Northern Ireland*

*Garter King of Arms*

*The College of Arms*

*Queen Victoria Street*

*London*

*EC4V 4BT*

*For Scotland*

*The Court of the Lord Lyon*

*HM New Register House*

*Edinburgh*

*EH1 3YT*

*It should be noted that the use of armorial insignia in Scotland which are not registered in the Public Register of All Arms and Bearings in Scotland constitutes an offence and may lead to prosecution.'*

5. The applicant was also notified of a similar earlier mark that it was considered they should be made aware of.
6. In accordance with standard procedure, failure to reply to the objection under Section 3(5) of the Act, within the stipulated time period which expired on 22<sup>nd</sup> November 2017, would result in the application being refused under Section 37(4).
7. On 29 November 2017, seven days after expiry of the response deadline, the examiner issued a "Failure to Respond" letter. This letter confirmed that the Registrar had not received any response relating to the objection taken under section 3(5), and, that as a result, the application was being refused under section 37(4).
8. On 5 December 2017, the applicant filed a Form TM5, requesting a written statement of reasons for the Registrar's decision.
9. I am now required under section 76 of the Act and rule 69 of the Trade Marks Rules 2008 ('the rules') to state in writing the grounds of the Registrar's decision and the materials used.

## **DECISION**

10. In the examination report of 22 September 2017 it was explained that failure to reply to the section 3(5) objection by the due date would result in the application being refused in accordance with section 37(4) of the Act.
11. Section 37 sets out the provisions which govern the examination and refusal of trade mark applications, sub-section (4), in particular, providing the Registrar with grounds for refusing such an application where it fails to meet the requirements for registration. The provision reads as follows:

*"If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application."*

12. The applicant did not respond to the examination report nor did it provide any reason for not responding within the time period. As a consequence, I must make my decision solely on the basis of the failure to respond within the period prescribed in the examination report. Section 37(4) is a mandatory provision setting out the consequence of failure to respond; there is no discretion. The Registrar believes that the examiner's decision to refuse the mark, as a result of the applicant's failure to respond within a clearly-communicated time frame, was correct and the application is accordingly refused.
13. However, for the sake of completeness, and in the interests of legal certainty, I present below a review and confirmation of the examiner's original objection taken under Section 3(5). Section 3(5) of the Trade Marks Act 1994 reads as follows:

*'A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).'*

14. Whilst the examination report did not make specific reference to section 4(1)(a) and (b) of the Act (or any other subsection of section 4(1) for that matter), it is clear that section 3(5) states that a trade mark shall not be registered in the cases specified, or referred to in section 4 (specially protected emblems). Section 4 reads as follows:

*'4(1) A trade mark which consists of or contains—*

- (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,*
- (b) a representation of the Royal crown or any of the Royal flags,*
- (c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or*
- (d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation, shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.*

15. In commenting on this matter, I take account of the guidance set out in the Manual of Trade Marks Practice ('the Manual') on page 138, under the heading 'Royal Marks' which states:

*'The registration of any word or figurative mark which consists of, or contains, elements which correspond to, or are heraldic imitations of, any of the provisions set out above, will face an objection.'*

'the above' being section 3 and section 4 of the Act.

16. The Manual also confirms that:

*'If a mark includes a device of the Royal Crown or a closely resembling image, an objection is appropriate under sections 3(5) and 4(1)(b).'*

17. The mark presented for examination contains an image of a Royal Crown that is identical to a conventional representation of a Royal Crown shown below:

| Representation of the Royal Crown notified by the Lord Chamberlains Office:       | The mark applied for:  |
|---|--|
|  |  |

18. It is clear when comparing the crowns above, that they are identical and as such the mark applied for contains a prescribed emblem under section 4(1)(b).

19. Since the mark contains the elements specified by the Act then refusal would be inevitable. In the event that I can take overall context of the whole mark into account the word 'Royalty' reinforces the impact of the individual elements, as far as the relevant consumer is concerned.

20. In the context of section 3(5), there is an obligation on the part of the applicant to provide an indication of consent from the Lord Chamberlain, as representative of the Royal family, to use emblems which fall within the remit of section 3(5) and section 4(1)(b).

21. No such consent was provided in this case.

22. The lack of any response from the applicant limits this decision to an evaluation of the administrative actions taken by the Registrar following the issuing of the examination report i.e. in light of the objections raised, a deadline for reply was set; that deadline was not adhered to which subsequently resulted in refusal under section 37(4) of the Act. As I have said however I have given a view on the substantive objections raised in addition, and with the aim of dealing with all matters should the decision be appealed.

## **CONCLUSION**

23. In this decision, I have considered the examination report on the official file and noted the lack of response from the applicant. For the reasons given above, the application is refused for all the goods sought under section 37(4).

Dated this 27th June 2018

Angela Davies  
For the Registrar  
The Comptroller-General