

TRADE MARKS REGISTRY
WORK MANUAL
CHAPTER 3
EXAMINATION AND PRACTICE ADDENDUM

1 Introduction

1.1 Purpose of the Addendum to Chapter 3 of the Work Manual (Trade Mark Examination and Practice) .

The purpose of this Addendum is to provide more detailed guidance to Trade Mark Examiners and practitioners on the registrability of specific marks or types of marks than is provided in Chapter 3. It is essential that each mark is considered by applying the general guidance provided in Chapter 3. However , certain specific marks have already been considered in the past . Therefore , this Addendum will indicate which marks can be accepted or rejected in light of these earlier decisions or will provide guidelines which can be applied to specific marks .

1.2 Sources used

This guide to Registry practice is compiled by senior officers in the Trade Marks Registry and is based on information from a variety of sources:

Reports of Patent Cases (RPCs) — these normally include reports of appeals to the courts and sometimes to the Appointed person. They may also include decisions of the Registrar where the decision contains statements of practice and interpretation of the law.

European Trade Mark Reports (ETMRs) — these contain trademark decisions from around the EU by examination offices, tribunals and courts which bear upon the interpretation of the EC Directive 89/104/EEC (approximation of laws relating to trade marks) underlying all EU national and supranational Trade Mark Law .

Fleet Street Reports (FSRs) — these also contain reports of Intellectual Property cases of interest, and are published by Sweet and Maxwell .

Decisions by the Appointed Person — these are published on the Office's website under "Trade Mark Hearings, Decisions and Appeals" - "Legal Decisions — from 1998" .

The Registrar is bound by the decisions handed down by the UK courts and European Court of Justice (ECJ). Appointed Person decisions are not binding but the Registrar may find them of persuasive value.

1.3 Practice

It is essential to remember that the practice stated in this Addendum should not be applied rigidly . Full consideration must be given to all relevant factors in any given application as each case must be considered on its own facts during the Examination process See for example the comments made by the Appointed Person (Simon Thorley QC) in the appeal by Henkel KGaA against the refusal of the Registrar to grant protection in respect of an International Registration (See reference BL 0/152/01 under "Legal Decisions — from 1998" , year 2001, on our website) .In that decision , at paragraph 12 , it says —

"It must always be remembered that the Registry Practice is a guideline and nothing more. It is helpful both to the Registry and to practitioners, but it cannot absolve the Registrar's hearing officers, or me on appeal, from approaching each case on its own facts".

It should also be remembered that the significance of certain words, phrases or signs in general use can change over time . Therefore any opinion relating to specific marks is not intended to determine or affect the registrability of any mark or any rights arising under the Trade Marks Act As already stated, this is only a guide and it is open to Examiners to be persuaded to depart from that guidance if the facts of the case warrant it

1.4 Amendments to Practice

Any changes to the guidance will be announced by way of a Practice Amendment Notice (PAN) which will be placed on the website and the Addendum will be updated immediately.

A

- **ACUMEN**

Means keen insight or discernment and is acceptable for most goods. This word is commonly used in the phrase "business acumen" and has laudatory connotations for business or financial services. Not acceptable prima facie, object under Sections 3(1)(b) and (c).

- **ADVANTAGE**

Generally acceptable unless the goods or services could give the purchaser a specific advantage. For example, ADVANTAGE would not be acceptable for sporting goods, financial services relating to investments or loans, or for marketing services (object under Sections 3(1)(b) and (c) where necessary).

- **AIRPORT**

Names of airports such as BIRMINGHAM AIRPORT will normally be acceptable for services without the need for evidence of distinctiveness to be filed. Objection should only be taken under Section 3(1)(b) and (c) where specifications include 'transport services' such as shuttle buses, taxis etc as it is likely that consumers would expect there to be more than one undertaking providing transport services to and from an airport and would therefore be descriptive of the destination/intended purpose of the services.

- **ALCOPOPS (Citing Guidance)**

Alcopops are defined in the New Oxford Dictionary of English as "ready mixed soft drinks containing alcohol". This has caused particular difficulty for Examiners when deciding whether to notify earlier right holders of marks between classes 32 and 33 under Section 5 of the Act. The following guidance is offered –

Specifications rarely include the term "alcopops" but the goods would be included in terms such as "alcoholic beverages", "alcoholic lemonade/orange/cola", "pre-mixed alcoholic drinks", "spirit mixers", "alcoholic carbonates/soda", "alcoholic ready to drink (RTDs)", "wine coolers", "dairy coolers".

Assuming the specification covers such goods, notification guidance is as follows:

Notify in relation to:

General terms, e.g. "non alcoholic beverages" against "alcoholic beverages"
"lemonade" etc against "alcoholic beverages"

Specific terms, e.g. "lemonade" against "alcoholic lemonade" or "alcoholic carbonated drinks"
"fruit juice" against "alcoholic fruit juice", "pre-mixed alcoholic drinks" or "spirit mixers"

In other cases the degree of similarity between the goods should be taken into account e.g. do **not** notify in relation to “fruit juice” against “alcoholic cola”.

NB. Only notify where the later mark is identical, or nearly identical, to the earlier mark or dominant feature of it. Therefore, where the earlier mark is only similar (as opposed to identical/near identical) to the later mark, or the dominant or distinctive feature of it, the Examiner may not notify in relation to an earlier mark for alcopops (however described) in Class 33 against a mark applied for in respect of non-alcoholic beverages in Class 32 and vice versa.

- **ALWAYS**

This word may be acceptable, solus, but if combined with other matter, may become non distinctive. For example, ALWAYS may be an acceptable mark in respect of `retail services' but ALWAYS OPEN in respect of the same services or ALWAYS RELIABLE (for cars) would not be acceptable. Each case should be carefully considered on its own facts.

- **ANGLIA**

Acceptable despite forming part of the geographical term 'East Anglia'.

- **ANIMALS (DEVICES OF)**

Certain animals are inherently non distinctive for certain goods e.g. cows or goats for dairy products, sheep for wool products. Such marks should be objected to, as appropriate, unless presented in a fanciful way e.g. a laughing or dancing cow.

Animal devices are often distinctive trade marks. However, care needs to be taken in relation to goods aimed at children such as children's clothing, children's bedding etc, where they are frequently used as decoration. As a rule of thumb, the more "warm and cuddly" the representation, the more likely it is to appeal to children and be seen as mere decoration and the less likely it is to be seen as a trade mark. Object under Sections 3(1)(b) where appropriate. (See also CARTOON CHARACTERS)

- **ANIMAL SKINS**

Devices of animal skins are devoid of any distinctive character for e.g. goods made of leather and prima facie objections should be raised under Sections 3(1)(b) and (c).

- **ANNIVERSARY**

This is non distinctive for cards, cakes, jewellery and other goods that may be marketed as specifically for the celebration of an anniversary. Otherwise acceptable, Object under Sections 3(1)(b) and (c) where appropriate.

- **ANSWER/ANSWERS**

It is possible that applications to register the word ANSWER, on its own, may be acceptable. However, combining this word with other matter may in fact render the mark as a whole non distinctive. The following have been accepted:

ANSWER — pregnancy testing kits
ANSWERS — underclothing

The mark THE ANSWER TO ALL YOU PROBLEMS, however, is unlikely to be registrable in respect of any goods or services.

- **ANZAC** (See Ch 3, para 38. 12)
- **AQUA**

A combining form relating to water; either alone or combined will normally be regarded as distinctive even for goods or services relating to water except where it is common trade practice to use the word descriptively as an alternative for water. In such cases objection should be taken if the mark, in totality, is descriptive;

eg **AQUA PARK** — for water parks — object Section 3(1)(b) and (c).
BROWN'S AQUA PARK — for water parks — accept.
AQUA AEROBICS — for Aerobics object Section 3(1)(b) and (c)
AQUA — for bathroom apparatus — accept.
AQUA PRESTIGE — for hose pipes — accept.

This is obviously not an exhaustive list and each case must turn on its own facts.

- **ARMAGNAC**

No trade marks bearing the words ARMAGNAC, COGNAC or CALVADOS can be accepted for registration in respect of goods other than those so designated. This restriction will equally apply even if these words are used with an indication of the true origin, for example JAPANESE ARMAGNAC, or with the addition of an expression such as "kind", "type" or "style". Objection will arise under Section 3(4) and 3(3)(b) of the Act. (See also Ch 3, para 38.8)

- **ARMORIAL BEARINGS** (See Ch 3, para 44)
- **ATLANTIC** (See Ch 3, para 35.5)

B

- **BEEFEATER**

The Lord Chamberlains Office has confirmed that it has no objection to the word BEEFEATER, or pictorial representations of Beefeaters, being used as trade marks.

- **BETA**

BETA marks may be accepted prima facie. The word need not be treated as too close to BETTER.

- **BIO**

BIO is now commonly known as an abbreviation for BIOLOGICAL. Examples of dictionary words are BIOCHEMISTRY, BIOCOLLOID, BIODEGRADABILITY, BIOMASS but listings of BIO words are not exhaustive. BIO is commonly added to other words to indicate a biological factor. Whether presented alone or with a descriptive prefix or suffix, treat BIO as if it were the word 'biological' and only object under Section 3(1)(b) and (c) where the totality is considered descriptive.

- **BIRTHDAY (see ANNIVERSARY)**

- **BLUSH**

This is now a recognised term for rosé wines. It was originally coined in the USA and has become a well established and commonly used term in English speaking countries. The word should be regarded as having a generic signification in relation to wines and is not acceptable prima facie as a trade mark. Object under Sections 3(1)(b)(c) and (d).

- **BOX: Word used in combination with a colour**

Clearly, a mark consisting of the words eg BLUE BOX would be devoid of any distinctive character when used in respect of boxes coloured blue. In this context, the mark would be open to objection under Section 3(1)(b) and (c) of the Act. (Care should also be taken where an application covers a wide range of goods which includes boxes, while not specifying them separately.)

However, it is unlikely that traders would wish to use words such as BLUE BOX to describe or advertise eg goods sold in blue boxes. The words BLUE BOX or WHITE BOX would in consequence be recognised as a trade mark for most goods or services.

It is emphasised that this practice relates only to word marks; objection should still be taken to coloured devices of boxes or other items of packaging unless the overall getup is distinctive.

- **BRANDSHARING (TOBACCO ADVERTISING) [See Ch 3, para 38.13]**

- **BREAKTHROUGH**

Not distinctive for goods or services that could be characterised as a 'breakthrough' in a particular field.

- **BRITANNIA**

This means Great Britain personified and is usually represented as a female figure forming an emblem of Great Britain. BRITANNIA suggest that goods are British made, but even so, it may be accepted prima facie (on the same basis as CALEDONIA).

- **BRITANNIC**

Unlike BRITANNIA, this word is still in use, for example "on her Britannic Majesty's Service" and means of or relating to Britain. However we can accept prima facie.

- **BUS SERVICES (See TRANSPORT SERVICES)**

C

- **CAD**

Standard abbreviation for "Computer Aided Design."

- **CALEDONIA**

Acceptable prima facie (ancient name for Scotland).

- **CALVADOS**

No trade marks bearing the words CALVADOS, COGNAC or ARMAGNAC can be accepted for registration in respect of goods other than those so designated. This restriction will equally apply even if these words are used with an indication of the true origin, for example JAPANESE CALVADOS, or even with the addition of an expression such as "kind", "type" or "style." Objection will arise under Section 3(4) and 3(3)(b) of the Act. (see also Ch 3, para 38.8)

- **CAM**

Standard abbreviation for "Computer Aided Manufacture".

- **CARE**

Devoid of any distinctive character for goods in Classes 3 and 5. May also be open to objection for other goods eg certain goods in Classes 10 or 20 which are adapted for medical purposes. For services, object prima facie when combined with another descriptive element, for example NURSING CARE for nursing home services, but accept when the totality simply alludes to the services, for example LEGALCARE for legal services. Object under Section 3(1)(b) and (c) when appropriate.

- **CARTOON CHARACTERS**

A cartoon character can often function as a distinctive trade mark e.g. when used in relation to shoe polish or accountancy software.

With other goods or services, such as clothing or soft toys, acceptability of a mark consisting of a cartoon character may be less clear. The following points should be considered and objections raised as appropriate under Section 3(1)(b):

- The representation at issue, whether two-dimensional or three-dimensional, should be treated the same way.
- If the cartoon character is well known to the Examiner, (s)he can take judicial notice of that fact. The Examiner must then consider whether the representation is likely to come from a single source (eg 'Mickey Mouse' being a Disney character) as opposed to a representation that could come from many sources eg a representation of TARZAN could come a variety of sources because numerous undertakings have produced TARZAN films in the past.

- Are the marks sufficiently individual as to differentiate them from standard variations for the goods where animals/cartoons are commonly used as decoration e.g. children's clothes?
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- There is usually a wide range of product variations for toy shapes including plush toys (which often have cartoon-like features). Therefore variation from the norm for these goods would rarely be sufficient for the mark to act as a badge of trade origin, especially for definable animal types eg rabbits, cats, birds, bears.

[See also ANIMALS (DEVICES OF)]

- **CE MARK**

This comprises the letters CE in the form illustrated below:



It is used to signify that a product conforms with the requirements of certain EC Directives. It follows that marks which contain the letters CE as illustrated above should not be accepted as trade marks or parts of trade marks. If in doubt staff should consult a senior officer.

- **CELEBRATION (see also ANNIVERSARY)**

This is non distinctive for the sorts of goods that would be marketed as being for the purpose of a celebration. Also not acceptable for entertainment or restaurant services. Object under Sections 3(1)(b) and (c) where appropriate.

- **CENTENARY**

This is non distinctive for commemorative articles. Object under Section 3(1)(b) prima facie. Evidence that the mark has acquired factual distinctiveness in the market place will be required.

- **CENTRAL**

Can be accepted prima facie for goods unless descriptive e.g. heating. CENTRAL is considered objectionable under Section 3(1)(c) for some services e.g. Hotels with a central location.

- **CHEF**

The word CHEF and CHEF devices are considered to be devoid of any distinctive character for food, drinks, kitchen equipment and food catering services and should be objected to under Section 3(1)(b) and (d) in the prima facie unless they are stylised. The examples shown below include CHEF elements but have sufficient surplus to permit registration.



- **CITIZEN'S CHARTER**

This has received a great deal of publicity and should now be recognisable to the general public as denoting the government programme to improve public services in the 1990s.

The only organisations permitted to use the CHARTERMARK are those providing public services deemed to have met certain quality standards. A representation of the CHARTERMARK is shown below:



Any marks similar to the words CITIZEN'S CHARTER or CHARTERMARK should be treated with the utmost caution. (Object under Section 3(3)(a) if necessary).

- **CLASSIC**

Means "of the highest class esp. in art or literature" (Collins English Dictionary). The word is applied most often to works of literature and the fine arts but can be used to describe any object which displays artistic taste and style, for example cars. Given the purely laudatory meaning of CLASSIC and its widespread use, it must be regarded as a word which may be unregistrable for some goods. CLASSIC would not be acceptable for furniture or cars but may be acceptable for some highly technical apparatus such as medical scanners. However like all marks under the 1994 Act, if the applicant can prove that the mark is factually distinctive it can be registered. Trade evidence may also assist for some goods/services.

- **CLOVERLEAF (see SHAMROCK)**
- **CLUB**

CLUB is devoid of any distinctive character for goods bearing a club's motif or sold through a club. It is also unregistrable prima facie for any services capable of being provided by a club. Object under Section 3(1)(b) for goods and 3(1)(c) for services.

- **COCKTAIL NAMES**

Marks in Class 32 consisting of the names of alcoholic cocktails should be objected to in the prima facie as not capable of distinguishing if the specification includes non alcoholic beverages, on the grounds of confusability with the alcoholic version in Class 33. A deceptiveness objection (Section 3(3)(b)) may also be appropriate. The references used for raising such objections should be carefully checked.

- **COGNAC**

No trade marks bearing the words COGNAC, CALVADOS or ARMAGNAC can be accepted for registration in respect of goods other than those so designated. This restriction will equally apply even if these words are used with an indication of the true origin, for example JAPANESE COGNAC, or with the addition of an expression such as "kind", "type" or "style". Objection will arise under Section 3(4) and 3(3)(b) of the Act. (see also Ch 3, para 38.8)

- **COLOUR TRADE MARKS (See Ch 3, para 16.1)**
- **COLOUR: NAME OF COLOUR IN A WORD MARK**

Where a mark consists of the name of a colour object prima facie under Section 3(1)(b) and (c) because the mark is "descriptive of [goods] coloured [red, green] or sold in packaging of that colour."

Note: This applies mainly to colours pure and simple, like RED, GREEN, GOLD etc. Where colour is a feature of the goods, such as clothing and motor cars, the same applies to other words such as EMERALD, PEACH, APRICOT, MINK and CHOCOLATE which, although having alternative meanings, are recognised as having a strong connotation with definite colours. Certain other words such as SAPPHIRE or FLAMINGO do not have a sufficiently strong colour connotation to overwhelm the other non colour meaning.

- **COLOUR: WORD APPEARING IN A MARK**

If a mark consists exclusively of the words COLOUR, COLOURS or names of hair shades, for example BLONDE, and is applied for in respect of goods which impart colour such as cosmetics, toiletries and hair preparations, Section 3(1)(b) and (c) objections should be raised.

- **COLOUR: WORD USED IN A MARK FOR PAINT**

Colours may describe the actual colour of the paint. The following guidelines should be applied:

Object under Sections 3(1)(b) and (c) to colour names such as CRANBERRY, DAMSON, GARNET, AMETHYST, AQUAMARINE;

Accept QUARTZ (no colour or various colours depending upon the impurities present), AGATE (variegated appearance, but no single colour indicated), PAPAYA (green fruit, yellow flesh, purple flowers — not known by one colour);

Colours in combination with other words can be accepted if the mark as a whole is distinctive : ICE COFFEE, VANILLA ICE and MISTY BLUE. Descriptive combinations such as DEEP BLUE should not be accepted (Object under Section 3(1)(b) and (c)).

Dictionary words which are descriptive but obscure and unlikely to be used by others can be accepted: LUNA (alchemists name for silver) and CARNELIAN (an alternative name for CORNELIAN, a red gem stone which is less well known).

- **COM or COMM**

This abbreviation for "communication" is entered in Websters Dictionary but does not seem to appear in English dictionaries. Nevertheless it is recognised as being the abbreviation and does not add distinctiveness to a mark where goods or services relate to communication (Classes 9 and 38 in particular). COM is commonly used on the Internet.

- **COMBI**

This is generic for a type of fuel efficient boiler and is sometimes used as a shortened form of 'combination.'

- **COMPANY NAMES**

A new paragraph is to be inserted in the Work Manual as follows :

29.2 Company Names

A company name may be accepted for registration provided that it meets with the normal requirements of Section 3 of the Act . The addition of `Ltd' or 'PLC' to descriptive words is unlikely to confer distinctive character by suggesting that the sign

is used by a single undertaking . For example 'SOAP LTD' (for soap) would not be acceptable prima facie . This is not , however, an inviolable rule . There may be situations where the addition of company name descriptors can be material . For example , 'The Blackheath Locksmiths Co Ltd' is likely to be acceptable for locksmiths' services , whereas 'Blackheath Locksmiths' would not . It is not the addition of 'The' which confers distinctive character . Rather it is the fact that there are likely to be a limited number of blacksmiths in Blackheath and so the **combination** is thought to convey a single trade source . However , 'The Organic Food Company' would **not** be acceptable for organic foodstuffs as there would be a large number of organic food producers , 'organic food' describing the name of a **category** of goods .

Conversely , the addition of a company name descriptor to words describing characteristics of the goods or services other than the name of the goods/services will sometimes bestow distinctive character . For example , 'Soft and Gentle' would not be acceptable for soap , whereas 'Soft and Gentle Ltd' would be seen as fanciful and therefore acceptable . Each case must be considered on its own facts .

A company name may be accepted for registration provided that it meets with the normal requirements of Section 3 of the Act. Unless the company name is **wholly descriptive** there will rarely be a basis of objection under Section 3(1) because the addition of 'Limited' or 'Plc' will often provide moderately descriptive words with some capacity to indicate origin. The addition of Limited or Plc will avoid any objection under Section 3(1)(c) or (d).

- **CONCEPT**

The word CONCEPT is defined as “an idea, especially an abstract idea”. Although there are goods and services where the mark, on its own, or with other matter, may be regarded as being distinctive, a cautious approach is required.

Objections under Section 3(1)(b) & (c) should be raised in circumstances where the word is considered to be descriptive e.g.

CONCEPT OF BIOLOGY in Class 16

CONCEPT in relation to modern construction, design, cars, music, fashion and art etc.

The word CONCEPT is also used in advertising to denote innovative and modern ideas such as DESIGN CONCEPT & FINANCIAL CONCEPT.

- **CONGRATULATIONS**

This is non distinctive for cards, flowers etc. Object under Section 3(1)(b) prima facie.

- **CONNECTION/CONNECTIONS**

This is devoid of any distinctive character for services that provide a link between individuals or places. Object prima facie to applications in respect of telecommunications and transport related services.

- **COOKS**

The word COOK is considered to be devoid of any distinctive character for kitchen equipment and food catering services and should be objected to under Section 3(1)(b)(c) and (d) in the prima facie. For examples of cook devices considered acceptable, see CHEF.

- **COPYRIGHT**

If the mark consists only of the word, examiners should consider whether it is likely to be seen as a trade mark or as a statement of rights when considered in relation to the goods or services applied for. If the latter, a Section 3(1)(b) objection is appropriate.

- **COUNTERFEIT**

Marks consisting of or containing this word are open to objection under Section 3(3)(a) of the Act on the basis that use of such a mark will encourage counterfeiting.

- **COUNTRY**

When used in relation to clothing COUNTRY is open to objection under Section 3(1)(c) prima facie for goods which can be used for country pursuits eg country coats. An example is the mark COUNTRY CLASSICS which was considered unregistrable because it is generic for classic clothing in a country style. Such marks may be registrable if supported by evidence of distinctiveness.

COUNTRY is also widely used in relation to all types of foodstuffs, particularly basic foods such as pork, chicken and eggs. That being the case no one company should be granted a monopoly in such a term for goods in Classes 29, 30 and 31. Although COUNTRY may have been accepted for registration in the past, marks consisting of COUNTRY plus the name of the goods will in future be subject, prima facie, to objections under Section 3(1)(b) and (c) eg COUNTRY PORK for pork, COUNTRY CHICKEN for chicken and COUNTRY EGGS for eggs.

- **COUNTRY SCENES (see LANDSCAPES)**

- **CRÈME**

Devoid of any distinctive character for food and drinks; object under Section 3(1)(b) and (c).

- **CREATIVE**

The Registrar has become aware of the generic use of the term "creative software" (DIALOG printouts have demonstrated this). Therefore we should not accept, prima facie, CREATIVE alone or with the name of such goods.

We may continue to accept the word in combination with other elements where the totality is fanciful or where the applicant has previous combinations registered.

- **CRESCENT MOON (See Ch 3 para 38.12.1)**
- **CROSSES/RED CROSS/GREEN CROSS (See Ch 3 para 38.12)**
- **CROWNS (See Ch 3 para 42.2)**
- **CRYO**

This means "low temperature" but in itself is a vague term. In the past deceptiveness objections have been raised in respect of goods or services which could be for use in (or with) low temperatures but in future this will not be necessary.

- **CUVE/CUVEE**

A French word meaning "blend" or "vat" found commonly in marks in Class 33 for wines etc. It is devoid of any distinctive character and an objection under Section 3(1)(b) and (c) is appropriate. It must be combined with a distinctive element to make it an acceptable trade mark.

- **CYBER**
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Words incorporating the word CYBER should be examined with particular care. Collins English Dictionary defines CYBER as "combining form indicating computers" and this term is frequently used in the context of the Internet/World Wide Web.

Marks incorporating the word CYBER and an apparently meaningful or descriptive word for specifications which may cover goods or services connected with the INTERNET/WORLD WIDE WEB should usually be objected to under Section 3(1). Use of Internet search may be particularly helpful to establish whether the word is generic e.g. CYBERCAFE (application no 1581071 for this mark was refused) and should be objected to under Sections 3(1)(b)(c) and/or (d). Where the mark conveys a similar idea eg CYBERPUB/BAR/LIBRARY ie a venue providing these facilities, object under Sections 3(1)(b) and (c) eg CYBERPUB Statement of Grounds for application no 2031220. CYBERSPACE is another example of apparently generic use.

Use of CYBER with non-distinctive or fanciful words may be accepted eg CYBERSMITH (an apparently meaningless combination of non distinctive elements) or CYBERAMA. Each case must be considered on its own merits.

D

- **DECEPTIVE MARKS (See Ch 3 para 36 and 37)**
- **DEPOT**

Acceptable for most goods but care is required where services are concerned eg DEPOT would be devoid of any distinctive character for transport and delivery services.

- **DEVICES OF GOODS OR THEIR PACKAGING (See Ch 3, para 18)**
- **DEVICES: REPRESENTATIONS INDICATIVE OF THE GOODS/SERVICES**

Conventional representations of devices indicative of the goods concerned are devoid of any distinctive character and consequently not acceptable under Section 3(1)(b) and (c). For example, devices of animals in respect of leather, skin or hides; devices of cows in respect of milk, butter, cheese and other dairy products; devices of trees in respect of timber. The same principles apply to service marks. For example, ordinary representations of motor cars would not be acceptable for car repair, car leasing or taxi services; a head for hairdressing; clothed figures for hire of clothing and a house for estate agencies.

While an ordinary representation of a cow would be objected to as being devoid of any distinctive character in respect of milk products the mark may be considered acceptable if the cow was shown in some fanciful manner such as dancing or laughing. (See also Ch 3, para 18)

When considering services, devices of human figures performing or connected with a given service, especially if dressed in uniforms, are not acceptable unless shown in a stylised, cartoon or fanciful way. Consider objecting to, for example, the device of a plumber, or typist for relevant services if the marks concerned do not incorporate other distinctive matter. Object under Section 3(1)(b) and (c).

- **DIAMOND**

Some examiners have raised objections, in the past, that this word is laudatory. This is not considered to be the case — objections should not be raised on these grounds. However, care should be taken in cases where DIAMOND may be descriptive eg for jewellery (obviously) or for machine tools (diamond-tipped).

- **DIRECT**

Direct is descriptive for services sold directly to the public (instead of through a broker or other traditional middleman) or for goods sold by mail order or similar direct selling methods. It will be usual to object under Sections 3(1)(b) and (c) when used alone or in combination with the name of the goods/services provided eg DIRECT CLOTHING.

- **DOCTOR**

This is commonly applied for in Class 37 combined with the goods being treated, eg RUG DOCTOR for rug repair, CAR DOCTOR for vehicle repair. Such marks can be accepted.

- **DOMAIN NAMES (See Ch 3 para 28)**

- **DREAM**

This word has a laudatory meaning ie "a person or thing that is pleasant or seemingly unreal as a dream" (Collins English Dictionary). DREAM is devoid of any distinctive character for services such as kitchens, kitchen design and holiday services. In such cases prima facie objections under Sections 3(1)(b) and (c) may be relevant. However it is usually acceptable prima facie where the word is not customarily used to indicate the desirability of a product/service eg pesticides, or for utility products eg DREAM knives.

E

- **E or e**

"e" as a prefix denotes "electronic" in the context of conducting business through an electronic medium and there are a number of acronyms and terms which use "e" in this sense, for example e-commerce, e-mail, e-learning and e-software. This is supported by the following definition for "e" in the New Oxford Dictionary of English:

“ ' e ’— denoting use of electronic data transfer in cyberspace for information exchange and financial transactions, especially through the Internet.”

An application for a word which describes the goods or services applied for and is prefixed with 'e' may be objectionable under Sections 3(1)(b) and (c) of the Act and in some cases 3(1)(d) may be appropriate. When considering an application, the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or services. The Internet will be searched where necessary, but it should be remembered that the fact that a term is not already in descriptive use does not preclude an objection under Section 3(1)(c) if the likelihood of normal descriptive use of the term is foreseeable at the date of application.

In general it is more likely that an objection will arise when the letter "e" (upper and lower case to be treated the same) is combined with a description of a service or goods used in e-commerce, particularly goods classes 9 and 16 (including the subject matter in Class 16) and the services in Class 38. However, each case must be treated on its own merits. So, for example, there would be no objection to e-doors or e-soap because 1) these goods are not normally associated with e-trading and 2) doors and soap sold over the Internet are the same as doors and soap sold in any way. Both considerations are relevant. However e-software, e-book and e-learning are open to objection.

- **EC**

Abbreviation for European Community. Not acceptable for goods or services which comply with EC standards. See also entries under 'CE', 'EEC' and EU.

- **ECO**

A combining form which is defined in Collins English Dictionary as denoting "ecology" or "ecological" and which is widely used in relation to study of the environment or environmentally "friendly" products. When considering marks of this type, substitute the word 'ecological' for eco and if the totality is objectionable, consider objecting under Section 3(1)(c). Care should be taken to ensure this guidance is not applied too strictly. For example, ECO TIMBER for timber and wood, should be objected to because it describes materials produced in an ecological way (from sustainable resources). Whereas it would be going too far to extend this to goods made from such materials eg ECO WINDOW for windows.

- **ECO-LABEL**

On 23 March 1992 the Council of the European Communities adopted a Regulation in a European Community ECO LABEL award scheme. The ECO LABEL (which incorporates the ECO LABEL logo shown below) will be awarded to products which provide a high level of environmental protection.



The provisions of the Regulation protecting the ECO LABEL logo came into force on 1 May 1992 and became binding in their entirety on, and directly applicable in, the United Kingdom. Any false or misleading advertising or the use of any label or logo which leads to confusion with the ECO LABEL is prohibited by the Regulation. Accordingly, any mark which contains the ECO LABEL logo or anything which could lead to confusion with it will be refused; object under Section 3(4).

Note: This type of protection has nothing to do with the type of protection afforded by Article 6ter of the Paris Convention, it is a matter of Community law. Consent cannot be obtained for this mark.

- **EEC**

Abbreviation for European Economic Community, although no longer officially in use it remains objectionable under Sections 3(1)(b) and (c) of the Act. Not acceptable for any goods or services which are likely to be sold or provided between members of the EC. It may also imply that the goods may comply with EC standards. See also entries under 'EC' and 'EU.'

- **ENVIRO**

The mark ENVIROSAFE was considered open to objection in the past. However the term ENVIRO has not found its way into dictionaries and it is not safe to assume that it is an accepted shortening of ENVIRONMENT. Accordingly (unlike ECO-)words with this prefix should no longer be objected to on the grounds described above.

- **EU**

Abbreviation for European Union. Not acceptable for any goods or services which originate in the European Union. It may also imply that the goods comply with EC standards. See also entries under 'EEC' and 'EC'.

- **EURO**

The Lord Chancellors Appointed Person issued a decision in an appeal before him against the Registrars refusal to register the trade mark EUROLAMB (for lamb — [19971RPC 27/90.)

The Registrar's decision to refuse the application was upheld. In the course of his decision, Geoffrey Hobbs QC expressed the view that

- The words 'Euro' and 'European' are now interchangeable and if the word 'European lamb' was open to objection, so too was the word 'Eurolamb.'
- Some previous acceptances by the Registrar of marks containing the word 'Euro' may have been too lenient.

In the light of this decision marks containing the word EURO should be treated in the same way as if the word EUROPEAN was present. Accordingly eg EUROTOURS (for holiday services) is no more registrable than "European Tours" or EURODEBATES is no more registrable than "European Debates" (for conference services) and will be open to objection under Section 3(1)(b) and (c) of the Act.

Where the combination of 'Euro' with other words describing the goods or services does not produce a term that is likely to be used in trade the mark may be accepted eg EUROMEDICAL for drugs.

- **EXPORT**

Found mostly on beer labels in Class 32. No deceptiveness objection is appropriate as the fact that the goods are exported as well as offered for sale on the home market should not affect purchasing decisions. An application for this word as a mark would not of course be acceptable in the prima facie, object under Section 3(1)(b) and (c).

- **EXTRA**

This means something "more than what is usual or expected, something that is better than usual in quality." (Collins English Dictionary). EXTRA (or phonetic equivalents — see Ch 3, para 26) may therefore be regarded as laudatory and objectionable under Section 3(1)(b) and (c). When examining marks including the word EXTRA, Examiners should consider whether the totality may be acceptable. For example, the combination could be meaningless, eg RUGBY EXTRA for building materials or only indirectly descriptive eg EXTRA VISION for tracking systems. However EXTRA MILES for car hire services or EXTRA FUN for toys would not be acceptable.

F

- **FAST TRACK**

Examination practice on the acceptability of the word FAST - TRACK has been mixed in the past . There are, in fact, numerous acceptances of the word for many services and these precedents may persuade some Examiners to accept further marks . However, its use as a means of indicating services where a speeded up service can be offered suggests that its usage is now common to many services and should no longer be accepted prima facie in many classes . The Internet , in particular , shows wide descriptive usage of the word in connection with many services . Therefore , objection should usually be taken under Section 3(1)(b) and(c) in cases covering a specification where a faster than standard service can be offered . If Dialog or Internet references show the word in generic use, for the services at issue, an objection under Section 3(1)(d) may also be appropriate .

- **FINESSE**

This means "elegant skill in style or performance" (Collins English Dictionary) and, as the word usually refers to people, it may be accepted in the prima facie for services that are generally provided to organisations or performed on goods, for example repair of vehicles.

The word lacks distinctive character for wine and possibly other types of alcoholic drinks, and is laudatory in relation to personal services such as finishing school services. In such instances it is open to objection under Section 3(1)(b) and (c).

- **FIRST**

'First' can be descriptive, eg FIRST SHOES, in respect of footwear for children. In this context objections should be raised under Sections 3(1)(b) and (c) of the Act. The word FIRST may be acceptable in combination with other descriptive or non distinctive words eg FIRST NATIONAL BANK

- **FLAGSHIP**

Open to objection under Section 3(1)(b) and (c) prima facie because of the common use of the word as a laudatory term (meaning "the leading item in a range, or the leading establishment", Collins English Dictionary). Widespread use in relation to motor vehicles.

- **FLEXI and FLEX**

When examining marks consisting of or incorporating FLEX/FLEXI, it is important to consider the message conveyed by the mark as a whole. Where flexibility is a desirable characteristic of the goods with which the mark is used, it is less likely that the mark as a whole will give a distinctive trademark message. So for example, FLEXI PIPE (for pipes) would not be acceptable.

Where flexibility is not a usual or desirable characteristic of the goods, it is more likely that the mark as a whole will be distinctive eg FLEXIHERB for food supplements or FLEXIBUILD for racking units. Equally where the message conveyed is not directly descriptive, it is possible that a mark may have distinctive character, even if the goods with which it is used are flexible by nature. So FLEXIGUARD has been accepted in respect of floor coverings. Each case must be examined on its own facts.

- **FLOAT**

This is the generic name for goods consisting of carbonated soft drinks served together with ice cream (see Collins English Dictionary). It is consequently open to objection under Section 3(1)(c) as being descriptive of such goods.

- **FLOWERS**

Representations of flowers are commonly used in the perfumery trade in labels and advertisements and for this reason are not regarded as distinctive in respect of perfumes or perfumed goods in Class 3 or in respect of similar medicated goods in Class 5; object under Section 3(1)(b). They are however considered to be acceptable prima facie for beauty salons because research has demonstrated that they are not generally used in respect of these services. Flower devices are considered devoid of any distinctive character for services such as gardening or landscaping, again object under Section 3(1)(b).

- **FOOTWEAR: GEOMETRICAL DEVICE MARKS FOR FOOTWEAR**

Device marks which are represented as part of a shoe(the applicant may do this by representing the shoe with dotted lines, or by an explanatory text or simply by depicting stitching and/or eyelet holes with the geometrical device) may require evidence of distinctiveness in support of the application unless the shape of the geometric device applied to the shoe is sufficiently noticeable so that, even as part of the shoe, it retains the capacity to signify the trade origin of the goods. In this connection it should be borne in mind that the consumer is now accustomed to seeing geometrical devices on sports shoes as trade marks. (Geometric devices, in the abstract, for footwear, are acceptable as long as they are not so banal as to lack inherent distinctiveness.)

- **FOREIGN CHARACTERS (eg Chinese or Japanese)**

Characters in a foreign script such as Chinese , Japanese , Arabic, will usually be acceptable and give distinctiveness to a sign . Even if the words translate as something descriptive for the goods/services , this will not be recognised by the average UK consumer. Conversely , if the goods/services are , by their very nature , aimed at the relevant ethnic group , such descriptive marks will not be acceptable as they will be recognised by that consumer . In this connection , it is important to bear in mind that such terms are often included in general terms used in specifications . For example the Arabic characters for 'yashmak' would clearly be descriptive for

`yashmaks' , goods which would be covered by a general term such as 'outer clothing' in Class 25 . In these circumstances it will be necessary for the general term appearing in the specification to be amended or restricted so as to make it clear that the registration does not cover goods or services for which the mark will be perceived as descriptive by the relevant consumer

- **FORENAMES ON CLOTHING (See Ch 3, para 20.4)**

Applications made in Class 25 for marks consisting of male or female forenames will be accepted , even when the specification covers T-shirts, baseball caps etc . Although the possibility of the mark being taken as a reference to the wearer cannot be ruled out, it is considered at least equally plausible that it could be taken as a brand . (For more general guidance on forenames see paragraph 20.4 of the Work Manual .)

- **FOREX**

This is unregistrable for foreign exchange or financial related services, object under Section 3(1)(d), unless, of course, the mark is combined with other matter to make an acceptable whole.

- **FUTURE**

The word FUTURE is considered, prima facie, to be devoid of any distinctive character in relation to goods where technical development and innovation are occurring such as computers. Object under Section 3(1)(c). The word is acceptable for most non-technical goods. The word is not acceptable for financial services.

G

- **GLEN**

If applied for in combination with, or as part of, a word which (as a totality) suggests Scottish origin eg GLENOBAN, GLENOCITE, HIGHLAND GLEN, the mark will be open to objection under Section 3(3)(b) of the Act unless the specification is limited accordingly — but only if Scotland has a reputation for the goods or services eg woollens, whisky. (See also Ch 3 para 37.3 — Whisky)

- **GOLD**

In some instances the word GOLD is open to objection because it is used in some industries in a laudatory manner. The Appointed Person has upheld the refusal of BONUS GOLD ([1998] RPC 859) for financial services accepting that the word GOLD is used in a laudatory fashion in this industry. Where appropriate object under Sections 3(1)(b) and (c).

- **GRAPES**

Devices of bunches of GRAPES are considered to be devoid of any distinctive character in respect of wines since such devices are a common feature of wine labels. The same would apply to wine bar, restaurant and public house services. Marks consisting of such features are not acceptable prima facie; object under Section 3(1)(b).

- **GREEK OR CYRILLIC LETTERS: ACCEPTABILITY**

The fact that Greek letters are quite common in trade marks does not mean they are necessarily without any distinctive character. The lambda, psi, omega, beta and sigma symbols and the words delta, omega, gamma and beta are registered in many classes and successfully serve the purpose of a trade mark.

However, Greek letters are frequently used as symbols for electrical purposes and care must be taken when examining marks consisting of or containing Greek letters, or the phonetics of these, applied for in relation to Class 9 goods. Similarly some Greek letters have a significance in mathematics eg delta, pi and sigma and are therefore devoid of any distinctive character for calculators and the like.

The European Community have adopted a reverse Greek letter epsilon to indicate aerosol dispensers which meet certain standards. For this reason the letter epsilon is without distinctive character if used in relation to aerosol dispensers or goods related thereto (there might also be a Section 3(4) objection in such cases).

- **GREEN**

Green has a meaning in relation to ecology and environmentally "friendly" products.

Objection should be raised under Section 3(1)(b) and (c) when GREEN is presented alone or combined with other descriptive words such as 'safe', 'friendly', 'care', or 'system', unless the mark is not being applied to products or services which could be considered environmentally "friendly."

H

- **HALLMARK**

Practice on the acceptance of this has been mixed in the past — it has laudatory connotations apart from the obvious descriptiveness of the mark for Class 14 goods. In future we can accept the word *prima facie* for goods and services other than goods/services relating to precious metals.

- **HEADS OF WOMEN**

Devices of women's heads are commonly used for advertising purposes in the perfumery trade and especially for hair preparations and hairdressing and/or beautician's services. They are therefore regarded as being devoid of any distinctive character in Class 3 in respect of hair preparations and beauty products, for similar medicated goods in Class 5 and for hairdressing or beauticians services in Class 42; object under Section 3(1)(b) and (d).

- **HEAVENLY**

May not be acceptable *prima facie* for goods that appeal strongly to the senses such as perfume and wine. Collins dictionary defines HEAVENLY as "alluring, wonderful or sublime." Likely to be accepted for many other goods and most services.

- **HIGH TECH (OR PHONETIC EQUIVALENTS)**

This term is considered to be devoid of any distinctive character and attracts objections under Sections 3(1)(b) and (c) in the *prima facie* for technological goods and for services which employ technology, for example engineering, health screening or research.

- **HIGHLAND**

This is a large administrative region in Scotland and consequently may be open to objection on geographical grounds *prima facie* (object under Sections 3(1)(b) and (c)). It is also open to objection under Section 3(3)(b) if applied for in relation to goods for which Scotland has a reputation (unless the specification is limited accordingly).

- **HIGHLAND GLEN**

This relates to or implies Scottish goods and would be deceptive if used on goods or services for which Scotland has a reputation but which do not have that origin. Object under Section 3(3)(b).

- **HOLOGRAMS (See Ch 3 para 16.5)**

- **HOUSE OF**

Marks that include the words HOUSE OF with a descriptive or non distinctive word should be accepted unless the word 'house' is established within the relevant industry.

For example 'House of Fashion' would not be acceptable because a fashion house is a well known term. The same would apply to finance. eg HOUSE OF FINANCE

Examples of marks that are acceptable in the prima facie are:

HOUSE OF SPEED computers, kitchen equipment etc

HOUSE OF PLAY Toys, games etc

HOUSE OF FLOWERS florists, silk/fresh flowers etc

HOUSE OF TRAVEL travel agency services

I

- **I or i**

The letter "i" is a generic abbreviation for Internet, for example, i-music and i-magazine. In addition, the letter "i" is also an abbreviation for "interactive".

An application for a word which describes the goods or services applied for and is prefixed with "i" may be objectionable under Section 3(1)(b) and (c) of the Act and in some cases 3(1)(d) may be appropriate. When considering an application, the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or services. The Internet will be searched where necessary, but it should be remembered that the fact that a term is not already in descriptive use does not preclude an objection under Section 3(1)(c) if the likelihood of normal descriptive use of the term is foreseeable at the date of application.

- **IDEAL**

Often unacceptable in the prima facie for goods or services because it means "a person or thing considered to represent perfection" (Collins English Dictionary) and is consequently laudatory.

- **IMPERIAL**

Past practice has been to object in the prima facie because the word has a laudatory connotation. However IMPERIAL is now regarded as somewhat old fashioned and is no longer in common use. It can consequently be accepted prima facie, for goods or services other than those (eg measuring apparatus in Class 9) where the word still has a specific meaning.

- **ISOTONIC**

This is a generic term for balanced drinks adapted to replace salts and minerals lost when taking part in sports activities. Object under Sections 3(1)(b),(c) and (d).

J

- **JUST**

When meaning “we specialise in”, e.g. JUST EDUCATION, object under Section 3(1)(b) and (c). This practice has been updated in line with High Court Decision Just Employment (a firm)v Just Employment Law Ltd [2007] EWHC 2203 (Ch)
<http://www.bailii.org/ew/cases/EWHC/Ch/2007/2203.html>

When meaning “pure”, e.g. JUST JUICE, object under Section 3(1)(b) and (c). When meaning “all that is required” e.g. JUST PLUG IT IN, object under Section 3(1)(b) and (c). When used in a laudatory phrase, e.g. JUST THE ONE YOU WANT, object under Section 3(1)(b) and (c).

The same practice will apply to SIMPLY marks, e.g. SIMPLY WOMEN’S for clothing will attract an objection under Section 3(1)(b) and (c).

- **JUMBO**

Where the size of packaging is relevant eg detergent, foodstuffs, some DIY materials, objections under Section 3(1)(b) and (c) should be taken in the prima facie.

K

- **KINGSIZE**

A word commonly used in relation to cigarettes and other goods. It is devoid of any distinctive character prima facie so object under Sections 3(1)(a),(b) and (c).

- **KRETEK**

The generic name for a cigarette made in Indonesia, containing cloves. Object under Section 3(1)(d) as appropriate.

L

- **LA**

This should now be regarded as devoid of any distinctive character for low alcohol beers, ciders, wines etc and is not acceptable prima facie. Object under Section 3(1)(b),(c) and (d).

- **LABEL: WORD USED IN COMBINATION WITH A COLOUR**

Word marks such as RED LABEL or WHITE LABEL may be accepted. The same applies to composite marks consisting of such words presented with label devices. A device of a simple coloured label should be objected to as devoid of any distinctive character.

- **LABELS: DEVICES OF**

A device of a simple label is considered to be devoid of any distinctive character; object under Section 3(1)(b). The following mark would be open to objection under Section 3(1)(b) and (d) prima facie because labels similar to the one depicted are commonly found on the necks of wine or beer bottles.



- **LAP TIME**

Devoid of any distinctive character for watches because it is a function of a watch to measure such times. Object under Section 3(1)(c) as appropriate.

- **LAND**

The word has been objected to in the past. However, marks such as:

LAND, when used in conjunction with a word characteristic of the relevant goods eg LAND OF SPEED or SPEEDLAND

LAND plus the name of the goods eg LAND OF COMPUTERS or COMPUTERLAND for computers

are now considered acceptable.

- **LANDSCAPES**

Scenes of cows grazing in a field are not acceptable in respect of dairy products because they are of a type commonly used as mere decorative matter on butter

wrappers, condensed milk labels etc. Object under Section 3(1)(b) and (c). Similar considerations apply to fields of cereals for cereal products, bread etc. Examiners should consider each case on its own facts and if there is evidence or their own knowledge that such matter is used in other areas, eg to designate free range or organic foods, then objections can be raised as necessary.

- **LASER**

This means a powerful light emitting device (Light Amplification by Stimulated Emission of Radiation). It is therefore devoid of any distinctive character for goods incorporating or produced by LASERS or for services performed using LASER equipment. Where appropriate, object under Section 3(1)(b) and (c).

Laser is sometimes used to indicate speed. It is thought unlikely that an objection can be sustained on this basis. However, LASER can indicate a degree of precision in the production of goods eg manufacture of precision tools. Object as appropriate.

- **LEDA**

Even though the word is close phonetically to the unacceptable word LEADER it can be accepted prima facie.

- **LETTERS (See Ch 3, para 19)**

- **LETTERS: FICTITIOUS**

No objections are raised to marks which consist of or contain hieroglyphics purporting to be foreign characters but which upon examination are found to be fictitious and without meaning.

- **LIFESTYLE**

LIFESTYLE may be accepted for goods but care should be exercised in relation to services such as insurance, travel agency services and provision of leisure facilities: other words where the services may be tailored for different "lifestyles".

- **LIGHT/LITE**

It is not necessary to raise an objection under Section 3(3) (b) when LIGHT or LITE is used in relation to cigarettes.

Historically it was considered necessary to limit the specification to cigarettes having yields of not more than 0.8mg nicotine and 10mg of tar per cigarette, or agree to a condition of registration that the mark would be used in relation only to cigarettes yielding not more than 0.8mg nicotine and 10mg tar per cigarette. No limitation or condition will be required in future.

- **LINE**

This word is descriptive if preceded by a word which describes a type or category of goods eg PASTEL LINE (for a range of plastic coated steel products in pastel

shades). As a rule of thumb, substitute the word 'Range' for the word LINE and if the mark as a whole is descriptive consider objecting under Sections 3(1)(b) and (c).

- **LINK**

LINK marks should be treated as follows:

- I. **LINK: alone**

If LINK describes a characteristic of the goods or services, object under Section 3(1)(c) prima facie e.g. for telephones or telecommunication services, computers, software and associated services or for transportation services.

If the connection is less obvious accept prima facie eg for trucks, industrial design, marketing or employment agencies.

If there appears to be no connection with the goods/services accept eg for tea, coffee, café services or restaurant services.

2. **LINK: as prefix or suffix**

LINK together with a word where the combination has a clear meaning, should be objected to under Section 3(1)(b) and (c) eg

HEATHROW LINK for bus or train services

COMPUTERLINK for network communication apparatus

FASTLINK for computer software and telecommunication services

For other combinations LINK will usually be acceptable.

- **LUX**

This is defined as a unit of light. It is not normally objected to because of this: the only instance would be if the item has some control over the amount of light being emitted.

M

- **M or m**

Care should be taken when examining applications with the prefix "m". The letter is increasingly being used as an abbreviation for "mobile" (as in mobile phone) and terms such as m-banking, m-payments and m-commerce are used to describe services provided via a mobile phone.

An application for a word which describes the goods or services applied for and is prefixed with "m" may be objectionable under Section 3(1)(b) and (c) of the Act and in some cases Section 3(1)(d) may be appropriate. When considering an application, the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or services. The Internet will be searched where necessary, but it should be remembered that the fact that a term is not already in descriptive use does not preclude an objection under Section 3(1)(c) of the Act if the likelihood of normal descriptive use of the term is foreseeable at the date of application.

- **MAGIC**

Colloquially, has the laudatory meaning "brilliant", "excellent", "super."

However, following another word, even a descriptive word, it may be acceptable because it then has less of a laudatory connotation. As a guide, the following have been accepted.

MIRROR MAGIC for mirrors etc
ANIMAL MAGIC for printed matter
BEDROOM MAGIC for bedroom furniture
MILK MAGIC for feeding apparatus

NB When used alone or before a descriptive word the word MAGIC may still retain laudatory connotations and be the sort of language used in some classes of goods/services eg those aimed at the young or trendy. Therefore objection under Section 3(1)(b) and (c) may be appropriate. For other classes the word would be fanciful eg MAGIC ACCOUNTANT for accountancy services.

- **MALL**

Non distinctive in Class 35 for retail services. Consider other cases on their own merits.

- **MANOR**

This is devoid of any distinctive character for accommodation services; object under Section 3(1)(b).

- **MANAGER**

A term widely used to denote software that manages different aspects of a programme. The term is not distinctive for software. Object under Section 3(1)(b) and (c) if used alone or with words where the totality is descriptive eg FILE MANAGER.

- **MAPLE LEAF (see Ch 3 para 38.2 — 6ter marks)**

The maple leaf is one of the state emblems of Canada which is protected under Article 6ter of the Paris Convention. As with other protected emblems it cannot be included in a registered mark without the consent from the appropriate body. The logo below, or any closely resembling this, should be objected to :



The words MAPLE LEAF is not a sign that may be used in trade to designate the geographical origin of goods from Canada and should not face an objection under Section 3(1)(b) or (c)

- **MART**

Mart means "a market or trading centre" but is normally acceptable in combination with other descriptive terms, including the name of the goods eg TILEMART, for tiles.

- **MASTER**

In view of the decision made by Robin Jacob QC (as he then was) sitting as the Secretary of State's tribunal in the case of THE MASTER for Class 33 goods, the practice relating to MASTER marks was reviewed.

MASTER has, in the past, been recognised as having a laudatory meaning and the BUSMASTER case (1953 RPC141) and the EARTHMASTER case (1956 RPC73) outlined the practice to be adopted. Since these cases were reported, use of the word MASTER in a non trade mark sense, ie to suggest goods of a superior nature, has become less popular. Dictionary references to MASTER now concentrate on the significance when used in relation to people ie (according to Collins Dictionary) "a person with exceptional skill at a certain thing", for example MASTER BUILDER, MASTER CRAFTSMAN, MASTERCROOK.

MASTER is consequently much more likely to be meaningful in relation to services than to goods.

An alternative meaning given for MASTER is "a machine or device that operates to control a similar one" (Collins Dictionary). MASTER may therefore be a term that is used in trade to describe goods with a control function for example MASTER CONTROL.

As a guide:

MASTER (alone) is acceptable for goods which do not have a control function (eg whisky) or for services not provided by "artisans". The word is therefore not acceptable for goods with a control function or for services provided by artisans. (See below.)

MASTER (combined with descriptive words) is acceptable for goods which do not have a control function eg MASTERBUS or BUSMASTER (for buses), SWINGMASTER for golf clubs, but would not be acceptable if applied to goods with a control function eg MASTERS WITCH for electric switches.

MASTER is acceptable in combination with a word which does not describe, directly, goods or services provided by an artisan. The following would be acceptable -

OFFICE MASTER (for cleaning services), MASTERHEAT (for plumbing services), MASTERCOURT (for legal services), MONEYSMASTER (for accountancy services).

The following would not be acceptable —

MASTERPRINTERS (for printing services), MASTER BAKER (for foodstuffs), MASTERCLEANER (for cleaning services).

- **MATE**

Accept prima facie even when following descriptive words, eg

CHISEL MATE — chisel sharpening apparatus

DRAIN MATE — Cleaning preparations for drains

GROW MATE — foodstuffs for animals

BRUSH MATE — anti hardening chemicals for paint brushes

- **MAXI**

A mark consisting of the prefix MAXI (meaning large, great or much) together with a word which is meaningful for the goods/services concerned is not usually open to objection. The word has a more limited trade usage than MINI. Therefore, the following examples are acceptable:

MAXI INSURANCE — for insurance

MAXICOVER — for paint

MAXICOVER — for insurance

MAXICRUISE — for travel services

MAXITOO — for tools

- **MEDALS**

Devices of MEDALS or awards on the labels of bottles need not be justified.

- **MEDI**

It is considered that the use of MEDI meaning 'medical' is well-known. Prima facie objections under Section 3(1)(b) and(c) should be taken to any application consisting of MEDI plus a word which, **as a whole**, may be used in trade as a description in a medical context.

- **MEGA**

Meaning "large". MEGA alone or MEGA plus the goods should be objected to prima facie where size or volume of goods (eg MEGA PACK) are likely to be relevant. MEGA plus a characteristic of the goods can usually be accepted prima facie.

- **MERIT**

This word was not considered registrable for cigarettes under the old law (1982 FSR 72) but is now considered to be registrable prima facie for most goods.

- **MICRO**

Examiners will wish to note that Collins Dictionary (Second Edition) defines MICRO as, inter alia, "short for microwave oven." There are many foodstuffs which are specially prepared for cooking in microwave ovens. MICRO (alone) is therefore usually devoid of any distinctive character for foodstuffs; object under Section 3(1)(b) and (c). No deceptiveness objections need be taken.

MICRO is also an abbreviation for 'microcomputer' and is thus devoid of any distinctive character for small computers (Collins English Dictionary); object under Section 3(1)(b) and (c).

- **MILLENNIUM/MILLENNIUM**

Both spellings of the word were not considered distinctive for goods or services associated with the recent millennium such as printed matter, figurines, jewellery, celebratory versions of consumer products including foodstuffs, souvenirs, organisation of parties or restaurant services. The word is now considered to have lost its descriptive appeal and relevance. Therefore the word can be accepted unless clearly the subject matter of the goods/services applied for eg MILLENIUM PROJECTS for printed matter (relating to building projects to mark the millennium).

- **MINI**

Consider whether to object to marks consisting of the prefix MINI (indicating something small) when combined with the name of the goods/services or of some feature of the goods/services. A source of reference is MINIGROOVE (1955RPC

183) which was refused registration in respect of long playing gramophone records (ie records having smaller grooves than the short playing type.)

By way of guidance:-

MINI together with a word directly descriptive of the goods/services may be objected to under Section 3(1)(b) and (c), eg MINILIFT for small lifts, MINICRUISE for short cruises, MINIBUS/MINICAB (for bus and taxi services utilising small buses/cars).

MINI together with indirect reference to the goods/services will usually be acceptable eg MINISWEEP (chimney sweeping services), MINIGUARD (security services).

- **MIRACLE**

Acceptable for many goods and services when used on its own but care is required in relation to some articles of clothing such as MIRACLE PANTS and goods in e.g. classes 3 & 5 and related services where claims to a MIRACLE product are widely used in advertising. When used in combination with other words e.g. MIRACLE CURE, MIRACLE OF BIRTH etc. the word is more likely to have descriptive connotations.

- **MISSPELLINGS — phonetic equivalents of objectionable words (See Ch 3, para 26)**

- **MIST**

A deceptiveness objection should not normally be raised in future when this term appears in a mark — even in Classes 1 and 5.

- **MISTER/MR**

Although the word MISTER can have a laudatory connotation when combined with a word describing subject matter and applied to a person, the view is now taken that the laudatory significance is somewhat reduced when such words are considered in the context of goods or services. However it is descriptive for fitness competitions; object under Section 3(1)(b) and (c).

Applications for marks consisting of the word MISTER, or the abbreviation MR, combined with the name of the goods or services will, in future, be regarded as capable of distinguishing and, therefore, acceptable eg MR BARBECUE (for barbecues).

- **MONO**

Consider whether to object under Section 3(1)(b),(c) and (d) when it has a meaning through common usage eg MONO has come to mean "monochrome" in relation to TV sets etc

MONO on its own or with descriptive words will be acceptable in most other cases. Examples of acceptable marks are:

MONOBIT (for drill bits), MONOCLEAN (for cleaning services), MONOGRIP (for tools).

- **MULTI**

Where the combination is clearly descriptive, consider whether an objection under Section 3(1)(b) and (c) will be appropriate

eg

MULTIBLADE (razors) .

MULTIFABRIC (dyes)

MULTICHOICE (pension services).

MULTI in combination with other descriptive words can often be accepted prima facie where the combination is not apt for use as a description eg MULTICLENS (cleaning services), MULTIWIPE (cleaning materials), MULTISTITCH (textile repair services), MULTISUIT (dry cleaning services).

- **MUST**

Meaning "to indicate necessity" (Collins English Dictionary) is regarded as being devoid of any distinctive character because it is used in the context of, for example "this product is a must!". Object under Section 3(1)(b) and (c).

- **"MY" and "MY FIRST" marks**

The use of "My" in trade marks has become increasingly common as a way of marketing goods and services of a personalised nature. Examiners must consider whether the goods or services applied for are such that "My" will fail to indicate to the average consumer that they are giving their custom to a single undertaking. As a guide, the following may be helpful:

What sorts of goods and services are "personal"?

"My" plus the name of such personalised goods or services will be likely to be unacceptable. This is not intended to be an exhaustive list, but examples include diaries, calendars, photograph albums, recipe notebooks, gardening notebooks, address books, birthday books, wedding planners, baby books, guest books etc. Services of a personalised nature, e.g. pet insurance, colour analysis and wedding planning, may also attract an objection.

Not all "my" marks will necessarily face an objection; practice should not be applied blanket-fashion, without due regard to the merits of each case. For example, "MY TRAVEL" is acceptable for travel agency services and "MY PLACE" is acceptable for night-club services: their imprecise meanings create a distinctive impression.

"My First..."

Are the goods or services aimed at children?

This area of goods also requires caution because it is common in the toy trade to market toys in this way, particularly as "my first..." e.g. "My First CD player", "My

40

First Bike", "My First Train Set", "My First Bed", "My First Toothbrush", "My First Bra" etc

N

- **NAPOLEON**

This is devoid of any distinctive character for cognac and subject to an objection under Section 3(1)(b)(c) and (d). No Section 3(3)(b) objection arises.

- **NATURAL SPRINGS**

If the mark consists of the name of a place where springs are known to exist, ie the name of the spring is listed in a reference book, it is necessary to raise a geographic objection under Section 3(1)(b) and (c) prima facie. This can be overcome if the applicant shows that he/she owns the exclusive rights to the spring.

- **NET**

1. The word NET is recorded in Collins Dictionary as an abbreviation for 'network.' The words NET and NETWORK are interchangeable for electronic goods and services. Consequently applications to register trade marks, which contain the word NET for such goods or services, whether or not as part of a domain name, are unlikely to be accepted prima facie if the same mark with the word NETWORK substituted would be refused.

2. This means that applications to register the word NET in combination with a word describing characteristics of electronic networks (eg FAST NET) are likely to be refused registration for network apparatus and services in Classes 9 and 38 unless there is evidence that the mark has acquired a distinctive character. The same is true of marks in Class 9 which describe characteristics of computer software (eg NET ACCESS).

3. Applications to register a trade mark consisting of the word NET in combination with the name of a subject (eg WEATHER NET) are also likely to be refused prima facie registration for electronic information services in Class 38 but not for software in Class 9.

4. A number of marks have been accepted in the past which are not in line with the above practice. However in view of the increasing use by traders of the abbreviation Net referred to above, the registrar considers that the significance of the word has changed.

- **NEWSPAPERS: GEOGRAPHICAL WORDS IN NEWSPAPER TITLES**

The titles of newspapers often combine geographic names with other words commonly used in the trade such as 'Echo', 'Chronicle' and 'Gazette.' The public are used to seeing such combinations and treating them as trade marks. In future, therefore, titles of newspapers may be accepted prima facie where they consist of geographic names combined with words used in the trade, but which are not actually

descriptive in totality eg 'Sunderland Chronicle' or 'Gwent Echo.' However care should be exercised where the totality describes the goods. For example, 'Monmouth News' or 'Beds Advertiser' for newspapers, magazines etc would still be open to objection under Section 3(1)(c) on the basis that the totality describes the nature and general area of circulation of the goods.

- **NEXT**

Previously objected to but now acceptable for most goods and services. Care is required when the word is used as part of a descriptive phrase eg 'The Next Fashion.'

- **NUMERALs (see Ch 3, para 19)**

O

- **OFFENSIVE DESIGNS (See Ch 3, para 39)**
- **OLYMPIAD/OLYMPIADS /OLYMPIAN/OLYMPIANS — See Ch 3, para 38.12)**
- **OLYMPIC/OLYMPICS (See Ch 3, para 38.12)**
- **OLYMPIC MOTTO (CITIUS, ALTUS, FORTIUS) (See Ch 3, para 38.12)**
- **OPEN**

This is meaningful in relation to computer services. OPEN is a term used to describe a type of computer system. Objections should be taken under Section 3(1)(b) and (c) against marks containing this term if the mark as a whole is descriptive, for example OPEN SYSTEMS (computers and software, etc), OPEN SOLUTIONS (services that provide remedies for the customers open system problems).

- **OPTIMA**

This is the plural form of OPTIMUM (which is devoid of any distinctive character — see below). Although it has laudatory connotations it is not a word in common use and is consequently considered acceptable. An example is the mark OPTIMA for golf clubs.

- **ORGANIC**

Marks containing the word ORGANIC would lead the average consumer to assume that the goods were either produced organically or derived from organic produce. Consumers would pay a premium for these goods and would be deceived if the goods were not organically produced.

As such an objection under Section 3(3) (b) should be raised if the specifications are not limited. This objection can be overcome by limiting all the goods to being of organic origin.

An EC directive has made it unlawful to refer to goods as being organic if they are not (see Article 2 of Council Regulation No. 2092/91 and the Judgment in Comité Andaluz de Agricultura Ecológica, C-107/04).

- **ORIGINAL/ORIGINALS**

Objection under Sections 3(1)(b) and (c) will be justified for most goods and possibly some services.

P

- **PACIFIC (See Ch 3, para 35.5)**
- **PACK, PAC, PAK**

Devoid of any distinctive character for packaging materials, equipment or services and for goods sold in packs or packages, both in the physical sense (packs of screws, stationery) and the metaphorical sense (software packages). Object under Section 3(1)(b) and (c) for these reasons where appropriate.

- **PAINTINGS: FAMOUS (See Ch 3, para 22)**
- **PARCELS**

PARCELS is often used to describe dishes the main constituents of which are wrapped in pastry, pasta, dough, edible leaves etc, or which are simply wrapped in foil for cooking. This word is therefore without distinctive character for many food dishes and open to objection under Section 3(1)(b) and (c) in appropriate cases. It is advisable to consult recipe books etc where a word appears to be descriptive. Such recipes should be quoted to justify any objections raised.

- **PARTNER**

Meaning "ally or companion" Collins English Dictionary). It is acceptable alone or when combined with another word unless the totality is meaningful. Examples of acceptable marks are:

CHISEL PARTNER - chisel sharpening apparatus
DRAIN PARTNER - cleaning preparations for drains
BRUSH PARTNER - anti-hardening chemicals for brushes
MARRIAGE PARTNER, for dating services, would not be acceptable.

- **PASTORAL SCENES (See LANDSCAPES)**
- **PATTERNS: DECORATIVE**

Neither devices which are likely to be used as patterns on the goods themselves, nor words describing such devices are regarded as acceptable in respect of those goods, eg flower devices or the words ROSE DESIGN in relation to, for example, textile piece goods or wallpaper, would not be acceptable. Object under sections 3(1)(b) and (c).

- **PHARMACEUTICAL NAMES (See Ch 3, para 38.5 and 38.6)**
- **PLUS**

PLUS is frequently used in connection with advertisements for various savings accounts operated by building societies and banks. Consider whether to object to PLUS on its own or following a descriptive word for finance related services. Proceed

with caution for other goods and services where the word PLUS is commonly used to indicate goods and services which offer something extra. PLUS alone, or as a prefix or initial word is usually acceptable prima facie.

- **POLY**

Words with the prefix POLY (meaning "more than one, many or much" — Collins Dictionary) will normally be acceptable unless there is evidence that the totality is already in use. When used alone POLY is generally acceptable except where it has, by common usage, become an adjective in its own right eg POLY is now virtually generic for polythene eg "Poly bag" and therefore objectionable under Section 3(1)(b) and (c) for goods which are made from polythene.

- **POWER**

POWER can denote strength or a particular form of energy. The guidance is:

POWER alone or combined with the name of the sort of powered goods (especially if there are non-powered versions eg Power tools) — object prima facie under Section 3(1)(b) and (c).

POWER plus a characteristic can generally be accepted. However each case must be assessed on its own facts.

- **PRECINCT (See MALL)**

- **PRO**

PRO (professional) is meaningful for certain goods, especially in Classes 7, 8 and 28, because it indicates goods adapted for professional use as opposed to 'nonprofessional' or 'D-I-Y' use.

Objections arise most obviously in the sporting field where the term Professional is in common use. PRO may be devoid of any distinctive character for sporting goods and services. Each case must be assessed on its own merits.

- **PROFILE**

PROFILE has a specific meaning when applied to building materials (particularly windows and doors) and bicycles because these can be profiled to cut down on wind resistance. Such bicycles are referred to as "low profile" and their parts are referred to as "profiled". It is considered to be devoid of distinctive character for building materials, bicycle parts and vehicle tyres in Class 12 and care needs to be exercised in relation to other goods. Object under Section 3(1)(b) and (c) as appropriate.

- **PUBLIC HOUSES: NAMES**

The issue is whether the name is common to the trade not just whether some other business has adopted the name. Pub names can be trade marks. Objection should not usually be taken simply because there are a few pubs listed with the same name.

Some names are frequently used for public houses eg RED LION, WHITE HORSE, PRINCE OF WALES. Dunkling and Wrights "Dictionary of Pub Names" is one source of names common to the trade. If a pub name is common, (ie dozens of pubs nationwide have the same name,) it cannot be a distinctive mark and should be objected to under Section 3(1)(b) and (d) prima facie as being devoid of any distinctive character.

R

- **REGAL**

Over the years the practice on REGAL marks has become mixed. Webster's Dictionary defines REGAL as "relating to royalty" and "of notable excellence or magnificence" and the latest edition of the Concise Oxford Dictionary retains the meaning of "magnificence". Collins and Chambers Dictionaries however suggest that "relating to royalty" is becoming the main signification.

Whilst the word retains its laudatory signification, changing use of the English language indicates that it can be accepted prima facie. (See also Ch 3, para 42.7 — ROYAL)

- **RESTAURANTS (See Public House: Names)**

- **ROAD SIGNS**

Devices of road signs adopted officially by the Department of Transport are open to objection under Section 3(1)(b) if the goods concerned are motor vehicles or other goods/services directly connected with the roads, road traffic or road transport.

- **ROSETTES**

Devices of ROSETTES are considered devoid of any distinctive character for goods/service that may have won an award.

- **ROYAL (See Ch 3, para 42)**

- **ROYAL SOVEREIGN (See Ch 3, para 42)**

- **ROYAL WARRANT (See Ch 6, para 42.6)**

S

- **SAFE**

There is no objection to accepting marks incorporating the word SAFE provided the mark as a whole is distinctive. An objection under Section 3(3)(b) will only arise when the mark creates strong impressions in relation to such goods as glass and helmets.

The addition or conjoining of the word SAFE to another descriptive word may result in a term that may serve in trade to designate the intended purpose of the goods or services eg WORKSAFE for scaffolding, SAFE INVESTMENTS for financial services.

- **SCOTTISH REFERENCES**

Words and devices such as THISTLE, TARTAN, HIGHLAND, GLEN or LOCH strongly suggest Scotland or Scottish goods. In the case of goods where Scotland has a reputation, like whisky, knitwear, salmon, spring water, beef, biscuits etc, a Section 3(3)(b) objection may be appropriate. This could be overcome by a limitation of the specification but of course, the mark as a totality must also be distinctive.

- **SHAMROCK (See Ch 3, para 38.2)**

The shamrock is one of the State emblems of the Republic of Ireland which is protected under Article 6ter of the Paris Convention (the other being the harp). As with other protected emblems it cannot be included in a registered mark without consent from the appropriate body. The logo below, or any closely resembling this, should be objected to:



The word SHAMROCK is not a sign that may be used in trade to designate the geographical origin of goods from Ireland and should not face an objection under Section 3(1)(b) or (c).

- **SHAREWARE**

Means computer programs that can be downloaded from the Internet free of charge. It is therefore devoid of distinctive character for computer programs and associated goods and services. Object under Section 3(1)(b) and (c).

- **SHILLING (OR 60/)**

Found on beer labels in Class 32 it indicates a strength of beer: 60/ - light or mild beer; 70/ - heavy or bitter beer; 80/ - export beer. Therefore they are terms devoid of any distinctive character and are open to objection under Section 3(1)(b) and (c).

- **SHOP**

A shop is a building or room for the retail sale of goods, services etc and may consequently be regarded as being devoid of any distinctive character. Objections under Section 3(1)(b) may be raised for goods and many services eg SHARE SHOP for financial services.

- **SHRUBS (See FLOWERS)**

- **SILK**

In future it will not be necessary to take a deceptiveness objection to a mark containing the word SILK for an application in Class 3. When used in relation to goods such as cosmetic preparations and hair care products the word SILK is more likely to indicate to the public a property imparted by the product eg "as smooth as silk" or "silky hair", rather than that the product contains silk. The word is nondistinctive in Class 3. There is a Section 3(3) objection for silk for clothing unless the specification is limited.

- **SIMPLY (See JUST)**

- **SOFTWARE :PRACTICE ON RELATIVE GROUNDS**

In the MERCURY case the breadth of this term was criticised. Where two potentially conflicting marks cover software for use in distinct applications or as an operating system rather than an application, these may not be regarded as similar enough to cause confusion. However there would need to be a very clear separation between the uses of the respective software before they would be considered dissimilar goods. The Registrar does not believe that he has vires to object to the general term 'software' which therefore remains acceptable for classification purposes.

- **STARS**

Star devices are commonly used in marks for tobacco and spirits (whisky, brandy etc) and are consequently considered to be devoid of any distinctive character for these goods. Simple star or crown devices are considered to be devoid of any distinctive character in respect of hotels and restaurants since these are often classified by star or crown ratings. Object under Section 3(1)(b),(c) and (d) as appropriate.

Star devices may be devoid of any distinctive character for other services since their use is creeping into other activities, for example gas central heating maintenance service are provided giving differing levels of service, dependent on whether the customer has a 1 star, 2 star or 3 star contract. Object under Section 3(1)(b),(c) and (d) as appropriate.

- **5 STAR/FIVE STAR**

This is widely used in relation to services and is open to objection as it has a laudatory signification. The mark has been accepted for "weed killers" as its use, in relation to these goods, is somewhat fanciful and others would be unlikely to wish to use the term in this area of trade.

- **STERLING**

The word does have laudatory connotations, mainly in relation to abstract qualities, for example a sterling performance, sterling work etc. However there have been a number of prima facie acceptances in the past and it is now considered that STERLING can be accepted for a broad range of goods and services.

Clearly the mark will continue to be unacceptable for some goods and services, for example jewellery (sterling silver), currency dealing etc. Object under Section 3(1)(b) and (c) in such cases.

- **STITCHING: DEVICES OF**

Practice has been reviewed in this area, following developments in case law. Stitching marks are now considered to be acceptable in respect of jeans, as stitching devices are commonly used in the trade upon jeans to denote trade origin, provided that the mark is sufficiently noticeable to stand out so as to be noticed by the average consumer without him/her paying particular attention (ie not simple devices such as parallel lines) . Public perception has therefore been elevated to perceive such signs as trade marks (Similar to the public perception of car grilles as trade marks, as reflected in the JEEP radiator grille decision). Paradoxically, very complex stitching devices are liable to be seen as merely decorative. However, for a wider range of goods, such as other clothing items or bags, stitching marks continue to be viewed as merely decorative and prima facie objections under Section 3(1)(b) of the Act are appropriate.

- **STUDIO**

This has become fashionable and has connotations wider than a mere workshop. Practice relating to STUDIO marks has been mixed in the past but it should in future be regarded as being devoid of any distinctive character for goods/services which may be sold/provided in a studio, such as works of art. Object under Section 3(1)(b) as appropriate.

- **SUPRA**

The word means "over", "above", "beyond or greater than." It has obviously laudatory connotations and in the past practice has been mixed. It is now considered that it is not a word that traders normally use in their day to day business in the same way that they would use SUPER and it can be accepted prima facie.

T

- **TARTAN**

Tartan is regarded as a commonly used pattern or background which traders in general should be free to adopt for ornamentation purposes in their labels. Consider whether to object under Section 3(1)(b) and (c) prima facie.

Care is required because the essential element of a tartan is the colour scheme and there may be variations in the way the actual stripes etc are put together. Therefore, the fact that a precise replica of the pattern cannot be found in the relevant reference books does not necessarily mean that the pattern will not be recognised as a particular tartan. In case of doubt the advice of the Tartan Society should be sought.

- **TECH**

An accepted abbreviation for "technology" (Collins English Dictionary) which is objectionable under Section 3(1)(b) and (c) when used in a combination which is an appropriate description. TEC should be similarly treated as it is a variant of "tech". Usually acceptable in combination with the name of non-technical goods. eg POOLTEC (swimming pools), SEALTEC (seals) have been accepted. Can also be accepted for some technical goods where the other word is not quite the name of the goods eg TILLTEC (tilling machines). HI-TEC has been refused. COMPUTER TECH, NETWORK TECH would also be refused.

- **TEX**

Information provide by the British Man-made Fibres Federation and the Textiles Finishers Association suggest that although TEX is not a recognised abbreviation for textiles it is a technical term for a metric measure of the thickness of yarn. Under these circumstances Registry practice will, in future, be as follows:
TEX alone or in combination; accept except in Class 23. Tex alone or in combination with a descriptive word in Class 23 may be rejected if the totality is an apt description of yarn, eg SILKTEX.

- **THANKYOU**

This is non-distinctive for goods whose intended purpose is as a 'thank you' present , eg it has been refused for chocolates. Object under Section 3(I)(b) and (c) if necessary.

- **THERMO/THERM**

A combining form meaning "related to, caused by or measuring heat" (Collins English Dictionary). It does not necessarily relate to high temperatures and is therefore unlikely to convey any precise meaning; it could relate to articles for use in high temperatures, or low temperatures, or for producing heat, for shielding from heat,

insulating, etc In most cases it can be accepted even when combined with another word which creates a meaningful term eg THERMOSHIELD.

- **THISTLES**

Unless highly stylised, thistle devices are open to objection under Section 3(1)(b) and (c) in respect of goods for which Scotland is widely famed (eg whisky) because such devices are commonly used by traders for the purpose of indicating the Scottish origin of the goods. If the goods do not originate in Scotland an objection under Section 3(3) may also arise. If they only form a small part of the background of a label no objection need be taken. The word THISTLE is not subject to this objection.

- **TREAT**

This is non distinctive for foodstuffs and beverages. Object under Section 3(1)(b) and (c) prima facie.

- **TREES (See FLOWERS)**

- **TTS**

These initials stand for Transdermal Therapeutic System. This is the method whereby drugs etc can be administered by means of a patch worn somewhere on the body. Clearly neither the initials or words are acceptable in connection with pharmaceutical products.

- **TWENTY FOUR SEVEN: 24/7**

Non distinctive for services and for goods sold through convenience stores eg. food and drink.

U

- **ULTRA**

Treatment depends on the totality of the mark but if ULTRA is combined with words which describe characteristics of the goods (ULTRAFINE for thread), the mark as a whole will attract objections under Section 3(1)(b) and (c). Each case should be assessed on its merits.

- **UNIVERSITIES**

Names of universities may be accepted prima facie.

V

- **VARIETAL NAMES**

Varietal names will no longer face an objection on absolute grounds at the prima facie stage, but trade mark consisting of varietal names are liable to be declared invalid if the name was generic at the date of application. If it is apparent to the Examiner that the name is generic (s)he will object in the usual way under Section 3(1)(b), (c) and (d).

- **VEGGIE OR PHONETIC EQUIVALENT**

Collins English Dictionary lists "veggie" as meaning an informal word for vegetarian. Furthermore, Collins lists "vegeburger" as a burger made from vegetables. It is now commonplace for animal-free products to be prefixed with 'veggie' and phonetic equivalents of this word. Vegetarian "friendly" products extend beyond Classes 29, 30 and the drinks classes (as beers and wines can use animal products for fermentation). Some pet foods in Class 31 are vegetarian and, in Class 3, soaps which do not use animal oil are vegetarian. There are Vegetarian Society approved tablet coatings for pharmaceuticals, and clothing and imitation skin and fur goods which do not contain animal products. There are also services relating to the above, such as vegetarian restaurants.

Since "veggie" has come to denote "vegetarian", applications to register VEGGIE, VEGGY, VEGGI, VEGY, VEGI and VEGE (and other phonetic equivalents of VEGGIE) in combination with the name of the goods or services, or a words descriptive of the goods or services, such as VEGE NUGGETS and VEGESOAP and, for services, VEGECAFE and VEGE MENU are no longer acceptable and will be objected to under Section 3(1)(b) and (c) of the Act. Previous acceptances will not be regarded as precedents for further acceptances. Invented words, such as VEGECATESSEN, remain acceptable.

- **VINE LEAVES**

Pictures of VINE LEAVES are considered to be devoid of any distinctive character in respect of wines since such devices are a common feature of wine labels. The same would apply to wine bar, restaurant and public house services. Marks consisting of such features are not acceptable; object under Section 3(1)(b) prima facie.

- **VR**

This means Virtual Reality and is now generic. It is therefore devoid of any distinctive character for games and software, object under Sections 3(1)(b) and (c). There is also a Section 3(3) objection if the games are not virtual reality.

- **VS**

These letters are generic indications of qualities of cognac. Object under Sections 3(1)(b) and (c) as appropriate.

- **VSOP**

These letters are generic indications of qualities of cognac. Object under Sections 3(1)(b) and (c) as appropriate.

- **VVSOP**

These letters are generic indications of qualities of cognac. Object under Sections 3(1)(b) and (c) as appropriate.

W

- **WAREHOUSE**

Becoming used in trade to characterise retail trading premises which resemble a warehouse, usually because of their size and layout. Objectionable alone. May be acceptable in combination with some other non-distinctive terms, but less likely to be distinctive when combined with the name of the goods, particularly where these are the sort of goods that are likely to be sold through specialist retail outlets.

- **WEB**

This can be taken as a reference to the World Wide Web and is interchangeable with Internet. Object under Section 3(1)(b).

Applications to register the word WEB in combination with words describing characteristics of electronic networks (eg WEB SERVER) are likely to be refused registration for network apparatus and services in Classes 9 and 38, unless there is some evidence that the sign has acquired a distinctive character as a trade mark through use.

The same applies to applications to register signs in Class 9 which describe characteristics of computer software (eg WEB ACCESS).

Applications to register a trade mark consisting of the word WEB in combination with the name of a subject (eg WEB SOCCER) are also unlikely to be accepted prima facie for electronic information services in Class 38, or for downloadable software in Class 9.

- **WORLD**

In the case of Mecklermedia Corporation v D.C. Congress Gesellschaft GmbH (passing off — unreported), Jacob J decided that the words "Internet World" were not so descriptive for trade shows (about the Internet) that people familiar with past trade shows organised by the plaintiff (of which there had been 3) would not expect further trade shows under that name to be run by the same people who had used that name in the past.

Trade Marks consisting of the word "World" in combination with the name of, or a description of, the goods or services will normally be accepted prima facie.

Applications to register everyday generic terms, such as "business world" and "financial world" are unlikely to be accepted without very convincing evidence of distinctiveness.

X

- **X**

This denotes strength of beer or lager and is considered to be particularly without distinctive character for such goods; object under Section 3(1)(b). No deceptiveness objection need be raised.