

TRADE MARKS ACT 1994

**In the matter of application no.2116410
by M.A.I.D Plc
to register a Trade Mark in Class 9**

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IN THE MATTER OF APPLICATION TO REGISTER TRADE MARK NO 2116410 IN CLASS 9 IN THE NAME OF M.A.I.D Plc

On 22 November 1996 M.A.I.D Plc of The Communications Building, 49 Leicester Square, London, WC2H 7DB applied under the Trade Marks Act 1994 to register a series of two trade marks **Infosort** and **INFOSORT** in Class 9 in respect of:-

All goods in Class 9; computer programs for transmitting, processing, manipulating and analysing data; magnetic disks, optical disks and magnetic tapes, all for conveying the aforesaid computer programs.

Objection was taken to the mark under paragraph (b) of Section 3(1) of the Act on the grounds that the mark consists of the abbreviation INFO meaning “information” and the word SORT conjoined, being devoid of any distinctive character for, eg, goods that sort and provide information, or sorts information in a specific order. Objection was also taken under Section 3(6) to the term “All goods in Class 9”.

At a hearing at which the applicants were represented by Mr Matthews of Atkinson & Co, their trade mark agents, the objection under Section 3(1)(b) and Section 3(6) were maintained. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of decision and the materials used in arriving at it.

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

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

3(1) The following shall not be registered -

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

The mark consists of the words “INFO” and “SORT”. Collins English Dictionary defines the two words, *inter alia*, as follows:

Info:- *n. Informal.* Short for **information**

Sort:- **10.** (tr) to arrange according to class, type, etc. **12.** (tr) to arrange (computer information) by machine in an order convenient to the computer user

I take the view that the majority of people in this country would readily understand the word INFO to be an abbreviation for the word “information”, a view accepted by Mr Matthews in the résumé attached to the Form TM5.

Computer programs often have limitations on the length of a character string that can be entered in a field. For this reason it is not unusual for a shortened version of a longer word to be used by traders to describe a function or group of functions performed by a program. One such word is “information” which from my own knowledge is used in the shortened form “INFO”.

The word “SORT” is an ordinary English word which, as can be seen from the reference in Collins English Dictionary, is used in the computing industry to describe a function in a computer program to arrange information in a way specified by the user.

Mr Matthews has argued that “INFO” is a slang term and when combined with the word “SORT” the mark as a whole would have no obvious meaning and is registrable for the goods. Both “INFO” and “SORT” are to my knowledge already being used and have a recognised meaning in the computer industry. When used conjoined in relation to the goods, the mark as a whole would be seen as a reference to a computer program for carrying out an “information sort” or, as described in the specification of goods, for “manipulating and analysing data”. The mere bringing together of the two words does not create any distinctiveness or hide the meaning or descriptive nature of the mark. In my view it is a sufficiently apt term for use that it seems likely that other traders may already be using, or may well wish to use the words in the future.

A similar point was addressed by Geoffrey Hobbs QC in the EUROLAMB case, 1997 RPC 8 at page 287, where he states:-

“My view on what I regard as the critical point is that the word “EUROLAMB” would be understood by persons encountering it, used in relation to the goods of interest as defined by the specification, as being an abbreviation of the longer expression “European Lamb”. I therefore think that the word “EUROLAMB” is no more and no less registerable than the words “European Lamb”. My view is that the words “European Lamb” would not be registerable. I therefore think that the objections which have been raised under Section 3(1)(b) and 3(1)(c) of the 1994 Act should be upheld in this particular case, there being no evidence of use which might be said to have educated the public to a different perception of the word”.

Similarly, I regard INFOSORT is no more or less registerable than INFORMATION SORT, the objections to which are, I believe, self evident. I recognise that there are other ways of conveying that the goods will “sort info” and that it could be argued that this, and not “info sort” is the most apt, but as Mr Hugh Laddie QC said in the “PROFITMAKER” case 1994 RPC 613 at page 616 lines 38-44:-

“The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the mark. If it were, then all these alternative ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the register to ensure that common descriptions or laudatory words or not unusual combinations of them, have been monopolised by others.”

In my view it makes little difference in which order the words are used. They will each convey a clear and very obvious meaning and are equally apt for use in describing computer programs that will sort information or will carry out an information sort.

It therefore appears to me that INFOSORT is a sign which may serve in the trade to designate the intended purpose of the goods at issue, and is therefore debarred from registration by Section 3(1)(c) of the Act. I should make it clear that the only objection taken by the Registrar and heard by me was under Section 3(1)(b) of the Act. However, my reasons for finding the mark to be devoid of any distinctive character are the same as if the objection had been taken under Section 3(1)(c). I recognise that this is not an entirely satisfactory way of handling the matter but I believe that the registrar's failure to take an objection under one heading does not prevent him taking objection under another if that objection is also relevant under that other heading. In my view any sign which is excluded from registration by Section 3(1)(c) of the Act is, prima facie, devoid of any distinctive character under Section 3(1)(b).

Objection was also taken under Section 3(6) of the Act because the range of goods specified seemed so extensive as to call into question the statement on the form of application that the applicant had a bona fide intention to use the mark on all of them. Section 3(6) of the Act reads as follows:

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The objection arises from the inclusion of the words "All goods in Class 9". Class 9 covers such a wide range of unrelated goods that it is unlikely that any save the largest of electronics companies will trade in the full range of goods in that class.

The Registrar's practice of objecting under Section 3(6) of the Act in cases of overly wide specifications would seem to be supported by comments made by Mr Justice Laddie in the *Mercury Communications v Mercury Interactive (UK) Ltd* case (1995 FSR 850) in which he states:-

"In my view it is thoroughly undesirable that a trader who is in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the grounds of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wider specification of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act

These comments were quoted with some approval by Mr Justice Walker in the *Road-Tech Computer Systems Limited v Unison Software (UK) Limited (Road-runner)* (1996 FSR 818) case in which he states:-

"Counsel have not been able to refer me to any material which shows the legislative purpose behind the Directive's reference to bad faith. The recitals to the Directive make clear that it is intended to achieve partial (not total) harmonisation of trademark law within the European Union. The recitals refer to it being essential to require "that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all member states" and to the need "to require that registered trade marks must actually be used or, if not used, be subject to revocation.

I find it impossible to get any clear guidance from these general recitals. They do however provide some support for Laddie J's observation in Mercury, which I have already cited, that unduly wide specification may not be possible under the 1994 Act”.

The Registrar does not, as a matter of course, consider that applications for a wide range of properly specified goods and services should be challenged. The application form contains a statement that the trade mark is being used by the applicant or with his or her consent, in relation to the goods or services stated, or that there is a bona fide intention that it will be so used. Accordingly, applications for lists of goods and services will normally be accepted even if they cover many classes. However, in extreme cases, or where vague and very wide terminology is used, the registrar will continue to object under Section 3(6) of the Act.

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

Dated this 12th day of June 1998.

MIKE FOLEY
For the Registrar
The Comptroller General