

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 2242086  
IN THE NAME OF CENTURION EUROPE LIMITED**

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY  
THERE TO UNDER NO 80035  
BY TAKTYLE INTERNATIONAL LIMITED**

**Trade Marks Act 1994  
in the matter of registration no 2242086  
in the name of Centurion Europe Limited  
and the application for a declaration of invalidity thereto under no 80035  
by Taktyle International Limited**

**Background**

1) On 21 August 2001 Taktyle International Limited (TIL) filed an application for a declaration of invalidity of trade mark registration no 2242086, which is for the trade mark **TAKTYLE**. The application for this registration was filed on 9 August 2000 and registered on 17 April 2001. It is in the name of Centurion Europe Limited (Centurion), who made the application. The registration is for *signs* in class 19 of the International Classification of Goods and Services.

2) TIL states that it trades in tactile signs and that Centurion uses the trade mark in suit for signs especially adapted so that they can be ‘read’ by blind people. TIL states that these signs have characteristic raised features and are known as tactile signs. TIL states that Centurion has a royalty bearing licence under British Patent no 2263354 to make tactile signs and that Centurion’s products fall within the terms of the patent. TIL states that the trade mark in suit is phonetically identical to the descriptive name for the signs which Centurion sell. Consequently, the trade mark in suit offends against sections 3(1)(b), (c) and (d) of the Act and should be declared invalid as per section 47(1) of the Act. TIL states that the trade mark in suit has not acquired, after registration, a distinctive character in relation to the goods for which it is registered.

3) TIL states that a previous application for the trade mark TAKTYLE was made under number 1569855 for signs and signs readable by blind people. TIL states that that application was refused registration on the grounds that the trade mark was the phonetic equivalent of the word ‘tactile’, being descriptive and non-distinctive for signs perceptible by touch.

4) TIL requests that the registration is declared invalid and seeks an award of costs.

5) Centurion filed a counterstatement in which it denies the grounds for invalidation. Centurion states that its signs are primarily designed for partially sighted people and not blind people and that they are known as Braille signs. Centurion admits the existence of the licence referred to by TIL but states that the signs are defined in the licence as “Plastic Braille Signs”. Centurion states that it has made substantial use of the trade mark in suit and by virtue of this use has established a considerable reputation in the trade mark, which has, therefore, acquired a distinctive character.

6) Centurion requests that the application is rejected and seeks an award of costs.

7) Only TIL filed evidence.

8) After the end of the evidence rounds were completed I reviewed the application. I was of the opinion that a decision could be made without recourse to a hearing. The parties were advised of this, and that they retained the right to be heard. As neither party requested a hearing I will give a decision based upon a careful study of the papers.

### **Applicant's evidence**

9) This consists of a statutory declaration by John Joseph O'Hara. Mr O'Hara is the managing director of TIL.

10) Mr O'Hara states that he is aware that the term Braille signs is sometimes used but that the term 'tactile signs' is also used. He exhibits at JOH1-4 various documents in relation to the use of the term 'tactile signs'. Exhibited at JOH1 is an extract from Centurion's web site. The documentation indicates that the information therein emanates from 26 February 2001, the last update. This is after the date of application. The pages from Centurion's web site show use of the term "tactile signs" The following is stated:

"Tactile signs are an accepted aid in providing improved access for the blind and partially sighted....".

11) The extract indicates that Centurion's existing customer base includes banks, building societies, councils, courts, government departments, hospitals, schools, hotels and supermarket chains.

12) Exhibit JOH2 is an extract from an NHS audit form for 1998 for signage and information. Included in the form is the following question: "Is signage tactile?". Exhibited at JOH3 is an extract from a good practice guide, the covering letter is dated 10 September 1999. Included in the extract is the following: "High visibility and Braille or other tactile signs may also be appropriate."

13) Exhibit JOH4 consists of three printouts from the Internet. All seem to emanate from outside the United Kingdom and from after the relevant date. Consequently I do not consider that they tell me anything about the position in the United Kingdom at the relevant date and so will say no more about this exhibit.

14) Exhibit JOH5 consists of an examination report for an application for registration of the trade mark TAKTYLE for signs and signs readable by blind people. The examination was made under the 1938 Trade Marks Act. The report states that the trade mark was not acceptable in either part A or part B of the 1938 Act as it consists of the phonetic equivalent of the word 'tactile'.

15) Mr O’Hara states that since the spelling was coined in 1994 it has been used by the following companies, all of which are related in some way to TIL:

Company Name	Company Number	Trading Period
Takyle Limited	2723313	1993 – July 1997
Takyle Signs and Labels Limited	3215390	September 1997 – February 2000
Takyle International Limited	3214784	January 2000 - date

16) Mr O’Hara states that TIL have been trading under its company name in the business of designers and distributors of signs to be ‘read’ by blind people before and after the application for registration by Centurion.

## **Decision**

### **Section 47(1)**

15) TIL seek invalidation of the registration in suit under section 47(1) of the Act. Section 47(1) of the Act states:

“The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

16) Centurion have adduced no evidence into the proceedings. Consequently, the issue of use, either before or after registration, does not arise.

17) According to sections 3(1)(b), (c) and (d) of the Act respectively the following shall not be registered:

- “trade marks which are devoid of any distinctive character”
- “trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”
- “trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade”

18) The evidence adduced by TIL is limited. However, there are clear references to tactile signs prior to the relevant date. They are referred to without any explanation and so there is a presumption that the phrase would be understood by the relevant public. Centurion's comments in their counterstatement denying that tactile signs is a term of the art seem somewhat disingenuous when considered in tandem with the page from their web site, which specifically refers to them. Their counterstatement was filed well after the web page was designed.

19) I have no doubt that for signs for the visually impaired tactile is meaningful and is a term of the art. If the trade mark in suit was for the word tactile this would be an open and shut case; the trade mark in suit would fall foul of sections 3(1)(b), (c) and (d) of the Act. The trade mark in suit is TAKTYLE. I consider that phonetically it is identical to tactile. However, this does not per se preclude it from registration. TIL have referred to an examination report in relation to the same trade mark under the 1938 Act. This does not have a bearing upon the case before me. I have to consider the case on the basis of the 1994 Act for which very different criteria apply. The practice of the Office in relation to phonetic equivalents of objectionable words is set out in PAN 5/02 of 18 June 2002. This sets out three areas where phonetic equivalents will be objectionable: common misspellings, where the phonetic equivalent is used in trade and text messaging abbreviations. There is no evidence to suggest that the trade mark in suit falls foul of any of the criteria set out in the practice notice. The only other user of TAKTYLE would appear to be TIL in its company name. TIL has adduced no evidence in relation to the nature or extent of this use. It is certainly not evidence upon which a claim to being customary in the trade can be substantiated.

20) In *Procter & Gamble Company v. Office for Harmonization In the Internal Market (Trade Marks and Designs)* [2002] ETMR 3 the European Court of Justice held the following:

“Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

21) The trade mark in suit would seem to fall within this category. It looks unusual and different. It is difficult to see how the public would see it as other than a trade mark. However, one issue does concern me; the relevant public. The goods in question are designed for the visually impaired. If the average consumer is visually impaired the visual difference between TAKTYLE and tactile will sink into insignificance. The trade mark would be identified primarily aurally, the visual impression will be of little import. If identified only aurally the trade mark in suit will simply be the word tactile and so will not be acting as an indicator of origin in relation to tactile signs. Are the visually impaired the average customers? I have no personal knowledge of such matters and rely solely upon the evidence before me.

22) That the visually impaired are the users of the signs does not mean that they are the purchasers of the signs, the relevant public. In the extract from Centurion's website the customer base is indicated as including banks, building societies, councils, courts, government departments, hospitals, schools, hotels and supermarket chains. The documents exhibited at JOH2 and 3 are addressed primarily to public bodies. There is no indication that they are addressed to the visually impaired. From the evidence I draw the conclusion that tactile signs are purchased by undertakings for use by the visually impaired but that they are not purchased primarily by the visually impaired. Consequently, I am of the view that the relevant public will be, by and large, sighted and so will be aware of the visual difference between TAKTYLE and tactile.

23) I consider that TAKTYLE in the terms of *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 is capable of distinguishing without first educating the public. Equally in the terms of *Mag Instrument Inc. v Office for Harmonization in the Internal Market (Trade Marks and Designs)* Case T-88/00 TAKTYLE will a priori "enable the targeted public to distinguish the marked goods or services from those of other undertakings when they come to make a purchasing choice."

**24) The application for invalidation is dismissed.**

**25) The registered proprietor having been successful he is entitled to a contribution to his costs. I order the applicant to pay the registered proprietor the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 28<sup>th</sup> day of August 2002**

**D.W. Landau  
For the Registrar  
the Comptroller-General**