

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NUMBER 3881572  
BY THE CORPORATE OFFICER OF THE HOUSE OF LORDS & THE  
CORPORATE OFFICER OF THE HOUSE OF COMMONS  
TO PROTECT THE FOLLOWING TRADE MARK IN CLASSES 3, 4, 8, 9, 14, 16,  
18, 19, 20, 21, 24, 25, 26, 27, 28, 29, 30, 32, 33, 35, 38, 39, 41, 42, 43, 45:**

**UK PARLIAMENT**

**Background**

1. On 15th December 2021, The Corporate Officer of the House of Lords & The Corporate Officer of the House of Commons ('the applicants') applied to register the above mark.
2. Registration was sought in classes **3, 4, 8, 9, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 29, 30, 32, 33, 35, 38, 39, 41, 42, 43, 45** for the following goods and services:

**Class 03:** *Toiletries; cosmetics; soaps; essential oils; bath salts; hair and skin care preparations; boot cream and boot polish; cosmetic kits; eau de cologne; aftershaves; perfumes and perfumery; shaving preparations and shaving soaps; talcum powder; hand wash; hand lotion; room scenting sprays; fragrant wax for use in potpourri burners; lipstick holder; fragranced reed diffusers presentation and gift sets incorporating some or all of the aforesaid goods.*

**Class 04:** *Candles and wicks; scented candles.*

**Class 08:** *Hand tools and implements; hand tools for gardening; cutlery; grooming kits; razors.*

**Class 09:** *Electrical adapters; battery chargers; compact discs [audio-video]; covers for personal digital assistants [PDAs]; covers for smartphones; covers for tablet computers; decorative magnets; digital weather stations; egg timers [sandglasses]; protective masks; sleeves for laptops; spectacle cases.*

**Class 14:** *Goods of precious metal or coated therewith; jewellery; costume jewellery; jewellery boxes; clocks and watches; tie pins; tie clips; badges; cuff links; key fobs; money clips.*

**Class 16:** *Paper, cardboard, and goods made from these materials; articles; magazines; calendars; diaries; parliamentary bills; parliamentary acts; parliamentary papers; white papers; green papers; forms; documents; licences; judgements; legislation; books, guide books, printed publications; electronic publications; catalogues; photograph stands, photographs; stationery; paperweights; prints; posters; pictures; postcards; notebooks; jotters; folders; diaries; albums; greeting*

*cards; writing instruments and materials; paper knives and letter openers; coasters; pens, pencils and crayons; pencil cases; rulers, sharpeners and erasers; ring binders; bookmarks; stickers; car stickers; carrier bags; placemats; wrapping paper; artists materials; paint brushes; instructional and teaching material; office requisites; leather desk accessories.*

**Class 18:** *Leather and imitation of leather; goods of leather or imitation leather; luggage and carrying bags; handbags; purses; umbrellas; walking sticks; wallets; coin wallets; garment bags; vanity cases; holdalls; satchels, shoulder bags; tote bags; attaché cases, briefcases; shopping bags and pouches; wallets, key fobs, key cases made of leather or imitations of leather, credit card holders of leather and imitation of leather, document cases made of leather or imitations of leather, pochettes, leather folders, labels made of leather; cosmetic cases and bags (sold empty), cases for manicure sets; leather dog leads; collars and clothing for animals.*

**Class 19:** *Mosaics for building; stained-glass windows; statues of stone, concrete or marble; floor tiles; wall tiles.*

**Class 20:** *Furniture; mirrors; picture frames; goods of wood, cork, reed, cane, wicker and substitutes for these materials, or of plastics; pillows and cushions; fitted baskets and hampers; boxes; umbrella stands; works of art.*

**Class 21:** *Household or kitchen utensils and containers; cookware and tableware; glassware, chinaware; porcelain; earthenware; vases, bowls, decanters, water jugs, wine glasses, champagne flutes, water goblets and drinking glasses; corkscrews; bottle openers; candlesticks and votive holders; combs and sponges; brushes; cases for brushes, toiletry articles; powder compacts; atomisers; pill boxes; trinket boxes; crockery; mugs, cups, tea sets; toby jugs; tankards; hip flasks; napkin holders; coasters; drinking flasks; lunchboxes; trays; drinking straws; water drinking bottles; gardening gloves; dog bowls; cat bowls.*

**Class 24:** *Textiles and textile goods; household textile articles; muslin squares; towels; table linen; aprons; tea towels; flags; handkerchiefs; textile wall hangings; sheets and pillowcases; place mats and coasters; travelling rugs; picnic blankets.*

**Class 25:** *Clothing; footwear; clothing for babies; headgear; caps and hats; belts (for wear); braces for clothing; ties; dressing gowns; bibs.*

**Class 26:** *Artificial Christmas garlands and wreaths; badges for wear, not of precious metal; brooches [clothing accessories]; hair barrettes / hair slides; sewing kits.*

**Class 27:** *Bath mats; carpets / rugs; door mats; floor coverings; textile wallcoverings; textile wallpaper; vinyl floor coverings; wall hangings, not of textile; wallpaper; yoga mats.*

**Class 28:** *Games; playing cards; puzzles; sporting articles; sports bags; playthings and toys; dolls and dolls' clothing; accessories for dolls; dolls furniture; dolls' furniture accessories; toy action figures, toy vehicles, toy building structures and toy vehicle tracks; play sets and play cases; toy moulding compounds and toy moulding machines; toy models; teddy bears; balls; hand-held computer games; decorations for Christmas trees.*

**Class 29:** *Jellies; jams; compotes; snack foods; preserves; marmalades; lemon curd; compotes; meat, fish, poultry and game; caviar; preserved, dried and cooked fruits and vegetables; cheese; oils; nut-based spreads; pickles.*

**Class 30:** *Tea; honey; treacle; coffee; cocoa; shortbread; cakes; bakery products; cereals; confectionery; chocolate; chocolate confectionery; coffee; mints; sweet and sugar confectionery; vinegars; condiments; sauces; mustards; chutneys; fruit sauces; salt, seasonings, spices, preserved herbs.*

**Class 32:** *Beers; mineral and aerated waters; non-alcoholic drinks; preparations for making beverages.*

**Class 33:** *Alcoholic beverages; alcoholic wines; spirits and liqueurs; alcoholic cocktails.*

**Class 35:** *Retail, wholesale, online shopping and mail order catalogue services; advertising; trade fairs; advertising; business management; business administration; operation of committees; business and commercial information, consultancy and advisory services; employment advisory services; research and advisory services relating to business and commercial issues; advice relating to business organisations and representative bodies; assistance, advice and information services relating to commerce, advertising, public relations, trade, economics and careers; assistance, advice and information services relating to the establishing and running of companies; computerised business information services; compilation of directories of business information for publishing on the Internet; collation and management of data; government administration services including local government services, public authority services; arranging debates, polls and votes; polling services; accountancy and auditing services; business enquiry services; information, advisory and consultancy services relating to all of the above-mentioned services.*

**Class 38:** *Broadcasting; provision of on-line forums; electronic bulletin boards; message boards; news agencies; press agencies; operating web logs.*

**Class 39:** *Arranging and conducting sightseeing tours; delivery of goods by mail order; gift wrapping.*

**Class 41:** *Education; providing of training; entertainment; cultural activities; sporting activities; arranging and conducting educational visits, tours, workshops, seminars, congresses, study sessions, symposia, learning programmes, conventions, conferences and exhibitions; exhibition of art; library, archive and reference services; electronic library and archive services; conducting virtual tours and exhibitions; information, advisory and consultancy services; providing live stream broadcasts, electronic publications, online videos and online television; providing information relating to all of the above-mentioned services.*

**Class 42:** *Hosting digital content; documentary research; feasibility studies.*

**Class 43:** *Restaurant and catering services; banqueting services; cafe, coffee shop and bar services; services for providing food and drink; provision of conference, exhibition and meeting facilities; venue hire; information, assistance and advice relating to the aforesaid services.*

**Class 45:** *Legal services; administration services; advisory services and information services relating to legal advice, administration, parliamentary procedures, parliamentary services and legislation; legal research services; provision of advice and*

*briefings relating to government work, policy issues, parliamentary business; information, advisory and consultancy services relating to all of the above-mentioned services.*

3. On the 10<sup>th</sup> of January 2022, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, a partial objection was raised under section 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') which reads as follows:

### **Absolute grounds for refusal**

#### **Section 3(1)(b) and (c)**

*The application is not acceptable partially in Classes 16,35,38 and 39. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the subject matter of the goods and services. i.e. the parliament of the UK.*

*The Oxford English Dictionary defines "Parliament" as (in the UK) the highest legislature, consisting of the sovereign, the House of Lords, and the House of Commons.*

*It is considered that the average consumer, when met with the expression "UK Parliament", in context with goods and services would perceive the sign as the subject matter of the of goods and services e.g electronic publications, books and education all relating to the UK Parliament.*

*For clarity the objection relates to the following terms only:*

#### **Class 16**

*Paper, cardboard, and goods made from these materials; articles; magazines; calendars; diaries; parliamentary bills; parliamentary acts; parliamentary papers; white papers; green papers; forms; documents; licences; judgements; legislation; books, guide books, printed publications; electronic publications; catalogues; photograph stands, photographs; prints; posters; pictures.*

#### **Class 35**

*trade fairs; operation of committees; compilation of directories of business information for publishing on the Internet; government administration services including local government services, public authority services; arranging debates, polls and votes; polling services;*

#### **Class 38**

*Broadcasting; Provision of on-line forums; Electronic bulletin boards; message boards; news agencies; press agencies.*

**Class 41**

*Education; providing of training; entertainment; cultural activities; arranging and conducting educational visits, tours, workshops, seminars, congresses, study sessions, symposia, learning programmes, conventions, conferences and exhibitions; library, archive and reference services; electronic library and archive services; conducting virtual tours and exhibitions; information, advisory and consultancy services; providing live stream broadcasts, electronic publications, online videos and online television;*

4. On the 09<sup>th</sup> of March 2022 the appointed representative of the applicant, Mathys & Squire LLP, filed written submissions in favour of the application.
5. On the 16<sup>th</sup> of March 2022 a letter maintaining the objection against classes 16, 35 and 41 was sent by the examiner. The letter also confirmed that the objection had been waived against class 38.
6. On the 16<sup>th</sup> of May 2022 a hearing was requested.
7. On the 09<sup>th</sup> of June 2022 the hearing was held with Mr Gary Johnston of Mathys & Squire LLP, representing the Applicants. I attended as the hearing officer. Mr Johnston submitted that the sign would not be perceived as a description of the subject matter of the goods and services by the average consumer, but instead as an indication of origin. He stated that there is only one institution in the UK called the UK Parliament and therefore there is no need to keep the sign free for other undertakings to use. Mr Johnston also claimed that any goods or services being provided bearing the name UK Parliament would be under the sole control of the Applicants.
8. Next, Mr Johnston referred to a number of acceptances that he felt were on a par with this application. He stated that the acceptance of these marks demonstrated that the office had a practice of accepting these kinds of marks previously. He specifically referred to the following marks:

UK00003722454 - BANK OF ENGLAND  
UK00003705223 - THE SCOTTISH PARLIAMENT PARLAMAID NA H-ALBA  
UK00002543869 - THE SCOTTISH PARLIAMENT  
UK00003039101 - HOUSE OF COMMONS

He argued that these acceptances and registrations demonstrate that these types of marks are considered to be distinctive and indicative of a single commercial undertaking.

9. Mr Johnston also referred to Section 11(2)(b) of the Trade Marks Act 1994 where it states:

11. - (1) *A registered trade mark is not infringed by the use of a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1).*

.....

(2) *A registered trade mark is not infringed by –*

(a) *the use by an individual of his own name or address.*

*(b) the use of signs or indications which are not distinctive or which concern 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, or*

*(c) the use of the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where that use is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts), provided the use is in accordance with honest practices in industrial or commercial matters.*

Mr Johnston argued that this section of the Act meant that even if a third party used the sign as a description of the subject matter of a book for example, then they would not be considered to be infringing the registration and therefore there is no need to keep the sign free for others to use. Mr Johnston stated that the applicant would not seek to enforce any rights in this situation in any case.

10. I issued the hearing report on the 22nd of June 2022 where I confirmed that the partial objection had been waived against classes 35 and 41 and against the following terms in class 16:

*Magazines; calendars; diaries; parliamentary bills; parliamentary acts; parliamentary papers; white papers; green papers; forms; documents; licences; printed matter being legislation; guidebooks; catalogues; photograph stands, photographs; prints; posters; pictures.*

The objection was therefore maintained for the following goods:

*Class 09 - Electronic publications*

*Class 16 - Books; printed publications*

A period of two months was given to allow Mr Johnston time to consult with the Applicants and to consider their options.

11. On the 22<sup>nd</sup> of August 2022 a request for an extension of time was received from Mr Johnston, which was subsequently granted on the 23<sup>rd</sup> of August 2022.
12. On the 29<sup>th</sup> of September a letter was received from Mr Johnston attempting to overcome the objection by limiting the specification to include the wording '*none of the aforesaid goods specifically about the UK PARLIAMENT*'.

13. On the 01<sup>st</sup> of December 2022 I issued a response to this letter stating that the proposed limitation was not acceptable in line with the principals set out in the *ECJ decision C-363/99 (POSTKANTOOR) (Paras 114 & 115.)*
14. On the 01<sup>st</sup> of February 2023 a form TM12 (Request to divide an application) was submitted by the representative. The TM12 requested that Classes 3, 4, 8, 9, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 29, 30, 32, 33, 35, 38, 39, 41, 42, 43, 45 be retained on the original application and for Classes 09 and 16 for the objectionable goods (Class 09: Electronic publications; Class 16: Books; printed publications) to be divided to create the 'child' application. The original application was duly divided as per the attorney's instruction and then proceeded to publication in respect of the acceptable specification namely:

**Class 3**

*Toiletries; cosmetics; soaps; essential oils; bath salts; hair and skin care preparations; boot cream and boot polish; cosmetic kits; eau de cologne; aftershaves; perfumes and perfumery; shaving preparations and shaving soaps; talcum powder; hand wash; hand lotion; room scenting sprays; fragrant wax for use in potpourri burners; lipstick holder; fragranced reed diffusers presentation and gift sets incorporating some or all of the aforesaid goods.*

**Class 4**

*Candles and wicks; scented candles.*

**Class 8**

*Hand tools and implements; hand tools for gardening; cutlery; grooming kits containing razors; razors.*

**Class 9**

*Electrical adapters; battery chargers; compact discs [audio-video]; covers for personal digital assistants [PDAs]; covers for smartphones; covers for tablet computers; decorative magnets; digital weather stations; egg timers [sandglasses]; protective masks; sleeves for laptops; spectacle cases; electronic bulletin boards.*

**Class 14**

*Goods of precious metal or coated therewith; jewellery; costume jewellery; jewellery boxes; clocks and watches; tie pins; tie clips; badges; cuff links; key fobs;.*

**Class 16**

*Magazines; calendars; diaries; parliamentary bills; parliamentary acts; parliamentary papers; forms; documents; licences; printed matter being legislation; guidebooks; catalogues; photograph stands; photographs; prints; posters; pictures; stationery; paperweights; postcards; notebooks; jotters; folders; diaries; albums; greeting cards; writing instruments and materials; paper knives and letter openers; coasters; pens, pencils and crayons; pencil cases; rulers, sharpeners and erasers; ring binders; bookmarks; stickers; car stickers; carrier bags; placemats; wrapping paper; artists' materials; paint brushes; instructional and teaching material; office requisites; leather desk accessories; money clips.*

### **Class 18**

*Leather and imitation of leather; goods of leather or imitation leather; luggage and carrying bags; handbags; purses; umbrellas; walking sticks; wallets; coin wallets; garment bags; vanity cases; holdalls; satchels, shoulder bags; tote bags; attaché cases, briefcases; shopping bags and pouches; wallets, key fobs, key cases made of leather or imitations of leather, credit card holders of leather and imitation of leather, document cases made of leather or imitations of leather, pochettes, leather folders, labels made of leather; cosmetic cases and bags (sold empty), cases for manicure sets; leather dog leads; collars and clothing for animals.*

### **Class 19**

*Mosaics for building; stained-glass windows; statues of stone, concrete or marble; floor tiles; wall tiles.*

### **Class 20**

*Furniture; mirrors; picture frames; goods of wood, cork, reed, cane, wicker and substitutes for these materials, or of plastics; pillows and cushions; fitted baskets and hampers; boxes; umbrella stands; works of art.*

### **Class 21**

*Household or kitchen utensils and containers; cookware and tableware; glassware, chinaware; porcelain; earthenware; vases, bowls, decanters, water jugs, wine glasses, champagne flutes, water goblets and drinking glasses; corkscrews; bottle openers; candlesticks and votive holders; combs and sponges; brushes; cases for brushes, toiletry articles; powder compacts; atomisers; pill boxes; trinket boxes; crockery; mugs, cups, tea sets; toby jugs; tankards; hip flasks; napkin holders; coasters; drinking flasks; lunchboxes; trays; drinking straws; water drinking bottles; gardening gloves; dog bowls; cat bowls.*

### **Class 24**

*Textiles and textile goods; household textile articles; muslin squares; towels; table linen; tea towels; flags; handkerchiefs; textile wall hangings; sheets and pillowcases; place mats and coasters; travelling rugs; picnic blankets.*

### **Class 25**

*Clothing; footwear; clothing for babies; headgear; caps and hats; belts (for wear); braces for clothing; ties; dressing gowns; bibs; aprons.*

### **Class 26**

*Artificial Christmas garlands and wreaths; badges for wear, not of precious metal; brooches [clothing accessories]; hair barrettes / hair slides; sewing kits.*

### **Class 27**

*Bath mats; carpets / rugs; door mats; floor coverings; textile wallcoverings; textile wallpaper; vinyl floor coverings; wall hangings, not of textile; wallpaper; yoga mats.*

### **Class 28**

*Games; playing cards; puzzles; sporting articles; sports bags; playthings and toys; dolls and dolls' clothing; accessories for dolls; dolls furniture; dolls' furniture*



*accessories; toy action figures, toy vehicles, toy building structures and toy vehicle tracks; play sets and play cases; toy moulding compounds and toy moulding machines; toy models; teddy bears; balls; hand-held computer games; decorations for Christmas trees.*

**Class 29**

*Jellies; jams; compotes; snack foods; preserves; marmalades; lemon curd; compotes; meat, fish, poultry and game; caviar; preserved, dried and cooked fruits and vegetables; cheese; oils; nut-based spreads; pickles.*

**Class 30**

*Tea; honey; treacle; coffee; cocoa; shortbread; cakes; bakery products; cereals; confectionery; chocolate; chocolate confectionery; coffee; mints; sweet and sugar confectionery; vinegars; condiments; sauces; mustards; chutneys; fruit sauces; salt, seasonings, spices, preserved herbs.*

**Class 32**

*Beers; mineral and aerated waters; non-alcoholic drinks; preparations for making beverages.*

**Class 33**

*Alcoholic beverages; alcoholic wines; spirits and liqueurs; alcoholic cocktails.*

**Class 35**

*Retail, wholesale, online shopping and mail order catalogue services; advertising; advertising; business management; business administration; business and commercial information, consultancy and advisory services; employment advisory services; trade fairs; operation of committees; compilation of directories of business information for publishing on the Internet; government administration services including local government services, public authority services; arranging debates, polls and votes; polling services; research and advisory services relating to business and commercial issues; advice relating to business organisations and representative bodies; assistance, advice and information services relating to commerce, advertising, public relations, trade, economics and careers; assistance, advice and information services relating to the establishing and running of companies; computerised business information services; collation and management of data; accountancy and auditing services; business enquiry services; information, advisory and consultancy services relating to all of the above-mentioned services.*

**Class 38**

*Broadcasting; provision of on-line forums; message boards; news agencies; press agencies; operating web logs.*

**Class 39**

*Arranging and conducting sightseeing tours; delivery of goods by mail order; gift wrapping; conducting virtual tours and exhibitions.*

**Class 41**

*Education; providing of training; entertainment; cultural activities; sporting activities; exhibition of art; arranging and conducting educational visits, tours, workshops, seminars, congresses, study sessions, symposia, learning programmes, conventions, conferences and exhibitions; library, archive and reference services; electronic library and archive services; information, advisory and consultancy services; providing information relating to all of the above-mentioned services.*

**Class 42**

*Hosting digital content; documentary research; feasibility studies.*

**Class 43**

*Restaurant and catering services; banqueting services; cafe, coffee shop and bar services; services for providing food and drink; provision of conference, exhibition and meeting facilities; venue hire; information, assistance and advice relating to the aforesaid services.*

**Class 45**

*Legal services; administration services; advisory services and information services relating to legal advice, administration, parliamentary procedures, parliamentary services and legislation; legal research services; provision of advice and briefings relating to government work, policy issues, parliamentary business; information, advisory and consultancy services relating to all of the above-mentioned services.*

The divided (child) application was given the number UK00003881572 and covered Classes 09 and 16 for the following goods:

**Class 09**

*Electronic publications*

**Class 16**

*Books; printed publications*

15. Before the 'child' application was formally refused for the goods identified above, a form TM5 was received on 20<sup>th</sup> of February 2023. The 'child' application was subsequently refused, and the attorney notified of the refusal in the letter of 23 February 2023.
16. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Mark Rules 2008, to state in writing the grounds for my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, in respect of the goods listed above, I only have the prima facie case to consider.

**The Law**

17. Section 3(1) of the Act reads as follows:  
3(1) The following shall not be registered –

(a) ...

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

(c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

(d) ...

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

### **The relevant legal principles – section 3(1)(c)**

18. There are a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act. For the avoidance of doubt, it is noted that the Trade Marks Act 1994 is largely derived from EU law (Directive 2015/2436). In relation to the interpretation of such retained law, the case law of the Court of Justice of the European Union (CJEU) (including the General Court) issued before the end of the transition period continues to apply, and is binding, as retained EU case law under section 6 of the Withdrawal Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P 'Doublemint'*, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that signs or indications relating to the categories of goods or services in respect of which registration is sought may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I2779, at paragraph 25).
- It is also a well-established principle that the Registrar's role is to engage in a full and stringent examination of the facts, underlying the Registrar's frontline role in preventing the granting of undue monopolies, see to that

effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I-1541 (*Technopol*).

- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA*, C-421/04);
- There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM*, T67/07);

19. I have also taken into account the consequences for third parties of granting the applicant a monopoly. In *Linde A.G. v Rado Uhren A.G.* Case C-53/01 the following guidance was given at paragraphs 73 – 74:

*“73. According to the Court’s case-law “Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of 12 which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).*

*74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.*

20. It is clear from the aforementioned case law that I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating the characteristic of the goods being provided. In this case, the characteristic being the ‘subject matter’ of the goods. In order to do this, I must assess who I consider the relevant consumer to be.
21. As mentioned above, the objection has been maintained against the following goods:

**Class 09**

*Electronic publications*

**Class 16**

*Books; printed publications*

22. When considering these goods, it is my view that the relevant consumer will be the general public but also professionals working in the field of education. The general public are likely to purchase the goods for their own personal use and entertainment, while those working in the education sector may select the goods for use by students as part of their educational curriculum. The level of attention will vary depending on the consumer; however, I consider that it is reasonable to assume that the prospective purchaser of the applicant's goods would apply at least a moderate level of attention and circumspection when considering whether or not to purchase.
23. In assessing the mark applied for, it is clear that it consists of the name of the highest legislative authority in Britain, consisting of the three separate entities being the House of Commons, which exercises effective power, proposes new laws, and can scrutinise government policies; the House of Lords, which plays a crucial role in examining bills, questioning government action and investigating public policy; and the sovereign, being the monarchy of the United Kingdom which is the constitutional form of government by which a hereditary sovereign reigns as the head of state of the United Kingdom, the Crown Dependencies and the British Overseas Territories.

It is my opinion, that given the public's familiarity with the UK Parliament, the average consumer will perceive the sign as nothing more than a reference to the subject matter of the goods and not as designating the commercial origin of them.

24. The objection was raised on the basis that the mark consists exclusively of a sign which may serve in trade to designate a characteristic of the goods, the characteristic being their subject matter, for example, electronic publications, books and printed publications all of which whose subject is that of the UK PARLIAMENT.
25. As regards what constitutes 'subject matter', during my assessment of the mark I took into consideration the comments of Iain Purvis KC in the *Canary Wharf* decision [2015] EWHC 1588 (Ch):

39. *The general approach to be taken by a tribunal dealing with a 'subject matter' or 'theme' objection under s3(1)(c) or s3(1)(b) was recently considered by Geoffrey Hobbs QC sitting as the Appointed Person in NMSI Trading Ltd's Trade Mark Application (Flying Scotsman) [2012] RPC 7 by reference to a number of authorities including the General Court in Danjaq v OHIM (Dr No) [2009] ECR II-2097, Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in Linkin Park [2006] ETMR 74, the First Board of Appeal of OHIM in Ferrero OHG v FIFA [2008] ETMR 76 and Mr Allan James in Diana Princess of Wales Trade Mark [2001] ETMR 25.*

40. *Following, in general terms, the approach of Mr Hobbs as set out in particular in paragraph 18 of Flying Scotsman, I believe that at least three*

*matters need to be considered where a 'subject matter' or 'theme' objection arises under s3(1)(c) or (b):*

*(a) The nature of the goods or services for which the application is made. Are they in principle apt to provide or convey information about (or imagery relating to) the subject matter of the sign?*

*(b) The nature of the sign. Is it something which it is reasonable to believe would be recognised by the relevant class of persons (that is to say average consumers of the goods or services in question) as indicating a particular subject matter or theme?*

*(c) Is the subject matter or theme of a kind which (in the context of the goods or services in question) the average consumer would consider was controlled by a single economic undertaking, as opposed to something which was free to be used and exploited by anyone. See for example Psytech International v OHIM [2011] ETMR 46 at [34]-[43] and the concept of 'official merchandise' recognised in Arsenal Football Club v Reed [2003] RPC 9 (CJEU) and [2003] RPC 39 at [50]-[69] (Court of Appeal).*

*41 So far as (a) is concerned, 'printed matter, printed publications, printed reports and circulars' is the paradigm case of goods which are apt to convey information. So far as (b) is concerned, it is common ground that the name Canary Wharf would be recognised by the great majority of people in the United Kingdom as designating a business district of London. It seems to me therefore inevitable that if the words 'Canary Wharf' were used in the name of a local newspaper or business directory, in the name of a book on modern architecture, or in a printed report on urban development strategy, the public would understand it as designating the Canary Wharf business district. As for (c), there is no reason to believe that the public would assume that books or publications about a business district of London were controlled by a single economic undertaking.*

*42. I therefore agree with the Hearing Officer that the class 16 application falls to be rejected under s3(1)(c) on the basis that it is reasonable to believe that the sign CANARY WHARF would be recognised by the relevant class of persons as a description of the subject matter of printed matter, printed publications, printed reports and circulars to which it was applied.*

26. In that decision it was concluded that the words 'Canary Wharf' would be seen as the subject matter of those particular goods listed above in paragraph 41 of the decision, and I believe the same conclusion applies here. The objectionable goods in the present case are of a kind that that are apt to convey information, and it is therefore considered the mark has the capacity to communicate information as to the characteristic of the goods. I believe it fair to say that the mark 'UK PARLIAMENT' is extremely well known amongst the average UK consumer as referring to the supreme legislative body of the United Kingdom. In that regard, it is my view that if the words 'UK PARLIAMENT' were used in respect of a political, historical, or financial printed/electronic publication or book, the consumer would understand it as designating the subject matter of such goods. Finally, I do not believe there to be any reason why the average consumer would assume that the books or publications about the UK

PARLIAMENT would be under the sole control of a single commercial undertaking due to the historical importance and significance surrounding the parliament of the United Kingdom. Consequently, it is my view that each of the requirements (a), (b) and (c) referred to in paragraph 40 of Mr Purvis' decision have indeed been satisfied.

27. Turning to the submissions surrounding the comparable marks I am bound to determine the mark's acceptability in accordance with the relevant legal principles rather than assessing the mark based on the state of the register. This well-established principle in trade mark law was cited in the Treat case and has been summarised recently in BREXIT O-262-18, where the AP (James Mellor KC) stated:

*'11. In addition, just because a mark is on the Register does not mean it will be held valid when challenged. Furthermore, if the touchstone for registration was to be a comparison with marks already on the register, then registration would come to depend on the lowest common denominator. In any event, it is quite clear that the application of the section 3(1)(b) ground requires an assessment not against other marks on the register, but against the standard laid down in that provision, as interpreted in the case law.'*

With that being said, I have considered the existence of these earlier marks and can appreciate the similarities. However, I must comment that three out of the four of these marks do not include goods such as books and publications per se but have much more limited specification. Additionally, I am unaware of the facts surrounding the acceptance of these marks and therefore do not believe it correct to comment on it.

28. I also do not agree with the submission that because of the existence of Section 11 of the Act it would prevent other traders from infringing descriptive marks if they used the sign in a descriptive manner. In this respect I refer to the comment of Geoffrey Hobbs KC in his capacity as the Appointed Person in relation to an appeal against the refusal of an application for the mark 'AD 2000' (1997) RPC 168.

*"Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse the registration of signs which are excluded from registration by the provisions of Section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacobs Esq. QC in his decision on behalf of the Secretary of State in Colorcoat TM (1990) RPC 511 at 517 in the following terms: 'That possible defences (and in particular that the use is merely as a bona fide description) should not be taken into account when considering registration is well settled, see e.g. Yorkshire TM (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. "Essentially the reason for this is that the privilege of a monopoly should not be conferred where it might require honest men to look for a defence."*

29. Indeed, this principal is also further backed up in *Agencja Wydawnicza Technopol v OHIM* C-51/10P where at paragraphs 58-63 the CJEU stated:

58 *Since the argument alleging inconsistency, or a misunderstanding of Article 7(1)(c) of Regulation No 40/94, must therefore also be rejected, it is necessary to examine, thirdly, Technopol's argument that the General Court failed to have regard to the relationship between that provision and Article 12(b) of Regulation No 40/94 and, fourthly and lastly, the argument that the General Court did not have due regard, in the course of its assessment, to the general interest underlying Article 7(1)(c).*

59 *As regards Article 12(b) of Regulation No 40/94, the Court has had occasion to point out that the rule set out in that provision does not have a decisive bearing on the interpretation of the rule set out in Article 7(1)(c) of that regulation (see, with regard to the identical provision laid down in Article 6 of Directive 89/104, Windsurfing Chiemsee, paragraph 28).*

60 *As the General Court rightly stated in paragraph 32 of the judgment under appeal, Article 12 of Regulation No 40/94 concerns the limits on the effects of a Community trade mark, whereas Article 7 of that regulation relates to the grounds for refusal to register signs as marks.*

61 *Contrary to what Technopol appears to be suggesting, the fact that Article 12(b) of Regulation No 40/94 ensures that every trader may freely use indications relating to the characteristics of goods and services in no way limits the scope of Article 7(1)(c) of that regulation. On the contrary, that fact clearly discloses the need for the ground of refusal set out in Article 7(1)(c) of Regulation No 40/94 – which, moreover, is an absolute ground for refusal – to be actually applied to any sign which may designate a characteristic of the goods or the services in respect of which its registration as a mark is sought (see, to that effect, as regards Article 6 of Directive 89/104, Case C-104/01 Libertel [2003] ECR I-3793, paragraphs 58 and 59, and, as regards Article 12 of Regulation No 40/94, Case C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-10031, paragraph 45).*

62 *Since the rule set out in Article 12(b) of Regulation No 40/94 plays no intrinsic role, therefore, in the application of Article 7(1)(c) of that regulation, the argument relating to the interplay between those two provisions is unfounded.*

63 *The argument that the General Court did not have due regard, in the course of its assessment, to the general interest underlying Article 7(1)(c) must also be rejected.*

30. No separate objection had been raised under Section 3(1)(b) and the finding of non-distinctiveness was the automatic consequence of the sign being considered to be descriptive. Therefore, I will give no separate rationale as regards the objection under section 3(1)(b) but will instead treat the two objections as co-extensive and based on the same rationale.

## **Conclusion**



31. For the reasons given above, I consider the sign to be descriptive of the subject matter of the goods pursuant to section 3(1)(c) and, by inference, also devoid of any distinctive character. The application is therefore refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c).

Dated this 11<sup>th</sup> day of May 2023

Oliver Rose'Meyer