Markenrecht
Zur Eintragbarkeit von Hologrammen

Entscheidung des Comprollers in der Markenanmeldung 2 031 496 vom 7. Juli 1999 (rechtskräftig)

Auch die Wiedergabe mehrfacher Ansichten eines Hologramms stellt keine graphische Wiedergabe im Sinne des [Britischen] Markengesetzes dar.

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2031496
By Checkpoint Security Services Limited
to register a trade mark in Class 36

DECISION AND GROUNDS OF DECISION

On 22 August 1995, Checkpoint Security Services Limited of Chatham Street, Reading, RGl 7JX, applied under the Trade Marks Act 1994 to register a hologram as a trade mark in respect of "payment services and financial transaction bureau services". [At this point in the decision it is usual to reproduce the mark at issue. However, for reasons which will be explained later, I am unable to do so].

The mark was filed with no response to question 3 on the form - "If the mark is not a word or a picture please indicate here (for example 3-Dimensional)". The application was originally accepted on the basis that the mark applied for was a picture. However, it became clear that the mark applied for was a hologram when the applicant asked for a clause to this effect to be included in the advertisement of the mark in the Trade Marks Journal. There was difficulty in reproducing the mark for publication in the Trade Marks Journal for opposition purposes and as a result ofthese difficulties a Hearing was appointed.

At a Hearing, at which the applicants were represented by Mr R Gallafent of Gallafent & Co, the matter of graphical representation, which falls under Section 3(1)(a), was discussed and after several rounds of correspondence the application was refused because it did not contain a graphical representation of the mark applied for. 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 the decision and the materials used in arriving at it.

Section 3(1)(a) ofthe Act reads as follows:

Section 3(1) "The following shall not be registered
(a) signs which do not satisfy the requirements of section 1(1)."

Section 1(1) ofthe Act reads as follows:

"In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."

Chapter 6 of the Registry's Work Manual provides guidance on what is meant by "being represented graphically" as follows:

"In the Registrar's view a sign is graphically represented when

(a) It is possible-to determine from the graphical representation precisely what the sign is that the Applicant uses or proposes to use without the need for supporting examples etc;

(b) The graphical representation can stand in place of the sign used or proposed to be used by the Applicant because it represents the sign and no other;

(c) It is reasonably practicable for persons inspecting the register or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is."

In support of the principles set out above, at point (c) in particular, I bear in mind the comments made by Laddie J in the CREOLA case (1997 RPC 507 at page 510):

"Mr Wyand, who has appeared on behalf of the applicant, has argued that, although indistinct, this is, nevertheless, substantially what was filed in the Registry, that the advertisement does enough to notify the public that the mark is being applied for and that any confusion or doubts that the public may have can be resolved by visiting the Registry and examining the original colour representation fled with the application. He says that the representation does not have to be crystal clear; it must disclose the relevant features.

Mr Arnold, who has appeared on behalf of the registrar, challenges this. He says that I should look at the requirements for advertisements in their proper legislative context. The purpose of advertisement is to allow interested third parties (and, in particular, third parties who may be adversely affected by registration) to learn that a potentially important statutory monopoly is being applied for, so that they can, ifthey so wish, oppose within the time set by the Act. If that is so, says Mr Arnold, the representation filed in the Registry must be sufficiently clear and distinct as to allow all the significant features of the mark to be readily discerned. Absolute clarity in the case of complicated graphical marks may be impossible and, in particular, in accordance with current practice the Registry only places monochrome advertisements, and some lack of definition will inevitably be caused by this. I was informed by Mr Arnold that coloured advertisements will be published in the not too distant future.

Whatever the current printing limitations may be within the Registry, I accept Mr Arnold's submission that when the Act and the Rules refer to a representation of the mark, they must be taken to mean a representation which clearly depicts the essential features which axe sought to be the subject of the rights granted by registration."

Also, as Simon Thorley QC stated in his role as the Appointed Person in the, as yet, unreported decision on the recent LOVE HEARTS case:

"In the final event, the question that has to be asked and answered is whether the graphical representation is adequate so as to enable traders to distinguish a sign which is identical to the registered trade mark from one that is merely similar to it."

The register need not be in documentary form (Rule 32) and in practice it is maintained in electronic form. From the above comments it is clear that the position regarding colour marks on the register is not ideal and plans are in hand to properly record colour marks of this kind electronically on the register. At present there are no plans to incorporate technology which will capture and reproduce holograms electronically.

The requirement for a graphical representation is a practical one, reflecting the fact that the 15 Act and the Directive set out a system ofprotection based upon registratiön. For example, three-dimensional marks must be represented by several drawings unless the essential features ofthe mark can all be captured by a single pictorial representation. Samples ofthe goods or their packaging are not accepted as a graphical representation of the shape in question. Although a hologram is essentially two-dimensional, similar practical problems of reproduction in the Trade Marks Journal and on the register, arise. Not only the Registrar would need to obtain the necessary technology, but also practitioners, who may search the register electronically and would need to reproduce the actual hologram filed on the application form (TM3) for searching purpöses. Further difficulty lies in the fact that, in this case, the mark filed has so many characteristics which vary according to the angle from which they are viewed, that it cannot be certain that anyone inspecting the register for the mark as filed would note or record aII the essential features of the mark. The representation filed, therefore, falls foul of principle (a) of the Registrar's guidance above. Furthermore, for the same reasons, there

would be difficulty in showing all the characteristics in the Trade Marks Journal and on the register for the benefit of third parties - therefore, falling foul of principle (c) above.

In an attempt to overcome these practical difficulties the agent provided various prints by way of "camera ready copy" for publication in the Journal. (Reproduced as Annex A). At all times it was stressed by the agent that the mark filed should be cönsidered "its own graphical representation" and that the separate views were only necessary, as a practical matter, for Journal publication purposes. However, I note the following comment in the agent's letter of 28 August 1997 - "Our clients have been consulting with various hologram engineers and suppliers and we are now able to confirm that it seems very unlikely that a relatively low number of photographic views would since for a complete description of the mark". The fact remains that the mark actually affixed to the TM3 is a complex hologram which would be impossible to reproduce sufficiently accurately in the register and in the Trade Marks Journal without multiple views from defined angles.

By way of analogy the agent commented that the Journal, published in black and white, often referred to marks where colour was an important element and where an interested third party would be able to see the full details of the mark only by inspecting the application form. It was argued that the same should apply in this case. It was also argued that, by providing sufficient views of the hologram for publication purposes, a third party should be able to construct a sufficiently clear idea of what the mark was, in much the same way that threedimensional marks are represented by several views from which the third party can construct the overall image without seeing the whole shape. It was also pointed out that viewing the hologram itself was an option available to them and that, unlike three-dimensional marks, the actual mark can be applied to the TM3 for inspection since the hologram itself is, essentially, two dimensional.

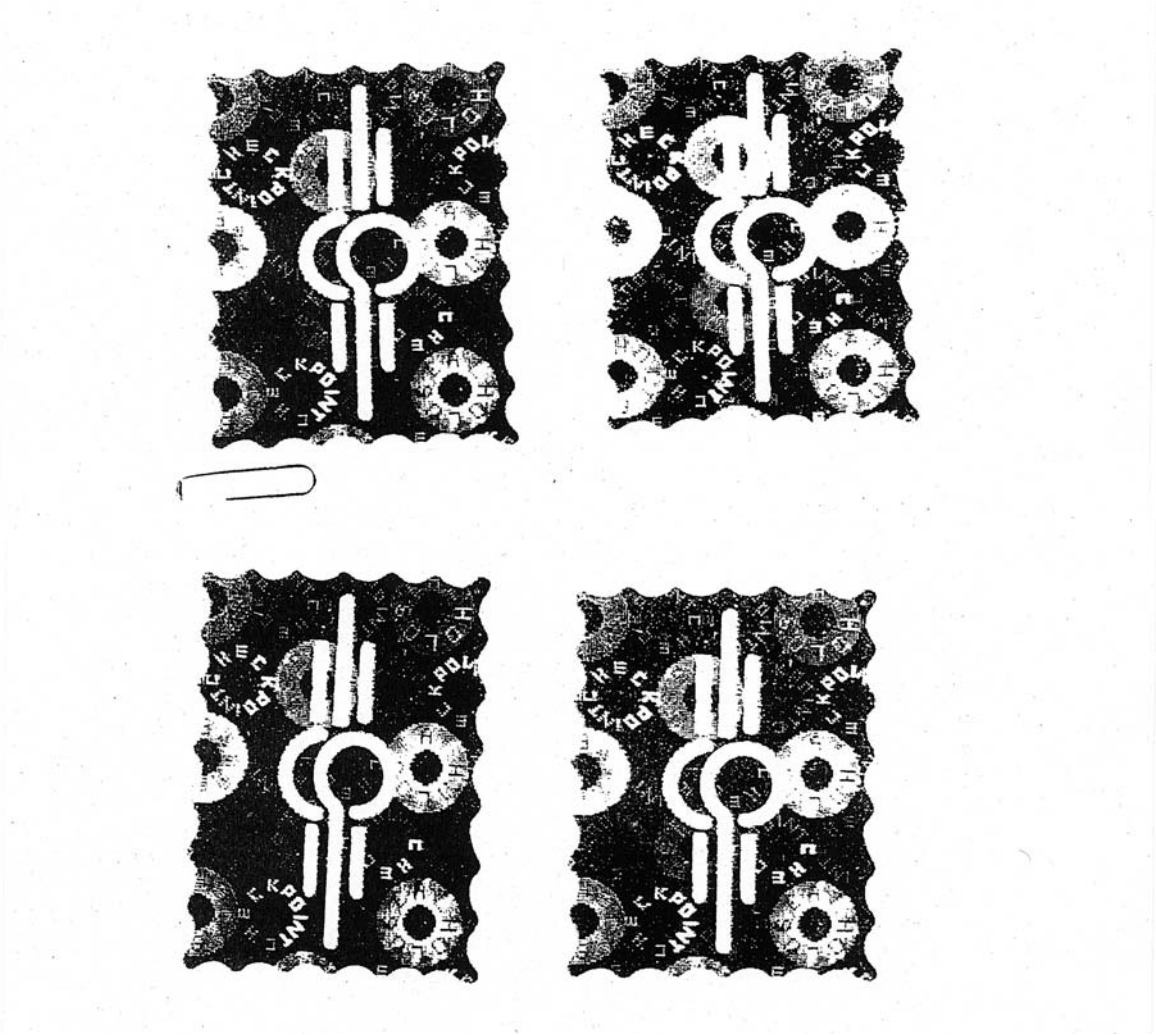
I disägree that the mark at issue can be considered on "all fours" with the examples stated. Firstly, the main elements of a mark containing colour can usually be readily established. This is not the case with the hologram where, as previously stated, whole elements of the mark can be overlooked when viewed even on paper. In the case of a three dimensional mark represented two dimensionally the Registrar will reject any graphical representation which does not give an accurate depiction ofthe mark. Furthermore, what is eventually published is what is actually on the application form. This is not the case with a hologram which, as the applicant accepts, would have to be published and stored with multiple non-hologramatic views in order to capture all the features of the mark.

The agent further offered to provide sufficient copies ofthe hologram as an insert for use in the Trade Marks Journal. This was rejected for the same reason that the version filed is deficient in that it is not an acceptable graphical representation of itself. This merely seems to underline the practical difficulties the Registrar would be faced with if it was necessary to reproduce images with a significant hologramatic element.

I do not say that holograms are unregistrable. However, it seems to me that, to represent multiple feature holograms graphically, the application form should consist not of the hologram itself but of a representation of the various views so that practitioners can clearly see all the material features of the mark in a single graphical representation. This will usually require more than one view of the mark unless it is of a very simple image where the essential features do not change according to the angle at which it is viewed. The current application cannot be amended to rectify this, as Section 39 of the Act does not give the Registrar such powers. The agent, in correspondence, acknowledges this fact. Therefore, I find that the mark is not represented graphically by virtue of the sign that appears on the application form, which is what Section 37 of the Act requires me to consider.

For the reasons outlined above, I therefore conclude that the mark is not graphically represented and so does not satisfy Section 1(1)(a) ofthe Act and as a consequence is debarred from registration by Section 3 (1)(a) öfthe 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 Section 3 (1)(a) ofthe Act.
Dated this 7 day of June 1999.

R A JONES
For the Registrar
The Comptroller General

Annex: