

BRIEFINGS

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Commerce & Technology Briefings

Can you register your surname as a Trademark?

The European Court of Justice has upheld the opinion of the Advocate General that when you are deciding whether or not a surname meets the conditions for registration as a trade mark you have to apply the same approach as when testing any other type of mark.

The definition of a trade mark is a mark that “consists” of any sign capable of being represented graphically, particularly words, (including personal names) provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

It is clear that a trade mark will not be registered if it is devoid of any distinctive character. Further, the Trade Marks Directive places limitations on the effects of a trade mark.

A trade mark would not entitle the proprietor to prohibit a third party from using, in the course of trade, his own name or address, providing that he uses it in accordance with honest practices in industrial and commercial matters. It is the latter point that makes it extremely difficult for individuals to register their own surname as a trade mark.

The UK Trade Marks Registry will consider the commonness of the surname and the number of undertakings engaged in the trade in which the Applicant is seeking registration before allowing a surname to be registered.

The facts of a recent application were that Nichols Plc tried to register the word “Nichols” as a trade mark in relation to automatic vending machines and products frequently sold in vending machines i.e. food and drinks. The application was not supported by evidence that the mark had required distinctiveness through use. The Trade Mark Registry allowed the application for vending machines but not for the goods contained within.

It was held that the surname “Nichols” and phonetically similar names were common surnames in the UK as they appeared 483 times in the London telephone directory. Further, the foods and drinks markets covered by trade mark classes 29, 30 and 32 were made up of a large number of operators and it would be difficult for consumers to identify the true origin of the products from a common surname. However, automatic vending machines were considered a more specialised sector with fewer undertakings operated and it was for this reason that this registration was successful.

The ECJ held that the criteria for assessing the distinctive character of trade marks consisting of a personal name, are the same as those applicable to other categories of trade mark, and the limitations set down in article 6(1) of the Directive in relation to prohibiting third parties from trading are not relevant when determining the distinctive character of a mark for which registration is sought. The more common the name, the less willing the Registry would be to accept it without proof that it has become distinctive through use.

In summary, the factors to consider are:-

- (a) The commonness of the surname;
- (b) The number of undertakings, supplying products and services of the type concerned;
- (c) The prevalence or otherwise of the use of surnames in the relevant trade

The case concluded that it was no longer the situation that registration of the common surname can be refused.

The ECJ in this decision did criticise the assessment criteria of the commonness of the surname and therefore the UK Trade Mark Registry may need to refine their guidance in the future so as not to place so much weight on these criteria.

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