
ERIC POTTER CLARKSON

PATENTS · TRADEMARKS · DESIGNS · COPYRIGHT

RETAIL SERVICES

It has been possible for some time to register trademarks in the United Kingdom for a variety of services, but the UK Trade Marks Registry (the Registry) has not accepted for registration applications to protect "retail services". This is because the courts have held that trademarks serve as indicators of goods and/or services and that trading in third party goods (ie retailing) has not been regarded as providing such an indicator.

Following two recent test cases (for the trademarks DEBENHAMS and DEWHURST) sponsored by The British Retail Consortium, the Registry has agreed, in principle, to accept the concept of the protection of trademarks for retail services, provided that the scope of the trademark rights can be clearly defined.

The Registry will continue to object to applications that claim "retail services" per se, as such descriptions are deemed to be too vague, but descriptions such as "the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and purchase those goods (in a department store) (in a supermarket) (in a retail pharmacy) (in a retail clothes store) (etc)" will probably be acceptable.

The Registry will also accept applications claiming mail order and/or electronic shopping services, providing that these applications are sufficiently defined. For example, a description on the following lines would probably be considered acceptable, "the bringing together, for the benefit of others, of a variety of goods (eg clothing and accessories), enabling customers conveniently to view and purchase those goods from a catalogue by mail order (or by means of telecommunications)". We expect that other European Union countries and the Community Trade Mark Office will follow the UK lead.

If your company, or a client of yours, provides retail, mail order and/or electronic shopping services, we strongly recommend that UK or CTM trademark applications be filed as soon as possible in order to establish or consolidate statutory rights.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

Please note that all our Newsletters can be found on our website at www.eric-potter.com.

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