

Registering Trade Marks for Retail Services – New Guidance from the UK Registry

Towards the end of 2005, the UK Trade Marks Registry issued fresh guidance in relation to the question of registering trade marks for retail services.

In recent years, the issue has been the subject of much discussion, with the argument centring around whether the use of a trade mark simply in relation to the supply of a variety of goods constituted providing a “service” per se. In brief, up until November 2005, the UK Registry took the view that such registrations were acceptable, if the nature of the retail outlet was specified. However, in view of a recent ruling from the European Court of Justice, all that has now changed.

In summary, the ECJ was asked for guidance as to what the term “services” could encompass, and whether it was necessary to provide any details of the services in order for a mark to be registered. In essence, the ECJ ruled that the concept of “services” does indeed cover “services provided in connection with retail trade in goods” and that it is not necessary to specify in detail the service(s) in question. That said, the ECJ also ruled that details must be provided in relation to the goods (or types of goods) to which those services relate.

The UK Registry, following that ruling, have now revised their guidance to the effect that the emphasis, now, will be on the nature of the goods supplied in connection with the services, rather than on the precise nature of the services themselves.

For the assistance of applicants, the UK Registry have also issued helpful guidance on what forms of wording, are and are not, acceptable in relation to such applications. An example of an acceptable form of wording is “stationery shop retail services connected with the sale of stationery, printed matter, computer equipment and peripherals and home entertainment products”, whereas “mail order”, “retail services” and “the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods” are not now acceptable, as they do not provide any details of the specific goods supplied.

Should you have any queries relating to this new practice, or if you are involved in the retail trade, and would like advice on how best to protect your trade marks, please contact our trade marks specialists, who will be happy to help you.