

# Trade Mark Series Explained

## The Law

Section 46(2) of the Trade Marks Act 1996 defines a series of trade marks as:

*“... a number of trade marks which resemble each other as to their material particulars and differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of the trade mark.”*

## The Tests

It is clear from the definition that for marks to be considered a series under Section 46(2) they must pass three separate tests. Firstly, and most importantly, the marks must be made up of the same material particulars. That is, they must contain the same elements and therefore must be almost identical.

Secondly, having established that the marks contain the same material particulars, any differences between the marks must be strictly confined to matter of a non-distinctive character.

If the first two tests are passed the marks will be deemed to be a valid series only when the third test is passed - that the difference between the marks do not substantially affect the identity of the marks.

These tests are carried out in order.

The first test relates solely to the physical make-up of the mark and is not concerned with whether the mark is comprised of or contains distinctive or non-distinctive elements. Accordingly, this test will be conducted without any consideration of the goods or services specified in the application. If one of the marks has more or less elements than the other mark(s), and if the missing or additional element is something other than a completely insignificant one that is likely to go unnoticed, then the marks are unlikely to be considered a series.

It is important to note that the second test, regarding distinctive or non-distinctive matter, will only come into play after it is established that the marks are made up of the same material particulars.

The third test is independent but equally as important as the first and second test. The term ‘not substantially affecting its identity’ means any differences which affects the way a mark is pronounced, its visual impact, or the idea conveyed by the mark will not pass the test.

The marks will be compared side by side, with full attention to detail, by considering the following factors:

- the appearance or look of the marks;
- the pronunciation or sound of the marks;
- the idea or meaning of the marks; and

- any other factors that might change the idea of one mark when compared to the idea of the other mark(s).

In general terms, the variation between members of a series must be such that no additional element or dimension contributes to the overall identity of the marks. The idea of the mark must remain essentially the same.

More details of the examination of applications claiming to be for a Series of Trade Marks are below with examples of what may constitute valid and invalid series.

### **Text Only Marks**

If the marks consist of a word, then the word must be the only element in the identity of each member of the series. The typescript may be varied, but only between known, conventional scripts, not fanciful get-up. The spelling may be varied, but only if the pronunciation and meaning remain unaffected.

The separation of one word into two, or the running together of two words would be governed by the same considerations: the sound and meaning must remain the same. The appearance of the word or words will also be taken into account when the spelling or physical arrangement of the letters is varied. Minor changes that do not alter the idea behind the mark such as JUMPIN' JACK FLASH and JUMPING JACK FLASH or WESTENDBOY and WEST-END-BOY will be acceptable. However, simple changes (even the inclusion of a hyphen or punctuation) that alter the idea or introduces a new meaning will not be accepted, for example, CORKSCREW, CORK-SCREW and CORKS-CREW is not a valid series, nor is LET'S EAT, GRANDMA and LET'S EAT GRANDMA.

An application may be considered a series where the marks differ due to minor changes in spelling and the variations are regarded as alternative spellings of the same word(s), e.g. COLOR/COLOUR, GRAY/GREY.

Where dictionary words are concerned, only common misspellings will be allowed. The differences in spelling must not change the pronunciation or meaning of the mark, nor affect the look of the marks, e.g. yogurt/yoghurt or t-shirt/tee-shirt.

Text marks containing different linking elements may be used when the meaning remains the same e.g. JACK AND JONES, JACK & JONES or JACK N' JONES. Where the linking element produces an alternative meaning e.g. BATTLING FOR PEOPLE and BATTLING 4 PEOPLE, it is not a valid series.

When the difference between the marks in a proposed series concerns a statement of price, quantity or quality, the statement must not contribute to the function that the mark has in distinguishing the proprietor's goods from those of other traders. Rather, they must be purely informative in nature. Therefore, the marks in Table 1 below are all valid series because they contain the house mark and an indication of the goods or services. However, the inclusion of "Kleenex" simpliciter in column 1 would not make a valid series of four marks, because each of the other three Kleenex marks have material particulars relating to the goods.

**Table 1 Valid Series**

Kleenex 50 Man-sized Tissues	Odlums Self-raising Flour	AIB e-banking
Kleenex 100 Man-sized Tissues	Odlums Plain Flour	AIB online banking
Kleenex 200 Man-sized Tissues	Odlums Strong Flour	AIB internet banking
(For tissues in Class 16)	(For flour in Class 30)	(For banking services in Class 36)

If the additional features of a mark take on the role of distinguishing the proprietor’s mark from that of others, the features cease to be purely informative of the goods and services the mark represents and therefore, the marks do not constitute a valid series. On this basis the marks in Table 2 below are not a valid series.

**Table 2 Invalid Series**

XYZ1	WALKERS SENSATIONS	KILKENNY WHISKEY
XYZ2	WALKERS BAKED	KILKENNY DISTILLERY
XYZ3	WALKERS CRINKLES	KILKENNY VODKA

### **Company Names, Domain Names and Social Media Tags**

A series of marks cannot consist of a trade mark and the same trade mark with an indication of a business entity, website address or social media address. Where the marks in an application have the same company type it may be a valid series. Where the company type is not the same then it is not a valid series. Word marks without the hash character and the same word preceded with the hash character (i.e. a social media address) do not make a valid series. Nor do words and the same words followed by a domain name extension (i.e. a website address). Table 3 below shows example of these invalid series.

**Table 3 – Invalid Series**

Novel Drinks PLC Novel Drinks CLG Novel Drinks LLC	7up 7up.com 7up.ie	Guinness #guinness @guinness
(Different company types and possibly different companies)	(The “idea” behind the first one is a brand name and the “idea” behind the other two is a website address)	(The “idea” behind the first one is a trade mark and the “idea” behind the other two is a link to social media)

## Combined Text and Figurative Marks

The four marks in Example 1 below do not constitute a series. The material particulars of the first mark is a black stylised 'C' within a black circle. The second mark contains these particulars but also contains the words 'SOURCE OF CALCIUM', which are not in the first mark. The first and second marks do not look the same, sound the same or have a common idea and therefore, they are not a series. Likewise, the third and fourth marks are not a series.

However, the first and third marks and the second and fourth marks are each a series of two marks. The only difference between them being the colour which, in this case, is non-distinctive (satisfying the second test) and also does not substantially alter the identity of the mark (satisfying the third test).

### Example 1 in respect of dairy products, milk, butter and cheese in Class 30.



If one mark in a claimed series contains a combination of figurative and text elements and the other mark(s) are only figurative or only text, then it is unlikely to be a valid series. In Example 2 below, the two marks are not a series as the figurative heart element, a material particular of the first mark, is not present in the second.

### Example 2 in respect of jewellery in Class 14.



## Cartoons Characters

For marks that contain cartoon characters to be a valid series the cartoon characters must be the same and be dressed the same. The marks in Example 3 below are not a series. Though the words are the same and the character in each mark is holding a hurley stick, the characters depicted are clearly not the same.

**Example 3 in respect of T-shirts; Short-sleeved T-shirts in Class 25.**



### **Non-Distinctive Matter**

The second test is only considered when all the material particulars are the same. The goods and services for which the mark seeks registration are taken into account at this stage. It is possible that a proposed series would be valid in respect of a particular class but not for other classes. The marks in Example 4 below would be a valid series for crisps in Class 30 but not for amusement parks (because the flavours would not be considered non-distinctive for Class 41).

**Example 4 in respect of crisps in Class 30 and amusement parks in Class 41.**



### **Differences in Colour**

If the only difference between two text marks is colour (see Example 5 below), the marks would typically be considered a series. Generally, the difference in colour would not be considered distinctive matter and it would not affect the identity of the marks.

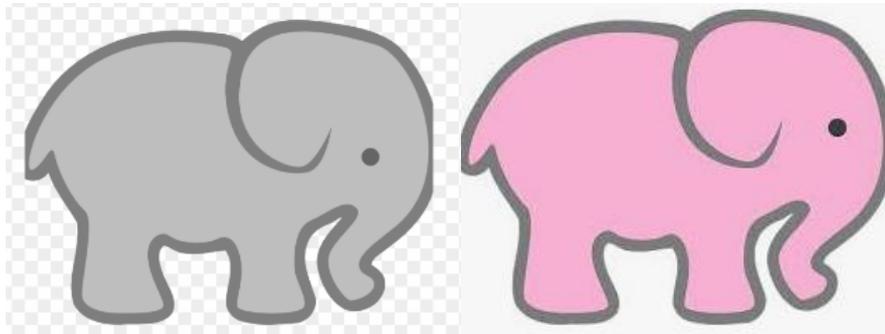
**Example 5 in respect of veterinary services.**



However, it is possible that differences in the colour alone will mean the marks do not constitute a series. In Example 6 below, the two marks contain an image of a cartoon elephant which are identical except in respect of their colour. In this case the material particulars are the same, so it passes the first test. Even if the colour was not considered distinct matter, the marks would fail the third test because the idea behind the first mark is one of a naturally coloured (grey) elephant and which would be identified as an elephant and nothing more, whereas the idea

behind the second mark is one of an unnaturally (pink) coloured elephant and it would be identified as such. Therefore, in this case, the difference in colour substantially affects the identity of the marks.

**Example 6 in respect of children's clothing in Class 25**



Therefore, particularly in cases concerning marks with figurative elements, the lessor the number of elements in the mark the greater the affect a colour change will have on the identity of the marks. Colour may also play a part where the marks in a proposed series contain nothing other than simple coloured geometrical shapes. This is case with regard to the two marks in Example 7 below, which has only two elements, but is not considered a valid series because the change of colour of the star from red to yellow significantly affects the identity of the marks.

**Example 7 in respect of pizza delivery services.**

