

Trade Marks Registry Practice Notice

With Immediate Effect

Surnames

The Trade Marks Registry takes notice of the recent decision of the European Court of Justice in the case of NICHOLS PLC V REGISTRAR OF TRADE MARKS (Case C-404/02).

The case dealt with the distinctive character of surnames.

The ECJ held that in determining whether a surname was to be refused registration on the ground of lack of distinctiveness, a specific assessment was to be made in each case, applying the same criteria as those applicable to other categories of signs and general criteria such as a predetermined number of instances of a name, above which lack of distinctiveness might be presumed was not to be applied.

The law on the registration of surnames as Trade Marks in Jamaica is governed by the Trade Marks Act, 1999. To qualify for actual registration, a sign must:

- (a) Be a Trade Mark.
 - (b) Not be devoid of distinctive character.
 - (c) Not designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of the rendering of the service or other characteristics of the goods or service.
 - (d) Not be a trade mark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.
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- (e) Not be a trade mark which is of such a nature as to deceive the public as to the nature, quality or geographical origins of the goods or service.

In assessing whether a surname breaches any of the above conditions, the Trade Marks Registry normally considers the commonness of the surname in question.

As part of the examination process, the practice of the Trade Marks Registry was to check to see how many times the surname appeared in the Jamaican telephone directory. A surname would not be regarded as common unless it appeared fifty (50) times in the aforementioned directory.

In light of the ECJ's ruling previously cited and the subsequent change in the U.K. Practice (which had been adopted and followed by the Jamaican Trade Marks Registry), the Trade Marks Registry will no longer raise objections to the registration of marks consisting of common surnames solely based on the "general criteria" of its appearance in the telephone directory.

The Registrar will not generally have specific information about the extent of the use of a particular surname in a specific sector of the market. Exceptionally, the Registrar may take judicial notice of facts which are generally known, which could include the extent of the use of a particular surname in a specific field. For example, the Registrar may not need evidence in order to notice that there are a large number of doctors in practice in Jamaica with the name 'Smith'. He may properly conclude from this finding that consumers or end users of medical services will not regard that name, by itself, as distinguishing the medical services of one undertaking from those of other such undertakings. In these circumstances it will, of course, be open to the applicant to challenge any of the facts upon which the Registrar relies to support a resulting objection under Section 11(1)(b) of the Act.

Following publication it will be open to third parties to supplement the Registrar's knowledge of the market by placing relevant facts before the Registrar through the filing of written observations or an opposition. For example, if an application is made to register the surname 'James' as a trade mark for 'clothing', it may be relevant that there is evidence that there were other clothing businesses already known to the public to be trading under that name at the date of the application. However, the mere existence of one or two unconnected undertakings with the same name in the same market sector will not automatically justify an objection under Section 11(1)(b) on absolute grounds. This is because the existence of earlier unregistered rights is a matter which, in principle, should support an opposition on relative grounds.

However, if the evidence shows that, at the date of the application, the relevant public's expectation was that there would have been numerous undertakings trading in the relevant sector under the name in question, with the result that the public could have had no expectation that relevant goods or services under that name would originate from any particular undertaking, then it would be legitimate to conclude that the name is devoid of any distinctive character, and therefore subject to objection under Section 11(1)(b).

Surnames with other descriptive meanings

Where a word which is a surname has another meaning, that meaning may found an objection to registration. For example, the trade mark BROWN

would face an objection under Section 11(1)(b) & (c) of the Act if applied for in relation to 'sauces' because it is a word which may serve, in trade, to designate a kind of sauce. Similarly, the same word would not be acceptable as a trade mark for 'paints' because it designates a characteristic of those goods (colour).

Trade Marks Registry

Jamaica Intellectual Property Office

36 Trafalgar Road

4th Floor, PCJ Building

