

Retailing of Services in Trade Mark Specifications

Who Benefits?

The types of business likely to benefit are described in Paragraphs 34-35 of the Netto Marken Decision:

"...there are situations in which a trader selects and offers an assortment of third party services so that the consumer can choose amongst those services from a single point of contact. The services rendered by such a trader can consist, in particular, both of activities designed to allow a consumer conveniently to compare and purchase those services and of advertising services".

This may be particularly relevant to internet traders offering a single portal/point of contact through which customers can view, select and then book or purchase services from a variety of third parties. For example, there are numerous online booking companies and price comparison websites across all commercial sectors whose businesses operate along these lines and who may wish to consider filing new trade mark applications to cover their retailing activities.

Background

Retailing of goods has been allowed since the 2008 CJEU Praktiker Case [C-418/02] and practice in this area is already established and set out in the UKIPO Classification and Examination Guides and those of the EUIPO in respect of European Union Trade Marks (EUTMs).

Following the 2014 CJEU Decision in the Netto Marken case [C-420/13], retailing of services has been permitted, provided guidelines are followed. In March 2015 the UKIPO published guidelines [PAN 1/15] on "Trade Mark Applications seeking to protect the retailing or 'bringing together' of services". These guidelines can be found [here](#). Similar guidelines in respect of EUTMs can be found in the EUIPO Manual [here](#).

Current Practice

It is now accepted that retailing of services is a commercial activity capable of protection, provided the specification wording is clear and precise (in accordance with Case C-307/10 IP Translator). In line with retailing of goods, it has been held that for retailing of services, the services being brought together must be clearly defined.

They must also be "framed" using the accepted Class 35 wording "The bringing together, for the benefit of others, ..., enabling customers to conveniently view and purchase those services". In contrast to the practice on retailing goods, PAN 1/15 states that variations on the "bringing together" wording will not be acceptable. In particular, it will not be permitted to refer to "retail services connected with..."; the reason being that such variations do not distinguish between retailing of services as a commercial activity in its own right and a business simply

providing its own services.

Examples given in PAN 1/15 of acceptable wording include:

- The bringing together, for the benefit of others, of a variety of legal services, enabling customers to conveniently view and purchase those services.
- The bringing together, for the benefit of others, of slimming club services, video-on-demand services, and detective agency services, enabling customers to conveniently view and purchase those services.
- The bringing together, for the benefit of others, of a variety of broadcasting services, enabling customers to conveniently view and purchase those services.

These are acceptable because they use the correct Class 35 "bringing together" wording in which to "frame" the services being brought together and because they clearly describe the retail service activity. Whilst not included in the above examples, and not essential to acceptance, PAN 1/15 also states that reference to the retail medium (e.g. from an internet website/in a wholesale outlet/in a retail store) is encouraged.

Unacceptable Wording

Examples given in PAN 1/15 of unacceptable wording include:

- Retail services connected with takeaway services.
- Retail services connected with the sale of legal services.
- Mail order retail services connected with the sale of detective agency services.

These are unacceptable because it is not clear whether there is genuine retailing of services or just the provision of a business's own services. For example, in the context of the first wording above, this could describe a business simply providing its own food on a takeaway basis (in which case Class 43 would be the appropriate class for food provision).

- The bringing together, for the benefit of others, of a variety of repair services, enabling customers to conveniently view and purchase those services from a retail outlet and Internet website.
- Retail services connected with the sale of personal and social services rendered by others to meet the needs of individuals.
- The bringing together, for the benefit of others, of a variety of services, enabling customers to conveniently view and purchase those services.

These are unacceptable because the services are not sufficiently precisely defined. Following the IP Translator case, the EUIPO and

UKIPO published a list of classification terms deemed insufficiently precise. Any inclusion of these terms within an application seeking protection for retailing of services will be subject to an objection.

The PAN also makes it clear that retailing of services is not intended as a means for applicants to duplicate protection of

services that they already provide in their own right, or a means of protecting the advertising of their own services. Class 35 retailing of services is not an appropriate way for a business to protect the mere selling and/or advertising of its own services. If the Registrar feels this is not clear from the specification, an objection will be raised.

For more information, please contact:

Tom Albertini – talbertini@jakemp.com

Ben Mooneapillay – bmooneapillay@jakemp.com

James Fish – jfish@jakemp.com

Charlotte Stirling – cstirling@jakemp.com