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## UK IPO issues Practice Amendment Notice (1/15)

Trade Mark Applications seeking to protect the retailing or 'bringing together' of services

The decision of the Court of Justice of the European Union in Case C-420/13 Netto Marken-Discount AG & Co. KG v Deutsches Patent-und Markenamt confirmed that the retailing of services is, in principle, a commercial activity which can be protected by a trade mark registration. Following this decision, the UK Intellectual Property Office (UK IPO) has issued Practice Amendment Notice 1/15 which clarifies the UK position on the inclusion of the retail of services in trade mark applications. The new practice is effective as of March 2015 and applies to all pending applications.

2. They describe the services being brought together using terms which are understood and acceptable in their own right and which meet the requirements of clarity and precision.

It is not required to specify how or where the services are brought together in order for the term to be acceptable, however, the UK IPO encourages the use of such information in order to maximise clarity and precision.

### What is not acceptable?

In relation to the bringing together of goods, a variety of different ways of phrasing the service of bringing together goods is currently accepted by the UK IPO. The bringing together of services must be framed using the wording indicated above in order to be acceptable. The following variations, which are acceptable in relation to the bringing together of goods, are not acceptable in relation to the bringing together of services:

- 'Retail services connected with...'
- Mail order retail services connected with...'
- Electronic shopping retail services connected with...'

These terms, and other variations, are not acceptable because they fail to distinguish between the retailing of services, and the provision of those services in their own right. This is an important distinction which the UK IPO requires the specification to make. The new practice should not be interpreted as a means for obtaining duplicate protection for services provided in their own right.

### What is acceptable?

The UK IPO will now accept claims to 'the bringing together of...' almost any service as long as the claim meets the requirements for clarity and precision. Examples of acceptable terms 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'

These acceptable terms satisfy two important requirements:

1. They use the familiar terms 'bringing together for the benefit of others.... enabling customers to view and purchase...' to frame the services being brought together

## How can we help?

If you would like further information, please contact one of our **trade mark attorneys**, who are qualified to advise on all aspects of trade mark law. The services of our trade mark attorneys include:

- Advising on your choice of trade marks and their registrability
- Trade Mark Audits and IP portfolio management
- Due diligence of trade mark rights
- Searches, investigations and advice on filing strategies
- Preparing, filing and prosecuting national, EU or international trade mark applications
- Facilitating registration of trade marks overseas
- Managing renewals of trade marks
- Trade mark watches to identify competitors' applications and registrations
- Handling oppositions, cancellations and appeals
- Negotiating amicable settlements and co-existence agreements
- Negotiating and drafting licence agreements and assignments
- Advising on infringement of trade mark registrations and attacks on validity
- Liaising with solicitors/ barristers in the enforcement or defence of registered and common law rights

## Contact

For more information please contact Sarah Neil via email at [smn@aathornton.com](mailto:smn@aathornton.com) or your usual A.A Thornton & Co. advisor.

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