

## NEW UK PRACTICE ON RETAIL SERVICES

The UK Trade Mark Registry has recently announced that it will accept trade mark applications for retail services.

This change of practice will be welcomed by many practitioners, common interest groups and their members, as well as retailers. It has been a long wait for those who have lobbied and fought to introduce protection for such services into trade mark law.

**Lloyd Wise** has been anticipating this development which follows a recent case held before the Community Trade Marks Office Second Board of Appeal. In that case it was decided, amongst other things, that “retail services” are beneficial to both the retailer and the customer and that the goodwill of an undertaking is built on the services it provides to its customers. It will now be possible to protect that goodwill by obtaining trade mark registrations for all services provided by retailers.

The Registry has just settled the details of the practice it will follow with respect to retail services which will be classified in International Class 35. These details are to be published over the next few weeks but the practice has already been adopted by Examiners.

**Lloyd Wise** is pleased to be able to give you information on the new practice so soon after the announcement from the Registrar and to provide guidelines as to the type of services that can be covered and acceptable terminology.

Under the new practice, protection can be obtained for any retail service provided by shops, stores, departmental stores, retail outlets and malls whether those services are individual, in-store or an amalgamation of services within one premises. Protection can also be obtained for mail order services and for retail services provided over the Internet or via TV shopping channels.

The Registry has however stated that it will not allow the term “retail services” *per se*, or any other term that is deemed indefinite.

As examples, the Registry has indicated it will not allow the following terms:

Retail services for department stores  
Department store services  
Internet shopping  
Supply or provision of foods  
E-commerce

The Registry has taken the position that to be acceptable the specification must indicate *the nature of the retail services* **and** *the relevant market sector*. If the specification does not include these two factors an objection will be raised against the application.

The Registry has suggested the following wording to indicate *the nature of the service* provided:

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a ...

To indicate *the specific market sector* in which the services are provided it is satisfactory to state, for example:

...in a supermarket;...in a retail off licence store;...in a retail furniture store.

An acceptable specification for a departmental store that provides goods and services is:

The bringing together for the benefit of others, of a variety of goods and services enabling customers to view and purchase those goods and take advantage of such services in a departmental store

The following are examples of acceptable specifications for services offered on the Internet/by mail order/on TV shopping channels:

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise web site

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a clothing and accessories catalogue by mail order or by means of telecommunications

We are attaching several more examples of acceptable specifications.

**Lloyd Wise** hope that this information will be of use to you and your colleagues and clients for future trade mark applications for retail services.

It is believed that the Community Trade Marks Office will allow applications for retail services in the not too distant future but no official announcement has been made as yet.

If you have any queries or require clarification on retail services (or any other trade mark matters) please do not hesitate to contact us. Our details are as follows:

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