

Patents Office Practice Regarding Trade Mark Disclaimers

Section 17(2) of the Trade Marks Act, 1996 provides grounds on which the Controller may refuse to accept an application unless the Applicant agrees to a disclaimer, if it appears to the Controller that such a disclaimer is warranted.

Before seeking a disclaimer the Controller will be satisfied that (i) the mark contains an element that is not distinctive¹ and (ii) the inclusion of that element is such as to give rise to doubts as to the scope of protection of the mark.

Many trade marks contain non-distinctive elements but, in most cases, that fact does not give rise to any doubt as to their scope of protection because the non-distinctive element is clearly self-disclamatory in the context of the mark as a whole. However, if a trade mark is dominated by a non-distinctive element and its distinctive component(s) is/are peripheral, subsidiary or otherwise of minor significance in terms of the overall impression formed by the mark, then it is appropriate to impose a disclaimer requirement, on the assumption that the mark is not caught by Section 8(1)(b) or (c).

By way of example, the ‘Fresh Milk’ element of the mark below left (registered in respect of “milk and dairy products”) merely identifies the goods, not the trade mark and is clearly self-disclamatory. However, in the case of the mark on the right (registered in respect of “beer, ale, stout, lager and porter”) it may not be obvious that Red Rye IPA is a specific type of beer and consumers might perceive the words to be a brand name. Accordingly, the Controller will seek a disclaimer, which will be recorded on the Register and confirm to consumers and other traders that monopoly rights in the words “Red Rye IPA”, irrespective of how the words are depicted, have not been granted to the Proprietor.



¹ Distinctive means the capacity to provide a reliable indication of origin that allows consumers to identify goods/services of the same origin that they have previously experienced by reference to the trade mark and, thus, to repeat the positive experience or avoid the negative experience, as the case may be, that they have had of those goods/services.

Where the registration of a trade mark is subject to a disclaimer, the rights conferred by Section 13 (*“rights conferred by registered trade mark”*) are restricted accordingly. Therefore, a disclaimer in respect of a component of a composite mark confirms that no rights can be asserted in the disclaimed component standing alone. Put simply, the rights conferred by the registration of a composite mark are those that flow from the use of the mark as a whole.

When a disclaimer is considered necessary the wording of the disclaimer will be written in terms that removes all doubt as to the scope of protection and will be in respect of all the non-distinctive word, device or colour elements of the mark.

During the examination of a later mark where the only component of the earlier trade mark which could be regarded as creating a similarity with a later trade mark is the subject of a disclaimer to any exclusive right, the Trade Mark Examiner will not consider the marks to be similar enough to create a likelihood of confusion.

If a mark is liable to objection under Section 8(1)(b) or (c) the Applicant’s willingness to provide a disclaimer will never be sufficient to overcome that objection. However, objections under either of these subsections may be waived if a claim to distinctiveness acquired through use is made and evidence is received which clearly supports that claim. In such cases disclaimers are not required but a noting will be recorded on the Register stating the mark is proceeding on the basis of distinctiveness acquired through the use made of it.

18 July 2017