

The Patent Office
Cardiff Road
Newport
South Wales
NP10 8QQ

Your Ref: 2423035/Team C/TLONG

**Application 2423035 in Classes 09, 16, 25, 38, 41
For the Mark: Pimp That Snack**

Dear Sirs,

In respect to your letter sent 30th August, we would reply as follows:

Firstly we'd like to query your statement that 'there is an objection under Section 3(1)(b) and (c) of the Act' and ask whether this refers to an objection by a third party or whether The Patent Office objects on these grounds.

As you state, the objection is under Section 3(1)(b) and (c) of the Act. For clarity, these sections are as follows:

"3(1) The following shall not be registered - ... (b) trade marks which are devoid of any distinctive character ... (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services."

Taking section 3(1)(c) (objection on the grounds of "descriptiveness") first, the Examination Report states that "[the application is refused] because the mark consists exclusively of the words "Pimp That Snack", being a sign which may serve in trade to designate the kind of goods, e.g. goods relating to recipes for the improvement or development of snacks".

I believe there has been a small misunderstanding of how the website (for which the applied mark corresponds) operates. The website does not sell anything except t-shirts. The informal 'recipes' that appear on the website are not bought or sold, so there are no 'goods' to which the trade mark 'Pimp That Snack' directly relates. 'Pimp That Snack' is not designating goods – it is a call to the uniquely-devised action of 'pimping' a snack food, more than anything else.

However, if the Patent Office is of the opinion that 'Pimp That Snack' is descriptive and therefore not eligible for registration, then one would query why registration of pimp (2199634), PIMP (2224549), PIMP (2413303), PIMP JUICE (E3261856), PIMP MY (E4279493), PIMP MY (E4713905), PIMP MY RIDE (E3992724) and PIMP MY RIDE (E4713913) have been allowed, as they are clearly of the same ilk.

In respect to 3(1)(b) (objection on the grounds of lack of "distinctiveness"), the word "devoid" indicates a very limited criterion for objection. Indeed the German Supreme Court in *Likoerflasche TM* [2002] said "the standard applied must be generous, that is, any distinctiveness, be it even the weakest kind will be sufficient to overcome the barrier of protection.". "Pimp That Snack" is more than the single word "pimp", which the Patent Office deem to be 'a new slang word in common use'. The evidence provided only shows usage of the word 'pimp' in

different contexts, none of which evidence 'Pimp That Snack' as a generic slang term. The phrase is not known anywhere except in the context of our own operations.

The fact that a trademark contains a word in common usage is not a barrier to it having distinctiveness. It is a distinctive *phrase* which in itself is not in common usage, and is wholly distinctive to the website of its origin. Indeed "Pimp That Snack" has developed a distinctiveness of its own through its use as well – witness the substantial media coverage and the large traffic the site has carried since its inception. Previous to this coverage the phrase "Pimp That Snack" was not known in any context and has risen to notoriety only since. "Pimp That Snack" is now inextricably associated solely with the website www.pimpthatsnack.com.

In any event "Pimp That Snack" is clearly distinctive enough to clear the low hurdle of "devoid of any distinctiveness". Again, if "Pimp That Snack" is lacking distinctiveness because of the word "pimp", then the same must be true of other registered marks containing the word "pimp" as listed above. Ineligibility for registration on these grounds would appear to be contradictory to established practise.

Lord Parker in *Registrar v. W&G Du Cros* (1913) said that the right to register should "largely depend on whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods", and that registration should be denied only where other traders would be under an intolerable burden, or where they would be hindered or embarrassed. Whilst this case has to a degree been superseded by the 1994 Trade Marks Act, this ethos should still apply, most particularly in relation to objections under sections 3(1)(b) and (c).

For these reasons we fully believe that the mark 'Pimp That Snack' is eligible for registration, and that the application process be carried forward. Should you deem this to be otherwise we would ask for a hearing with the Registry as soon as possible.

Yours Faithfully,

Peter Wilcock

For and on behalf of Pimp That Snack Ltd.