

O-125-15

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 3012530**

**BY ASSOCIATED NEWSPAPERS LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9, 35, 38 AND 41:**

**SERIOUSLY POPULAR**

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### **Background**

1. On 3 July 2013, Associated Newspapers Limited ('the applicant') applied to register the above mark for the goods and services as follows:

Class 9: On-line electronic publications; electronic publications (downloadable); electronic newspapers; publications available on-line through a global computer network; CDs; CD-Roms; DVDs; pre-recorded video tapes and cassettes; media storage devices; electronic publications; digital music (downloadable) provided from the Internet; software; software applications; computer software and hardware to enable searching of data and connection to databases and the Internet.

Class 35: Advertising, marketing, public relations, publicity and promotional services; advertising, marketing, public relations and promotional services, all relating to employment and personnel selection; classified advertising; personnel management; agency, counselling, recruitment and placing services, all relating to employment and personnel selection; market studies and analysis; rental of advertising space, dissemination of advertising matter; advertising mail order; provision of advertising space on a website; compilation of advertisements for use as web pages on the Internet; provision of advertisement programmes; provision of commercial information; television, radio and satellite commercials; business management and administration; business research; business organisation and management consultancy services; compilation and provision of business information, advice and statistics; economic forecasting; computerised business information storage and retrieval services; opinion polling, market surveys; market research; computerised accounting; computerised database management; computerised data processing and business management advice and consultancy; storage of information; information, advisory and consultancy services relating to all the aforesaid services; all the aforementioned services also provided on-line from a computer database or from the Internet.

Class 38: Telecommunication; computer inter-communication services; broadcasting by radio, television and satellite; broadcasting and transmission of programmes; operation of broadcasting facilities; news services; transmission of news; transmission of publications; telecommunication of information (including web pages), computer programs and any other data;

providing access to online information and/or communication services; information and advisory services relating to telecommunication services; provision of information about communication and/or broadcasting by electronic media; communication services provided by electronic, computer, cable, teleprinter, teletype and electronic mail means; communication services provided on the Internet; interactive communications services provided by means of a computer; transmission of information; communication by computer terminals; message sending services; message boards; providing on-line electronic bulletin board services and chat rooms; operating chat rooms; telegraph services; wire services; information, advisory and consultancy services relating to all the aforesaid services; all the aforementioned services also provided on-line from a computer database or from the Internet.

Class 41: Education and entertainment services; publication services; publishing services; publication of printed matter and printed publications; publication of newspapers, newsletters; publication of printed and educational material; provision of news; provision of news online; education, entertainment, publishing and publication services; electronic publishing services; providing on-line electronic publications [not downloadable]; publication of electronic books and journals on-line; publication online of information in a variety of fields, including news, fashion, travel, food and drink, television, show business, current affairs, sport, health, finance, science and technology, property and motoring; editing services; journalism services; organisation of exhibitions and shows; provision of information relating to education, sporting, political, current events, cultural activities, film, theatre, cinema, television, radio, shows, music and entertainment; entertainment; sports information services; organisation of competitions, quizzes, games and recreational, recreational activities, amusements, cultural activities; news programme services for radio or television; commissioned writing services; syndication of previously published content for re-use or re-purposing; syndication of previously published content for re-publication in other media or sale to the public; syndication of visual works for re-publication in other media or sale to the public; publication of material which can be accessed from databases or from the internet; syndication of cuttings (digital and non-digital); information services relating to all the aforesaid services; electronic game services provided by means of the Internet; production of shows and radio and television programmes; cable television, television and radio entertainment services; providing digital music [not downloadable] from the Internet; providing digital music [not downloadable] from MP3 Internet web sites; providing digital music from the Internet; providing an on-line music store for purchase of singles and albums; information, advisory and consultancy services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the Internet.

2. On 22 July 2013, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the sign may serve in trade to designate the quality of the goods and services, e.g. electronic publications, advertising services, telecommunication services and education services which are extremely popular. The examiner went on to say that the word 'seriously' can, when used informally, mean 'extremely'. Therefore, the sign 'SERIOUSLY POPULAR' simply means 'extremely popular' which would just be viewed by the average consumer as laudatory and promotional, and that the words would not denote single trade origin.
3. On 23 September 2013, Haseltine Lake LLP ('the agent') requested an extension of time, which was granted until 2 December 2013. On 2 December 2013, the agent responded to the examination report contesting the objection. The examiner was not persuaded by the agent's arguments, and on 20 December 2013 wrote to the agent confirming this. The examiner also stated that if the objection was to be contested further, an *ex parte* hearing should be requested.
4. On 20 February 2014, the agent requested a further extension of time and again this was granted until 22 March 2014. On 21 March 2014, the agent requested an *ex parte* hearing.
5. At the hearing, which was held on 6 August 2014, Mr Krause of Haseltine Lake made submissions in favour of acceptance of the mark. At the hearing, I agreed with Mr Krause that the objection under section 3(1)(c) was not appropriate. For that provision to apply, there must be a direct and specific link made by the average consumer between a characteristic of the good or service and the sign applied for. In my view, the sign is too vague to designate such a characteristic, and as such, the objection under section 3(1)(c) was waived. However, I was not persuaded by Mr Krause's arguments in respect of the objection raised under section 3(1)(b), and so maintained that objection. A period of two months was then granted until 5 August 2014 to allow Mr Krause time to establish whether the applicant was able to demonstrate acquired distinctiveness.
6. On 5 August 2014, the agent filed a third request for additional time in order to consider alternative ways to deal with the objection (particularly the possibility of filing evidence in support of a claim to acquired distinctiveness). A final extension of time was issued, setting a final deadline of 5 September 2014. On 22 September 2014, due to the fact that no further response or evidence had been received by the Registrar and with the objection still in force, the application was refused.
7. On 24 October 2014, the agent submitted a form TM5 requesting a statement for the reasons for the decision. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

## The applicant's case for registration

8. Prior to setting out the law in relation to sections 3(1)(b) of the Act, I will set out the applicant's case for *prima facie* acceptance of the mark. At the hearing, Mr Krause submitted that:
- Given that 3(1)(b) objection is based on descriptiveness, and given that the section 3(1)(c) objection has already been waived, then the section 3(1)(b) objection should also fall.
  - The objection had been maintained specifically on the basis that the sign would designate a characteristic of the goods and services, and the examiner had not raised a separate objection under section 3(1)(b).
  - There had been a complete change in respect of the section 3(1)(b) objection as originally raised. The mark had originally been subject to an objection based upon it being considered 'laudatory and promotional', but this had vanished from the examiner's letter of 20 December 2013.
  - In respect of the objection under section 3(1)(b), the mark contains a play on words. Mr Krause referred to the decision of the Court of Justice of the European Union ('CJEU') in Case C-398/08 *Audi V Ohim 'Vorsprung durch Technik' (Audi)* where it was confirmed that a mark should not be refused protection simply on the basis of it being promotional or laudatory. Specific reference was made to paragraphs 45 and 47 of the decision which state:

*45. On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood - perhaps even primarily understood - as a promotional formula has no bearing on its distinctive character.*

*47. As regards the General Court's finding in paragraph 41 of the judgment under appeal that the mark *Vorsprung durch Technik* can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.*

- The Court has confirmed that the existence of wordplay is likely to endow the mark with distinctive character. Reference was also made to paragraph 58 of the decision which states:

*58. Even if it were to be supposed that the slogan 'Vorsprung durch Technik' conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.*

- The juxtaposition of the words had been deliberately chosen by the applicant so that the expression in its totality does not merely describe the goods and services applied for, but rather leads consumers to a line of questioning about what the term means. The juxtaposition of the words is unusual; 'serious' and 'popular' mean quite different things to consumers, and the wordplay and 'ironic contradiction' was specifically created by the applicant in order to exercise the minds of consumers.
- The goods and services covered by the application are not those which would likely be bought on an impulse, but rather are considered purchases. When considered in relation to the goods and services, the sign would appear unusual.
- In written correspondence submitted prior to the hearing, the agent had already stated that the informal meaning of the word 'seriously' has been derived from its use to indicate a degree of a characteristic that required serious attention - for example, a *seriously* dangerous animal or a *seriously* large quantity of toxic waste. When used informally (as in this application), it is used almost ironically, as a means of exaggerating an inherent characteristic, to suggest an extreme in a situation or context where one would not ordinarily expect the situation to be taken very seriously. An example relating to 'taste' was provided; a chocolate pudding may be described as 'seriously rich' as opposed to being just 'very rich'. Such use would suggest that the pudding it is at the top end of the scale in terms of its chocolate flavour. The word 'seriously' would therefore be used as a way of exaggerating an experience in an informal setting between people.
- The term is not used in this way to qualify words that are *not* liable to be exaggerated in conversation; it is very unlikely that someone would be described as 'seriously kind' or 'seriously hilarious'. It was submitted that, used in context, the question is whether consumers will perceive the use of the word in its literal form, or in its informal exaggerated, form; what is the setting in which it is being used and what is it being used to qualify?
- With regard to the word 'popular', it was submitted that this has a well-known meaning, i.e. 'well-liked' or 'wanted by many'. However, its derivation from the word 'people' also gives it a subtly different meaning; a way of describing something

that appeals to ordinary people as opposed to experts or other select groups. So, for example, 'popular science' refers to science that is targeted at the general public as opposed to scientists. Also, the expression 'popular press' distinguishes newspapers and publications targeted at 'the person in the street' as opposed to the broadsheets, which are considered to be serious publications.

- Some of the key products and services of interest to the applicant and which are covered by the application are electronic publications and the online publication of information in a variety of fields. The objective of the publication-based products/ services is to appeal to a broad cross-section of the population in the UK. The use of the word 'popular' is therefore suggestive of this objective; products and services that will have broad appeal in that they are readily accessible to a large swathe of the population, not just in terms of the appeal of the subject matter and ease with which content can be read and assimilated, but also in terms of the convenience with which material can be accessed, i.e. using the internet or mobile devices.
- The applicant also wants to convey the significance of its editorial integrity; it is important that the potential consumer base is made aware of the seriousness with which the applicant provides the content for the products and services, even if the medium by which they editorial is conveyed to the consumer base is not considered to be 'serious'.
- The mark plays on the double meaning of the word 'seriously' and the shades of meaning of the word 'popular'. Certainly in respect of any products and services that relate to media, the word 'popular' will suggest 'popular press' and the ironic juxtaposition of this non-serious media with the word 'seriously' will be clear. However, this play on words will be apparent for all of the goods and services for which protection is sought, even if in some cases (such as media storage devices) consumers may well be left wondering what the mark is suggesting.
- Consumers will not, therefore, perceive the mark as a simple promotional statement. The inventive word play through the paradoxical conjunction of the two words 'seriously' and 'popular' will serve as an indicator of origin.

## Decision

9. Section 3(1) of the Act reads as follows:

*3.-(1) The following shall not be registered –*

*(a) ...*

*(b) trade marks which are devoid of any distinctive character,*

*(c) ...*

*(d) ...*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b),(c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”*

**The relevant legal principles - section 3(1)(b)**

10. The CJEU has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC ('the Directive', being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 ('the Regulation', being the codified version of original Council Regulation 40/94), in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, para 59 and the case law cited there and, e.g. Case C-273/05P *Celltech R&D Ltd v OHIM*).
11. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above upon which section 3(1)(b) is based) the Court has held that “...*the public interest... is, manifestly, indissociable from the essential function of a trade mark*” (Case C-329/02P *Satelliten Fernsehen GmbH v OHIM 'SAT.1'*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word 'devoid' has, in the UK at least, been paraphrased as meaning 'unpossessed of' from the perspective of the average consumer.
12. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the CJEU provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor)* C-363/99 where, at paragraph 34, it stated:

*“A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C-55/01 Linde and Others 5 [2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75).”*
13. So the question of a mark being devoid of distinctive character is answered by reference to the goods and services applied for and the perception of the average consumer for those goods. I should add also that being 'devoid of distinctive character' does not represent an objective standard, but is based on an assessment which concludes that the sign presented for registration is 'unpossessed' of distinctive character from the perspective of the average consumer. Since, in the relevant authorities' assessment, the



sign is unpossessed of distinctive character (this has been, in turn, paraphrased as being 'origin-neutral' as distinct from 'origin-specific'), the sign is not considered capable of performing the essential function of a trade mark.

14. In applying that assessment to this case, it is important I am convinced the objection applies to all the goods and services applied for. If there are goods and services specified which are free of objection under section 3(1)(b) then they must be allowed to proceed. In CJEU Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau*, the question being referred to the court was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The court answered (paragraph 38), saying that the competent authority was required to assess the application by reference to individual goods and services. However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all the goods and services concerned. This guidance by the European authorities has, of course, been applied and interpreted in relation to the approach taken by the relevant UK authorities and which can be found in Tribunal Practice Notice ('TPN') 1/2012 headed 'Partial Refusals'.
15. Furthermore, following on from CJEU guidance on cases such as *Real People Real Solutions, Sykes Enterprises v OHIM* (REAL PEOPLE REAL SOLUTIONS) [2002] ECR II-5179, there has been a tendency to skew assessments of distinctiveness in respect of promotional marks, such as the one applied for. This sort of assessment is based on the assumption that consumers are not in the habit of regarding slogans as designating trade origin, but instead regard them as purely promotional, non-distinctive material. Following the Court's decision in *Audi* we now know that this is only part of the consideration that must be made. In paragraph 44 of that decision, the Court stated:

*"...while it is true... that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that the mark is devoid of distinctive character."*

16. Given such guidance, I intend to approach this matter from a semantic perspective in order to assess whether or not the phrase is capable of performing the essential function of a trade mark, and whether or not it should therefore be free from objection under section 3(1)(b).
17. It is also a well-established principle these days that the Registrar's role in examination will involve a full and stringent examination of the facts, underling the Registrar's frontline role in preventing the granting of undue monopolies, see, to that effect, CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I-1541. Whilst this case was, technically speaking, in relation only to section 3(1)(c) or its equivalent in European law, the principle about the 'prevention of undue monopolies' must hold good whether section 3(1)(b) and/or (c) applies.

### Application of legal principles - section 3(1)(b)

18. Given the breadth of goods and services listed in this application, it is difficult to identify and/or categorise precisely who the average consumer would be. The specifications cover a wide range of goods and services in classes 9, 35, 38 and 41, including e.g., publications and software in class 9, advertising and business services in class 35, telecommunication services in class 38, and also education and entertainment services in class 41. As such, I consider that the relevant consumer base consists of the general public, but not exclusively so. In relation to some of the very broad terms claimed in the specifications, such as 'software' and 'education', depending on the subject matter of those goods and services, these could just as easily be highly specialised products targeted at more sophisticated consumers. The level of consumer attention may therefore vary, depending on the customer. However, I consider it reasonable to assume that a prospective user of the applicant's goods and services would apply a moderate to high level of attention at the point of considering a purchase.
19. Given that the objection has been maintained under section 3(1)(b), the issue here is whether the sign applied for when used in relation to the goods and services claimed would be perceived as one which simply lacks any capacity *prima facie* to distinguish the products of one trader from those of another. I must then, consider the effect upon the perceptions of the average consumer on seeing the words 'SERIOUSLY POPULAR' in normal and fair use in relation to the goods and services of the application. This process starts with a linguistic analysis of the individual words which appear in the combination as presented. Although it is paramount that any assessment of distinctiveness takes into account the mark's totality, it is also useful to first analyse the mark by reference to its constituent parts.
20. The mark applied for consists of the expression 'SERIOUSLY POPULAR'. The individual words within the mark are defined in Collins English Dictionary as follows:

**Seriously** *adverb, informal*; extremely or remarkably: seriously tall

**Popular** *adjective* appealing to the general public; widely favoured or admired.

The word 'popular' is also defined in Collins English Dictionary as meaning:

**Popular** *noun* (usually plural) cheap newspapers with mass circulation; the popular press. Also shortened to: pops.

21. In this case, the sign possesses no particular stylisation or device elements; it is word-only. Both words are in grammatically correct order and are recognisable. The word 'seriously' has some informality about it, but nonetheless merely qualifies that the goods and services are extremely, or remarkably appealing, or favoured. In terms of the phrase's inherent linguistic characteristics, in my opinion it is difficult to see exactly what about it as a whole could ever conceivably perform the essential function of a trade mark in the *prima facie* case. It is, to coin a well known phrase in trade mark circles in the UK, entirely 'origin neutral'

22. It has been asserted in the original examination report that the sign is laudatory and promotional, and that it would therefore not denote single trade origin. I prefer not to state, conclude or infer the sign is inevitably a 'slogan' *per se*; this is especially difficult in an *ex parte* analysis based only on inherent characteristics and thus devoid of context. Regardless then, as to whether a sign may be categorised as a 'slogan', case law such *Audi* confirms (at paragraph 47 of that particular decision) that semantic characteristics such as '*having a number of meanings*', '*being a play on words*', or being perceived of as '*imaginative, surprising and unexpected*', such that the sign in which they reside can be easily remembered, are, as a rule, likely to endow it with distinctive character. Admittedly, the Court nonetheless notes that such characteristics are not essential pre-requisites for a finding of distinctive character.
23. Mr Krause submitted that, according to the aforementioned *Audi* decision, the sign's element of word play should render it distinctive. At the hearing, he stressed that the word 'popular' would be understood to mean 'popular press'. However, when considered in the *prima facie*, as stated above, linguistic features such as e.g. unusual juxtaposition, quirkiness or surprise may be said to tilt the balance in favour of registration. In this case, I do not believe such features exist in this sign in the *prima facie*, such that the average consumer could latch onto them in some way, as to create the necessary resonance, or whatever other words one chooses to describe the function of a trade mark. Apart from goods or services associated with newspapers (which are very few in the context of the entire application) I do not consider that consumers would associate the word 'popular' with the meaning 'popular press'. I think that it is highly unlikely that consumers would make this mental leap to arrive at such a meaning. This is particularly so when considering the sign in its totality; I fail to understand why consumers would reach the suggested meaning when considering the mark as a whole.
24. In my view, this mark provides the consumer with nothing more than information about positive aspects of the goods and services on offer. I have considered the judgement of the CJEU in *Audi* cited above, which states:

*"41. It must be held that, even though the General Court stated in paragraph 36 of the judgment under appeal that it is clear from the case-law that registration of a mark cannot be excluded because of that mark's laudatory or advertising use, it went on to explain that the reason for its finding that the mark applied for lacks distinctive character was, in essence, the fact that that mark is perceived as a promotional formula: that is to say, its finding was made precisely on the basis of the mark's laudatory or advertising use.*

*44. However, while it is true - as was pointed out in paragraph 33 of the present judgment - that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character.*

45. On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood - perhaps even primarily understood - as a promotional formula has no bearing on its distinctive character.

46. However, by the line of reasoning set out in paragraphs 42 and 43 of the present judgment, the General Court did not substantiate its finding to the effect that the mark applied for will not be perceived by the relevant public as an indication of the commercial origin of the goods and services in question; in essence, rather, it merely highlighted the fact that that mark consists of, and is understood as, a promotional formula.

47. As regards the General Court's finding in paragraph 41 of the judgment under appeal that the mark *Vorsprung durch Technik* can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.

56. In that regard, it must be stated that all marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message. It is clear, however, from the case-law set out in paragraphs 35 and 36 of the present judgment that those marks are not, by virtue of that fact alone, devoid of distinctive character.

57. Thus, in so far as those marks are not descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, they can express an objective message, even a simple one, and still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring little in the way of interpretation by the relevant public, or setting off a cognitive process in the minds of that public.

58. Even if it were to be supposed that the slogan '*Vorsprung durch Technik*' conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any

*further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.*

*59. In that context, it should be pointed out that that message does not follow obviously from the slogan in question. As Audi observed, the combination of words 'Vorsprung durch Technik' (meaning, inter alia, advance or advantage through technology) suggests, at first glance, only a casual link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, in as much as it is a widely known slogan which has been used by Audi for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods or services covered."*

25. The important message to be taken from such comments is, I think, that one should avoid deeming a trade mark as being necessarily devoid of any distinctive character by virtue of an assertion that it would be seen entirely, or even primarily, as a 'promotional message' as far as the average consumer is concerned. Moreover, the comments also imply that trade marks which convey objective and simple messages may also *not* necessarily be devoid of any distinctive character solely by virtue of that characteristic. The issue for the Court seems to be that, where such marks possess 'originality' and 'resonance' capable of being remembered (qualities which may result from the presence of word-play, imagination, creativity or 'unexpectedness'), then they are unlikely to be devoid of any distinctive character. The impact of the Judgement is, therefore, to urge relevant authorities to undertake a full semantic analysis of the mark in question, without preconception or pre-emption, and also taking into account all known and relevant surrounding circumstances. Having done just this, I only add comments made by the Appointed Person in BL-O-353-10 *BRING THE WORLD CLOSER*, page 15:

*"The expression... is caught by the exclusion from registration in section 3(1)(b) because it is liable to be perceived and remembered by the relevant average consumer as nothing more than an origin-neutral statement about the [goods] concerned. It appears to me to involve no verbal manipulation or engineering of the kind which, in other cases, has been recognised as sufficient to turn explanatory phraseology into a sign possessed of a distinctive character."*

26. In this case, I have sought to limit my analysis to the mark's semantic content - largely by considering the dictionary defined (and generally accepted) meanings for the words which are found in the mark applied for, and assessing their collective impact as a phrase in its totality, by reference to the goods and services applied for. In doing so, I have not identified any of those characteristics or qualities mentioned by the CJEU as being contributory to a finding of a *prima facie* distinctiveness.
27. As required, I have also considered whether the objection properly applies to all goods and services. In my view, the approach taken by the Appointed Person in BL O/185/12 '*FEEDBACKMATTERS*' is indicative of a general proposition. Even if it is not, and was never intended as, a general proposition *per se*, it is certainly indicative of the inherent problems in handling a sign which may be considered 'devoid' in relation to certain

goods and services but not others. The fact that, in that case, the Appointed Person was limited in the application of the proposition to consideration of services in class 36 does nothing to undermine the practical or theoretical soundness of approach. The consideration that 'FEEDBACKMATTERS' is a generic phrase does not detract from it being an expression of potentially wider application. Put simply, once a view is taken that, linguistically, a phrase is 'devoid', that is to say 'unpossessed of distinctive character' or 'origin neutral' for my purposes, it is hard to contend that the sign 'Seriously Popular' is capable of ever being magically transformed, *prima facie*, from being 'devoid' into being 'origin specific', in relation to certain (only) goods and services. This is not, emphatically, to suggest that, of necessity, a section 3(1)(b) objection against a word mark will bite against all goods and services, *but it is to admit that it theoretically could, in any given instance*. The phrase, 'any given instance', allows me opportunity to take into account not just the inherent linguistic qualities of the mark in suit, but also takes into consideration the fact that when used to promote any of the goods and services of the applicant, consumers would perceive the sign as nothing more than information used to endorse the applicant's goods and services.

28. I have assessed the mark as applied for, and must conclude that as a whole, the sign cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creative element which might endow it with the necessary capability to function as an indicator of trade origin. Applying the CJEU's guidance in *Audi* as well as those cases which have preceded it, I therefore have no hesitation in maintaining the objection under section 3(1)(b) of the Act.

### **Conclusion**

29. In this decision I have considered all the papers filed and submissions made. For the reasons given above, the application is refused under section 3(1)(b) in relation to all goods and services.

**Dated this 24th day of March 2015**

**Bridget Whatmough  
For the Registrar  
The Comptroller-General**