

**TRADE MARKS ACT 1994  
AND  
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**In the matter of  
International Registration No.694833  
and the request by Alcatel Business Systems  
to protect a trade mark in Class 9**

**TRADE MARKS ACT 1994 and  
THE TRADE MARKS (INTERNATIONAL  
REGISTRATION) ORDER 1996**

**In the matter of  
International Registration No.694833  
and the request by Alcatel Business Systems  
to protect a trade mark in Class 9**

**DECISION AND GROUNDS OF DECISION**

On the 25<sup>th</sup> June 1998, Alcatel Business Systems societe anoyne of 10/12, rue de la Baume, F-75008 PARIS, France, on the basis of a International Registration, requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the trade mark

**ONE TOUCH VIEW**

The following words appear beneath the mark on the form of notification:

*Indication relating to the nature or kind of mark:* standard characters.

The International Registration is numbered 694883 and protection is sought in the United Kingdom in Class 9 in respect of:

“Telephone apparatus, especially mobile radio telephones”.

On 12<sup>th</sup> October 1998, the notification of a total refusal of protection by the United Kingdom Patent Office was issued. Objection was taken to the mark under paragraphs (b) and (c) of Section 3(1) of the Act, on the grounds that the mark consists exclusively of the words ONE TOUCH VIEW which is devoid of any distinctive character and which may be required in trade to designate telecommunications apparatus that has for example, interactive touch and view systems.

In addition, objection was taken on relative grounds for refusal under paragraph (b) of Section 5(2) of the Act, because there was a likelihood of confusion with two earlier trade marks as defined by Section 6 of the Act. However, these objections were overcome using the provisions of Section 5(5) of the Act and gaining the consent of the proprietors of both the earlier trade marks. This matter is therefore of no further consequence in this decision.

In correspondence, Elkington & Fife, the agents acting on behalf of the applicants, argued that the mark is not devoid of any distinctive character and neither is it descriptive in relation to the present goods. They elaborated by saying that it is in the nature of a telephone that it enables connection with a multiplicity of users throughout the world, each uniquely identified by a plurality of numbers made up of country, district/state, area and designated individual number codes. They argued it is therefore counter-intuitive and would be surprising for any trader to

describe his telephone as a “one touch” telephone. They added that since telephones are essentially auditory, employing the sense of hearing, the word VIEW is not directly descriptive in relation to these goods, although, potentially, is a covert allusion to there being some form of display, eg of telephone numbers dialled or of received calls. They conclude that it follows that the mark ONE TOUCH VIEW is not devoid of any distinctive character, nor is it a directly descriptive statement which other traders would wish to describe their goods in any bona fide fashion.

I disagree with these arguments for reasons I shall give later in this decision, but I reproduce the arguments virtually verbatim from Elkington and Fife’s letter to the Registrar dated 12<sup>th</sup> April 1999 because they ostensibly did the job of convincing the examiner to waive the objection taken under paragraph (c) of Section 3 (1) of the Act. In the official letter to the agents dated 22 April 1999, that objection is waived, but the objection under paragraph (b) of Section 3(1) is maintained.

Elkington and Fife in their correspondence of 21<sup>st</sup> June 1999 felt this approach (to waive the S.3(1)(c) and not the 3(1)(b) objection) to be inconsistent in the context of the present mark and submitted that as the mark ONE TOUCH VIEW does not consist exclusively of signs or indications which may serve in trade to designate the characteristics of the goods, then, viewed as a whole, the mark cannot be devoid of **any** distinctive character and therefore must be registrable.

This view was not shared by the examiner and the objection under Section 3(1)(b) was maintained and on request of the agents, the case came to be heard before me on the 27<sup>th</sup> September 1999.

At the hearing at which the applicants were represented by Ms Fiona Crawford of Elkington and Fife, the objection under Section 3(1) (b) was maintained. At the hearing I also presented Ms Crawford with a copy of a page from a mobile phone brochure entitled “What Mobile”, (although the page itself does not carry that title), namely “The Carphone Warehouse Communications Centre” page. This is attached as an Annex to this decision. The Carphone Warehouse Communications Centres are a nationwide high street retail outlet for car and mobile phones etc. The brochure illustrated a selection of the applicants products, including one utilising the mark “Alcatel One Touch View” and in my view gave me no option but to raise again the Section 3(1)(c) objection which had previously been waived in correspondence. I took the view that the descriptive use in the brochure illustrated to me that the objection should not have been waived in correspondence, but given the lack of notice about re-raising of the objection and in allowing Ms Crawford to view the brochure, I gave her the option of reserving her position on this issue if she so wished. Looking at the document, Ms Crawford indicated that she herself had not seen it elsewhere before, but that she was content to proceed with the hearing and to deal with the Section 3 (1) (b) & (c) objections. I will come back to the extract from the brochure later in this decision.

Having listened to the arguments regarding the Section 3 (1) (b) & (c) objections at the hearing, which essentially restated the case put in correspondence and referred to above, I was not persuaded to waive them. Ms Crawford did not indicate whether any evidence of use of the mark prior to the date of application was available and she did not request any time to make enquiries on this point. She requested one month in which to discuss with her clients how to proceed or indeed the possible withdrawal of the request for protection. This I granted.

Following no further substantive action to progress the case, the application was refused under Section 37(4) of the Act. I am now asked under Section 76 and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

As no evidence of use has been put before me, I have therefore, only the prima facie case to consider.

Sections 3(1)(b) and (c) of the Act read as follows:

**Section 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 rendering of services, or other characteristics of goods or services.**

The mark consists of three common dictionary words. The Collins English Dictionary (Third Edition 1994), gives various meanings. The most pertinent as numbered in the said dictionary, are reproduced below:

- ONE -
  - 1. single; lone; not two or more
- TOUCH -
  - 1. the sense by which the texture and other qualities of objects can be experienced when they come into contact with a part of the body surface, esp. the tips of the fingers.
  - 3. The act or an instance of something coming into contact with the body.
  - 4. a gentle push, tap, or caress
- VIEW -
  - 1. the act of seeing or observing; an inspection.
  - 2. vision or sight, esp. range of vision
  - 4. a pictorial representation of a scene, such as a photograph.

Whilst each mark clearly has its own individual meaning, as shown above, The New Oxford Dictionary of English (1998 edition) also lists the following entry for the words “one-touch” as a phrase in its own right:

**one-touch-** adjective [attrib.] 1 (of an electrical device or facility) able to be operated at or as though at the touch of a button

These references, to my mind, readily establish that when the mark is regarded as a whole, as indeed it is well established in trade mark law that it must be, the objections under Section 3 (1) (b) & (c) of the Act are well founded.

I will deal with Section 3(1)(c) first. The goods specified in the designation are “Telephone apparatus, especially mobile radio telephones”. Section 3(1) indicates under paragraph (c) that the following shall not be registered:

**“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 rendering of services, or other characteristics of goods or services”.**

The words ONE TOUCH VIEW are presented in standard characters, which I have taken to mean that no form of stylisation is claimed by the applicants in the form of notification. There is no other matter in the mark to add distinctiveness to it, save the allusive content the agents have argued in correspondence, but which I do not accept. Given the ordinary dictionary meanings of the words, which although self-evident, I have included above, I believe the mark in totality consists exclusively of words which may serve in trade to designate the “kind”, “quality” and “intended purpose” of the goods. Anyone happening upon the mark will readily take on board its direct descriptiveness of goods which offer a “one touch view” of eg (in the case of the goods in question) text messages sent to the mobile phone and displayed upon its screen, icons displayed on the screen, numbers stored in its memory, etc. The words plainly indicate that this is the “kind” of phone which has a one touch viewing facility. This also indicates to my mind that this would be a desirable “quality” in such goods as compared to less sophisticated models which do not offer such speed or ease of operation. It follows that it would be the “intended purpose” of the goods in question to provide a ONE TOUCH VIEW of various visual options.

By way of corroboration of this, I reproduce below, sample text from the “Alcatel One Touch View” model illustrated in the brochure presented to the agent at the hearing and annexed to this decision. Along with a picture of the phone, the following two extracts can be seen within the text:

C     *“The large screen displays up to 15 characters plus icons and it’s easy to read SMS text messages”.*

C     *“...and there are nine quick dial memories”*

It was suggested by the agents in correspondence that it would be surprising for any trader to describe his telephone as a “one touch” telephone, because of the nature of telephone numbers consisting of country and area codes etc, but this, to my mind, is to ignore the modern trading position in such goods. In my own knowledge I know that many telephones today, mobile or land line, offer memory facilities which allow the user to store often used or important numbers and to access them more easily via quick dial or perhaps one-touch functions.

Further, the agents argued that since telephones are essentially auditory, employing the sense of hearing, the word VIEW is not directly descriptive in relation to these goods, although, potentially, is a covert allusion to there being some form of display, eg of telephone numbers dialled or of received calls. Clearly telephones necessarily have auditory qualities, but again it is in my own and in the common sphere of public knowledge (and indeed is illustrated in the annexed brochure), that many phones today have various viewing facilities, be they to see text messages, numbers dialled or even I believe, pictures via the Internet in some cases. The reference to the word VIEW in the mark, in these circumstances cannot be held to be an allusion to the goods, much less a covert one.

It is my view that the mark as a whole is one that is directly descriptive as shown above and further, is the sort of descriptive statement which other traders would want to, and should therefore be free, to use.

It is for these reasons that I also consider that the mark ONE TOUCH VIEW is devoid of any distinctive character and is therefore also not acceptable, prima facie, for registration under Section 3 (1) (b) of the Act. In this regard, I am guided by the comments of Mr Justice Jacob in the British Sugar Plc and James Robertson and Sons Ltd case (the “TREAT” case) (1996) RPC 281, comments which also go to Section 3(1)(c) of the Act , when he said:

“Next, is “Treat” within Section 3(1)(b)? What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act “inherently” but the idea is much the same) devoid of distinctive character. I also think “Treat” falls within Section 3(1)(c) because it is a trade mark which consists exclusively of a sign or indication which may serve in trade to perform a number of the purposes there specified, particularly to designate the kind, quality and intended purpose of the product”.

His comments above, also support the view that words apt for use by other traders are not registrable in the prima facie case but instead require the benefit of use if they are to adequately perform the function of a trade mark. While I do not contend that the words ONE TOUCH VIEW are the only way other traders could describe similar goods, I think the following comments of Mr Hugh Laddie in the PROFITMAKER case (1994) 17 RPC at page

616 lines 38-44 are also helpful in determining whether a mark of this sort is acceptable for registration in the prima facie case. He said:

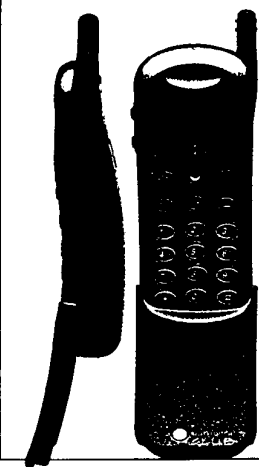
“The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the marks. If it were, then all of these alternative ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the Register to ensure that common descriptions or laudatory words or not unusual combinations of them, have been monopolised by others”.

In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this designation and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3 (1) (b) and (c) of the Act.

**Dated this 16 day of February 2000**

G J ROSE' MEYER  
For The Registrar  
The Comptroller General

## Alcatel One Touch Club

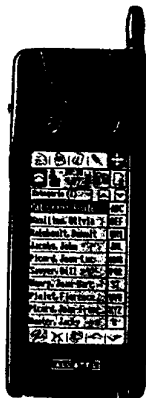


**COMMENTS:**

At 175g and 133x51x24mm it feels clunky. Good battery life—120 hours standby/5.7 hours talktime. Only two lines of text and a row of icons onscreen. Can store up to 250 numbers. It has nine quick dial numbers, but just two ring tones. 250 memories on the phone. Appointment feature means the phone will remind you about important dates. The sliding cover doesn't feel secure and it can't be used to answer calls. Great control of the last made and received calls. £9.99 or £69.99 on Pay As You Talk.

**CONTACT NUMBER:** 0800 330030

## Alcatel One Touch Com



**COMMENTS:**

Also available as the Sharp MC-G1. It has a touch-screen and can send email. However, it can't send or receive faxes. It measures 142x21x57mm and weighs 249g. The NiMH battery gives up to 45 hours on standby, 2.5 hours talktime. Only five ring tones. Lots of extras, including a world clock, calendar, contacts book and excellent text messaging creation.

**CONTACT NUMBER:** 0800 330030

## Alcatel One Touch Pocket

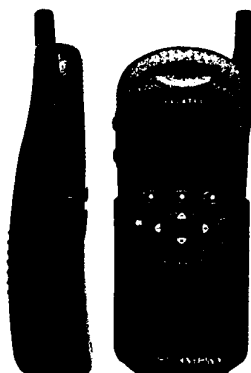


**COMMENTS:**

Sophisticated and stuffed with features including a calendar and calculator. The Li-ion battery delivers up to 80 hours on standby and three hours talktime, but it has a labyrinthine menu system and a poor manual. Light at 125g and slim at 116x59x19mm. The standby screen has the usual battery and signal strength indicators. Stores up to 100 names and addresses, plus the additional memories on the SIM. There are also nine quick dial memories. £79.99

**CONTACT NUMBER:** 0800 330030

## Alcatel One Touch View



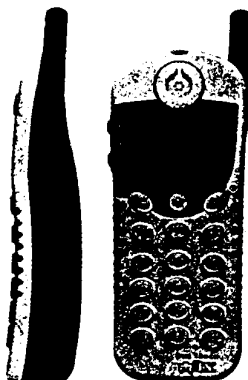
**MOBILE**  
Editors choice

**COMMENTS:**

Dinky budget phone. Quite light at 160g, small at 133x54x25mm. The NiMH battery lasts for 60 hours on standby, 2.5 hours talktime. The large screen displays up to five lines of 15 characters plus icons and it's easy to read SMS text messages. 50 numbers can be stored in both the phone's two memories and there are nine quick dial memories. Can use alkaline batteries. Desktop charger as standard. Will store last missed 10 calls. Bin the slider. £29.99

**CONTACT NUMBER:** 0800 330030

## Alcatel One Touch Max

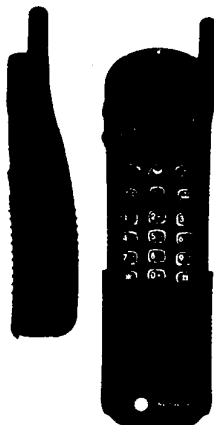


**COMMENTS:**

One of the cheapest contract phones available at £14.99. It's not that heavy at 160g, but its 133x55x24mm dimensions are bulky. The NiMH battery lasts for up to 120 hours on standby and three hours and 45 minutes talktime. You can also use three AA alkaline batteries, which deliver up to 75 hours on standby and one hour talktime. The user interface may take some getting used to, partly because there isn't the room for onscreen prompts. The phonebook is stored on the SIM card and there are nine speed dial numbers. A desktop charger comes as standard.

**CONTACT NUMBER:** 0800 330030

## Alcatel One Touch Easy



**COMMENTS:**

At 160g and 133x54x25mm, the Easy is hardly miniature, but it's not bad for a budget phone. The Easy has features that you wouldn't expect to see on a phone costing £19.99. There's a speakerphone setting and the phone comes with a desktop charger. Other pluses include a battery saving option where the phone turns off during idle periods and an appointment alarm. The NiMH battery lasts for up to three hours and 45 minutes talktime or 120 hours standby. The menu system is based on long and short key presses, which can make things confusing.

**CONTACT NUMBER:** 0 0800 330030