

**BEFORE:  
MR SIMON THORLEY QC**

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**AND**

**IN THE MATTER OF APPLICATION NO 2182437A  
BY CABLE AND WIRELESS PLC TO REGISTER A  
TRADE MARK IN CLASSES 16, 36 & 38**

**AND**

**IN THE MATTER OF AN APPEAL FROM THE  
DECISION OF MR R A JONES DATED 27 JUNE 2000**

**MR TIBOR GOLD (of Stephenson Harwood)  
appeared on behalf of the Applicant**

**MR A JAMES (Principal Hearing Officer)  
appeared as the Registrar's Representative**

**D E C I S I O N**

MR THORLEY: This is an appeal from a decision of Mr Jones, the officer acting for the Registrar, dated 27<sup>th</sup> June 2000 in relation to an application by Cable and Wireless Plc to register a trade mark in Classes 16, 36 and 38. The application consists of four related marks composed of the words CAN AND WILL in capitals, or with initial capitals, combined with the word AND in upper or lower case, or with the ampersand symbol. Initially there were six marks in the group, the last two consisting of the words CAN AND WILL.COM. These latter two have now been registered in respect of a separate application.

Mr Jones dealt first with the Class 36 and 38 registrations for services, and concluded as follows: “I consider the words, in combination, to be an ordinary statement of the quality of service offered to the customer - a ‘can do’ approach so that not only are the applicants saying that they are able to provide a service or deliver goods but that they will do so. As such I consider it typical of advertising strap lines making promises to the customer, is not an invented phrase and is a phrase that other traders should be free to use when advertising their services.”

As a result he concluded that it would be the sort of sign that could be used in the course of trade to designate the quality of the services provided, and thus found that registration would be contrary to Section 3(1)(c) of the Act since there was no evidence of prior distinctiveness as a result of use.

When considering the question of goods in class 16, Mr Jones felt that he could waive the objection under Section 3(1)(c) but none the less maintained the objection under Section 3(1)(b) on the ground that the words CAN AND WILL constituted the sort of strap line “which could be used in advertising the delivery of the goods at issue, eg that they can and will be delivered on time.”

Mr Gold, who appeared before me on behalf of the applicant, realistically accepted at the outset that this application was a borderline case, but he submitted the Hearing Officer had held it to be on the wrong side of the border. He accepted that the words “can do” would not be registrable without evidence of use leading to distinctiveness, but contended that the words

CAN AND WILL were a sufficient variation of “can do” to be registrable without evidence of use.

Mr James likewise accepted that the last two marks, CAN AND WILL.COM, were just over the border of registrability, but contended that CAN AND WILL too closely resembled CAN DO to be registered.

Mr Gold invited me to consider two additional matters. First, that although regard should be had to the question that honest men should not have to look for a defence - a quotation from the decision of Mr Robin Jacob QC in the **COLOURCOAT** trade mark [1990] RPC 511 at 517 and recited in Mr Jones’ decision - this has to be approached with some caution. Secondly, he said that I should place some weight on the fact that the equivalent mark has been registered in respect of equivalent goods and services as a Community Trade Mark under No 000993105, which was registered on 10<sup>th</sup> May 2000.

I shall consider each of these, but I should first observe that in the course of argument before me neither Mr James nor Mr Gold was minded to draw any great distinction between the question of the registration in respect of services and the registration in respect of goods. I have to say that I agree. I do not see that there is any logical distinction between registering the mark CAN AND WILL for goods related to financial or communications services and registration in respect of services themselves. I propose to consider the matter as one.

I turn then to consider Mr Gold’s two points. The question of whether or not a mark should be registered in circumstances where it might cause honest men to look for a defence is plainly a consideration that all tribunals must take into account. As matters stand at present, this is particularly important since one has to accept, following the observations of the Court of Appeal in **Philips v Remington** [1999] RPC 809, that objection can be taken on the grounds of infringement to use of a sign in a non trade mark sense. The only protection to a trader using a mark in a none trade mark sense is that provided by Section 11(20). But, equally, once one accepts, as I believe one must, that this is a trade mark which could be registered on proof of distinctiveness, there being no objection under Section 3(1)(a), the consideration relating to

honest traders has less force because once the mark is registered on proof of distinctiveness then the honest trader will have to, and can only, rely on the provisions of Section 11(2). Whilst therefore it is plainly a matter to be taken into account, it could not be decisive. The Act provides for registration and provides for the defence.

5 Secondly, the community trade mark. In this case the mark was registered without evidence of acquired distinctiveness in respect of similar classes of goods and services. Mr James accepted that it was a matter to be taken into account, but quite rightly said that it could not be decisive. The decision is not binding either on the Registry or on me. Mr James particularly drew my attention to the fact that this is not a case where there has been a  
10 reasoned decision from the community trade mark registry which indicates what process they adopted and whether they were mindful of the fact that the expression CAN DO could not be registered. I think there is force in these observations. Equally, there is force in the observation that there are bound to be cases where the registry in this country and the registry in Alicante come to different conclusions on the same facts, just as different Hearing Officer  
15 and this tribunal may come to different conclusions. Plainly it is desirable to strive for comity, but that cannot be an overriding factor. I therefore do not feel that the registration of CAN AND WILL at Alicante is decisive in this case.

I come back then to first principles and ask the basic question, is the expression CAN AND  
20 WILL used in relation to communication and financial services, and goods to be used in relation to such services, devoid of distinctiveness? Is it so indicative of quality that it should not be registered?

Mr James said this was a matter of first impression, I think he is right. Is there a sufficient  
25 variation between CAN AND WILL and CAN DO? I believe there is - just. I have paid careful regard to my own observations in **DAY BY DAY**, which I remain satisfied is correct. One must have regard to natural use in the context of advertising, and this is particularly so where one is considering service marks.

30 None the less, I do not feel that CAN AND WILL is of itself an expression that is likely

naturally to be used as part of an advertisement. I have no personal knowledge of it ever having been used, and no material has been put before me showing it to be used. Not without some hesitation, I have come to the conclusion that this is a mark which does just qualify for registration without evidence of use. If any of the factors I have taken into account in reaching my conclusion are factually incorrect, no doubt those can be raised on an opposition by an interested party. But I should make it plain that my decision is not based on the fact that the possibility of opposition is open. It is based on the fact that I have come to the conclusion that, narrowly, this mark qualifies for registration. The appeal will therefore be allowed.

Under the usual practice, Mr Gold, you do not get any costs.

MR GOLD: I am not pressing for any, sir.

MR THORLEY: Thank you very much.