TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2360946
BY O2 LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 9, 16, 38 AND 41

BACKGROUND

1. On 15th April 2004 O2 Limited of Wellington Street, Slough, Berkshire, SL1 1YP applied under the Trade Marks Act 1994 for registration of the following trade mark in classes 9, 16, 38 and 41:

2. The goods and services for which registration are sought are:

Class 09

Apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; computer hardware; computer software; computer software downloadable from the Internet; PDA's (Personal Digital Assistants), pockets PC's, mobile telephones, laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; computer software onto CD Rom, SD-Card, parts and fittings for all the aforesaid goods; downloadable electronic publications; downloadable electronic tariffs; downloadable electronic tariffs relating to telecommunications.

Class 16

Printed matter; printed tariffs; printed tariffs relating to telecommunication services.

Class 38

Telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; Internet access services; application services provision; email and text messaging service, support services relating to telecommunication networks and apparatus; monitoring services relating to telecommunications networks and apparatus; information and advisory services relating to the aforesaid.

Class 41

Education; providing of training; entertainment; interactive entertainment services; electronic games services provided by means of any communications network; entertainment and information services provided by means of telecommunication networks; sporting and cultural activities; provision of news information; information and advisory services relating to the aforesaid.

3. Objection was taken to the mark in classes 9 and 41 under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of a stylised device of a hand control for a video game, being a sign which may serve in trade to designate the nature of the goods and services e.g. video game apparatus, online video games.

4. A hearing was held on 30th September 2005 at which the applicant was represented by Mr Stobbs of Boult Wade Tennant, their trade mark attorney. Following the hearing the objection under Section 3(1)(b) and (c) of the Act was maintained.

5. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

The Law

7. Section 3(1)(b) and (c) of the Act reads 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,"

The case for registration

8. At the hearing Mr Stobbs raised his concerns that the objection appears to have been raised simply because that the mark is an icon found on the screens of mobile phones and computers etc. Mr Stobbs stressed that whereas some icons may well be generic others are clearly trade marks. I fully agreed that icons may be generic or totally distinctive and assured him that this application had been examined independently from other icons and judged as an independent mark in relation to the goods and services applied for.

Decision – Section 3(1)(c)

9. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM),* Case - 191/01 P, (the DOUBLEMINT case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 28 - 32 of the judgement are reproduced below:

"28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being

reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee,* paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-0000, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned."

10. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods and services in question.

11. It is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods and services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to these goods and services I consider the average consumer to be the general public and organisations of varying sizes. I accept that some of the goods and services in question may be considered to be relatively sophisticated which will be purchased with a degree of care.

12. The purchasers, and potential purchasers, of the goods and services in question purchase them because they satisfy their own personal requirements regarding the specifications and facilities that they offer. In relation to phones, computers, laptops, other electronic communication devices, interactive entertainment, education and training services, the mark would signify that these goods and services feature games. In the case of drivers and software for phones etc. the mark designates the intended purpose of the goods as being to provide a game option.

13. Mr Stobbs has sought to persuade me that this particular device, in this particular arrangement, in the colour yellow, is distinctive of the goods and services for which registration is sought in classes 9 and 41. The device of a games console does possess an abstract quality. It is not a particularly clearly defined representation of a games console, but in my view it will be perceived as a representation of a games console by the relevant consumer. The mark as represented on the form of application has an abstract quality because it is lacking in detail. This is partly because of the size it has been reduced to on the form: 9 x 6 mm. In any event, as Mr Stobbs appears to acknowledge, it is the sort of abstraction common to many screen icons on electronic

apparatus and web site interfaces. Abstract descriptive pictures are commonly used on packaging and promotional material to indicate either characteristics of the goods or a product or environment where the goods in question may be used. The device is clearly a representation of a games console coloured yellow. In my view, this is a descriptive device which indicates that the goods and services provided under such a mark relate to games or the provision of games. A sign such as this is a perfectly apt way to indicate that the goods and services in question provide such a feature.

14. The relevant consumer of such goods and services would therefore, in my view, perceive this mark as no more than an indication that games facilities are offered as one of the features available, either on the goods themselves or as part of the service package provided. The fact that this particular trade mark is represented in the colour yellow does not persuade me that this by itself bestows distinctive character on the mark to the extent that it becomes capable of performing the function of a trade mark. Screens on modern mobile phones, laptops, computers and other communication devices are full of colour. They display numerous icons in a wide variety of colour. Similarly, pictorial designs on packaging and promotional material are often in colour. Without evidence which successfully demonstrates that the consumers of such goods and services place reliance on this sign in this particular colour to designate the goods and services of a single undertaking I do not consider that it converts the trade mark applied for from a descriptive and non-distinctive sign into one which satisfies the requirements of Section 3(1)(c) of the Act. In order to achieve that the sign must guarantee that the goods and services originate from a single undertaking.

15. This colour as applied to this mark does not alter my conclusion that the objection taken under Section 3(1)(c) of the Act is correct. Games consoles are available in a wide variety of colours and there is nothing striking or unusual about this particular colour which would be capable of denoting trade source.

16. If the mark was used as an icon on the screen of a mobile phone, computer, laptop or other communication device the sole function of this mark would be perceived by the relevant consumer as being to allow the user to identify the facilities designated by the design of the icon. Such uses of this mark are examples of normal and fair use of the mark in relation to the goods and services for which registration is refused. In other uses, such as on packaging or promotional material, the significance of the mark as a descriptive sign would still be apparent to the average consumer. While I accept that some icons appearing on such screens may be there in order to identify the service provider, and I also accept that some may be successful in such a function, it remains my view that this sign does not perform such a function. This mark is a games console represented in the colour yellow and in relation to the goods and services in classes 9 and 41 it will indicate that games entertainment goods and services are available and will convey no other message.

17. Finally, I note that it is clear from the hearing report that, at the hearing, Mr Stobbs accepted that this particular icon is in general use by the applicant and others in relation to at least some of the goods and services applied for in classes 9 and 41 and further agreed that the claim to the colour yellow does little to assist this application.

18. Consequently, I have concluded that the mark applied for consists exclusively of a sign which may serve in trade to designate a characteristic of the goods and services in classes 9 and 41 and is debarred from registration under Section 3(1)(c) of the Act.

Decision – Section 3(1)(b)

19. Having found that this mark is to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

20. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01* *Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

> "37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.
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> .....
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> *39.* Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.
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> 40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).
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> 41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and *circumspect (see Case C-*210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).
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> .....
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> 47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

21. I am not persuaded that this trade mark, which consists of a representation of a

games console coloured yellow, is sufficient, in terms of bestowing distinctive character on the sign as a whole in respect of the goods and services identified in classes 9, 16, 38 and 41 to conclude that it would serve, in trade, to distinguish the goods and services of the applicants from those of other traders.

22. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that for the same reasons that the mark applied for is debarred from registration by Section 3(1)(c) of the Act it is also devoid of any distinctive character and is therefore excluded from prima facie acceptance in classes 9 and 41 under Section 3(1)(b) of the Act.

Bona fide intention to use mark on all goods and services applied for-

23. It is clear from statements made at the hearing and in correspondence that Mr Stobbs has confirmed that the mark applied for is an icon which appears on computer screens, laptop screens, mobile phones and screens for other communication devices. However, the specifications applied for appear to be much wider than the goods and services for which this mark is intended to be used. By way of example the specification in Class 9 covers all telecommunication apparatus and all apparatus for the transmission of sound and images and in Class 16 all printed matter. The specification in Class 38 covers all telecommunication services and all Internet portal services and class 41 covers all education, training and entertainment services. I raise this point as an issue which may need to be considered further in the event of a successful appeal against my decision.

24. Although no objection was raised against the goods and services contained in the specifications in classes 16 and 38 I consider this mark to be descriptive of telecommunication services offering gaming options and printed tariffs for goods and services with gaming options and a further objection to these goods and services will be raised subject to the outcome of this appeal.

CONCLUSION

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

Dated this 7th day of June 2006

A J PIKE
For the registrar
The Comptroller-General