

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATIONS NOS 2360930,  
2360935, 2360938, 2360944, 2360945, 2360946 AND 2360950  
BY O2 HOLDINGS LIMITED**

**AND IN THE MATTER OF APPEALS  
TO THE APPOINTED PERSON  
AGAINST DECISIONS THEREIN OF MR A J PIKE  
DATED 11 JULY 2006, 10 MAY 2006, 20 JUNE 2006, 20 JUNE 2006, 6 JUNE  
2006, 7 JUNE 2006 AND 22 JUNE 2006 RESPECTIVELY**

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**DECISIONS**

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**Introduction**

1. It is accepted that: (a) these appeals involve icons for use on computer and mobile telephone screens; and (b) depending on content, a screen icon can be a trade mark even though it represents to the user a program, option or window especially one of several for selection.
2. O2 Holdings Limited (“the Applicant”<sup>1</sup>) seeks to register as trade marks the icons included in its “O2 Active” services package. Mr. Julius Stobbs of Messrs. Boulton Watt & Tennant, who represented the Applicant on appeal, told me that the Registry had accepted two such applications for publication. Mr. Allan James, on behalf of the Registrar, confirmed that he had no objection to Mr. Stobbs providing me with a printout of the Applicant’s web page presenting (most of) the O2 Active icons.
3. I am concerned with seven applications that were filed on 15 April 2004. All the applications request registration of their subject icons in respect of (the same) specifications in Classes 9, 16, 38 and 41. Applications numbers 2360930 and 2360950 claim additional services, the former in Classes 35, 36, 39, 42, 43 and 44 and the latter in Class 45.
4. The Hearing Officer, acting for the Registrar, refused the applications as being contrary to section 3(1)(c) and 3(1)(b) of the Trade Marks Act 1994 (“the TMA”). In most cases, he decided that the grounds for refusal pertained or should pertain to all the goods and services applied for. Application number 2360935 escaped objections in Class 16 and it is common ground that the extent of goods and services objected to in Application number 2360930 is unclear.

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<sup>1</sup> Originally O2 Limited.

5. Within the due times, the Applicant filed notices of appeal to an Appointed Person under section 76 of the TMA. The appeals were listed before me for hearing together. Mr. Stobbs chose to present the Applicant's generally applicable arguments on appeal in relation to Application number 2360944. He then dealt more specifically with each application in turn.
6. The appeals commonly raise *inter alia* three important issues (in no particular order):
  - (i) Do the marks applied for consist *exclusively* of signs or indications precluded by section 3(1)(c) of the TMA?
  - (ii) Are the designations in suit ones, which may serve, in trade, to designate characteristics of goods and services contrary to section 3(1)(c) of the TMA and, if so, to what extent?
  - (iii) If the marks are found to be unobjectionable under section 3(1)(c) of the TMA, must the objections under section 3(1)(b) fall away?
7. Mr. James was similarly content to centre the Registrar's responses to the appeals on Application number 2360944 before dealing with each application individually. I intend to follow the same strategy having considered first, the disputed grounds for refusal of registration and second, the standard of appeal.

### **Grounds for refusal of registration**

8. Section 3(1) of the TMA states:

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

  - (a) signs which do not satisfy the requirements of section 1(1),
  - (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 services, or other characteristics of goods or services,
  - (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade.

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.”
9. Section 3(1) of the TMA implements Article 3(1)(a) – (d) and (3) of Council Directive 89/104/EEC (“the Directive”) and is the equivalent of Article 7(1)(a) – (d) and (3) of Council Regulation (EC) 40/94 (“the CTMR”). The case law of the Court of Justice of the European Communities (“the ECJ”) and the

Court of First Instance (“CFI”) on those Articles in the Directive and the CTMR is applicable to the interpretation of section 3(1) (*O2 Holdings Ltd v. Hutchison 3G Ltd* [2006] ETMR 677, Lewison J., paragraphs 62 – 63) .

10. The Hearing Officer made no objections to the applications under section 3(1)(d) of the TMA. Nor did the Applicant claim the benefit of the proviso to section 3(1), i.e., no evidence of distinctiveness acquired through use was adduced.

### **Approach under section 3(1)**

11. The approach is well established and is summarised by the ECJ in Case C-363/99 [2004] ECR I-1619, *Koninklijke KPN Nederland NV v. Benelux-Merkenbureau (POSTKANTOOR)* at paragraphs 67 – 70:

- “67. ... it is clear from Article 3(1) of the Directive that each of the grounds for refusal listed in that provision is independent of the others and calls for a separate examination (see, inter alia, *Linde*, paragraph 67). That is true in particular of the grounds for refusal listed in paragraphs (b), (c) and (d) of Article 3(1), although there is clear overlap between the scope of the respective provisions (see to that effect Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraphs 35 and 36).
68. Furthermore, according to the Court’s case-law, the various grounds for refusing registration set out in Article 3 of the Directive must be interpreted in the light of the public interest underlying each of them (see in particular Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 77, *Linde*, paragraph 71, and *Libertel*, paragraph 51).
69. It follows that the fact that a mark does not fall within one of those grounds does not mean that it cannot fall within another (see to that effect *Linde*, paragraph 68).
70. In particular, it is thus not open to the competent authority to conclude that a mark is not devoid of any distinctive character in relation to certain goods or services purely on the ground that it is not descriptive of them.”

12. In accordance with Article 13 of the Directive<sup>2</sup>, competent authorities must examine applications for registration of trade marks against the grounds for refusal listed in Article 3 with regard to each of the goods or services claimed (*POSTKANTOOR*, paragraph 73). An official examination must be thorough and full, and take into account all the relevant facts and circumstances including the perceptions of the relevant public, who are reasonably well informed and reasonably observant and circumspect (*POSTKANTOOR*,

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<sup>2</sup> Article 13 of the Directive states: “Where grounds for refusal of registration ... of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for ... refusal of registration ... shall cover those goods or services only”.

paragraphs 123 and 31 – 37). A decision of a competent authority to refuse registration wholly or in part must, in principle, give reasons in respect of each of the individual goods or services. However, where the same ground for refusal is given for a category or group of goods or services, an office may use only general reasoning for all the goods or services concerned (Case C-239/05, *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau*, 15 February 2007, paragraphs 34 – 38). National legislation governs the scope of tribunal review of a competent authority’s decision under Article 3 of the Directive (*BVBA*, paragraphs 43 – 48 and 60 – 61).

### **Section 3(1)(c)**

13. The Hearing Officer sought guidance from Case C-191/01 P, *OHIM v. Wm. Wrigley Jr. Company (DOUBLEMINT)* [2003] ECR I-12447 where the ECJ said at paragraphs 28 - 32:
  - “28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any 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, geographical 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 the 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 under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”
14. *DOUBLEMINT* makes clear that a designation with several meanings can fall foul of section 3(1)(c). The word “exclusively” in section 3(1)(c) relates instead to the content of the mark. That was indicated by the ECJ in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v. Boots- und Segelzubehör Walter Huber and Franz Attenberger* [1999] ECR I-2779 at paragraph 25 (emphasis added):

“25. However, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, *including as collective marks or as part of complex or graphic marks*”.

And explained by the ECJ in Case C-383/99 P, *Procter & Gamble Company v. OHIM (BABY-DRY)* [2001] ECR I-6251 at paragraph 39:

“39. The signs and indications referred to in Article 7(1)(c) of Regulation No. 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”

15. In the absence of distinctiveness acquired through use, a trade mark that falls within section 3(1)(c) is necessarily devoid of any distinctive character under

section 3(1)(b) (*POSTKANTOOR*, paragraph 86). But the converse is not always true. Even though a mark is pronounced not “exclusively descriptive” for 3(1)(c), it may still lack the requisite distinctive character when assessed overall against the public interest underlying section 3(1)(b) (*POSTKANTOOR*, paragraphs 70, 86, Case C-329/02 P, *SAT.1 SatellitenFernsehen GmbH v. OHIM (SAT.2)* [2004] ECR I-1619, paragraph 42).

16. The wording of section 3(1)(c) is sufficiently broad to cover a wide variety of trade marks including functional non-verbal signs (Joined Case C-53/01 to C-55/01, *Linde AG, Winward Industries Inc and Rado Uhren AG* [2003] ECR I-3161, paragraph 69, *Dyson Ltd’s Trade Mark Application* [2003] RPC 821, Patten J., paragraphs 22 – 24).

### **Section 3(1)(b)**

17. The public interest behind section 3(1)(b) is that a trade mark should perform its essential function of indicating the source or origin of the goods or services concerned. The Hearing Officer referred to paragraphs 37, 39 – 41 and 47 of the ECJ’s judgment in *Linde*:

“37. It must first of all be observed 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.

[...]

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.

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).

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).

[...]

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.”

18. Similarly in *SAT.2* the Court explained (at paragraphs 23 – 28):

“23. First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product 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, in particular, Case 107/77 *Hoffmann-La Roche* [1978] ECR 1139, paragraph 7, and Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 30). Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.

24. Secondly, in order to determine whether a sign presents a characteristic such as to render it registrable as a trade mark, it is appropriate to take the viewpoint of the relevant public. Where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (see Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26, and Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 46).

25. Thirdly, it is important to observe that each of the grounds for refusal listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).

26. As regards the registration as trade marks of colour per se, not spatially delimited, the Court has already ruled, in *Libertel*, paragraph 60, that the public interest underlying Article 3(1)(b) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), a provision which is identical to Article 7(1)(b) of the regulation, is aimed at the need not to

restrict unduly the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.

27. Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Article 7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in paragraph 23 above.
  28. Finally, as regards a trade mark comprising words or a word and a digit, such as that which forms the subject-matter of the dispute, the distinctiveness of each of those terms or elements, taken separately, may be assessed, in part, but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those elements, considered separately, is devoid of any distinctive character does not mean that their combination cannot present a distinctive character (see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-0000, paragraphs 40 and 41, and C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-0000, paragraphs 99 and 100).”
19. SAT.2 emphasises that the determination of distinctive character must be of the mark as a whole (paragraphs 28, 35 and 43). Registrability is not dependent on a specific level of creativity or imaginativeness (SAT.2, paragraph 41, Case C-64/02 P, *OHIM v. Erpo Möbelwerk GmbH (DAS PRINZIP DER BEQUEMLICHKEIT)* [2004] ECR I-10031, paras. 31 and 32). Moreover, the overall perception an average consumer has of a trade mark may be conditioned by practices in the marketplace. In SAT.2, the frequent use in the telecommunications sector of word and number trade marks indicated that SAT.2 could not in principle be devoid of any distinctive character (see paragraph 44 of the ECJ’s judgment; see also the ECJ jurisprudence on the registrability of shape marks, e.g., Joined Cases C-456/01 and C-457/01 P, *Henkel KGaA v. OHIM* [2004] ECR I-5089, paragraphs 38, 39 and 56).

### **Standard of review**

20. An appeal to the Appointed Person against an ex parte decision of the Registrar is by way of review and not rehearing (*Dyson Limited’s Trade Mark Application* [2003] RPC 821, Patten J. at paragraphs 4 - 14). The approach is as articulated by Robert Walker L.J. in *REEF Trade Mark* [2003] RPC 101 at paragraphs 28 - 29 (see also *DU PONT Trade Mark* [2004] FSR 293 at paragraph 94):

“In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.



The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed.”

If the Hearing Officer is shown to have made a material error, I must decide whether in the circumstances the overriding objective is best achieved through remitting the application(s) to the Registry or determining the objections myself.

**Application No. 2360944**

21. UK Trade Mark Application number 2360944 (“the Envelope Application”) was filed on 15 April 2004 and stands in the name of the Applicant. It requests registration of the following trade mark in Classes 9, 16, 38 and 41:



The Envelope Application states that the Applicant claims the colour blue for the mark.

22. The specifications of goods and services are:

Class 9

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 telecommunications networks; sporting and cultural activities; provision of news information; information and advisory services relating to the aforesaid.

## **The Hearing Officer's decision**

23. In a decision, dated 20 June 2006 (BL O/170/06), the Hearing Officer rejected Application number 2360944 for all the goods and services in Classes 9, 38 and 41 and intimated that, subject to the outcome of any appeal, a late objection ought to be taken to printed tariffs in Class 16. He summarised his reasons as follows (paragraph 3):

“3. Objection has been taken to the mark in classes 9, 38 and 41 under Section 3(1)(b) and (c) of the Act because the mark consists [of a] device of an envelope, being a sign which would not be seen as trade mark as it is devoid of any distinctive character. This is because such signs are commonly used as computer icons, used to direct the user around an Internet site or other interactive computer or communications equipment. The mark is considered to be descriptive of a characteristic of the goods and services i.e. goods and services relating to the provision of e-mail facilities.”

24. The Applicant observes that the Registry vacillated between section 3(1)(b) and 3(1)(c) during examination of the Envelope Application on absolute grounds. Nevertheless, both sides accept that the Hearing Officer's main objection was under section 3(1)(c) of the TMA. The Hearing Officer's approach was primarily to ask himself whether the mark was descriptive, i.e., whether the mark conveyed information about the characteristics of the goods and services concerned.
25. The Hearing Officer's reasoning under section 3(1)(c) is set out below (paragraphs 12 – 19):

“12. 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. As I have indicated at Paragraph 10 of this decision Mr

Stobbs is of the view that “it is impossible for a device of this sort to be descriptive”. I do not accept this submission because I can see no reason why it is impossible for a particular type of sign to be descriptive of the goods and services applied for. I consider my view to be supported by the decision of the High Court of Justice in the appeal by Dyson Limited against a decision of the Registrar [2003] EWHC 1062 (Ch). In this case The Honourable Justice Patten confirmed that the application to register a clear bin for vacuum cleaners was caught by the provisions of Section 3(1)(c) of the Act. I consider this to be a clear authority for the proposition that a functional non-verbal sign may be excluded under Section 3(1)(c) of the Act.

13. Furthermore, 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.

14. The purchasers, and potential purchasers, of the goods and services in question purchase them because they satisfy their own personal requirements regarding the specification they offer. In relation to telecommunication and e-mail services and supporting goods and services for these goods and services such as downloadable electronic tariffs, the mark simply designates the kind of goods and services. In relation to phones, computers, laptops, other electronic communication devices, Internet application services, interactive entertainment, education and training services, news services and information services, Internet access services, e-mail and text messaging and monitoring services the mark would signify that these services can communicate with or be accessed via e-mail, which is a characteristic of such goods and services. In the case of drivers and software for phones the mark designates the intended purpose of the goods, i.e. provision of e-mail facilities.

15. Mr Stobbs has sought to persuade me that this particular device, in this particular arrangement, in the colour blue, is distinctive of the goods and services for which registration is sought in classes 9, 38 and 41. 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: 8 x 5 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. Signs such as these are commonly used on packaging or promotional material to indicate either the contents or a product or the environment in which the goods in question may be used. The device is clearly a representation of an envelope which is itself commonly used as a descriptive sign to indicate that e-Mail facilities are available or to

indicate that the user has received an e-Mail message. A sign such as this is a perfectly apt way to indicate that the goods and services in question provide such a feature.

16. The relevant consumer of such goods and services would therefore, in my view, perceive this mark as no more than an indication that messaging and/or e-mail facilities are offered as one of the features available, either on the goods themselves or as part of the service package.

17. Mr Stobbs referred me to the fuzzy appearance of the sign but it appears that this only occurs when the sign is enlarged when photocopies or otherwise represented in an enlarged form. The mark filed on the form of the application is small in size and I note that on this representation the fuzzy appearance does not appear to exist. The fact that this particular trade mark is represented in the colours blue and white 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. These colours as applied to this mark do not alter my conclusion that the objection taken under Section 3(1)(c) is correct.

18. 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 screens may be there in order to identify the service provider, and I accept that some may be successful in such a function, it remains my view that this sign does not perform such a function whether it is used on a screen or otherwise.

19. 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, 38 and 41 and is debarred from registration under Section 3(1)(c) of the Act.”

26. Turning to the objection under section 3(1)(b) of the TMA, the Hearing Officer said (paragraphs 23 – 24):

“23. I am not persuaded that this trade mark, which consists of a representation of an envelope coloured blue and white, 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, 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.

24. 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 under Section 3(1)(b) of the Act.”

### **The appeal**

27. The Hearing Officer records in his decision: “At the hearing Mr Stobbs accepted that devices of envelopes are commonly used to represent e-mail and messaging facilities ...” (paragraph 9). The Hearing Officer also quotes a passage in a letter written by Mr Stobbs following the hearing, dated 21 December 2005 (paragraph 10):

“We spent a lot of time discussing these matters, as you know, and I made it very clear that it is impossible for a device of this sort to be “descriptive”. These devices are not inherently descriptive of anything. It is arguable, and I agree borderline, that they may be considered devoid of distinctive character because third parties have adopted similar devices to refer to generic services. However, that does not make the device(s) “descriptive”.”

At the appeal hearing, Mr. James commented: “One would have to be living on the moon not to know that an envelope is a routine way of representing an e-mail”. Thus, even absent Mr. Stobbs’ concession, the Hearing Officer and I would be entitled to take judicial notice of that fact.

28. The perceptions of the average consumer regarding signs or indications that may serve, in trade, to designate characteristics of goods and services for the purposes of section 3(1)(c), are to be judged at the time of application for registration (*BACH AND BACH FLOWER REMEDIES Trade Marks* [2000] RPC 513 at 525 – 526, Morritt L.J. and 534, Chadwick L.J.) although “may” in section 3(1)(c) contemplates future trade usages (*WINDSURFING*, paragraph 31, *DOUBLEMINT*, paragraph 32, *POSTKANTOOR*, paragraph 56).

29. I did not understand Mr. Stobbs to retract from his concession on appeal. Instead, his arguments were as described at paragraph 6 above. In brief, Mr. Stobbs says the Hearing Officer erred under section 3(1)(c) because:

- (i) The mark applied for is a particular schematic and stylistic device of an envelope in shaded blue. The mark does not consist exclusively of signs or indications that designate characteristics of the goods or services applied for.
- (ii) Whilst the mark might allude to e-mail, it does not describe the goods or services in the application.

30. Mr. James' responses in brief are:
- (i) The get-up – colour etc. – of the envelope makes no difference.
  - (ii) Section 3(1)(c) of the TMA should be given a broad interpretation to include signs or indications which convey information about the goods or services concerned without necessarily defining a characteristic(s) of those goods and services.
31. In support of his first argument, Mr. Stobbs referred me to three authorities. The first is the decision of Patten J. in *Dyson*. Whilst the Hearing Officer correctly cited the decision as authority for the fact that section 3(1)(c) extends to non-verbal signs, Mr. Stobbs contends that the Hearing Officer did not have sufficient regard to the reasoning of the judge in that case. The mark in *Dyson* consisted of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner. Registration was sought inter alia for vacuum cleaners. Mr. Stobbs notes that the judge concluded that the mark fell within section 3(1)(c), not because it was a true representation of part of the product itself, nor because it told the public when the dust collection bin was full, but because the mark indicated to the public that the cleaner was bagless<sup>3</sup>. The second case is the CFI decision in Case T-128/01, *DaimlerChrysler Corporation* [2003] ECR II-00701. The *DaimlerChrysler* case is in fact concerned with Article 7(1)(b) of the CTMR and not Article 7(1)(c). However, the point Mr. Stobbs wishes me to take from the CFI decision is that a schematic 2D representation of the grille of a JEEP vehicle was not objected to on the basis that it corresponded to part of the product or indicated to the consumer that the vehicle had a grille. Thirdly, Mr. Stobbs referred me to the decision of the Court of Appeal in *Koninklijke Philips Electronics NV v. Remington Consumer Products* [2006] FSR 537 involving inter alia three device marks consisting of schematic representations of the head of a rotary shaver with three cutting heads. Whilst the device marks conveyed clear descriptions of the goods when used in relation to shavers, the stylised presentations meant that they were not caught by section 3(1)(c) (paragraph 102).
32. Mr. James sought to distinguish the cases on the basis that each involved unique products. Further, in *Philips*, two out of the three device marks were subject to disclaimers as to the exclusive use of a device of an electric shaving head and Philips did not seek to allege that Remington's shavers or packaging infringed any of the device marks.
33. I believe that in relation to Mr. Stobbs' first argument, the Hearing Officer did err in his application of section 3(1)(c), essentially through failing to keep separate the requisite approaches for section 3(1)(c) and 3(1)(b). An issue for section 3(1)(c) is whether the mark consists *exclusively* of indications that designate characteristics of the goods or services, or whether there are additional elements, which mean that the mark as a whole cannot be

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<sup>3</sup> *Dyson* was referred to the ECJ for a ruling on the question of acquired distinctiveness. In the event, the ECJ ruled that the application related to a concept and not a sign within the meaning of Article 2 of the Directive (Case C-321/03, *Dyson Ltd v. Registrar of Trade Marks*, 25 January 2007).

considered exclusively to comprise such designations (*BABY-DRY*, paragraph 39, and specifically in relation to word combinations, *POSTKANTOOR*, paragraphs 96, 98 – 100, 104, Case C-265/00 *Campina Melkunie BV v. Benelux-Merkenbureau (BIOMILD)* [2004] ECR I-1699, paragraphs 39 – 43).

34. Having noted that representations of envelopes are commonly used to indicate e-mail facilities or that the user has e-mail, the Hearing Officer concluded at paragraph 16 that the consumer would perceive the mark as “no more than” indicating e-mail features. Again, at paragraph 18, he says that the mark when used as a screen icon would appear to the consumer as purely functional, i.e., allowing the user to identify the facilities available at the icon. At paragraph 17, the Hearing Officer considers the “fuzzy appearance” and colours of the sign and says:

“The fact that this particular trade mark is represented in the colours blue and white 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.”

The question for section 3(1)(c) is not whether additional elements in a mark themselves confer distinctive character. At the risk of repetition, it is whether the mark consists exclusively of signs or indications that designate characteristics of the goods or services. Distinctive character forms the basis for enquiry under section 3(1)(b) against the perceptions of the average consumer in relation to the goods and services of the mark overall.

35. Mr. Stobbs secondly argues that the mark is in any event not descriptive of the goods and services in question. It merely alludes to those goods and services. In particular, e-mail does not employ envelopes. Mr. James invited me to consider what the position might be if the mark achieved registration and a third party used a representation of an envelope to indicate that an e-mail service was available through their portal or website or whatever. If sued for infringement, the defendant would argue that they were using the envelope descriptively. Mr. James observes that there cannot be a gap in the application of, on the one hand the grounds for refusal of registration in section 3(1)(c) and, on the other hand the defences to infringement under section 11(2)(b). That augurs for a broad interpretation of section 3(1)(c) per the Opinion of A.G. Sharpston in Case C-273/05 P, *OHIM v. Celltech R&D Ltd (CELLTECH)*, 14 December 2006, paragraphs 58 – 65).
36. In *CELLTECH*, A.G. Sharpston considered that “areas of use” in the context of pharmaceuticals, medical devices and medical research constituted “other characteristics” within the meaning of Article 7(1)(c) of the CTMR<sup>4</sup>. By contrast in Case C-48/05, *Adam Opel AG v. Autec AG*, 25 January 2007, the ECJ ruled that use by a toy manufacturer of the OPEL logo<sup>5</sup> on scale model OPEL cars was not within the defence in Article 6(1)(b) of the Directive because it is not use of an indication concerning a characteristic of those scale

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<sup>4</sup> Contrary to the view of the CFI, Case C-260/03 [2005] ECR I-1215, paragraphs 38 – 39. The ECJ in *CELLTECH* (19 April 2007) found it unnecessary to decide the point, see paragraphs 53 – 57.

<sup>5</sup> Registered inter alia for motor vehicles and toys.

models (paragraphs 39 – 45). Infringement would depend on whether the use was liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods. There is no infringement where the consumer perceives the mark as merely indicating that these are reduced-scale models of the real car (paragraphs 21 – 25). It seems to me that analogous reasoning might be applied to Mr. James' envelope example.

37. The authorities indicate that there may be difficulty in pinpointing the exact boundaries of “characteristics” for the purposes of section 3(1)(c). I accept that by the date of the Envelope Application, 15 April 2004, it is arguable that the device of an envelope fell within those boundaries in relation to e-mail services. However, I do not accept that just because goods and services can communicate with or be accessed by email, the device of an envelope designates a characteristic of such products. The same could be said of any good or service<sup>6</sup>. Thus, I disagree with the Hearing Officer that the mark designates a characteristic (even a “lower order” characteristic as suggested by Mr. James<sup>7</sup>) of, e.g., education or training services, interactive entertainment services, news or information services or any of the Class 9 goods mentioned by the Hearing Officer at paragraph 14 of his decision. I believe that the Hearing Officer was again straying into section 3(1)(b) territory.
38. In *BVBA*, the ECJ makes clear that an office must identify the goods and/or services in a trade mark application that are affected by a ground for refusal of registration and state the reason(s) why (paragraphs 32 – 34). The Hearing Officer finds that in relation to telecommunication and e-mail services the mark designates the kind of services. He adds that a similar objection applies to “supporting goods and services for these goods [sic] and services”. The only example he gives is downloadable electronic tariffs in Class 9. Any other “supporting goods and services” remain unidentified. Moreover, e.g., sporting and cultural activities appear not to have been dealt with at all.
39. For the reasons set out above, in my judgment, the Hearing Officer misapplied section 3(1)(c). Mr. Stobbs says that is the end of the matter. Since the same reasoning underpinned the Hearing Officer's refusal of the Envelope Application under section 3(1)(b), the mark must proceed to registration. I disagree. As made clear earlier in this decision, even though a mark may not be objectionable under section 3(1)(c), it may still be devoid of any distinctive character for section 3(1)(b) (see, e.g., *SURFUNLIMITED*, BL O/487/02). The same information that was available to the Hearing Officer is before me. Moreover, at my invitation, Mr. Stobbs specifically addressed section 3(1)(b) at the appeal hearing. I believe the overriding objective is best served by me determining the objection under section 3(1)(b).
40. There is no claim to acquired distinctiveness and therefore distinctive character falls to be assessed in the prima facie. The applicable principles are set out at paragraphs 17 – 19 of this decision. The Applicant's

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<sup>6</sup> Take, for example, a mail order catalogue that uses a representation of an envelope to indicate that goods offered for sale in the catalogue can be ordered from the retail services provider by email.

<sup>7</sup> *POSTKANTOOR*, paragraph 102.



acknowledgement that “third parties have adopted similar devices to refer to generic services” is recorded at paragraph 27. Further, the Applicant provided me with materials showing the use of icons by other mobile telephone providers and icons presented on a personal computer screen (including devices of envelopes).

41. Mr. Stobbs’ main argument is that if the mark is capable of distinguishing for section 3(1)(a) and there is no objection to the mark under section 3(1)(c) or (d) then the mark cannot be devoid of any distinctive character contrary to section 3(1)(b). That argument is fallacious because it ignores the fact that section 3(1)(a) contemplates both inherent and factual distinctiveness (Case C-299/99, *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd* [2002] ECR I-5475, paragraphs 36 – 40).
42. The perceptions of the relevant public must be assessed of the mark overall in relation to the goods and services concerned. All the relevant facts and circumstances must be taken into account including practices in the trade (*POSTKANTOOR*, paragraphs 34 – 35 and 75 – 76, *SAT.2*, paragraphs 28, 35, 43 – 44). It is uncontroversial that the average consumer in this case is a reasonably well-informed and reasonably observant and circumspect member of the general public whose level of sophistication and/or attention will vary according to the product purchased. That average consumer will be familiar with the use in the trades covered by the specifications of Application number 2360944 (and indeed in trades generally) of envelope devices in order succinctly and non-verbally to convey information about mail (traditional and electronic) and messaging. I take judicial notice of the fact that he or she will also be familiar with the practice in all walks of life of using letter or picture icons visually to convey functional information, e.g., road and public conveniences signs (Case T-215/03, *Sigla SA v. OHIM*, 22 March 2007, paragraph 45).
43. The test for distinctive character is whether members of the public would perceive the mark as an indication of origin. Mr. Stobbs says marks can convey trade mark and other messages and still be registrable. I agree (*Merz & Krell GmbH & Co.* [2001] ECR I-6959, paragraph 40 and, e.g., *Best Buy Concepts v. OHIM (BEST BUY)* [2003] ECR II-2235).
44. However, in my judgment the average consumer will not recognise the present mark as performing a trade mark function in relation to the goods or services in question unless educated through use to do so. Instead, they will understand the mark as indicating something to do with mail/e-mail/messages depending on the context in which it is used. That is simply because the mark consists of a picture of an envelope, which the average consumer will recognise as a functional communication symbol. As regards the Applicant’s present areas of interest in mobile telecommunications, I agree with the Hearing Officer’s observation that, when used as a screen icon, the mark will be perceived as allowing the user to identify the program/option/window open to him or her, and not as an indication of origin (paragraph 18). Nevertheless, for the sake of clarity, the general objection and reasoning stated in this paragraph applies to all the goods and services in Classes 9, 38 and 41.

45. Accordingly, I uphold the Hearing Officer's refusal of registration to Application number 2360944 in Classes 9, 38 and 41 but on the ground that the mark is contrary to section 3(1)(b). The Envelope Application will be remitted to the Registry for further consideration in Class 16 in the light of my decision.
46. I now turn to consider the remaining applications. During the hearing, Mr. Stobbs made the double-edged observation that if I were to find 2360944 objectionable under section 3(1)(b) then the same objection would apply to all the applications, but two (not subjects of the present appeals) had already been accepted by the Registry (Transcript, page 31). Each and every trade mark application must be considered on its own merits and an office decision in one application is not binding with regard to another (see, inter alia, Case T-230/05, *Golf USA, Inc v. OHIM*, 6 March 2007, paragraphs 57 – 60). Moreover, as Mr. James pointed out, it is accepted that some icons may be distinctive whereas others may not.

**Application No. 2360945**

47. Application number 2360945 is in the name of the Applicant for the following trade mark:



The colours purple and blue are claimed for the mark. I shall call it “the Downloads Application”. The goods and services are the same as for 2360944 and the filing date is again 15 April 2004.

48. The Downloads Application was objected to on the following bases (paragraph 3):
- “3. Objection has been taken to the mark in classes 9, 16, 38 and 41 under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the device of a mobile telephone and a non-distinctive arrow, being a sign which may serve in trade to designate the nature of

the goods and services e.g. telecommunication apparatus, printed matter relating to telephones or telecommunication apparatus, printed matter relating to telephones or telecommunication services, telecommunications services, information services provided by telecommunications networks.”

49. More specifically in relation to section 3(1)(c), the Hearing Officer held in terms that it must be said are very similar to the Envelope Application refusal (Decision BL O/144/06, dated 6 June 2006, paragraphs 14 – 19):

“14. The purchasers, and potential purchasers, of the goods and services in question purchase them because they satisfy their own personal requirements regarding the specification they offer. In relation to phones and telecommunication services and support services for these goods and services, the mark simply designates the kind of services. In relation to computers, laptops, other electronic communication devices, Internet application services, interactive entertainment, education and training services, news services and information services, Internet access services, e-mail and text messaging and monitoring services the mark would signify that these services can communicate with or be accessed via a mobile phone, which is a characteristic of such goods and services. In the case of drivers and software for phones, and tariffs and instructional printed matter, the mark designates the intended purpose of the goods.

15. Mr Stobbs has sought to persuade me that this particular device, in this particular arrangement, in the colours purple and blue is distinctive of the goods and services for which registration is sought in classes 9, 16, 38 and 41. The device of the telephone does possess an abstract quality. It is not a particularly clearly defined representation of a telephone, but in my view it will be perceived as a representation of a telephone 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: 8 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. Stylised representations of goods are commonly used on packaging to indicate either the contents or a product or the environment where the goods in question may be used. The arrow device is placed to the upper right hand side of the telephone and is pointing down towards the telephone. This indicates that the goods and services relate to the provision of data and information to the telephone. The provision of downloads to telephones and other apparatus is now very common. One particular example that comes to mind is the popularity in downloading ring tones so that a mobile telephone possesses a distinctive and personalised ring tone.

16. The relevant consumer of such goods and services would therefore, in my view, perceive this mark as no more than an indication

that the device in use provides the user with a facility to download data and information to their telephone.

17. Mr Stobbs referred me to the fuzzy appearance of the sign but it appears that this is only occurs when the sign is enlarged when photocopies or otherwise represented in an enlarged form. The mark filed on the form of the application is small in size and I note that on this representation the fuzzy appearance does not appear to exist. The fact that this particular trade mark is represented in the colours purple and blue 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. These colours as applied to this mark do not alter my conclusion that the objection taken under Section 3(1)(c) of the Act is correct. Mobile phones are available in a wide variety of colours and there is nothing unusual about this combination which would be capable of denoting trade source.

18. 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, the resemblance of the mark to a descriptive screen icon 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 accept that some may be successful in such a function, it remains my view that this icon does not perform such a function. The mark is a representation of a telephone with an arrow pointing downwards and in relation to most of these goods and services will indicate that download goods and services are available and will convey no other message.

19. 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, 16, 38 and 41 and is debarred from registration under Section 3(1)(c) of the Act.”

50. Again, it is clear to me that the Hearing Officer fell into error when applying section 3(1)(c) because:
- (i) He did not consider whether the stylised presentation of the mark in the colours purple and blue meant that the mark did not consist *exclusively* of signs or indications which may serve, in trade, to designate characteristics of goods or services. He asked himself whether those elements in themselves were apt to confer distinctive character on the mark and whether the mark as a whole would be perceived as an indication of origin for the goods and services in question. The latter questions are apt to address the public interest behind section 3(1)(b) of the TMA but not section 3(1)(c).

- (ii) At paragraph 9, the Hearing Officer states his concern that the sign applied for is one that indicates that the goods and services in question relate to the provision of downloads to the telephone. Mr. Stobbs response is that there is nothing wrong with a mark that is allusive for the goods or services. The Hearing Officer does not go on to explain why, at paragraph 14, he considers that in relation to phones and telecommunication services and support services for those goods and services, the mark designates the kind of services (sic). At the very highest it might be argued that the mark indicates that downloads can be made to a mobile phone, which is a characteristic of that phone. But as regards the Hearing Officer's further findings at paragraph 14, in my view, the mere fact that computers, laptops, other electronic communication devices, Internet application services, interactive entertainment, education and training services, news services and information services, Internet access services, e-mail and text messaging and monitoring services can communicate with or be accessed via a mobile phone is at too general a level to qualify as even "lower order" (*POSTKANTOOR*, paragraph 102) characteristics of goods or services for the purposes of section 3(1)(c).
- (iii) Some of the services specified, e.g., sporting and cultural activities appear not to have been dealt with in the decision.
51. Mr. Stobbs has not sought to challenge the Hearing Officer's finding that the relevant public<sup>8</sup> will realise that the mark includes a representation of a mobile phone. He also accepts the widespread use in the telecommunications industry of arrows to indicate the action of downloading<sup>9</sup>. The Hearing Officer records in his decision that in a letter dated 21 December 2005, Mr. Stobbs acknowledged, "third parties have adopted similar devices to refer to generic services". As I observed in connection with the Envelope Application, the general public is well used to encountering picture/letter icons, which convey functional information. Mr. Stobbs accepted at the hearing before me that the mark is allusive to the goods and services in the Downloads Application.
52. It is clear from the case law that section 3(1)(b) independently provides a broader ground of objection to registration than section 3(1)(c) (Case C-104/00 P, *DKV v. OHIM (COMPANYLINE)* [2002] ECR I-7561, paragraphs 26 – 30, *POSTKANTOOR*, paragraphs 68 - 70, 86)). In *CYCLING IS Trade Mark* [2002] RPC 729, Mr. Geoffrey Hobbs QC sitting as the Appointed Person summarised the test for section 3(1)(b) as being whether the perceptions and recollections that the sign in issue would trigger in the mind of the average consumer of the specified goods or services are likely to be origin neutral or origin specific (paragraph 69; see also *SURFUNLIMITED*, paragraph 14).
53. In my view, the mark would convey a purely functional meaning to the average consumer when used in relation to the goods and services applied for namely,

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<sup>8</sup> Accepted to be the general public.

<sup>9</sup> In any event, I believe that judicial notice can be taken of such practices.

either that the goods can be employed to achieve the action of downloading to a mobile phone or that goods, e.g., printed matter or services content, e.g., email or entertainment can be downloaded onto a mobile phone. In other words the relevant perceptions and recollections are likely to be origin neutral and not origin specific.

54. In conclusion, although in my judgment the mark is not wholly descriptive, it is devoid of any distinctive character. In the absence of acquired distinctiveness through use, the Downloads Application must be refused registration for the specified goods and services in Classes 9, 16, 38 and 41 because it is contrary to section 3(1)(b).

**Application No. 2360938**

55. The device applied for in Application number 2360938 (“the Football Application”) is:



The Football Application has a filing date of 15 April 2004 and the Applicant claims the colours blue and white as elements of the mark. The specified goods and services are the same as for Applications numbers 2360944 and 2360945.

56. In a decision dated 20 June 2006 (BL O/169/06), the Hearing Officer explains that (paragraph 3):

“3. Objection has been taken to the mark in classes 9, 38 and 41 under Section 3(1)(b) and (c) of the Act because the mark consists of a device of a football, being a sign which would not be seen as a trade mark because it is devoid of any distinctive character. This is because such signs are commonly used as computer icons, used to direct the user around an Internet site or other interactive computer or communications equipment. It is descriptive of goods and services relating to football.”

57. It is accepted that the Hearing Officer’s primary challenge to registration of the mark was under section 3(1)(c). His findings in that regard were (paragraphs 14 – 18, emphasis supplied):

“14. The purchasers, and potential purchasers, of the goods and services in question purchase them because they satisfy their own personal requirements regarding the specification they offer. In relation to entertainment and information services and telecommunication services and supporting goods and services for

these services such as downloadable electronic tariffs, the mark simply designates the kind of goods and services as being football entertainment and information. In relation to phones, computers, laptops, other electronic communication devices, Internet application services, education and training services, Internet access services, e-mail and text messaging and monitoring services the mark would signify that these goods and services can be used to obtain football games, entertainment and/or information which is a characteristic of such goods and services. In the case of drivers and software for phones, the mark designates the intended purpose of the goods as being to provide access to football games, entertainment and/or information.

15. Mr Stobbs has sought to persuade me that this particular device, in this particular arrangement, in the colours blue and white, is distinctive of the goods and services for which registration is sought in classes 9, 38 and 41. 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: 8 x 8 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. Signs such as this are commonly used on packaging or promotional material to indicate either the contents or a product or environment in which the goods in question may be used. The device clearly represents a ball and the arrangement of the colours blue and white are very similar to those used as panelling on modern footballs. Sport, and football in particular, is very popular in the United Kingdom and a representation of a ball or football is clearly a descriptive device which indicates that the goods and services provided under such a mark relate to football or sport in general. A sign such as this is a perfectly apt way to indicate that the goods and services in question provide such a feature.

16. The relevant consumer of such goods and services would therefore, in my view, perceive this mark as no more than an indication that facilities which provide information relating to football or sport in general are offered as one of its features available, either on the goods themselves or as part of the service package. Although sport in general covers a wide range of sports other than football the mass appeal of football as participation and spectator sport renders the device of a football eminently suitable as an indicator that the information provided relates to all sport. *The fact that this particular trade mark is represented in the colours blue and white does not persuade me that this by itself bestows distinctive character on the mark to the extent that that it becomes capable of performing the function of a trade mark. In order to achieve that the sign must guarantee that the goods and services originate from a single and no other undertaking.*

17. 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 such 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 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 whether it is used on a screen or otherwise.

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, 38 and 41 and is debarred from registration under Section 3(1)(c) of the Act.”

The Hearing Officer added that he thought a late objection under section 3(1)(c) should be made against printed tariffs in Class 16.

59. I find it particularly apparent from the Football Application decision that the Hearing Officer’s reasoning in relation to the icons in suit was more apt for section 3(1)(b) than section 3(1)(c). I have highlighted a passage at paragraph 16 of his decision, which I believe encapsulates this<sup>10</sup>. The test for section 3(1)(c) is not whether the fact that the mark is represented in the colours blue and white by itself confers distinctive character on the mark such that it becomes capable of performing the function of a trade mark but whether the mark judged as a whole possesses elements, which mean that it does not consist exclusively of signs or indications that designate characteristics of goods or services. Contained in the materials, which Mr. Stobbs sent me prior to the hearing (see paragraph 40 above) is another football device. That football bears a completely different livery namely, red stripes running around the circumference of a white ball, with what appears to be the Barclay’s Premiership logo and other logos included in the middle white stripe. The present mark comprises a stylistic representation of a football in the colours blue and white. It does not consist exclusively of a descriptive indication (even if a football device is a descriptive indication in the relevant 3(1)(c) sense).
60. The public interest guarded by section 3(1)(c) is the need to keep free for other traders descriptive signs or indications relating to characteristics of goods or services (*Windsurfing*, paragraph 26). That does not mean that a trade mark cannot convey a descriptive message about a product (see, e.g., *Koninklijke Philips Electronics NV v. Remington Consumer Products* [2006] FSR 537, Mummery L.J. at paragraph 101). The distinction is between a mark that is directly descriptive and one, which is indirectly descriptive or allusive. Despite the popularity of football in the UK, I fail to see how the mark can be said to be directly descriptive of the goods and services objected to, at least

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<sup>10</sup> Subject to the rider that perceptions for section 3(1)(b) must be of mark overall.



those in Classes 9 and 38 and cultural activities in Class 41<sup>11</sup>. That is tantamount to saying: because one can watch football on the television, a football designates the characteristics of a television. Or, to use an example provided by Mr. Stobbs from the case law, analogous to saying that a clear dust collection bin is descriptive in relation to the characteristics of a vacuum cleaner because it tells the consumer when the bin is full (*Dyson*, paragraph 24).

61. On the other hand, the public interest behind section 3(1)(b) requires that a mark must be able to fulfil its essential function of guaranteeing to the relevant consumer that products bearing it originate from the trade mark owner and not from an unrelated origin (*SAT.2*, paragraph 23). In order to perform that essential function, the mark must in turn trigger perceptions and recollections in the minds of the relevant public<sup>12</sup> when used in relation to specified products, which are origin specific and not merely origin neutral (*CYCLING IS*, paragraph 69). Practices in the marketplace are a relevant consideration (*SAT.2*, paragraph 43). Mr. Stobbs does not dispute that the mark contains a football that would clearly be recognised as such. Moreover he acknowledged that third parties have adopted similar devices to refer to generic services (as confirmed in the materials he provided me with before the hearing concerning icons in use by other mobile telecommunications suppliers). I have referred earlier in this decision to general practices in wider life of using/interpreting picture or letter signs to/as conveying functional information. Accordingly, I believe that the Hearing Officer was right in his finding that when used for its claimed purpose as a screen icon on a mobile phone or computer the mark in suit would be perceived by the average consumer as conveying origin neutral information, i.e., that football or sport related information, entertainment, materials or other facilities are available through selecting that icon. In my judgement, since no use is claimed, the mark is therefore devoid of any distinctive character within the meaning of section 3(1)(b) of the TMA for the goods and services specified in Classes 9, 38 and 41 with the exception of cultural activities in Class 41. In connection with cultural activities, the mark conveys no relevant meaning to the average consumer and in that circumstance can function as an indication of origin.
62. The Football Application is remitted to the Registry for further processing in relation to cultural activities in Class 41, and reconsideration in Class 16 in the light of my decision.

### **Application No. 2360946**

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<sup>11</sup> The Hearing Officer did not say why he thought the mark was objectionable under 3(1)(c) in relation to cultural activities nor did he identify the “supporting goods and services” for which he considered the mark to be designative of kind (*BVBA*, paragraphs 34 – 38).

<sup>12</sup> Accepted to be the general public.

63. The issues concerning the appeal in Application number 2360946 are similar to those in relation to the Football Application. Application number 2360946 (“the Games Console Application”) was filed on 15 April 2004 for the following mark:



The Games Console Application states that the colour yellow is claimed as an element of the mark. The specified goods and services in Classes 9, 16, 38 and 41 are the same as for the other icon applications considered so far.

64. The Hearing Officer’s decision, dated 7 June 2006 (BL O/0156/06), records that the mark was objected to as follows (paragraph 3):

“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.”

65. The Hearing Officer goes on to develop the section 3(1)(c) objection at paragraphs 12 – 18 of his decision:

“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 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 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 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.”

The Hearing Officer added that although no objections were raised against the mark in Classes 16 and 38<sup>13</sup>, he considered that the mark was descriptive of telecommunication services offering gaming options and printed tariffs for goods and services with gaming options and that late objections should be made subject to the outcome of the appeal (paragraph 24).

66. Again, I have highlighted passages in the Hearing Officer’s decision (at paragraph 14), which in my view illustrate that the Hearing Officer’s reasoning under section 3(1)(c) was more appropriate to section 3(1)(b). The question for section 3(1)(c) is: does the mark consist exclusively of signs that may serve, in trade, to designate characteristics of goods or services? The question is not: does an additional element in itself bestow distinctive character on the mark<sup>14</sup>? The mark in suit is a stylised depiction of a games console in the colour yellow, which is claimed as an element of the mark. Mr. Stobbs’ advance materials show a games console device used by a competitor that is diagrammatically different and the top section is coloured blue with the rest being either white or transparent. In my judgment, the Hearing Officer wrongly characterised the mark as consisting exclusively of descriptive indications (even if, the device of a games console can be considered descriptive in relation to characteristics of the specified products, see below). The case in point here is the Court of Appeal decision in *Koninklijke Philips Electronics NV v. Remington Consumer Products* [2006] FSR 537 at 98 – 102 (read in the light of 92 – 97) referred to earlier.
67. I accept that depending on specificity, a games console device may be directly descriptive of a games console. However, I am unable to agree with the Hearing Officer that the mark may serve, in trade, to designate characteristics

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<sup>13</sup> There is clearly a mistake at paragraph 21 of the Hearing Officer’s decision where he mentions classes 9, 16, 38 and 41. He corrects this mistake at paragraph 22.

<sup>14</sup> Even for section 3(1)(b) the mark must be assessed as a whole.

of the specified goods and services in Classes 9 and 41 merely because it conveys the information that those goods and services relate to games. As Mr. James identified, there is a distinction between conveying information about goods and services and designating characteristics of the same.

68. In my judgment, the Hearing Officer misapplied section 3(1)(c) for the reasons set out in paragraphs 66 – 67 above. Furthermore, he did not in accordance with the ECJ's guidance in *BVBA* give reasons why he was objecting under section 3(1)(c) to certain of the specified goods and services in Classes 9 and 41, e.g., downloadable electronic publications/tariffs, sporting and cultural activities, provision of news information (i.e., claimed products in 9 and 41 other than those identified at paragraph 12 of the Hearing Officer's decision).
69. The mark is, however, clearly recognisable to the relevant consumer<sup>15</sup> as a representation of a games console. I agree with the Hearing Officer that when used as a screen icon on a computer, mobile phone or other electronic communication device, the average consumer will not perceive the mark as an indication of origin. Instead, the mark will be viewed as conveying the origin neutral information that access is provided to electronic games. That is due to: (a) the nature of the mark itself; (b) competitors' uses of similar devices for functional purposes (acknowledged by Mr. Stobbs at the appeal and first instance hearings and shown in his advance materials); and (c) the general practice in everyday life of using picture/letter icons to convey origin neutral messages, e.g., road, exit signs.
70. The mark is therefore objectionable under section 3(1)(b) for registration and use in relation to all the goods specified in Class 9. In Class 41, the mark is, in my view, devoid of any distinctive character in relation to entertainment; interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by means of telecommunications networks; information and advisory services relating to the aforesaid. Moreover, since sporting activities includes sporting games and educational/training software can be played on games consoles, I further find that the mark is devoid of any distinctive character in Class 41 for education; providing of training; sporting activities; information and advisory services relating to the aforesaid. However, in relation to cultural activities; provision of news information; information and advisory services relating to the aforesaid, I believe the mark is cryptic to the degree that it can perform the function of indicating origin.
71. The Games Console Application is remitted to the Registry for further processing in relation to the permissible services in Class 41, and for reconsideration in Classes 16 and 38 in the light of my decision.

### **Application No. 2360950**

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<sup>15</sup> Again the general public.

72. Application No. 2360950 (“the Speech Bubbles Application”), dated 15 April 2004, requests registration for the following mark:



The Speech Bubbles Application states that the Applicant claims the colour blue as an element of the mark. The goods and services for which registration of the mark is sought in Classes 9, 16, 38 and 41 are the same as for the other applications. However, registration of the mark is additionally sought in respect of:

Class 45

Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals; dating services; on-line dating services; information and advisory services relating to the aforesaid.

73. The Hearing Officer’s decision, dated 22 June 2006 (BL O/174/06), explains that objections were made under section 3(1)(b) and (c) (paragraph 3):

“3. Objection has been taken to the mark in classes 9, 38 and 41 under Section 3(1)(b) and (c) of the Act because the mark consists of a device of two speech bubbles, being a sign which would not be seen as a trade mark as it is devoid of any distinctive character. Also the image is commonly used as a sign to indicate interactive speech.”

74. Despite the ubiquitous wording of that objection, it is accepted that the Hearing Officer’s prime concern was that the mark was contrary to section 3(1)(c) (paragraphs 16 – 21):

“ 16. The purchasers, and potential purchasers, of the goods and services in question purchase them because they satisfy their own personal requirements regarding the specification they offer. In relation to phones and telecommunication services and supporting goods and goods or services for these goods and services such as downloadable electronic tariffs, the mark simply designates the kind of services. In relation to computers, laptops, other electronic

communication devices, Internet application services, interactive entertainment, education and training services, news services and information services, Internet access services, e-mail and text messaging and monitoring services the mark would signify that these services can communicate with or be accessed via a mobile phone, which is a characteristic of such goods and services. In the case of drivers and software for phones, the mark designates the intended purpose of the goods.

17. Mr Stobbs has sought to persuade me that the use of two speech bubbles arranged in this particular way are distinctive of the goods and services for which registration is sought in classes 9, 38, 41 and 45. The device of two speech bubbles does possess an abstract quality. It is not a particularly clearly defined representation of two speech bubbles, but in my view it will be perceived as a representation of speech bubbles 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: 12 x 8 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. In relation to these goods and services I do not accept that this particular representation of two overlapping speech bubbles will be perceived by the relevant consumer as anything other than an indication that chat services, chat room services and/or text messaging services or facilities are available for selection from phones, laptop computers and other telecommunication apparatus. The fact that this particular trade mark is represented in the colours blue and black 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. In order to achieve that the sign must guarantee that the goods and services originate from a single and no other undertaking.

18. The relevant consumer of such goods and services would therefore, in my view, perceive this mark as no more than an indication that chat room services and/or text messaging services are offered as one of the features available, either on the goods themselves or as part of the service package.

19. Mr Stobbs referred me to the fuzzy appearance of the sign but it appears that this only occurs when the sign is enlarged when photocopied or otherwise represented in an enlarged form. The mark filed on the form of the application is small in size and I note that on this representation the fuzzy appearance does not appear to exist. The fact that this particular trade mark is represented in the colour blue 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. These colours as applied to this mark do not alter my conclusion that the objection taken under Section 3(1)(c) is

correct. In my view there is nothing striking or unusual about this combination which would be capable of denoting trade source.

20. 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 such 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 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 whether it is used on a screen or otherwise.

21. 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, 38 and 41 and is debarred from registration under Section 3(1)(c) of the Act.”

The Hearing Officer said that he also considered the mark descriptive of printed tariffs in Class 16 and live dating services in Class 45 and that subject to the outcome of any appeal a late objection would be raised against those goods and services.

75. A section 3(1)(c) objection must be explained in relation to the goods or services concerned (*POSTKANTOOR*, paragraph 73, *BVBA*, paragraphs 34 – 38, *CELLTECH*, paragraphs 42 – 46, 66). The Hearing Officer’s first finding that (paragraph 16):

“In relation to phones and telecommunication services and supporting goods and goods or services for these goods and services such as downloadable electronic tariffs, the mark simply designates the kind of services”

is not only unclear in extent but also fails to state why the mark is considered to designate the kind of product.

76. The Hearing Officer’s second finding that (paragraph 16):

“In relation to computers, laptops, other electronic communication devices, Internet application services, interactive entertainment, education and training services, news services and information services, Internet access services, e-mail and text messaging and monitoring services the mark would signify that these services can communicate with or be accessed via a mobile phone ...”



is also uncertain as to extent. Moreover, with the possible exception of text messaging services, the fact that services can be communicated with or accessed via a mobile phone is, in my view, too general an attribute to qualify as a characteristic of goods or services. One can communicate with or access most, if not all, modern services by mobile phone. This constitutes information or an instruction, not a product characteristic.

77. Even in relation to text messaging services, I fail to see how the mark can be said to consist *exclusively* of descriptive indications since it comprises a particular schematic and stylistic representation of two overlapping speech bubbles in the colour blue<sup>16</sup>.

78. The Hearing Officer's third finding that (paragraph 16):

“In the case of drivers and software for phones the mark designates the intended purpose of the goods.”

is again unexplained. Finally, some goods and services within the scope of the objection have not been subjected to individual (or group) consideration, e.g., downloadable electronic publications; electronic games services provided by means of any communications network; sporting and cultural activities.

79. Much of the Hearing Officer's reasoning at paragraphs 16 – 21 is, in my view, more appropriate to section 3(1)(b) than 3(1)(c). In order to be possessed of distinctive character, a mark when perceived overall must serve to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him or her, without any possibility of confusion, to distinguish the product from others that have another origin (*SAT.2* paragraphs 23 and 28). The relevant consumer in the case of the Speech Bubbles Application is accepted to be the general public.

80. To use Mr. James' expression, I would have to be living on the moon not to know that speech bubbles are used in many fields including telecommunications, publishing, education, entertainment, broadcasting and advertising in order to convey messages or pieces of information or to portray interactive communication, e.g., in comic strips (*CELLTECH*, paragraph 39). In any event, Mr. Stobbs acknowledged in a letter, dated 21 December 2005, and sent to the Registry after the first instance hearing that third parties have adopted similar devices to refer to generic services.

81. I am therefore in agreement with the Hearing Officer's alternative finding that registration of the mark in Classes 9, 38 and 41 is contrary to section 3(1)(b) because the mark is devoid of any distinctive character. However, the reason is that without educating, the average consumer would not perceive the mark in relation to any of the products concerned as indicating the origin of those products. Instead, the mark would merely evoke the response in the consumer depending on the context in which the mark were used that messaging, information, e.g., an instruction or warning, or interactive speech was

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<sup>16</sup> The Hearing Officer noted that the outline of the speech bubbles appears to be in the colour black.

involved, i.e., an origin neutral response. In the particular case of the mark being used as a computer/mobile phone icon it would convey to the average consumer the purely functional information that a messaging programme, option or window can be selected at that point.

82. As regards “personal and social services rendered by others to meet the needs of individuals” in Class 45, the Speech Bubbles Application attracted an objection under section 3(6) and rule 8(2) of the Trade Marks Rules 2000 as amended because of vague wording and uncertainty in scope. That objection was confirmed by the Hearing Officer at paragraphs 33 – 36 and 38 of his decision. I did not hear argument on this point at the appeal hearing but understand from the statement of grounds of appeal that the Applicant is willing to put forward a revised specification.
83. My conclusions in relation to the Speech Bubbles Application are: (i) the Hearing Officer’s refusal of registration to the mark in Classes 9, 38 and 41 is confirmed but on the ground that the mark is contrary to section 3(1)(b) of the TMA; (ii) the Speech Bubbles Application is remitted to Registry for further consideration in Classes 16 and 45 in the light of my decision. That further consideration is to take into account any revision to the Class 45 specification if appropriate.

#### **Application No. 2360935**

84. Application number 2360935 (“the Human Figure Application”) was filed on 15 April 2004 for the mark as represented below:



The Applicant claimed the colour red as an element of the mark. The specified goods and services in Classes 9, 16, 38 and 41 are as for the other applications considered in my decision.

85. The Hearing Officer’s decision, dated 10 May 2004 (BL O/116/06), records that the mark was objected to under section 3(1)(b) and (c) of the TMA (paragraph 3):

“3. Objection has been taken to the mark in classes 9, 38 and 41 under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the device of a person together with three separate rectangles, each containing part of a human figure, being a sign which may serve in trade to designate the nature of the goods and services e.g. goods and services relating to the provision of teleconferencing and video conferencing facilities.”

86. Mr. Stobbs has taken issue with the account of exchanges between himself and the Hearing Officer relating to the Human Figure Application. First, he says, it was made clear that the Applicant is the only service provider who uses this type of device, i.e., the device was not common to the trade. Second, the Applicant uses the device to indicate an address book or contacts service and not conferencing facilities. The decision itself appears somewhat contradictory on the first aspect. At paragraph 9, the Hearing Officer records:

“Mr Stobbs stressed that the applicant is the only service provider using this particular combination ...”.

Whereas in paragraph 10 there is reference to a letter from Mr. Stobbs dated 21 December 2005 in which Mr. Stobbs says:

“These devices are not inherently descriptive of anything. It is arguable, and I agree borderline, that they may be considered devoid of any distinctive character because third parties have adopted similar devices to refer to generic services ...”.

And at paragraph 20 (sic) the Hearing Officer states<sup>17</sup>:

“In my view the relevant consumer, bearing in mind that I have determined that this particular trade mark is in general use in relation to at least some of the goods and services applied for, would not consider this mark to denote trade origin.”

87. It is accepted that the Hearing Officer’s primary objection to the mark was under section 3(1)(c). The Hearing Officer’s findings in that regard are set out in paragraphs 14 – 18:

“14. The purchasers, and potential purchasers, of the goods and services in question purchase them because they satisfy their own personal requirements regarding the specification they offer. Computers, laptops, mobile phones and other communication devices offer a varying number of facilities on such apparatus. One of the facilities offered is the provision of modern forms of communication such as teleconferencing and video conferencing services.

15. Mr Stobbs has sought to persuade me that this particular device, in this particular arrangement, in the colour red, is distinctive of the goods and services for which registration is sought in classes 9, 38 and 41. 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. 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. Stylised representation of goods are commonly used on packaging to indicate either the contents or a product or environment where the goods in

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<sup>17</sup> In relation to the section 3(1)(b) objection.

question may be used. The device clearly indicates that the single human figure represents one party and the multiple images of rectangle screens, each containing other human figures, represents other parties who may, by using the facility offered and indicated by this sign, contact each other and hold a conference. Electronic conferencing is not unusual today and is available both locally and internationally. It is clearly a feature of a communication device that the relevant consumer may well look for. An icon such as this is a perfectly apt way to indicate that the goods and services in question provide such a feature.

16. The relevant consumer of such goods and services would therefore, in my view, perceive this mark as no more than an indication that the device in use provides the user with a facility to participate in conferencing with other parties.

17. In use on the screen of a mobile phone, computer, laptop or other communication device the primary function of this icon is to allow the user to identify the facilities designated by the design of the icon. Such uses of this icon 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, the resemblance of the mark to a descriptive screen icon 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 accept that some may be successful in such a function, it remains my view that this icon does not perform such a function. This icon is, in my view, a sign which in relation to these goods and services will indicate that teleconferencing and videoconferencing facilities are available and will convey no other message.

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, 38 and 41 and is debarred from registration under Section 3(1)(b) [sic<sup>18</sup>] and (c) of the Act.”

88. In my judgment, the Hearing Officer misapplied section 3(1)(c). Inter alia:
- (a) The extent and reasons for the objection are entirely unclear (*POSTKANTOOR*, paragraph 73, *BVBA*, paragraphs 34 – 38, *CELLTECH*, paragraphs 42 – 46, 66). The Hearing Officer appears to conclude that because modern communication devices may have teleconferencing options, the mark designates characteristics of all the goods and services applied for in Classes 9, 38 and 41. There is no consideration/explanation of the applicability of the ground for refusal as required by the case law in relation to the individual goods and services concerned. A conferencing feature may arguably be a characteristic of telecommunication apparatus or a telecommunications

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<sup>18</sup> The Hearing Officer goes on to consider the mark under section 3(1)(b) in paragraphs 19 – 21.

service but it is difficult to see how any such argument can be extended to, e.g., education, entertainment, sporting and cultural activities, provision of news information.

- (b) The Hearing Officer describes the mark as consisting of “what appears to be a representation of a human figure together with three separate rectangles, each of which contain representations of the upper part of a human figure”. He further notes that the mark appears to be represented in the colours red, black and purple even though only the colour red is claimed in the application (paragraph 9). The Hearing Officer accepts that the mark has abstract quality and that it comprises a stylised representation. Yet nowhere does he address the issue of whether the mark consists *exclusively* of descriptive signs or indications within the meaning of section 3(1)(c).
89. Nevertheless, I believe that the Hearing Officer’s observations are pertinent to section 3(1)(b) where the aim is deny registration to signs, which do not (either inherently or in fact) perform the essential function of a trade mark, namely to guarantee to the consumer that products bearing the mark originate only from the trade mark owner. The question is whether, when viewed overall in relation to the products concerned against the backdrop of trade practices, the average consumer is likely without further education to perceive the mark as conveying a trade mark message (it being understood that a mark can convey other messages at the same time, e.g., alluding to the nature of the product).
90. I have not found this case easy to determine. Both parties accept that some screen icons are distinctive whereas others are not. The answer in my view depends on whether the mark conveys purely functional information to the consumer or whether, in addition or alternatively, it serves to identify the option provider. I take on board Mr. Stobbs’ statement that, insofar as they are aware, the Applicant is unique in its use of the present icon. I also note that the mark gives rise to at least two interpretations: teleconferencing (the Hearing Officer) and contacts (the Applicant). On the other hand, I bear in mind the general use in telecommunications/IT sectors (and more widely, e.g., publishing) of informational picture icons (e.g., printers) and that the public is well versed in such practices.
91. After much consideration, I have concluded that the Hearing Officer was right in his assessment that the mark would not be viewed as an indication of product source when used as an icon on the screen of a mobile phone, computer, laptop or other communication device. Instead it would solely tell the consumer that a contacts directory (in the case of the Applicant) or conferencing is accessible through selecting that icon. For that reason and in the absence of acquired distinctiveness, in my judgment the mark is devoid of any distinctive character in relation to the specified goods and services in Classes 9 and 38. However, in respect of the specified services in Class 41, I find that any meaning conveyed to the consumer would be sufficiently obscure to allow the mark to function as an indication of origin. Accordingly the Human Figure Application is remitted to the Registry for further processing in

Class 41 where the Hearing Officer's decision is overturned and Class 16 where no objection has been raised.

**Application No. 2360930**

92. The final application the subject of these appeals is Application number 2360930 ("the i Symbol Application") dated 15 April 2004 for the mark shown below:



The i Symbol Application states that the Applicant claims the colours red and white as elements of the mark. The specified goods and services in Classes 9, 16, 38 and 41 are the same as for the other applications in suit. Registration is additionally sought in respect of:

Class 35

Advertising; business management; business administration; office functions; marketing, promotional and advertising services; business advisory, consultancy and information services; the bringing together for the benefit of others of a variety of goods and services to allow customers to conveniently view and purchase those goods and services by means of Internet websites, retail stores, wholesale stores, mail order services, all specialising in the provision of telecommunications goods and services; information and advisory services relating to the aforesaid.

Class 36

Insurance; financial affairs; monetary affairs; real estate affairs; information services and interactive database information services all relating to finance, insurance, shares and share dealing; information and advisory services relating to the aforesaid.

Class 39

Transport; packaging and storage of goods; travel arrangements; information services relating to travel and transport; booking and ticketing services relating to travel and transport; information and advisory services relating to the aforesaid.

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services; information and advisory services relating to weather; information and advisory services relating to the aforesaid.

Class 43

Services for providing food and drink; temporary accommodation; information and advisory services in respect of food and restaurants; booking and reservation services for restaurants; information and advisory services relating to the aforesaid.

Class 44

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; information and advisory services in respect of hygiene, beauty care and health care; information and advisory services relating to the aforesaid.

93. The Hearing Officer records in his decision, dated 11 July 2006 (BL O/189/06), that (paragraph 3):

“3. Objection has been taken to the mark in classes 9, 16, 35, 36, 38, 39, 41, 42, 43 and 44 under Section 3(1)(b) and (c) of the Act because the mark consists of a single lower case letter “i” within a red circle, the whole being a sign which would not be seen as a trade mark as it is devoid of any distinctive character. This is because such signs are commonly used as computer icons, used to designate Internet access, interactive or information services.”

94. Nevertheless, the Hearing Officer makes clear that his primary ground for refusing the i Symbol Application was under section 3(1)(c), i.e., the mark consists exclusively of signs or indications which may serve, in trade, to designate characteristics of goods or services. He said:

“14. The purchasers, and potential purchasers, of the goods and services in question purchase them because they satisfy their own personal requirements regarding the specification they offer. Mr Stobbs has agreed that the letter “i” is commonly used as an abbreviation for the words Internet, interactive and information.

15. In relation to mobile telephones, laptop computers, drivers and software for telecommunications networks and telecommunication apparatus in Class 9 the mark designates that Internet and interactive services are available via these goods. In relation to Internet portal services and Internet access services in Class 38 the mark designates that Internet connection services are available. In relation to Class 41 the mark designates that interactive entertainment and interactive games services are available.

16. In relation to downloadable electronic tariffs in Class 9 and printed tariffs in Class 16 the mark designates that information relating to these

goods is available. In Classes 35, 36, 38, 39, 41, 42 and 44 the mark designates that information relating to all of the services applied for in those classes is available.

17. Mr Stobbs has sought to persuade me that this particular device, in this particular arrangement, in the colours red and white, is distinctive of the goods and services for which registration is sought in classes 9, 16, 35, 36, 38, 39, 41, 42, 43 and 44.

18. The relevant consumer of such goods and services would therefore, in my view, perceive this mark as no more than an indication that Internet access, interactive entertainment and information services are offered as one of the features available, either on the goods themselves or as part of the service package. The fact that this particular trade mark is represented in the colours red and white 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. In order to achieve that the sign must guarantee that the goods and services originate from a single undertaking.

19. 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 whether it is used on a screen or otherwise.

20. 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, 16, 35, 36, 38, 39, 41, 42, 42 [sic 43] and 44 and is debarred from registration under Section 3(1)(c) of the Act.”

95. At the appeal hearing there was some dispute over the symbol used to signify tourist information. Mr. James supplied a print out from an Internet web site entitled “EVERY new product”, which shows a lower case letter “i” (not in the same font/style as the “i” in the mark in suit) apparently in a red circle (the copy provided was not in colour). The print out states:

“The symbol we have used for “information” is the universal information symbol based on the letter “i” which is often seen at tourist attractions.”



Mr. Stobbs pointed out that the symbol used for tourist information is different. The letter “i” is in a different font and the tourist information sign is blue. In the face of that objection, Mr. James conceded that the statement on the “EVERY new product” print out was equivocal. Following the appeal hearing, Mr. Stobbs sent me two emails with two separate attachments. The first email, dated 24 January 2007, attaches a symbol comprising a letter “i” in lower case leaning forward on a dark square background with white edging. The second email, dated 1 February 2007, attaches the “EVERY new product” “i” symbol, which was originally supplied by Mr. James. In both emails, Mr. Stobbs writes that he is attaching the “Tourist Information” symbol. In spite of the mix-up, I believe I can take judicial notice of the fact that the symbol used in the UK to indicate tourist information centres consists of a stylised letter “i” in lower case angled forward often in white on a blue square background (or vice versa) and sometimes in white and brown.

96. Mr. James concedes that the scope of the Hearing Officer’s objection under section 3(1)(c) is unclear and therefore non-compliant with the ECJ ruling in *BVBA* (see, paragraphs 30 – 34 and 38). In particular, the Hearing Officer’s reasoning at paragraph 16 concerning services in Classes 35, 36, 38, 39, 41, 42 and 44<sup>19</sup> seems directed at “information and advisory services relating to the aforesaid” rather than the services themselves. In other words, as Mr. James observes, the Hearing Officer appears not to have turned his mind to whether there is any distinction between the information and advisory services and the services in relation to which information etc. is provided, such as, transport, packaging and storage of goods and so on. I would add that, in my view, the provision of information or advice concerning a product is not *per se* a characteristic of that product. Accordingly, a section 3(1)(c) objection in those circumstances is misplaced.
97. The discussion at paragraph 95 of this decision indicates a number of different modes in which the letter “i” can figuratively or stylistically be represented. The Hearing Officer asks himself whether the fact that the mark is represented in the colours red and white “by itself bestows distinctive character on the mark to the extent that it becomes capable of performing the function of a trade mark”. Rather he should have considered whether the figurative presentation overall took the mark outside section 3(1)(c) because it could not be said to consist wholly of descriptive signs or indications.
98. In my judgment the appropriate objection in this case is the Hearing Officer’s alternative ground that the mark is devoid of any distinctive character for the specified goods and services contrary to section 3(1)(b). This is again a situation where one would have to be living on the moon not to be familiar with the pervasive use in commerce and otherwise of the “i” symbol to signify the making available or provision of information and advice. Such practice is prevalent not only in the telecommunications industry of present interest to the Applicant but also in the other industries covered by the applied for specifications, e.g., insurance, travel arrangements, temporary accommodation, medical services.

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<sup>19</sup> I note in passing that the Hearing Officer omits any consideration of specified services in Class 43.

99. Accordingly, not only in relation to information and advisory services as such but also in relation to all the specified goods and services in Classes 9, 16, 35, 36, 38, 39, 41, 42, 43 and 44, in the *prima facie*, the mark will be perceived by the average consumer<sup>20</sup> as conveying the origin neutral message that information and, or advice about the respective goods or services is accessible. Concerning goods in Class 9 and services in Classes 38 and 41, the Hearing Officer considered that the mark would signify Internet access or interactivity. The fact that the mark might trigger such additional/alternative origin neutral perceptions/recollections in the minds of relevant consumers serves to reinforce my conclusion that the mark is devoid of any distinctive character for the goods and services concerned and must be refused registration pursuant to section 3(1)(b).

### **Conclusions**

100. In summary my conclusions are as follows:
- (i) Application number 2360944, the Envelope Application – refused registration under section 3(1)(b) in Classes 9, 38 and 41 and remitted to the Registry for reconsideration in Class 16 in the light of my decision.
  - (ii) Application number 2360945, the Downloads Application – refused registration under section 3(1)(b) in Classes 9, 16, 38 and 41.
  - (iii) Application number 2360938, the Football Application – refused registration under section 3(1)(b) in Classes 9, 38 and 41 except for cultural activities in Class 41. Remitted to the Registry for further processing in relation to cultural activities in Class 41 and reconsideration in Class 16 in the light of my decision.
  - (iv) Application number 2360946, the Games Console Application – refused registration under section 3(1)(b) in Classes 9 and 41 except for cultural activities; provision of news information; information and advisory services relating to the aforesaid in Class 41. Remitted to the Registry for further processing in relation to cultural activities; provision of news information; information and advisory services relating to the aforesaid in Class 41 and reconsideration in Classes 16 and 38 in the light of my decision.
  - (v) Application number 2360950, the Speech Bubbles Application – refused registration under section 3(1)(b) in Classes 9, 38 and 41 and remitted to the Registry for reconsideration in Classes 16 and 45 in the light of my decision.

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<sup>20</sup> The average consumer is accepted to be the general public.

- (vi) Application number 2360935, the Human Figure Application – refused registration under section 3(1)(b) in Classes 9 and 38 and remitted to the Registry for further processing in Classes 41 and 16.
- (vii) Application number 2360930, the i Symbol Application – refused registration under section 3(1)(b) in Classes 9, 16, 35, 36, 38, 39, 41, 42, 43 and 44.

101. Finally, in accordance with normal practice, I make no order as to costs.

Professor Ruth Annand, 11 May 2007

Mr. Julius Stobbs, Messrs. Boulton Wade Tennant, appeared on behalf of the Applicant.

Mr. Allan James appeared for the Registrar.