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INTELLECTUAL PROPERTY OFFICE

The Rolls Building  
7 Rolls Building  
Fetter Lane  
London EC4A 1NL

Friday, 7th August 2015

Before:

MR. GEOFFREY HOBBS QC  
(Sitting as the Appointed Person)

- - - - -

In the Matter of the Trade Marks Act 1994

and

In the Matter of Trade Mark Application No. 3012530

SERIOUSLY POPULAR  
by Associated Newspapers Limited (Appellant)

- - - - -

(Transcript of the Stenograph Notes of  
Marten Walsh Cherer Limited, 1st Floor, Quality House,  
6-9 Quality Court, Chancery Lane, London, WC2A 1HP  
Telephone No: 020 7067 2900. Fax No: 020 7831 6864  
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MR. MARTIN KRAUSE (for Haseltine Lake LLP) appeared on behalf  
of the Appellant.

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APPROVED DECISION  
- - - - -

## O-381-15

1 THE APPOINTED PERSON: On 3rd July 2013, Associated Newspapers  
2 Limited applied, under number 3012530, to register the  
3 designation SERIOUSLY POPULAR as a trade mark for use in  
4 relation to a wide array of goods and services, listed in  
5 classes 9, 35, 38 and 41 as follows:

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

15 "Class 35: Advertising, marketing, public relations,  
16 publicity and promotional services; advertising, marketing,  
17 public relations and promotional services, all relating to  
18 employment and personnel selection; classified advertising;  
19 personnel management; agency, counselling, recruitment and  
20 placing services, all relating to employment and personnel  
21 selection; market studies and analysis; rental of advertising  
22 space, dissemination of advertising matter; advertising mail  
23 order; provision of advertising space on a website;  
24 compilation of advertisements for use as web pages on the  
25 Internet; provision of advertisement programmes; provision of

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1 commercial information; television, radio and satellite  
2 commercials; business management and administration; business  
3 research; business organisation and management consultancy  
4 services; compilation and provision of business information,  
5 advice and statistics; economic forecasting; computerised  
6 business information storage and retrieval services; opinion  
7 polling, market surveys; market research; computerised  
8 accounting; computerised database management; computerised  
9 data processing and business management advice and  
10 consultancy; storage of information; information, advisory and  
11 consultancy services relating to all the aforesaid services;  
12 all the aforementioned services also provided on-line from a  
13 computer database or from the Internet.

14 "Class 38: Telecommunication; computer  
15 inter-communication services; broadcasting by radio,  
16 television and satellite; broadcasting and transmission of  
17 programmes; operation of broadcasting facilities; news  
18 services; transmission of news; transmission of publications;  
19 telecommunication of information (including web pages),  
20 computer programs and any other data; providing access to  
21 online information and/or communication services;  
22 information and advisory services relating to  
23 telecommunication services; provision of information about  
24 communication and/or broadcasting by electronic media;  
25 communication services provided by electronic, computer,

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1 cable, teleprinter, teleletter and electronic mail means;  
2 communication services provided on the Internet; interactive  
3 communications services provided by means of a computer;  
4 transmission of information; communication by computer  
5 terminals; message sending services; message boards; providing  
6 on-line electronic bulletin board services and chat rooms;  
7 operating chat rooms; telegraph services; wire services;  
8 information, advisory and consultancy services relating to all  
9 the aforesaid services; all the aforementioned services also  
10 provided on-line from a computer database or from the  
11 Internet.

12 "Class 41: Education and entertainment services;  
13 publication services; publishing services; publication of  
14 printed matter and printed publications; publication of  
15 newspapers, newsletters; publication of printed and  
16 educational material; provision of news; provision of news  
17 online; education, entertainment, publishing and publication  
18 services; electronic publishing services; providing on-line  
19 electronic publications [not downloadable]; publication of  
20 electronic books and journals on-line; publication online of  
21 information in a variety of fields, including news, fashion,  
22 travel, food and drink, television, show business, current  
23 affairs, sport, health, finance, science and technology,  
24 property and motoring; editing services; journalism services;  
25 organisation of exhibitions and shows; provision of

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1 information relating to education, sporting, political,  
2 current events, cultural activities, film, theatre, cinema,  
3 television, radio, shows, music and entertainment;  
4 entertainment; sports information services; organisation of  
5 competitions, quizzes, games and recreational, recreational  
6 activities, amusements, cultural activities; news programme  
7 services for radio or television; commissioned writing  
8 services; syndication of previously published content for  
9 re-use or re-purposing; syndication of previously  
10 published content for re-publication in other media or sale to  
11 the public; syndication of visual works for re-publication in  
12 other media or sale to the public; publication of material  
13 which can be accessed from databases or from the internet;  
14 syndication of cuttings (digital and non-digital);  
15 information services relating to all the aforesaid services;  
16 electronic game services provided by means of the Internet;  
17 production of shows and radio and television programmes; cable  
18 television, television and radio entertainment services;  
19 providing digital music [not downloadable] from the Internet;  
20 providing digital music [not downloadable] from MP3 Internet  
21 web sites; providing digital music from the Internet;  
22 providing an on-line music store for purchase of singles and  
23 albums; information, advisory and consultancy services  
24 relating to all the aforesaid services; all the aforesaid  
25 services also provided on-line from a computer database or

1 from the Internet."

2 The applicant made no claim for registration on the  
3 basis of distinctiveness acquired through use of the  
4 designation in question in relation to any goods or services  
5 of the kind specified.

6 The application was refused in its entirety for the  
7 reasons given by Ms. Bridget Whatmough, on behalf of the  
8 Registrar of Trade Marks, in a decision issued under  
9 reference BL O-125-15 on 24th March 2015. She concluded that  
10 the designation was caught by the exclusion from registration  
11 contained in section 3(1)(b) of the Trade Marks Act 1994 for  
12 being devoid -- that is to say unpossessed -- of any  
13 distinctive character in relation to the goods and services  
14 for which protection by registration had been requested.

15 Having directed herself, correctly, as to the scope and  
16 application of section 3(1)(b), she considered that the  
17 designation SERIOUSLY POPULAR lacked the power to  
18 individualise such goods and services to a single economic  
19 undertaking for the following reasons:

20 "19. Given that the objection has been maintained  
21 under section 3(1)(b), the issue here is whether the  
22 sign applied for when used in relation to the goods and  
23 services claimed would be perceived as one which simply lacks  
24 any capacity prima facie to distinguish the products of one  
25 trader from those of another. I must then, consider the

1 effect upon the perceptions of the average consumer on seeing  
2 the words 'SERIOUSLY POPULAR' in normal and fair use in  
3 relation to the goods and services of the application. This  
4 process starts with a linguistic analysis of the individual  
5 words which appear in the combination as presented. Although  
6 it is paramount that any assessment of distinctiveness takes  
7 into account the mark's totality, it is also useful to first  
8 analyse the mark by reference to its constituent parts.

9 "20. The mark applied for consists of the expression  
10 'SERIOUSLY POPULAR'. The individual words within the mark are  
11 defined in Collins English Dictionary as follows:

12 Seriously adverb, informal; extremely or remarkably:  
13 seriously tall  
14 Popular adjective appealing to the general public;  
15 widely favoured or admired.

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

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

20 "21. In this case, the sign possesses no particular  
21 stylisation or device elements; it is word-only. Both words  
22 are in grammatically correct order and are recognisable. The  
23 word 'seriously' has some informality about it, but  
24 nonetheless merely qualifies that the goods and services are  
25 extremely, or remarkably appealing, or favoured. In terms of

1 the phrase's inherent linguistic characteristics, in my  
2 opinion it is difficult to see exactly what about it as a  
3 whole could ever conceivably perform the essential function of  
4 a trade mark in the prima facie case. It is, to coin a well  
5 known phrase in trade mark circles in the UK, entirely 'origin  
6 neutral'."

7 In paragraphs 23 to 25 of her decision, she noted (and  
8 accepted) the applicant's contention, linked to the reasoning  
9 of the CJEU in Case C-398/08 P, Audi AG v OHIM ("Vorsprung  
10 durch Technik"), to the effect that a sign, including a sign  
11 which conveys a promotional message, can, by combining verbal  
12 elements in a way that noticeably involves an element of  
13 wordplay, be thus endowed with a distinctive character.

14 In paragraphs 26 to 28 of her decision, she rejected the  
15 further contention that the designation SERIOUSLY POPULAR  
16 could and should be regarded as a sign which involved, in  
17 the combination of its constituent verbal elements, a play on  
18 words.

19 The applicant now appeals under section 76 of the Trade  
20 Marks Act 1994, contending, in substance, that there is a play  
21 on words in the designation SERIOUSLY POPULAR which should  
22 have been taken to render it registrable for possession of a  
23 distinctive character in relation to all of the goods and  
24 services specified; alternatively, in relation to those of  
25 them which may be regarded as goods and services pertaining to



1 the communication of information by popular media, such as  
2 newspapers and, I infer, television.

3 I have struggled to understand what it is about  
4 combining the word "seriously" with the word "popular" that is  
5 said to involve the wordplay upon which freedom from objection  
6 under section 3(1)(b) is said to depend. With the benefit of  
7 the submissions which have been addressed to me on this point,  
8 I understand the applicant to be contending that the word  
9 "seriously" as used in the designation SERIOUSLY POPULAR  
10 is open to interpretation as meaning either "extremely" or  
11 "gravely" popular", and to those who thought about the designation  
12 in the latter way, it would be a quirky or idiosyncratic and  
13 hence distinctive form of expression.

14 These submissions echo the applicant's arguments as  
15 recorded in the bullet points in paragraph 8 of the Hearing  
16 Officer's decision. She did not overlook or ignore the  
17 arguments; having noted them, she rejected them. It is clear  
18 that she did so on the basis that she saw no 'double entendre'  
19 of the kind suggested in the way in which the designation  
20 SERIOUSLY POPULAR would be understood by the relevant  
21 average consumer of the goods and services in issue in this  
22 case. There is, so far as I can see, no failure of analysis  
23 in her decision in that respect.

24 In my view, the argument advanced on behalf of the  
25 applicant involves an unnatural and contrived approach to the

1 meaning and use of the words in issue here. In modern  
2 parlance, there is widespread and well-established use of the  
3 word "seriously" as an emphatic refinement of the words  
4 "really" and "very".

5 The word "popular" plainly (and obviously) relates to  
6 the status of being well-liked and appreciated. In the sign  
7 that I am now considering, "seriously" qualifies "popular" and  
8 "popular" qualifies "seriously". Saying that something is  
9 seriously popular is, to all intents and purposes, the same  
10 thing as saying that it is really very well-liked and  
11 appreciated.

12 That is not an individualising message of the kind that  
13 a trade mark must convey in order to serve as an indication of  
14 provenance in relation to goods and services of the kind for  
15 which it is used. I am satisfied that the present application  
16 for registration is entirely unsustainable in the prima facie  
17 case; that the Hearing Officer rightly rejected it under section  
18 3(1)(b) of the Act; and that the appeal from her decision must  
19 be dismissed. In accordance with the usual practice on  
20 appeals from decisions of the Registrar in ex parte  
21 proceedings, the appeal is dismissed with no order as to  
22 costs.

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