

O-065-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER
2534126**

**BY 02 HOLDINGS LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN
CLASSES 9, 38, 41 AND 42:**

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Background

1. On 11 December 2009, O2 Holdings Limited ('the applicant') applied to register UK trade mark application number 2534124, consisting of the word-only mark THE WORKS ('the mark') for the following goods and services:

Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; 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; PDAs (Personal Digital Assistants), pocket PCs, mobile telephones, laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; computer software recorded onto CD Rom; SD-Cards (secure digital cards); glasses, spectacle glasses, sunglasses, protective glasses and cases therefor; contact lenses; cameras; camera lenses; MP3 players; audio tapes, audio cassettes, audio discs; audio-video tapes, audio-video cassettes, audio-video discs; video tapes, video cassettes, video discs; CDs, DVDs; electronic publications (downloadable); mouse mats; magnets; mobile telephone covers, mobile telephone cases; magnetic cards; encoded cards; parts and fittings for all the aforesaid goods.

Class 38: Telecommunications; telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications

access; broadband services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging services; information services provided by means of telecommunication networks relating to telecommunications; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; provision of access time for data networks and data banks, in particular the Internet; communications services for accessing a database, leasing of access time to a computer database; providing access to computer databases; rental of access time to a computer database; support services relating to telecommunications and apparatus; operation of a network, being telecommunication services; expert advice and opinion relating to telecommunications; planning relating to telecommunications equipment; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; interactive entertainment services; electronic games services provided by means of any communications network; entertainment and information services provided by means of telecommunication networks; provision of news information; television services; Internet protocol television services; provision of entertainment by means of television and Internet protocol television; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

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; information and consultancy services relating to information technology; consultancy services relating to information technology; engineering services relating to information technology; information services relating to information technology; technical consultancy services relating to information technology; computer programming services; programming of data processing apparatus and equipment; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; computer rental; computer software design; installation of computer software; maintenance of computer software; updating of computer software; rental of computer software; rental of computer hardware; computer system design; computer systems analysis;

consultancy in the field of computer software; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites) of others; engineering services relating to telecommunications; technical consulting; rental of computers; monitoring of telecommunications network systems; services of information brokers and providers, namely product research for others; weather forecasting; research relating to telecommunications; research of field telecommunication technology; expert advice and opinion relating to technology; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

2. On 21 December 2009, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') on the grounds that the mark designates the kind of the goods and services e.g. 'the provision of the most comprehensive package of goods and/or services in a field'.

3. In response to the objection, an *ex parte* hearing was requested which subsequently took place on 19 February 2010. At the hearing, the agent argued that whilst the phrase 'the works' might be used in a limited and colloquial manner to convey the meaning alleged by the examiner, it was not used universally, and would not be subject to descriptive use in the context of services such as telecommunications. The agent also submitted that the Registrar had an obligation to provide evidence in order to substantiate his opinion that the mark may be used in respect of the goods and services claimed.

4. In my hearing report I confirmed that the sign was both descriptive and devoid of any distinctive character pursuant to sections 3(1)(b) and (c), but only in respect of those goods and services for which the relevant consumer would understand the sign as being a denotation of type or characteristic i.e. those products (including service 'products') capable of being presented as a complete or comprehensive package. The objection was therefore maintained in respect of the following:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; data processing equipment and computers; 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; PDAs (Personal Digital Assistants), pocket

PCs, mobile telephones, laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; computer software recorded onto CD Rom; cameras; MP3 players; parts and fittings for all the aforesaid goods.

Class 38: Telecommunications; telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications access; broadband services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging services; information services provided by means of telecommunication networks relating to telecommunications; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; provision of access time for data networks and data banks, in particular the Internet; communications services for accessing a database, leasing of access time to a computer database; providing access to computer databases; rental of access time to a computer database; support services relating to telecommunications and apparatus; operation of a network, being telecommunication services; expert advice and opinion relating to telecommunications; planning relating to telecommunications equipment; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; interactive entertainment services; electronic games services provided by means of any communications network; entertainment and information services provided by means of telecommunication networks; television services; Internet protocol television services; provision of entertainment by means of television and Internet protocol television; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; casino services; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

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; information and consultancy services relating to information technology; consultancy services relating to

information technology; engineering services relating to information technology; information services relating to information technology; technical consultancy services relating to information technology; computer programming services; programming of data processing apparatus and equipment; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; computer rental; computer software design; installation of computer software; maintenance of computer software; updating of computer software; rental of computer software; rental of computer hardware; computer system design; computer systems analysis; consultancy in the field of computer software; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites) of others; engineering services relating to telecommunications; technical consulting; rental of computers; monitoring of telecommunications network systems; services of information brokers and providers, namely product research for others; weather forecasting; research relating to telecommunications; research of field telecommunication technology; expert advice and opinion relating to technology; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

5. In the note, I also confirmed that the objection had been waived in respect of those goods and services which were not considered to fall into the category referred to at paragraph 4 above. Those goods and services are as follows:

Class 9: Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines; fire-extinguishing apparatus; protective clothing; protective helmets; SD-Cards (secure digital cards); glasses, spectacle glasses, sunglasses, protective glasses and cases therefor; contact lenses; camera lenses; audio tapes, audio cassettes, audio discs; audio-video tapes, audio-video cassettes, audio-video discs; video tapes, video cassettes, video discs; CDs, DVDs; electronic publications (downloadable); mouse mats; magnets; mobile telephone covers, mobile telephone cases; magnetic cards; encoded cards; parts and fittings for all the aforesaid goods.

Class 41: Provision of news information; rental of music venues and stadiums; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a

computer database or the Internet; information and advisory services provided over a telecommunications network.

6. Although the agent was granted one post-hearing extension of time in order to file further submissions, no more correspondence was received. This led to a partial refusal in respect of the goods and services highlighted above which, in turn, prompted the agent to submit a form TM5 requesting a statement of reasons for the Registrar's decision.

7. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purpose of demonstrating acquired distinctiveness. Therefore, in respect of the goods and services listed at paragraph 4 above, I have only the *prima facie* case to consider.

The applicant's case for registration

8. In the absence of any written submissions from the agent, the only arguments put forward in support of *prima facie* acceptance were those made orally at the *ex parte* hearing on 19 February 2010. These arguments centred on subjective interpretation of the phrase 'the works' and its alleged unsuitability and inherent distinctiveness when used in respect of the goods and services claimed. The agent noted the dictionary definitions referred to by the Registrar (referred to in greater detail in subsequent paragraphs of this decision), but submitted that those definitions only applied to use of the phrase in very limited contexts. Whilst acknowledging that it might be used in respect of e.g. pizza and restaurant services (where the term might refer to a particular meal option), the agent argued against its wider application into areas such as telecommunications and entertainment. Our discussions also touched upon the Registrar's obligation (or otherwise) to substantiate objections based on absolute grounds with supporting material showing *bona fide* third party use of the mark. In all cases, the agent strongly maintained that the sign was capable of denoting trade origin, without any prior education required on the part of the consumer.

The Law in relation to section 3(1)(c)

9. Section 3(1)(c) of the Act reads as follows:

"3.-(1) The following shall not be registered-

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose,

value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services."

Decision - Section 3(1)(c)

10. In *JanSport Apparel Corp v Office for Harmonisation in the Internal Market* (Case T-80/07) the General Court ('GC') gave a helpful summary of the considerations to be taken into account in relation to Article 7(1)(c) of the regulation, the equivalent of section 3(1)(c) of the Act:

"18. Under Article 7(1)(c) of Regulation No 40/94, '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 or the 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. In addition, Article 7(2) of Regulation No 40/94 (now Article 7(2) of Regulation No. 207/2009) states that, 'paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

19. By prohibiting the registration of such signs, that article 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 (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31).

20. Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 28, and Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 28).

21. 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 (see the judgment of 9 July 2008 in Case T-323/05 *Coffee Store v OHIM (THE COFFEE STORE)*, not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in

which it is understood by the relevant public (Case T-322/03 *Telefon & Buch v OHIM– Herold Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 90).

22. It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).

23. It must finally be pointed out that the criteria established by the case law for the purpose of determining whether a word mark composed of several word elements is descriptive or not are identical to those applied in the case of a word mark containing only a single element (Case T-28/06 *Rheinfelsquellen H. Hövelmann v OHIM (VOM URSPRUNG HER VOLLKOMMEN)* [2007] ECR II-4413, paragraph 21).”

11. Furthermore, in Case C-363/99 *Koninklijke KPN Nederland NV and Benelux-Merkenbureau, C-363/99 (Postkantoor)*, the Court of Justice of the European Union stated:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned...

...

102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”

12. In order to determine whether or not the mark is excluded by section 3(1)(c) on account of it performing a descriptive function, the Registrar must consider both the goods and services intended for protection under the mark, and the perception of the average consumer for such products. In the case of the former, I have already identified those goods and services which are no longer subject to an objection, and those for which the sign remains unacceptable. In the case of the latter, the Registrar is obliged to identify the relevant consumer, and gauge the level of attention likely to be exercised where the sign is encountered in trade.

13. For most of the terms subject to an objection, it is reasonable to assume that the relevant consumer will be the general public. Although technical by nature, the majority of products claimed in classes 9 and 38 are now likely to be purchased by everyday householders. IT and technical literacy is such that one no longer needs any specialist knowledge in order to use mobile telecommunications devices, palm-top computers and the like, and most of us make frequent use of those services which provide use with Internet access, email and digital content. Such goods and services are therefore likely to be directed towards a fairly non-specialist public. Similarly, class 41 contains a range of broad, non-specialised terms such as 'entertainment' and 'sporting activities', which denote services likely to be used by the general populace. For most of these terms, the relevant consumer is likely to be someone without any particular technical expertise, but also, given the reasonably high unit price of telecommunications apparatus and services, someone who is likely to exercise an above-average level of attention when considering a purchase.

14. At the same time, the application contains a smaller range of terms which reflect goods and services directed towards a more specialist consumer base. These would include *inter alia* nautical, surveying and life-saving apparatus and instruments in class 9, telecommunications planning in class 38, and almost all of the scientific and technological services claimed in class 42, most of which are likely to be purchased with a greater degree of attention. On balance, therefore, when assessing consumers' perception of the sign 'THE WORKS' in respect of all the terms claimed, I have assumed that the average consumer will apply an above-average level of attention.

15. Turning my assessment to the mark applied for, I refer to dictionary entries for the phrase 'the works' (as a noun) where it is defined - in the context of definitions for the word 'work' as follows:

the works *informal* everything needed, desired, or expected: *the heavens put on a show: sheet lighting, hailstones, the works.*
(Taken from New Oxford Dictionary of English (Oxford University Press, 2001))

the works *plural* everything possessed, available, or belonging: *the whole works, rod reel, tackle box, went overboard; ordered pizza with the works.*

(Taken from Merriam-Webster Online Dictionary)

16. Both of these dictionary definitions demonstrate that the phrase 'the works' not only possesses a consistent and recognisable meaning likely to be understood by the average English speaking consumer, but also that its suitability to act a descriptor is not especially limited to a small number of contexts or scenarios. In the example text used in the definitions provided, the phrase is used in relation to meteorological phenomena, fishing tackle, and pizzas. Furthermore, in each case, it is used to convey the scale, quantity or degree of something which is either being *witnessed* (in the case of the weather), *misplaced* (in the case of fishing tackle), or - of greatest relevance to this decision - *provided* (in the case of pizzas).

17. In determining the mark's suitability for acceptance and registration under section 3(1)(c), the Registrar is obliged to consider the semantic content of the sign and consider, in the context of the goods and/or services claimed, whether or not the relevant consumer is likely to perceive it as being a denotation of a particular characteristic. Given the dictionary definitions provided above, the Registrar finds it likely that the relevant consumer would recognise the sign as conveying a particular message, and that the message conveyed would be understood as having a functional (rather than a distinctive) role to play in respect of goods or services it is used upon.

18. For class 9, the section 3(1)(c) objection is based on the premise that the term 'the works' used in respect of products such as mobile phones, computers, content carrying media and other electronic items would be understood as reference to the feature set of the product, its effectiveness, or simply the quantity and breadth of goods provided for sale. For example, a smart phone which provides the user with a comprehensive range of features such as web connectivity, high definition video streaming, and a high resolution digital camera could be marketed as something which provides 'the works' in terms of modern-day digital communications. Similarly, where the latest laptops are now commonly configurable and customisable in terms of features such as processing speed and memory capacity (dependent upon the customer's requirements), the phrase 'the works' might reasonably be used by the trader to describe that option which provides the ultimate level of performance i.e. where all of those custom features are maximised. In terms of quantity, the phrase may also perform a descriptive function where a range or package of products is offered for sale. Therefore, in respect of computers, peripherals and software, where the consumer is often able to choose between a range of complimentary products to suit budget and personal requirements, 'the works' may be used to denote that package which contains more 'product' than any other package offered for sale.

19. In drawing these conclusions, the Registrar recognises that one's interpretation of what the phrase 'the works' actually signifies is a largely subjective process dependent on consumer expectation. Therefore, a consumer accustomed to using

smart phones may consider the type of features listed in the previous paragraph as being nothing more than the industry standard. Conversely, a consumer with little experience of using computers may consider industry-standard features such as email and the Internet as being - in the words of the dictionary definition provided above - 'everything one might need or expect'. It is therefore acknowledged and accepted by the Registrar that the mark may mean different things to different consumers. However, a trade mark's capacity for subjective interpretation does not render it distinctive (confirmed by the ECJ in case C-191/01 P *Wm. Wrigley Jr. Company v OHIM (Doublemint)* where, at paragraph 32, it confirmed that "...a sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned").

20. For the service classes, the reasoning which underpins the section 3(1)(c) objection is essentially the same. In respect of telecommunications, the differentiation between various product packages is often characterised by the amount, degree, or extent of the service provided. One might wish to purchase a limited service package which provides a predetermined amount of call minutes, texts, download capacity, or television channels. Equally, one might wish to purchase a more premium package without restrictions, for example, one which provides unlimited talk time, the largest available download capacity, and/or the full range of television channels. Used in these scenarios, the relevant consumer would not perceive the phrase 'the works' as anything other than a reference to the extent or breadth of service being provided, and registration of such a phrase would clearly serve to inconvenience other parties seeking to use it in the course of their trade. In essence, any service with the capacity to be provided in an incremental fashion - which would apply to all of the services identified in classes 38, 41 and 42 and listed at paragraph 4 above - might be described as being 'the works' where that service is being provided to its fullest extent.

21. At the *ex parte* hearing, the agent sought substantiation from the Registrar to demonstrate that the phrase is used in contexts which apply to the goods and services subject to an objection. In response, I sought to emphasise that the objection was based on the phrase's established (and dictionary-defined) meaning, and the descriptive message it would likely convey when used in the normal course of trade. The Registrar maintains that position in this decision, which reflects our published practice in respect of onus during examination. As was confirmed by Geoffrey Hobbs QC sitting as The Appointed Person in the EUROLAMB case (1997, RPC 279), section 37 of the Trade Marks Act 1994 (dealing with registration procedure) is neutral, with no presumption in favour of or against registration; and there is nothing in the nature of a burden for the Registrar to discharge in order to justify his decision to refuse an application.

22. Having found the mark to be partially excluded from registration by section 3(1)(c) of the Act, that effectively ends the matter. However, in case I am found to be wrong in that respect, I will go on to determine the matter under section 3(1)(b).

Decision - Section 3(1)(b)

23. In relation to section 3(1)(b), the ECJ held in *Postkantoor* (cited above) that:

"86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regards to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive."

24. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) - (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);

- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus distinguish that product (or service) from the products (or services) of other undertakings (*Linde*, paragraphs 40-41 and 47);

- A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor*, paragraph 86);

- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought, and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);

- The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

25. Taking all of the above into account, the Registrar is obliged to reject a trade mark pursuant to section 3(1)(b) where, although it may be considered too imprecise

a term to indicate a direct and specific relationship with the goods or services at issue without further thought, the mark remains generally non-distinctive. For reasons already given, the Registrar clearly does consider the sign to be descriptive of specific characteristics. However, in the context of 3(1)(b), the mark is also clearly non-distinctive. The agent's submissions in respect of subjective interpretation on the part of the consumer may have more weight in respect of this provision, than in relation to section 3(1)(c) i.e. one might argue that a mark with the capacity to convey multiple subjective meanings renders it less capable of being found to denote one dominant meaning. If that is the case, and it is found that the sign is not descriptive, I still believe that the sign would not perform the essential function of a trade mark. The Registrar is obliged to consider notional and fair use, including use of the mark on promotional literature, advertising materials and, in the context of goods, packaging. Given the general and broad range of meanings conveyed by the phrase 'the works', the relevant consumer would not attach to it any trade origin signification when viewed in the normal manner. He or she would not consider the mark to be that of any particular supplier of electronic goods, telecommunications, education, or technical consultancy services; it could properly be at home on such goods and services provided by any supplier.

26. I therefore conclude that the mark applied for will not be identified as a trade mark without first educating the public to that effect; that it is devoid of any distinctive character; and that it is therefore excluded from *prima facie* acceptance under section 3(1)(b).

Conclusion

27. In this decision, I have considered all documents filed by the applicant/agent and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is partially refused - for the goods and services listed at paragraph 4 above - under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and (c) of the Act.

Dated this 23 day of February 2011

**Nathan Abraham
For the Registrar
The Comptroller-General**