

O-123-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 2500983  
BY SOLOMON TELEKOM COMPANY LIMITED  
TO REGISTER THE FOLLOWING SERIES OF MARKS IN  
CLASSES; 16, 35, 38 and 41:  
NOW WIRES, NO WORRIES and no wires, no worries**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application Number 2500983**

**By Solomon Telekom Company Limited**

**To register the following trade marks as a series of two marks in classes 16, 35, 38 and 41:**

**NO WIRES NO WORRIES and no wires, no worries**

**Background**

1. On 27 October 2009, Solomon Telekom Company Limited ("the applicant") applied to register trade mark application number 2500983, consisting of a series of two marks, word marks "NO WIRES, NO WORRIES" and "no wires, no worries" for the following goods and services:

Class 16 Paper advertising cards, printed matter including printed directory information, books, magazines, periodicals and publications; point of sale materials including posters, cardboard strut cards, cardboard leaflet dispensers; window decals and three dimensional cardboard constructions; photographs; stationery; writing instruments; office requisites (except furniture); instructional and teaching material (except apparatus); book marks; diaries including desk diaries; note books and address books.

Class 35 Promotional, advertising and marketing services.

Class 38 Telecommunication services; provision of Internet chat rooms; provision of online access to exhibitions and exhibition services; provision and operation of electronic conferencing, discussion groups and chat rooms.

Class 41 Entertainment services; provision of games; provision of on-line electronic publications, publication of electronic books and journals on-line; operation of quizzes via the Internet or other electronic networks; sporting and cultural activities, exhibition services; news reporting services for transmission across the Internet; ticket reservation and booking services for entertainment, sporting and cultural events, electronic library services for the supply of electronic information (including archive information) in the form of text, audio and/or video information; provision of digital music (non-downloadable) from the Internet; provision of digital music (non-downloadable from mp3 Internet websites); fashion information provided by telecommunication means from a computer database or via the Internet; provision of information relating to all the aforementioned services.

2. On 19 November 2008, the UK Intellectual Property Office issued an examination report in response to the application. In the report, a partial objection was raised against Class 38 only of the application under Section 3(1)(b) and (c) of the Trade Marks Act 1994 ("the Act"), on the basis that the mark was devoid of any distinctive character, in that the mark "consists exclusively of the words 'NO WIRES, NO WORRIES'" in upper and lower case, being a sign which may serve in trade to advertise the kind of the goods e.g. worry free wireless telecommunications services. The examiner supported the objection with Internet references demonstrating use of the phrase in trade and which were issued with the examination report.

3. A period of two months from the date of the examination report was given for reply, (up to 19 January 2009), with the Registrar confirming that "...the application would be refused if the applicant did not reply by the relevant date requested".

4. Following a hearing, which was held on 7 May 2009, at which the applicant was represented by Mr Gardner of The Trade Marks Bureau, their trade mark attorneys, the objection was maintained.

5. Notice of refusal was issued under Section 37(4) of the Trade Marks Act 1994 and I am now asked under Section 76 of the Act and Rules 69(2) of the Trade Mark Rules 2008 to state in writing the grounds of my decision and the material used in arriving at it.

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

### **The applicant's case for registration**

7. Prior to the hearing, in written correspondence with the examiner Mr Gardner provided submissions in support of his claim that the mark is sufficiently distinctive for acceptance. In these submissions, Mr Gardner stated that the Internet references all refer to use by 3 Mobile Broadbands in connection with their wireless internet connection services and submitted that one other instance of use of the term, could not be deemed an indication that the relevant consumer, or members of the trade, will consider the term to be wholly descriptive of the services and as such devoid of any distinctive character.

8. Mr Gardner also considered that to make the mark a wholly descriptive advertising slogan, additional words must be added and/or removed from the mark such as NO WIRES TO WORRY ABOUT or DON'T WORRY ABOUT WIRES. He argued that the term is not the normal or common way of describing the services and does not need to be left free for other traders to use in the normal course of trade.

9. Mr Gardner stated that the mark is fanciful in that it consists of two elements NO WIRES and NO WORRIES both begin with the word NO and the first letter of the second word both begin with the letter W and both end with the letter S i.e. NO

WIRES, NO WORRIES, there is therefore a symmetry between the marks components which gives the mark a fanciful theme.

10. At the hearing, Mr Gardner reiterated that the Internet references supplied did not support the objection as they all related to one undertaking and that this was not a basis for maintaining that the mark was descriptive. Mr Gardner also reiterated those arguments already presented in his written submissions.

## Decision

11. “3.-(1) The following shall not be registered –

(a) .....

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) .....

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.”

12. The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

## Relevant authorities – general considerations

13. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

14. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. Thus, in the case of the registration of colours *per se*, not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to Section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest ... is, manifestly, in dissociable from the essential function of a

trade mark” (Case C-329/02P, SAT.1 *SatellitenFernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark 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 paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM (Doublemint)*, C-191/0P paragraph 31.

## **The Mark**

15. The mark consists of four words, “NO WIRES, NO WORRIES” which need no explanation as to their grammatical meaning.

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

16. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. In terms of the issues before me in this case I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM – (Doublemint)* paragraph 30;
- 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 category of goods and services in question or one of their characteristics – *Ford Motor Co v OHIM*, Case T-67/07;
- a sign’s descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services – *Ford Motor Co v OHIM*;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word “exclusively” in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux-Merkenbureau*, Case C-363/99 (*Postkantoor*), paragraph 57;

- it is in principle irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary – *Postkantoor*, paragraph 102.

17. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of services or other characteristics of services. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the services in question. The services in Class 38 are 'Telecommunication services; provision of Internet chat rooms; provision of online access to exhibitions and exhibition services; provision and operation of electronic conferencing, discussion groups and chat rooms.'

18. In respect of this section it might be submitted that the relevant consumer of services in question would see the words "NO WIRES, NO WORRIES", on first impression, as a normal way of designating the nature or other characteristic of the services for which registration is sought, i.e. telecommunication services, that utilise wireless connections and which are trouble free. The conclusion that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind of services and is, therefore, excluded from registration by Section 3(1)(c) of the Act, would naturally follow.

19. I have given this argument detailed consideration - it was clearly one that caused the examiner to object to the sign in the first place. However, it seems to me that there is not the sufficient, 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 category of goods and services in question or one of their characteristics (see *Ford Motor Co v OHIM*, Case T-67/07, as cited above).

20. I therefore do not regard the objection under Section 3(1)(c) as made out and now wish to consider that under Section 3(1)(b).

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

21. In relation to (b) it was held in *Postkantoor* 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 regard 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."

22. 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 to 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*).

23. It appears reasonable when applying the normal rules of English language and grammar, that the words NO WIRES and NO WORRIES when used in combination are readily comprehensible. As stated above the services in Class 38 are 'Telecommunication services; provision of Internet chat rooms; provision of online access to exhibitions and exhibition services; provision and operation of electronic conferencing, discussion groups and chat rooms.'

24. The term 'telecommunication services' is an extremely broad term and which would cover multitude of different kinds of telecommunication services' from every day use of a mobile phone that utilises a telecom service or a wireless broadband connection to far more sophisticated telecommunication services. As such I consider that the average consumer of these services would vary accordingly depending on the actual services. In respect of the term 'provision of Internet chat rooms; provision of online access to exhibitions and exhibition services; provision and operation of electronic conferencing, discussion groups and chat rooms', I deem that the relevant consumer of these services would be the public at large. Depending on the kind of telecommunication services the level of attention and knowledge of the consumer will also vary accordingly. However, irrespective of the telecommunication services, they are not an everyday purchase. I therefore consider that the average consumer of even the less sophisticated services will purchase the services with a moderate level of attention and knowledge.

25. In my view, the average consumer will understand the phrase as one which advises consumers that the undertaking provides wireless, worry free telecommunications. I do not agree with Mr Gardner's submissions that to make the mark a wholly descriptive advertising slogan, additional words must be added and/or removed from the mark such as NO WIRES TO WORRY ABOUT or DON'T WORRY ABOUT WIRES. It seems to be that the phrase is one which is plain, unambiguous; there are no alternative meanings possible. Similarly, I do not agree with Mr Gardner's statement that symmetry between the marks components endow the mark

with a fanciful theme. Although not necessarily be determinative on the question of distinctiveness, the phrase cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creativity, such that its meaning becomes elusive or vague. There is some basic alliteration and rhythmic structure (engendered by the repetition of NO) but this is simplistic and glib.

26 Furthermore, because, on the face of it, the phrase potentially operates *both* as a designation of characteristic *and* in a promotional sense (to claim possible advantage), I draw attention to the relevant authorities on 'advertising' and 'promotional' marks. Those key relevant authorities are Case T- 130/01 *Real People Real Solutions* and Case C-64/02P *The Principles of Comfort*. At paras 33-35 of *The Principles of Comfort*, the ECJ says

"33. It is clear from the case-law of the Court of Justice that, as far as assessing distinctiveness is concerned, every trade mark, of whatever category, must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings (see, to that effect, in relation to Article 3(1)(b) 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), which is identical to Article 7(1)(b) of Regulation No 40/94, *Linde and Others*, paragraphs 42 and 47).

34 The Court of Justice has also held that, although the criteria for assessing distinctiveness are the same for the various categories of marks, it may become apparent, in applying those criteria, that the relevant public's perception is not necessarily the same for each of those categories and that, therefore, it may prove more difficult to establish distinctiveness for some categories of mark than for others (see Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraph 38; Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-0000, paragraph 36; and Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] I-0000, paragraph 36).

35. The possibility cannot be excluded that the case-law mentioned in the foregoing paragraph of this judgment is also relevant to word marks consisting of advertising slogans such as the one at issue in this case. That could be the case in particular if it were established, when assessing the distinctiveness of the trade mark in question, that it served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as a trade mark, namely that of guaranteeing the origin of the product. Indeed, in such a case, the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans (see, to that effect, *Procter & Gamble*, paragraph 36)."

27. In Case T-130/01 *Real People Real Solutions*, the CFI says:

“30. Furthermore, there is nothing about the term REAL PEOPLE, REAL SOLUTIONS that might, beyond its obvious promotional meaning, enable the relevant public to memorise the sign easily and instantly as a distinctive trade mark for the services designated. Even if the sign were used alone, without any other sign or trade mark, the relevant public could not, in the absence of prior knowledge, perceive it other than in its promotional sense.

29. Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark.

30. The Court therefore concludes that the sign will be perceived by the relevant public primarily as a promotional slogan, based on its inherent meaning, rather than as a trade mark.”

28. Both authorities are consistent. They do not deny the possibility that promotional phrases may also serve the essential function of a trade mark. They are also consistent, in my view, with the recent judgment, handed down by the ECJ since the refusal of this application, in Case C-398/08P *Audi AG v OHIM* (“*Vorsprung Durch Technik*”), selected paragraphs of which I also quote below.

“41 It must be held that, even though the General Court stated in paragraph 36 of the judgment under appeal that it is clear from the case-law that registration of a mark cannot be excluded because of that mark’s laudatory or advertising use, it went on to explain that the reason for its finding that the mark applied for lacks distinctive character was, in essence, the fact that that mark is perceived as a promotional formula: that is to say, its finding was made precisely on the basis of the mark’s laudatory or advertising use.

44 However, while it is true – as was pointed out in paragraph 33 of the present judgment – that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character.

45 On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood

– perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character.

46 However, by the line of reasoning set out in paragraphs 42 and 43 of the present judgment, the General Court did not substantiate its finding to the effect that the mark applied for will not be perceived by the relevant public as an indication of the commercial origin of the goods and services in question; in essence, rather, it merely highlighted the fact that that mark consists of, and is understood as, a promotional formula.

47 As regards the General Court's finding in paragraph 41 of the judgment under appeal that the mark *Vorsprung durch Technik* can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.

56 In that regard, it must be stated that all marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message. It is clear, however, from the case-law set out in paragraphs 35 and 36 of the present judgment that those marks are not, by virtue of that fact alone, devoid of distinctive character.

57 Thus, in so far as those marks are not descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, they can express an objective message, even a simple one, and still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring little in the way of interpretation by the relevant public, or setting off a cognitive process in the minds of that public.

58 Even if it were to be supposed that the slogan '*Vorsprung durch Technik*' conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.

59 In that context, it should be pointed out that that message does not follow obviously from the slogan in question. As Audi observed, the combination of words '*Vorsprung durch Technik*' (meaning, inter alia, advance or advantage

through technology) suggests, at first glance, only a casual link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, inasmuch as it is a widely known slogan which has been used by Audi for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods or services covered.”

29. The message from this case is, I think, that one should avoid deeming an application as necessarily devoid of distinctive character by virtue of an assertion that it would be seen as entirely, or even primarily, a ‘promotional’ message as far as the average consumer is concerned. Moreover, that objective and simple messages may well also not necessarily be devoid of distinctive character by virtue, solely, of that characteristic. The issue for the ECJ seems to be that where such marks possess ‘originality and resonance’ capable of being remembered (which may, for example, result from word play, imagination and creativity), they are unlikely to be devoid of distinctive character. The impact of the Judgment is, in effect, to urge the relevant authorities to undertake a full semantic analysis of the mark in question (as I have undertaken in this case), without preconception or pre-emption, and also take into account known and relevant surrounding circumstances.

30. As regards the surrounding circumstances in the *Vorsprung durch Technik* case, plainly in paragraph 59 the ECJ factored into their analysis the fact that Audi’s use over many years made it easier for the average consumer to identify the commercial origin of products sold under that slogan. I note that there is no evidence of use in this case. There are no other relevant surrounding circumstances that have been brought to my attention either by the examiner or the applicant.

31. As far as my semantic analysis is concerned, I have concluded that the mark cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creative application which might help endow it with the necessary capability to function. After applying the ECJ’s guidance in ‘*Vorsprung durch Technik*’, as well as those cases which have preceded it, I have no hesitation in upholding the refusal under section 3(1)(b) of the Act. In my view consumers would not consider that the mark to be that of any particular supplier of telecommunication services. It is incapable of distinguishing the services of the undertaking and is nothing more than a non distinctive phrase that could equally apply to any undertaking.

32. I have concluded that 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 the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under Section 3(1)(b) of the Act.

## **Conclusion**

33. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is partially refused in Class 38, under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) of the Act.

**Dated this day 21 April 2010**

**Bridget Whatmough  
For the Registrar  
The Comptroller-General**