

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2182437A
BY CABLE AND WIRELESS PLC
TO REGISTER A TRADE MARK IN CLASSES 16, 36 AND 38**

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5 TO REGISTER A TRADE MARK IN CLASSES 16, 36 AND 38

10 DECISION AND GROUNDS FOR DECISION

On 18 November 1998, Cable and Wireless plc of 124 Theobalds Road, London WC1X 8RX, applied to register the following six marks, then as application number 2182437:

CAN AND WILL

Can and Will

CAN & WILL

Can & Will

CAN AND WILL.COM

CAN & WILL.COM

20 The application was made in respect of the following goods and services:

Class 16

25 Printed matter, magazines, books, directories, brochures, leaflets, cards, stationery; paper and cardboard and goods made from these materials; photographs, instructional and teaching material; materials for packaging; cards in the form of debit cards, credit cards, charge cards and telephone cards.

30 Class 36

35 Insurance and financial services; financial services provided by telecommunications; financial consultancy and advisory services; credit card services, debit card services, charge card services and cheque guarantee services; banking, savings and investment services; financial management services; services for debiting and crediting financial accounts; electronic banking services; consultancy, information and advisory services relating to the aforementioned services.

40 Class 38

45 Communication services; electronic communication services; telecommunication services; interactive telecommunications services; network services; provision of world-wide web facilities and structures; electronic mail-box services; electronic order transmission services; satellite communication services; leasing and rental services in connection with communications apparatus and equipment; services for the establishment and exploitation of telecommunications; services for the transmission, provision, and/or display of data and/or information from databanks; recording, transmission, and/or reproduction of documents,

voice, data, messages, sound and/or images; broadcasting and transmission of radio and television programmes; video conferencing; cable television broadcasting; home shopping services; consultancy, information and advisory services relating to the aforementioned services.

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Objection was taken to the application under Section 41(2) of the Act in that the fifth and sixth marks in the series differ in their material particulars from the first four marks substantially affecting the identity of the marks, that there is an objection under Sections 3(1)(b) and (c) of the Act because the marks consist essentially of ordinary dictionary words being a sign that others should be free to use when e.g. advertising their goods or services. There were also objections against Classes 16 and 36 under Section 3(6) of the Act because the specifications seemed so wide that there was doubt about the accuracy of the statement on the application form that the applicant is using, or intends to use, the marks on all the goods and services applied for.

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At the hearing at which the applicants were represented by Mr T Z Gold of Stephenson Harwood, their trade mark agents, the Series objection was maintained. As a result the application was divided into two parts, versions five and six forming Part B of the original application which then proceeded as a separate application and no further mention need be made of those elements of the original application. The agent also advised me that the items in the specifications causing the objections under Section 3(6) of the Act could be deleted in Classes 16 and 36, resulting in the following revised specifications:

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Class 16

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Printed matter, magazines, books, directories, brochures, leaflets, cards, stationery; photographs, instructional and teaching material; materials for packaging, cards in the form of debit cards, credit cards, charge cards and telephone cards.

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Class 36

Financial services provided by telecommunications; financial consultancy and advisory services; credit card services, debit card services, charge card services and cheque guarantee services; banking, savings and investment services; financial management services; services for debiting and crediting financial accounts; electronic banking services; consultancy, information and advisory services relating to the aforementioned services.

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Therefore the objections under Section 3(6) of the Act were waived and no further mention need be made of these objections, also.

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Objections under Sections 3(1)(b) and (c) were maintained against the first four versions of the original application, which now forms Part A.

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Following refusal of the revised application bearing the suffix "A", I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of the decision and the materials used in arriving at it.

The relevant part of the Act under which the objection was taken is as follows:

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

- 5 (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,
- 10

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."

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No evidence of use has been put before me, therefore the proviso to this Section of the Act does not apply and I have only the prima facie case to consider.

The marks consist of the words "CAN" and "WILL" in capitals or with initial capitals and combined with the word "AND" in upper or lower case or the symbol "&". Put simply, it is the combination "Can and Will" in various forms. Therefore, the mark consists, essentially of ordinary dictionary words which, individually, are so well known that I believe I do not need to set out any dictionary references here. I am, in any case, bound to accept or reject the mark in its totality.

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Turning firstly to the services listed above, I consider the words, in combination, to be an ordinary statement of the quality of service offered to the customer - a "can do" approach so that not only are the applicants saying that they are able to provide a service or deliver goods but that they will do so. As such I consider it typical of advertising strap lines making promises to the customer, is not an invented phrase and is a phrase that other traders should be free to use when advertising their services.

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With regard to the goods listed above, after further consideration the objection under Section 3(1)(c) can be waived. However, the objection under Section 3(1)(b) remains in my view, in that it is the sort of strap line which can be used in advertising the delivery of the goods at issue e.g. that they can and will be delivered on time.

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In this decision I have taken account of the comments in the unreported decision of the DAY BY DAY case (Application No. 2068646 dated 12 April 1994). In that appeal Mr Simon Thorley QC in his role as the Appointed Person said:

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"In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising"

I also bear in mind the comments of Mr Geoffrey Hobbs QC in the AD2000 decision (1997 RPC 168) at page 176, lines 9 to 23:

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5 "Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of Section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Mr Robin Jacob QC in his decision on behalf of the Secretary of State in the *Colorcoat trade mark* [1990] RPC 511 at 517 in the following terms:

10 "That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Works Limited's trade mark application* 919540 lines 20 to 25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require "honest men to look for a defence"."

15 I therefore conclude that the marks CAN AND WILL, Can and Will, CAN & WILL and Can & Will are devoid of any distinctive character and consist exclusively of a sign that other traders may use in the course of business to designate the quality of the services provided or as a strap line indicating the quality of service in the delivery of the goods and is thus excluded from registration under Sections 3(1)(b) and (c) of the Act in respect of the services applied for and under Section 3(1)(b) in respect of the goods applied for.

25 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 refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 27 day of June 2000.

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35 R A JONES
For the Registrar
The Comptroller General