

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION No. 2472042
IN CLASS 41
BY THE COCA-COLA COMPANY**

**AND IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANT
AGAINST THE DECISION OF MR. A. J. PIKE
DATED 30 APRIL 2009**

DECISION

Background

1. This is an appeal against a decision of Mr. A.J. Pike, acting for the Registrar, dated 30 April 2009 (BL O/113/09), in which he refused an application by The Coca-Cola Company to register the designation NO HALF MEASURES for use as a trade mark in Class 41.
2. U.K. Trade Mark Application number 2472042 was filed on 12 November 2007 in respect of the following services:

Education; providing of training; entertainment including musical entertainment; sporting and cultural activities; consultancy and information services relating to all of the aforementioned services; including all of the aforementioned services provided by telephone or online from a computer database, national or international telecommunications networks or the Internet.

3. Mr. Pike recorded in his decision that:

“3. Objection was taken against the application under Section 3(1)(b) of the Act because the mark consists exclusively of the words NO HALF MEASURES being a sign which would not be seen as a trade mark as it is devoid of any distinctive character because the mark is nothing more than a slogan which sends a message that could apply to any undertaking”.

One of the grounds of appeal is that the decision was contradictory as to the categorisation of the mark in suit.

4. Section 3(1)(b) of the Trade Marks Act 1994 states:

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

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

Section 37(4) obliges the Registrar to refuse an application that fails to meet the requirements for registration in the Act.

5. Having instructed himself in relation to: (a) distinctiveness generally by reference to Joined Cases C-53/01 to C-55/01, *Linde AG, Windward Industries Inc and Rado Uhren* [2003] ECR I-3161 and Case C-329/02 P, *SAT.1 SatellitenFernsehen GmbH v. OHIM* [2004] ECR I-8317; and (b) slogans particularly citing Case C-64/02 P, *OHIM v. Erpo M□belwerk GmbH (DAS PRINZIP DER BEQUEMLICHKEIT)* [2004] ECR I-10031 and *YOU WON'T BELIEVE YOUR EYES*, BL O/010/06, the Hearing Officer made the following findings, in brief:

- (i) The average consumer was the general public and corporate organisations.
- (ii) He was hesitant to categorise NO HALF MEASURES as a slogan (*DELIBERATELY INNOVATIVE*, BL O/325/07).
- (iii) In any event all marks including slogans must face the same test of distinctive character.
- (iv) The mark comprised a well known expression which gave the immediate impression of services where no short cuts were taken or stone left unturned. Typically, that was the type of impression providers of the services in question wished to convey. NO HALF MEASURES simply indicated that the services would be as good as the provider could achieve in terms of both delivery and content.
- (v) The Applicant's argument that numerous meanings might be attributed to the mark so that the consumer would not naturally or automatically connect it with the services was irrelevant (Case C-191/01 P, *OHIM v. Wm. Wrigley Jr. Company* [2003] I-12447).
- (vi) The registration of NO HALF MEASURES in Class 32 as a Community trade mark was not persuasive (*ZURICH PRIVATE BANKING*, BL O/201/04).
- (vii) Samples of the mark in use (not intended to bring the mark within the proviso to section 3(1)) were also unpersuasive. The fact that a sign was used in the manner of a trade mark had no bearing on the contention that it could function as a trade mark per se.
- (viii) Overall, the public would perceive NO HALF MEASURES as a non-distinctive promotional statement with no trade mark message.
- (ix) The objection extended to all the services.

6. The Hearing Officer concluded:

“28. Judging the trade mark applied for in its entirety, I am of the view that it will be perceived by the consumer as a message indicating that the applicant provides services which will meet their requirements, even if their expectation levels are high. Because of this perception of the relevant consumer, the words fail to designate services from a single undertaking.”

7. On 28 May 2009, the Applicant filed notice of appeal to the Appointed Person under section 76 of the Act. The grounds of appeal were both procedural and substantive: (a) infringement of the right to be heard and, or breach of rule 63 of the Trade Marks Rules 2008; and (b) infringement of section 3(1)(b) of the Act.

8. At the appeal hearing, Mr. Simon Malynicz of Counsel, instructed by Simmons & Simmons, appeared on behalf of the Applicant. The Registrar was represented by Mr. Nathan Abraham.

The procedural issue

9. Something of the history of the Application is necessary to understand the procedural ground of appeal. On 18 February 2008, the Trade Mark Examiner, Toni Williams, issued a “Final Response” in the examination of the Application and offered the Applicant a hearing. On 9 April 2008, a hearing was held before Mr. R. A. Jones, at which he expressed the view that the mark was not registrable for reasons he recorded in his notes of the hearing, but suspended the case for the Applicant to provide a proposed limitation to the specification. On 25 April 2008, the Applicant made further written submissions but it did not put forward any amendment to the specification. On 7 August 2008, Toni Williams responded maintaining the section 3(1)(b) objection. On 29 January 2009, Toni Williams wrote to the Applicant confirming that the objections to the registration of the mark remained and inviting the Applicant to submit a request for the reasons for the refusal if it wished to appeal, which the Applicant duly did. On 30 April 2009, Mr. A. J. Pike issued the decision.

10. The Applicant complains that as such, the decision was not taken after a hearing in the sense that it represented the reasoned decision of Mr. Jones following the hearing, as one would expect. Rather it represented the reasoned decision of Mr. Pike, and it was taken without any hearing or any opportunity for the Applicant to address Mr. Pike.

11. At the hearing, I was informed by Mr. Abraham that the reason for the different hearing officers was Mr. Jones’ retirement in October 2008, that is, after the hearing but before the request for a statement of reasons for refusal on Form TM5.

12. Subsequent to the hearing on my enquiry, Mr. Abraham confirmed in a letter dated 8 December 2009 that the Registrar’s (unpublished) practice in such situations was to encourage the hearing officer writing the decision to seek reasons and approval from the hearing officer who heard the case before issuing the decision. That practice worked when the initial hearing officer had moved elsewhere in the IPO but could be problematic where, like Mr. Jones, the initial hearing officer had left the IPO completely. Occasionally the Registrar would offer a rehearing but neither procedure was consistently applied nor followed in the present case.

13. The Applicant's written observations in response criticised the Registrar's informal practice as in breach of rule 63¹ whether a completely new hearing officer drafted the decision having not taken the hearing, or whether he or she sought comments from the hearing officer who did. Suggestions were put forward on how the Registrar might internally deal with eventualities such as retirement including the provision of reasoned decisions as a rule, but that is a matter for the Registrar.
14. In my judgment, the Applicant's procedural complaint is justified. The situation is analogous to the death of a judge in the period between trial and judgment reserved. A fresh hearing should be appointed before a hearing officer with no involvement in the case. That entitlement may be waived by consent but parties should be given an opportunity if they so wish to have a hearing in front of a person who will be giving the decision (*Halsbury's Laws of England*, vol. 10 (reissue), para. 325 and the cases cited therein). Clearly in the present case, the Applicant was unaware of the retirement of Mr. Jones and did not consent to the decision being given by Mr. Pike. In those circumstances, the decision must be overturned.
15. At the hearing and in subsequent correspondence, the Applicant requested that if the procedural issue was decided in its favour, then I should determine the substantive issue also. I have seen the Registry file and have had the benefit of full oral submissions from Mr. Malynicz (Applicant) and Mr. Abraham (Registrar). Over two years have elapsed since the application was filed and I agree that it is in the interest of procedural economy for me to deliberate on the acceptability of the Application for registration on absolute grounds.
16. Moreover, on 21 January 2010, the Court of Justice of the European Union ("ECJ") delivered its judgment in Case C-398/08 P, *Audi AG v. OHIM (Vorsprung durch Technik)*. Both Mr. Malynicz and Mr. Abraham provided further written submissions to take account of that judgment and the Registrar asked for my observations on the apparent divergence in approach between *Audi* and the earlier ECJ decision in *OHIM v. Erpo Möbelwerk*, supra, and the decisions of the Court of First Instance (now the General Court ("GC")) in, for example, Case T-130/01, *Sykes Enterprises v. OHIM (REAL PEOPLE, REAL SOLUTIONS)* [2002] ECR II-5179 and Case T-281/02, *Norma Lebensmittelfilialbetrieb GmbH & Co KG v. OHIM (Mehr für Ihr Geld)* [2004] ECR II-1915.

Section 3(1)(b) (art. 3(1)(b) Directive 2008/95/EC, art. 7(1)(b) Regulation (EC) 207/2009)

17. In *Audi*, the ECJ clarified and explained its previous case law on marks consisting of advertising slogans or promotional statements. The context was an application for registration as a Community trade mark by Audi of the word mark *Vorsprung durch Technik* in respect of a large number of goods and services in various Classes.

¹ Rule 63(1) provides: "Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings, give that party an opportunity to be heard".

18. It is clear from *Audi* that there has been some misunderstanding or over-enthusiastic application of *OHIM v. Erpo M□belwerk*, in particular, paragraphs 34 and 35 of that case where the ECJ stated (emphasis mine):

“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)”.

19. That had created a circular situation or “Catch 22” for applicants of marks consisting of advertising slogans or promotional statements to the extent that it had become very difficult in practice to obtain registration of such marks in the absence of evidence of acquired distinctiveness through use. In Case C-517/99, *Merz v. Krell* [2001] ECR I-6959 at paragraph 40, the ECJ recognised that a sign can perform the dual functions of being an advertising slogan or promotional statement and an indication of origin (Case C-487/07, *L’Oréal SA v. Bellure NV*, 18 June 2009, para. 58). However, the highlighted passage in *OHIM v. Erpo M□belwerk* (para. 35) was taken to impose² a requirement that the relevant public must immediately perceive the sign as an indication of origin so that even if a mark was not descriptive of the goods or services it covered, it would be regarded as non-distinctive if it conveyed an objective message.
20. On the other hand, in *OHIM v. Erpo M□belwerk* at paragraph 35, it seems to me that the ECJ was dealing with the U.K. Government’s contention that a mark must unambiguously identify the origin of the goods or services concerned. An advertising slogan or promotional statement would ultimately only do that if it created a striking impression when used in relation to the goods or services in question. Following paragraph 35, the ECJ stated in *OHIM v. Erpo M□belwerk*:

² Or confirm – see *REAL PEOPLE, REAL SOLUTIONS*, para. 20, *Mehr für Ihr Geld*, para. 25.

“36. However, difficulties in establishing distinctiveness which may be associated with certain categories of trade marks because of their very nature, such as those consisting of advertising slogans – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from the criterion of distinctiveness as interpreted in the case-law referred to in paragraphs 32 to 34 of this judgment ...”.

21. In other words, the Court was saying that notwithstanding the objective message conveyed by a mark comprising an advertising slogan or promotional statement it was impermissible to demand added value as a condition for registrability. The ECJ accordingly confirmed the GC’s annulment of the OHIM decision to refuse registration of DAS PRINZIP DER BEQUEMLICHKEIT for land vehicles and household furniture on the ground of the mark’s non-distinctiveness.

The Audi judgment

22. In *Audi* the ECJ unravels the conundrum. It starts by setting out the familiar principles of distinctive character:

“32. Under Article 7(1)(b) of Regulation No 40/94 [section 3(1)(b) of the Act], trade marks which are devoid of any distinctive character are not to be registered.

33. It is clear from settled case-law that, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those goods from those of other undertakings (*Procter & Gamble v OHIM*, paragraph 32; *OHIM v Erpo Möbelwerk*, paragraph 42; Case C-144/06 P *Henkel v OHIM* [2007] ECR I-8109, paragraph 34; and Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66).

34. According to equally settled case-law, that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the relevant public’s perception of the mark (*Procter & Gamble v OHIM*, paragraph 33; Case C-25/05 P *Storck v OHIM* [2006] ECR I-5719, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67).”

23. Next, the ECJ turns to the registrability of advertising slogans or promotional statements again in familiar terms:

“36. As regards the assessment of the distinctive character of such marks, the Court has already held that it is inappropriate to apply to slogans criteria which are stricter than those applicable to other types of sign (*OHIM v Erpo Möbelwerk*, paragraphs 32 and 44).

37. However, it is apparent from the case-law that, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see *Proctor & Gamble v OHIM*, paragraph 36; *OHIM v Erpo Möbelwerk*, paragraph 34; and *Henkel v OHIM*, paragraphs 36 and 38).

38. While the Court has not excluded the possibility that that case-law may, in certain circumstances, be relevant to word marks consisting of advertising slogans, it has however stated that difficulties in establishing distinctiveness which may be associated with word marks consisting of advertising slogans because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from the criterion of distinctiveness as interpreted in the case-law referred to in paragraphs 33 to 34 of the present judgment (see *OHIM v Erpo Möbelwerk*, paragraphs 35 and 36).

39. The Court has therefore held, in particular, that an advertising slogan cannot be required to display 'imaginativeness' or even 'conceptual tension which would create surprise and so make a striking impression' in order to have the minimal level of distinctiveness required under Article 7(1)(b) of Regulation No 40/94 [section 3(1)(b) of the Act] (*OHIM v Erpo Möbelwerk*, paragraphs 31 and 32; see also Case C-392/02 P *SAT.1 v OHIM* [2004] ECR I-8317, paragraph 41)."

24. However, the ECJ explains that the GC's appraisal of the distinctive character of *Vorsprung durch Technik* (or lack of it), proceeded on a misunderstanding of those principles:

"40. In the present case, the reasoning followed by the General Court derives from an erroneous interpretation of the principles set out in paragraphs 36 to 39 of the present judgment.

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.

42. Thus, in paragraphs 41 and 42 of the judgment under appeal, the General Court held that, although 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, this nevertheless does not make it distinctive. It held that those various elements make the mark distinctive only if it is perceived immediately

by the relevant public as an indication of the commercial origin of the goods and services covered by that mark. It held that, in the case before it, the relevant public perceives the mark, first and foremost, as a promotional formula.

43. The General Court based that finding on its analysis in paragraphs 43 to 45 of the judgment under appeal. It considered, first, that because of the broad range of meanings attributable to the notion of ‘Technik’, the reference to that notion is not, for all the goods and services covered, such as to confer distinctive character on the mark applied for. Secondly, the word ‘Vorsprung’ (meaning, inter alia, ‘advance’ or ‘advantage’) linked with the preposition ‘durch’ (meaning, inter alia, ‘through’) is, for the public relevant to the trade mark application and, in particular, for the German-speaking public, primarily laudatory in nature. Thirdly, although it is necessary, for the purposes of assessing whether a compound mark is distinctive, to consider that mark as a whole, it is also necessary to note that the mark is addressed to a wide public and that the majority of undertakings wishing to provide goods and services to that wide public might well, in view of the laudatory character of that expression, use it themselves, regardless of how it ought to be interpreted.

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.

48. As for the conclusion of the General Court in paragraph 46 of the judgment under appeal that ‘the mark Vorsprung durch Technik does not therefore contain elements which, beyond the obvious promotional message of the mark, could enable the relevant public to commit the expression to memory easily and immediately as a distinctive mark for the goods and services covered’, suffice it to state that not only is that finding wholly unsupported by the reasoning which precedes it but, moreover, it is contradicted to a certain extent by the finding made in paragraph 41 of that judgment, as set out in paragraph 47 of the present judgment.

49. It follows that Audi is right to claim that the assessment carried out by the General Court under Article 7(1)(b) of Regulation No 40/94 [section 3(10)(b) of the Act] is vitiated by an error in law ...”.

25. Finally, the Court substitutes its own determination of the distinctiveness of Vorsprung durch Technik:

“53. As the Board of Appeal stated in the contested decision, the expression ‘Vorsprung durch Technik’ is a widely known slogan which Audi has been using for years to promote the sale of its motor vehicles. It was registered in 2001 as a Community trade mark for goods in Class 12 on the basis of proof that that slogan was widely known in German-speaking regions.

54. As regards the goods and services in question, other than those in Class 12, the Board of Appeal based its refusal of registration on the fact 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. According to the Board of Appeal, a combination of words which limits itself to that banal objective message is, in principle, devoid of any inherently distinctive character and cannot therefore be registered unless it is shown that the public has come to perceive it as a trade mark.

55. That analysis shows that Article 7(1)(b) of Regulation No 40/94 [section 3(1)(b) of the Act] was misapplied.

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 [section 3(1)(c) of the Act], 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 at least some 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 causal 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.

60. It follows from the foregoing considerations that the contested decision must be annulled in so far as, on the basis of Article 7(1)(b) of Regulation No 40/94 [section 3(1)(b) of the Act], the Second Board of Appeal refused in part the application for registration of the mark Vorsprung durch Technik.”

NO HALF MEASURES

26. I make no apology for quoting so extensively from the judgment of the ECJ in *Audi* since I believe that the Hearing Officer similarly misapplied section 3(1)(b).
27. Mr. Abraham conceded that the decision was contradictory over the nature of the mark. In my view that was symptomatic of uncertainty as to the correct approach for determining the distinctiveness of the mark.
28. The Hearing Officer held that NO HALF MEASURES was a well known expression. Mr. Malynicz said there was no authority for this. He accepted that “half measure” would be known - meaning an action that is not forceful or decisive enough despite the situation calling for something more forceful or determinative - but disputed the

Hearing Officer's finding. Mr. Abraham referred me to a similar definition of "half measure" in The New Oxford Dictionary, which continues: "there are no half measures with this company". I do not think that helps. In the absence of evidence, I am not prepared to say whether NO HALF MEASURES is a well known expression or not. However, I cannot see it makes any difference. A trade mark is not devoid of any distinctive character merely because it is a well known word or expression.

29. Although Mr. Malynicz "refined" the Applicant's arguments on appeal, it is clear that the mark has a range of possible connotations to the relevant consumer (agreed to cover general members of the public and corporate organisations):
- (a) The Hearing Officer defined the mark in various ways, equating it to "no short cuts", "no stone left unturned"; "as good as the service provider can achieve regarding both delivery and content"; and/or "services which meet customer requirements even if expectations are high".
 - (b) Mr. Abraham thought that the Hearing Officer had in mind "completeness".
 - (c) In response to the Examination Report, the Applicant had argued:

"At most NO HALF MEASURES is an opaque reference to the 'capability' of the Services. Within this vague allusion, the phrase has various possible meanings, for example, the speed, power, appearance, performance, durability, capacity, etc. of the Services".
 - (d) On appeal, Mr. Malynicz preferred to stick with the reverse of the dictionary definition of "half measure". "No half measures" means doing something in a forceful or determinative way.

30. The Hearing Officer's finding on the relevance of the range of possible interpretations was as follows:

"21. I reject the argument that the fact that there are numerous meanings that could be attributed to this mark renders it distinctive. I am supported in this view by the judgment of the ECJ in Case C-191/01 P *Wrigley v OHIM (DOUBLEMINT)* that such facts are irrelevant. The judgment states at Paragraph 32:

"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."

31. That was clearly wrong. The ruling of the ECJ in Case C-191/01 P, *OHIM v. Wm. Wrigley Jr. Company (DOUBLEMINT)* [2003] ECR I-12447 was concerned only with article 7(1)(c) Regulation No 40/94 (section 3(1)(c) of the Act). It is well established that the absolute grounds for refusal of registration are to be examined separately and according to the public interest underlying each of them. The general interest behind section 3(1)(c) is that descriptive signs or indications may freely be used by all (Case C- 273/05 P, *OHIM v. Celltech R&D Ltd* [2007] ECR I-2883, para. 75). On the other hand, the general interest behind section 3(1)(b) is to guarantee the identity of origin

of the designated goods or services (Case C-304/06 P, *Eurohypo AG v. OHIM* [2008] ECR I-3297, para. 56). The fact that a mark can convey a number of meanings may signify that the mark is possessed of distinctive character (*Audi*, para. 47).

32. Mr. Malynicz contended that the Hearing Officer did not assess the distinctiveness of the mark in relation to each of the claimed services separately as required by the case law (Case C-239/05, *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ECR I-1455, paras. 32 – 38). Whilst education and training might be grouped together, and possibly entertainment and cultural activities, the groups or categories of services in the Application were diverse. Mr. Abraham thought the objection applied to the whole specification. The Hearing Officer found that the mark indicated that the services would be as good as the provider of them could achieve in terms of both content and delivery. That was an impression other service providers would wish to convey. However, as the ECJ stated in *Audi*, the mere fact that the mark is perceived as a promotional statement and because of its laudatory nature could in principle be used by others, is insufficient per se to support a finding of non-distinctiveness (para. 44). In my judgment, the Hearing Officer failed to substantiate his conclusion that the mark was devoid of any distinctive character for the entire breadth of services covered by the specification under section 3(1)(b).
33. Finally, the Hearing Officer dismissed as irrelevant the examples of the mark in use supplied by the Applicant. He said:

“25. The fact that a sign is used in the manner of a trade mark can have no bearing on the contention that it can function as a trade mark per se. Given use sufficient such that the proviso to section 3(1) can be relied on, I would agree with Mr Stone’s assertion that the mark is capable of performing as a trade mark. I am sure that Mr Stone had no intention of contending that the material submitted was sufficient to achieve the latter. It might, given more of the same material set before the material date, reveal use on the full spectrum of the services provided and otherwise conforming to the requirements of paragraph 51 in *Windsurfing Chiemsee* (C-108 & C-109/97)”.

34. I have concerns over paragraph 25. Mr. Abraham told me that even though the examples provided by the Applicant might demonstrate use of NO HALF MEASURES as a trade mark that was looking at the mark in the best possible light. The Hearing Officer had to consider the mark in notional and fair use, that is, in all manners of use. The problem with that approach, is that it takes one back into the “Catch 22” already identified. Due to the dual functions of a mark which consists of an advertising slogan or promotional statement, it will always be possible to envisage instances of the mark being used in a non-trade mark sense (*Audi*, paras. 41 and 56). As I observed in *Scranage’s Trade Mark Application (THERE AIN’T NO F IN JUSTICE)* [2008] ETMR 43:

“25. The distinctive character of a trade mark must be assessed in relation to the goods or services for which registration is sought (*Linde*, para. 41). However, the manner of use ... is a matter of choice for the trade mark owner (*Bang Olufsen*, para. 31). Its relevance is to use of the trade mark (*Arsenal Football Club plc v. Reed* [2001] ETMR 860, paras. 66 – 68). The possibility

that a trade mark might be used in a non-trade mark manner does not per se detract from its distinctive character.”

35. I turn to make my own assessment of the mark bearing in mind the above points. To recap, it is accepted that:
- (i) The average consumer comprises general members of the public and corporate organisations.
 - (ii) Education and training services can be grouped for the purposes of assessment.
 - (iii) The mark is not descriptive of the services. There is no objection under section 3(1)(c) of the Act.
 - (iv) The mark can have a number of meanings in relation to the services.
 - (v) In assessing distinctive character, practices in the marketplace may be relevant (*SAT.1* supra, para. 44, *Celltech*, supra, para. 39).
36. Mr. Malynicz argued in essence that the mark was atypical in relation to the services. The mark had a bold declaratory nature. Particularly education and training services were normally marketed in more sober or restrained terms. Even in respect of entertainment services, it was not usually an important value of such services that they were supplied in a forceful or decisive way in accordance with the demands of the situation (as per the dictionary definition preferred by Mr. Malynicz). The average consumer when attending a music event arranged by NO HALF MEASURES or enrolling on a training course provided by NO HALF MEASURES would not fail to perceive NO HALF MEASURES on the ticket or on the application form as indicating the trade origin of the event or course even if, which in his view was unlikely, they also regarded it as having a promotional function. Mr. Abraham on the other hand thought that the average consumer would have essentially the same perception of the mark whether in the context of education, entertainment or sport, that is, services where no short cuts were taken or no stone was left unturned. However, I believe Mr. Abraham like Mr. Pike was viewing the mark in relation to the company or organisation providing the services rather than, as is apposite, the services in question themselves.
37. In my judgment, the mark is possessed of distinctive character in relation to entertainment services. I mentioned at the hearing that I thought it would make a good name for a band. In Mr. Malynicz’s words there is no comfort between the mark and the services. The average consumer of entertainment services would be interested in who was performing what, when and where, not whether short cuts were or were not taken. In my view, the mark has a certain originality or resonance for entertainment services which makes it easy to remember. I believe the same is true of the mark in relation to cultural activities.
38. With regard to sporting activities, the mark could be seen as an exhortation to the participant to perform at his or her best. That is apparent from one of the examples provided by the Applicant for the RELENTLESS NO HALF MEASURES TOUR

SKATE SESSION 2007³. However, the example also neatly demonstrates what the ECJ said in *Audi* about the duality of functions in a mark that comprises an advertising slogan or promotional statement. It can convey an objective message - even if simple and/or primary - and still act as an indication of origin. I believe that is the case for NO HALF MEASURES in respect of sporting activities. There is only a casual link with the services, which will require a measure of interpretation by the consumer.

39. In relation to education and training, I find the mark more meaningful. In the end, I was swayed by Mr. Malynicz's point that the mark is atypical of marketing speak in the area. I believe that would create an element of unexpectedness for the consumer. I do not believe that the message(s) conveyed by the mark is ordinary to the extent of excluding distinctiveness for education and training services.

Conclusion

40. The appeal is successful. The mark is not objectionable under section 3(1)(b) of the Act. As is customary, I will make no order as to costs.

Professor Ruth Annand, 28 February 2010

Mr. Simon Malynicz of Counsel instructed by Simmons & Simmons appeared on behalf of The Coca-Cola Company

Mr. Nathan Abraham appeared on behalf of the Registrar

³ It is of course no objection that two trade marks are used together.