

O-113-09

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2472042

TO REGISTER A TRADE MARK

BY THE COCA-COLA COMPANY

IN CLASS 41

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DECISION AND GROUNDS OF DECISION

Background

1. On 12 November 2007 The Coca-Cola Company of One Coca-Cola Plaza, Atlanta, Georgia 30313, United States of America applied under the Trade Marks Act 1994 to register the following trade mark:

NO HALF MEASURES

2. Registration is sought for the following services:

Class 41

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. 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.

4. Following a hearing before Mr R Jones which was held on 09 April 2008 and at which the applicant was represented by Mr Stone of Howrey LLP, their trade mark attorneys, the objection was maintained.

5. I am now asked under Section 76 of the Act and Rule 69(2) of the Trade Mark Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence has been put before Mr Jones or myself. I have, therefore, only the prima facie case to consider.

The Law

7. Section 3(1)(b) of the Act reads as follows:

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

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

The case for registration

8. During the hearing Mr Stone referred to previous correspondence and explained that the applicant will be using the trade mark to sponsor events. No final decision was made at the hearing which was suspended at Mr Stone’s request to consider the reduction of the scope of the specification of services as filed.

9. In Mr Stone’s letter of 5 February 2008, to which supporting documentation was attached, the following points were made:

1. The ECJ decision in the *DAS PRINZIP DER BEQUEMLICHKEIT* case (*OHIM v Erpo Möbelwerk GmbH*, C-64/02) was cited together with a summary of the ECJ’s decision.
2. The registry’s Work Manual was referred to and Chapter 6 Part 32, which refers to slogans, was quoted and it was argued that this trade mark satisfies the test in respect of the services for which registration is sought.
3. In relation to the services specified with the application Mr Stone notes that “The assessment of distinctiveness must be made with reference to these Services each taken individually”.
4. Mr Stone sets out various submissions in support of this application. He states that Consumers would not naturally connect NO HALF MEASURES with the services applied for and suggests that it is no more than an opaque reference to the “capability” of the services. Mr Stone also suggests numerous alternative meanings that could be attributed to this mark and suggests that consumers would not naturally or automatically connect it with the services provided. It is also suggested that NO HALF MEASURES is not commonly used in the trade of these services and that its registration would not prevent other traders from using the phrase descriptively in the course of trade for describing goods and services. The Guidance available in the registry’s Work Manual is again referred to but, this time, in more detail.
5. Mr Stone refers to CTM registration No 004746483 for the same mark in Class 32.
6. Finally , examples of the mark in use are provided in the supporting documentation which was enclosed with the letter.

10. In his subsequent letter dated 25 April 2008 Mr Stone referred to the *THERE AIN’T NO F IN JUSTICE* decision by Professor Annand sitting in her role as the Appointed Person. In this letter Mr Stone asserts that the criticisms of registry practice made by Professor Annand in that decision are equally relevant in respect of this application and again states that this trade mark is distinctive for the services applied for.

11. The registrar responded to those submissions in the official letter dated 7 August 2008 when the objection was again maintained.

Decision

12. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

13. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods and services in question to identify the origin of the goods and services and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

14. The test required under section 3(1)(b) of the Act is that a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. This means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect.

15. In respect of the services applied for the relevant consumer is likely to consist of both general members of the public and corporate organisations. I note that the services applied for are not restricted to the services indicated in the documentation attached to Mr Stone’s letter of 5 February 2008. This specification of services covers all education, training, entertainment, sporting and cultural activities and consultancy and information services relating to them. Such services are provided to all ages and to all members of the general public together with many, if not all, segments of the corporate markets.

16. I hesitate in categorising this mark as a slogan for the purposes of this decision. In this respect I am mindful of the comments of Mr Geoffrey Hobbs QC (Sitting as the Appointed Person) in the DELIBERATELY INNOVATIVE appeal (0-325-07) when he said:

“They were reinforced by the suggestion “Deliberately Innovative” should be categorised as a strap line or slogan for the purpose of assessing its eligibility for registration.

I, for my part, do not think it is particularly helpful to adopt that categorisation in a case such as the present because I think it tends to draw attention away from the basic legal requirement for the designation as a whole to be capable of functioning effectively as a stand-alone trade mark.”

17. In any case, it is now firmly established that all marks, whether perceived as slogans or simple word marks, must face the same test as far as assessing distinctive character is concerned. The ECJ Case C-64/02P *Das Prinzip Der Bequemlich* (“*The Principles of Comfort*”) provides the leading guidance on the subject of slogans.

18. I also note that in Case BL O/010/06, the Appointed Person sets out the guidance she sees as being confirmed by “*The Principles of Comfort*”. The guidance is as follows:

1. Every trade mark including those comprising slogans must be capable of identifying the product as originating from a particular undertaking and thus distinguishing it from those of other undertakings (paragraphs

33, 42).

2. The criteria for assessing distinctiveness are the same for the various categories of marks (paragraph 32).

3. It is inappropriate to apply to slogans criteria for assessing distinctiveness (e.g. a requirement for “imaginativeness” or “conceptual tension which would create surprise and so make a striking impression”) that are different/stricter than those applicable to other types of sign (paragraphs 31, 36).

4. Use in advertising may be taken into account (paragraphs 35, 38).

19. This mark is a simple combination of three well known words which, when reproduced in combination as a single mark, will be recognised as a well known expression. The expression NO HALF MEASURES creates the immediate impression of services where no short cuts are taken, no stone left unturned. The services applied for cover all aspects of education, training, entertainment, sporting, and cultural activities. Typically, these are the very types of services where providers wish to create such impressions. This mark simply indicates that the services will be as good as the provider of them can achieve and that this will extend to their delivery as well as their content. For these reasons I reject the submissions of Mr Stone in his letter of 5 February 2008 at paragraph 2 where he states that:

“the average consumer does not naturally connect it (the slogan) with the qualities consumers would normally associate with the relevant goods/services”.

20. In Paragraph 4 of his letter Mr Stone states:

“At most NO HALF MEASURES is an opaque reference to the “capability” of the Services. Within this vague allusion, the phrase has various possible meaning, for example, the speed, power, appearance performance, durability, capacity, etc. of the Services.

Given that NO HALF MEASURES has multiple possible interpretations, a consumer would not naturally or automatically connect it with the Services or any one of them. The slogan does not directly describe the Services or the essential characteristics.”

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 judgement of the ECJ in case C-191/01P *Wrigley v OHIM (DOUBLEMINT)* that such facts are irrelevant. The judgement 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.”

22. Furthermore, Mr Stone has referred to the fact that the OHIM have registered CTM 004746483 for NO HALF MEASURES in Class 32 and appears to suggest that this should influence the outcome of this application. I do not accept this.

23. I draw support for this from the decision of Mr Hobbs, sitting as the Appointed Person, in Zurich Private Banking (O/201/04) where he said at pages 5 – 6:

“...the position as between different national registries and the Community Trade Marks Office is that they are not competent to adjudicate on the correctness of each other’s determinations and, as a corollary of that, not required to treat each other’s determinations as binding upon them in the independent exercise of their own powers. That is not to say that each of them should or will simply ignore determinations of the others. The general principle is that each of them should give determinations of the others such weight (if any) as they might fairly and properly be said to bear in the decision-taking processes they are required to undertake independently of one another. ... More particularly, at the national level in the United Kingdom, it cannot be right that the Registrar should be deflected from reaching the decision he considers to be correct in a given case by the decision reached in another case on another occasion.”

24. Finally, Mr Stone has provided documentation which is purported to demonstrate the mark in use as a trade mark, together with a conclusion that the mark is clearly capable of functioning as a trade mark.

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 & 109/97).

26. I must judge the perception of the relevant consumer when they encounter the mark in use in relation to the services in question. They will encounter the mark as a whole and perceive it as a non distinctive promotional statement with no trade mark message at all.

27. The specification of services in class 41 may be wide ranging, but in my view the objection is equally valid for all of the services applied for.

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.

29. For the reasons set out above I have concluded that the relevant consumer of the services identified would not consider this mark to denote trade origin. The average consumer of these services will, upon encountering the words NO HALF MEASURES, perceive them as no more than an indication that the applicant is providing services which, as I have already said, meet their requirements. That is why it will not be seen as a sign which guarantees that the services emanate from a single undertaking. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the services of the applicant from those of other traders.

30. 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

31. In this decision I have considered all the documents filed by the applicant 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) of the Act.

32. Consequently, I have concluded that the mark applied for consists exclusively of signs which may serve, in trade, to designate the kind of services and is, therefore, excluded from registration by Section 3(1)(b) of the Act.

Dated this 30th day of April 2008

A J PIKE
For the Registrar
The Comptroller-General