

O-246-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 2483280  
BY O2 HOLDINGS LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASSES 9, 35, 36, 37, 38, 39, 41, 42, 43, 44, 45:**

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**WE'RE BETTER, CONNECTED**

**Background**

1. On 26 March 2008, O2 Holdings Limited ('the applicant') applied to register trade mark application number 2483280, consisting of the word-only mark WE'RE BETTER, CONNECTED ('the mark'), for the following goods and services:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; computer hardware; computer software; computer software downloadable from the Internet; PDA's (Personal Digital Assistants), pocket PC's, mobile telephones, laptop computers; telecommunications network apparatus; driver software for telecommunications networks and for telecommunications apparatus; computer software onto CD Rom, SD-Card; protective clothing, protective helmets; parts and fittings for all the aforesaid goods.

Class 35: Advertising; business management; business administration; office functions; retail services and online retail services relating to scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for

recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, apparatus for the transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, computer software, computer software downloadable from the Internet, PDA's (Personal Digital Assistants), pocket PC's, mobile telephones, laptop computers, telecommunications network apparatus, driver software for telecommunications networks and for telecommunications apparatus, computer software onto CD Rom, SD-Card, protective clothing, protective helmets, parts and fittings for all the aforesaid goods, paper, cardboard and goods made from these materials, not included in other classes, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging (not included in other classes), printers' type, printing blocks; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 37: Building construction; repair; installation services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 38: Telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; Internet

access services; email and text messaging service, support services relating to telecommunication networks and apparatus; monitoring services relating to telecommunications networks and apparatus; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network; information services relating to telecommunications, provided by means of telecommunications networks; operation of a network, being telecommunications services; services of information broker and providers, namely rental of access time to data networks and databases, in particular the Internet; provision of information relating to the aforesaid; provision of access time to data networks and banks, providing access to the Internet; providing access to database; rental of access time for data networks and data banks, Internet.

Class 39: Transport; packaging and storage of goods; travel arrangement; provision of information relating to travel, transport, traffic, traffic flows and congestion; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; interactive entertainment services; electronic games services provided by means of any communications network; information services provided by means of telecommunication networks relating to entertainment; provision of news information; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services; services of engineers; computer programming; services of programmer; development of technical expertise; researches in matter business legal protection (technical and legal); technical consulting and expert activities; rental of data

processing apparatus and computers; management and use of copyright; applying business property right; projection and planning of equipment for telecommunication; weather forecasting; arbitration services; research of field telecommunication technology; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network; application service provision.

Class 43: Services for providing food and drink; temporary accommodation; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 45: Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

2. On 24 April 2008, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') on the grounds that the mark is devoid of any distinctive character, being a "straightforward slogan/statement about customer service standards (which could be applied) to any undertaking." The examiner also raised a number of specification objections under Rule 8 of the Trade Mark Rules 2000 (now superseded by the 2008 rules). The specification objections related to terms claimed in classes 42 and 45.

3. Following a three-month extension of time, the agent submitted arguments in support of the mark's alleged *prima facie* distinctiveness. In these arguments, it was submitted that, whilst the examiner had speculated as to the mark's use in respect of customer service standards, no explanation had been provided as regards its actual meaning. It was submitted that the phrase is meaningless, grammatically incorrect, and at best vaguely allusive of the applicant's intention to promote mobile communities via use of the mark (paragraph 4 of the agent's letter stated that "the philosophy of O2 is that their consumers are part of a community and the mark WE'RE BETTER, CONNECTED helps consumers identify themselves as part of this community..."). The agent also submitted alternative terms in response to the specification objections.

4. Although the examiner then waived the specification objection, she was not persuaded to waive the section 3(1)(b) objection. In response to maintenance of the absolute grounds objection, the agent requested an *ex parte* hearing which subsequently took place on 9 June 2009. At the hearing, the agent expanded on arguments previously put forward in correspondence, and encouraged me to take into account presence of the comma in the mark which, it was claimed, contributed to the mark's *prima facie* distinctiveness by significantly affecting the relevant consumer's perception and understanding of the sign.

5. In my hearing report, I confirmed that the sign was devoid of any distinctive character pursuant to section 3(1)(b), but only in respect of those goods and services for which the relevant consumer would understand the sign to denote the provider's superior connections to other related businesses (as in a 'network' of outlets or affiliated dealers) *or* where the sign would promote the benefits of being connected in a telecommunications/technical context. The objection was therefore maintained in respect of the following:

Class 9: Apparatus for recording, transmission or reproduction of sound or images; data processing equipment and computers; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; computer hardware; computer software; computer software downloadable from the Internet; PDA's (Personal Digital Assistants), pocket PC's, mobile telephones, laptop computers; telecommunications network apparatus; driver software for telecommunications networks and for telecommunications apparatus; computer software onto CD Rom, SD-Card.

Class 35 Retail services and online retail services relating to apparatus for recording, transmission or reproduction of sound or images, data processing equipment and computers, apparatus for the

transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, computer software, computer software downloadable from the Internet, PDA's (Personal Digital Assistants), pocket PC's, mobile telephones, laptop computers, telecommunications network apparatus, driver software for telecommunications networks and for telecommunications apparatus, computer software onto CD Rom, SD-Card; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

- Class 38 Telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; Internet access services; email and text messaging service, support services relating to telecommunication networks and apparatus; monitoring services relating to telecommunications networks and apparatus; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network; information services relating to telecommunications, provided by means of telecommunications networks; operation of a network, being telecommunications services; services of information broker and providers, namely rental of access time to data networks and databases, in particular the Internet; provision of information relating to the aforesaid; provision of access time to data networks and banks, providing access to the Internet; providing access to database; rental of access time for data networks and data banks, Internet.
- Class 39 Transport; packaging and storage of goods; travel arrangement; provision of information relating to travel, transport, traffic, traffic flows and congestion; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.
- Class 41 Entertainment; interactive entertainment services; electronic games services provided by means of any communications

network; information services provided by means of telecommunication networks relating to entertainment; provision of news information; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 42 Rental of data processing apparatus and computers; projection and planning of equipment for telecommunication; technical expert advice and opinions related to telecommunications; research of field telecommunication technology; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network; application service provision.

Class 45 Dating services; online dating services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

6. In the hearing note, I confirmed that the objection was waived in respect of those goods and services for which I considered the mark to be meaningless, namely:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines fire-extinguishing apparatus; protective clothing, protective helmets; parts and fittings for all the aforesaid goods.

Class 35 Advertising; business management; business administration; office functions; retail services and online retail services relating to scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming,



accumulating, regulating or controlling electricity, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, fire-extinguishing apparatus, protective clothing, protective helmets, parts and fittings for all the aforesaid goods, paper, cardboard and goods made from these materials, not included in other classes, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging (not included in other classes), printers' type, printing blocks; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

- Class 36 Insurance; financial affairs; monetary affairs; real estate affairs; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.
- Class 37 Building construction; repair; installation services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.
- Class 41 Education; providing of training; sporting and cultural activities; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.
- Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; services of engineers; computer programming; services of programmer; development of technical expertise; weather

forecasting; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network; application service provision.

Class 43 Services for providing food and drink; temporary accommodation; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 44 Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

Class 45 Security services for the protection of property and individuals; legal services; research in matters of business legal protection; management and use of copyright; applying business property right; arbitration services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services provided over a telecommunications network.

7. As the agent did not make further submissions within the allotted time period set after the hearing, the application was partially refused on 9 September 2009. The agent subsequently submitted a form TM5 requesting a statement of reasons for the Registrar's decision.

8. I am now asked under section 76 of the Trade Marks Act 1994, and rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, in respect of the goods and services listed at paragraph 5 above, I have only the *prima facie* case to consider.

## The applicant's case for registration

9. All arguments in support of *prima facie* acceptance were presented either in the form of the agent's letter dated 24 September 2008, or in the form of oral submissions made at the *ex parte* hearing on 9 June 2009. Although some of the agent's primary arguments have been briefly summarised at paragraph 3, I consider it useful at this stage to restate those submissions. In the aforementioned letter, the agent made reference to the Registrar's published practice on slogans as set out in the current Examination Guide (formerly known as the Examination Work Manual) where, in paragraph 1.6 of the section entitled 'Slogans', it is stated that "any objection will identify the alternative message (to a trade mark message) conveyed by the mark". In the agent's opinion, the examiner's categorisation of the slogan as being simply one which is 'about' customer service standards did not provide enough substantiation for the objection, and did not identify the alternative message as prescribed by the Examination Guide. The agent then proceeded to submit that the phrase "we're better, connected" was both grammatically incorrect and meaningless, and emphasised that the use and position of the comma rendered the mark impenetrable. Although the agent accepted that, when taken in isolation, the word 'connected' has a number of meanings (one of which relates to telecommunications), it was submitted that the sign in totality is both allusive, and one which would be instantly recognisable as an indicator of trade origin.

10. These points were expanded upon in oral submissions made at the hearing, with the agent bringing my attention to presence of the comma, and emphasising the alleged impact made by this punctuation mark in the context of the mark as a whole. The agent submitted that the mark filed would *not* be perceived as a laudatory statement denoting one's business connections (in terms of promoting the applicant's superior services by reference to its commercial 'connections'), on account of the comma being present. Taking into consideration the punctuation and grammar of the phrase as filed, the agent submitted that one could not be 'better' as a result of being connected to something or someone, and that this analysis demonstrated that the mark is both meaningless and distinctive.

11. At the hearing, I acknowledged a lack of detail in the examiner's initial objection, and sought to address this in my hearing record by providing a more thorough analysis. Expressing my concerns over the alleged amount of impact made by the punctuation, I sought to explain the Registrar's reasons for objecting irrespective of whether the sign was perceived by relevant consumer as "we're better, connected" (i.e. as filed) or as "we're better connected". In the case of the former reading, I confirmed that the sign would be perceived as denoting the benefits of being connected to others, whether via telecommunication products, travel, entertainment, or any other activity which is characterised by the bringing together of people in either a physical or a virtual space. In the case of the latter reading, I confirmed that the phrase "we're better connected" (i.e. where the comma is *not* identified by the

relevant consumer as being a significant element of the mark) would be seen as a laudatory reference to one's connections within a particular sector. Either way, for the goods and services listed at paragraph 5 above, I concluded that the mark was inherently non-distinctive pursuant to section 3(1)(b).

### **The Law in relation to section 3(1)(b)**

12. 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

### **Decision - section 3(1)(b)**

13. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds of 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. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "...the public interest... is, manifestly, indissociable 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 judgement). 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/OP, paragraph 31).

15. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the ECJ provided guidance in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Postkantoor) where, at paragraph 34, it stated:

"A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 *Linde and Others* [2003] ECR I-3161, paragraph 41, and Case C-104/01 *Libertel* [2003] ECR I-3793, paragraphs 46 and 75)."

16. This establishes the principle that the question of a mark being devoid of any distinctive character is answered by reference firstly, to the goods and services applied for, and secondly, to the perception of the average consumer for those goods or services. In terms of the goods and services, I have already sought to establish which goods and services, if any, are *not* considered to be subject to the objection under section 3(1)(b). The list of those goods and services are presented at paragraph 6 above. The remainder of the goods and services (i.e. those presented in paragraph 5) are all considered to be subject to a 3(1)(b) objection for a number of reasons as will be presented below.

17. In relation to identifying the relevant consumer, it is reasonable to assume that the sort of goods and services claimed will be used by the general public. One no longer needs to have any specialist knowledge in order to purchase and use technology such as mobile telecommunication devices, 'palm-tops', or laptop computers, whilst general travel, entertainment and social-type services (such as the dating agencies claimed in class 45) are generally consumed and used by all members of the public. The technical services still subject to objection in class 42 are likely to be directed towards more specialist consumers, whilst telecommunication-related goods and services in classes 9, 35 and 38 are likely to be marketed towards both specialist and non-specialist consumers. The remainder, including the transport and travel, entertainment, and dating services claimed in classes 39, 41 and 45 respectively, are all likely to be directed towards a fairly non-specialist public. On the whole, therefore, the goods and services claimed by the applicant can reasonably be described as being directed towards a non-specialist general public, who would demonstrate an average level of attention when considering purchase. One must also be aware that the test is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)*, 2002, ECT II-5179, stated the following:

"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to

distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."

18. The mark consists of the phrase "WE'RE BETTER, CONNECTED". I purposely use the term 'phrase' here to avoid categorisation and judgement of the mark as a slogan. Following on from ECJ guidance on cases such as *Real People Real Solutions*, there has been a tendency to skew assessments of distinctiveness in respect of 'phrase' marks such as the one applied for towards an assumption that they will always be used a slogan or strap line - possibly alongside other more distinctive elements and/or in a promotional context - and that they might consequently have to 'work harder' to perform the essential function of a trade mark. This sort of assessment is based on the assumption that consumers are not in the habit of regarding slogans as designating trade origin, but instead regard them as purely promotional, non-distinctive material. Following the Court's decision on *Vorsprung Durch Technik* (Case C-398/08P, *Audi AG v OHIM*), we now know that this is not the test. In paragraph 44 of that decision, the Court stated:

"...while it is true... 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 the mark is devoid of distinctive character."

Given such guidance, I intend to approach this matter from a purely semantic perspective in order to assess whether the phrase is capable of performing the essential function of a trade mark, and which would therefore be free from objection under section 3(1)(b).

19. Examining the mark from that perspective, I must reach the view that it conveys a clear message which would be understood by the relevant consumer of the goods and services identified at paragraph 5 above. The pronoun 'we', defined in Collins' online English dictionary as meaning "*all people, or people in general*", is not infrequently used in commerce where the providers of goods and services seek to address their potential or actual collective consumer base. Meanwhile, the word 'better' is defined as "*good*" and "*more excellent than others*", whilst 'connected' is defined as "*being linked*" and "*being put into telephone communication with*". In totality therefore, the phrase WE'RE BETTER, CONNECTED would be immediately understood as a reference to the (unstated) benefits of being connected to someone or something.

20. Used in respect of telecommunications products and services, which are commonly marketed in terms of their ability to facilitate connections and communications between one human being and another, this message is particularly transparent. However, the potential for the message to be so easily understood is not limited to its use in respect of telecommunications products claimed in class 9, or telecommunications services claimed in class 38. With communications technology now permeating numerous spheres of commerce and social activity via online retailing, web-based marketing, social networking sites, and other interactive platforms, one's quality of life, and one's effectiveness in society, can now be framed in the context of how we use technology to interact and connect with others. Therefore, the provider of interactive video games which make use of the web in order to allow online playing in real time may seek to flatter and/or impress potential consumers by claiming that there is a tangible benefit in being connected to others - for example, via an online multiplayer facility, where the actual benefit might be a more realistic gaming experience. If the marketing aim of such a company was to promote the benefits of being connected to others, then the phrase 'we're better, connected' clearly meets the brief. Similarly, a broadcaster providing a 24 hour news stream may seek to appeal to our innate desire to understand and be aware of the world around us by reinforcing the message that we are 'better off' (or just 'better') on account of being connected to the news service. Using terminology employed in the mark applied for, such a commercial entity may wish to convey the simple message that we're better, connected.

21. In short, *any* product or service which can be characterised by its capacity to bring people into contact with one another for a productive end is, in the Registrar's opinion, unlikely to enjoy having its commercial origin denoted by the phrase 'we're better, connected' other than as a result of extensive use of the mark over a period of time. This is not because I believe the phrase to literally describe any such service. Clearly it does not. However, I do believe that the phrase refers to a value or benefit to the relevant consumer seeking to purchase goods or services which facilitate communication or connection. Used in the context of marketing and promoting goods and services which do facilitate connectivity between people, the consumer is sophisticated enough to understand the value and purpose of this message when used in a commercial context. It would be perceived not as a reference to commercial origin, but rather as a motivational statement intended to reinforce the personal benefits of being connected to others. Given that the message conveyed by the mark is generally accepted as a truism (that is to say, most of us now understand and recognise the personal and professional benefits of being connected to the online community - whether via social networking sites, 3G mobile phones, or any other platform), it is the sort of statement that consumers might expect to be used by any provider of communications technology. In drawing this conclusion, I am not supporting the objection by reference to a need to keep the statement free for others to use - that is clearly a policy which underpins section 3(1)(c) rather than 3(1)(b), and it would be difficult to substantiate a claim that other traders would likely coin the

*exact* same phrase. However, I am stating that the message conveyed by the mark is so clear, and so universally accepted, that the relevant consumer would not perceive it as something with which to differentiate the goods and services of one trader from those of another. In that sense, it fits the explanation of section 3(1)(b) set out in *Postkantoor* as being applicable to "(those marks which are) none the less... devoid of any distinctive character in relation to goods or services for reasons other than the fact they may be descriptive".

22. Returning to points touched upon in paragraph 17 above, it must be emphasised that the finding of an absence of *prima facie* distinctiveness has not been reached as a result of categorising the sign in terms of its potential use as a promotional slogan. Whereas previous rulings from the ECJ suggested that registering authorities should place at least some emphasis on the manner in which slogan-type marks were likely to be used (in *The Principles of Comfort*, for example, the Court suggested that a mark's non-distinctive promotional function would need to be 'manifestly secondary' to its purported function as a trade mark in order to reach the threshold for *prima facie* distinctiveness), we now have the more recent ECJ ruling on *Vorsprung Durch Technik* (C-398/08P) - selected paragraphs of which I present 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, in as much 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."

22. The important message to be taken from such comments is, I think, that one should avoid deeming a trade mark as being necessarily devoid of any distinctive character by virtue of an assertion that it would be seen entirely, or even primarily, as a 'promotional message' as far as the average consumer is concerned. Moreover, the comments also imply that trade marks which convey objective and simple messages may also *not* necessarily be devoid of any distinctive character solely by virtue of that characteristic. The issue for the ECJ seems to be that, where such marks possess 'originality' and 'resonance' capable of being remembered (qualities which may result from the presence of word-play, imagination, creativity or 'unexpectedness'), then they are unlikely to be devoid of any distinctive character. The impact of the Judgement is, therefore, to urge relevant authorities to undertake a full semantic analysis of the mark in question, without preconception or pre-emption, and also taking into account all known and relevant surrounding circumstances.

23. In this case, I have sought to limit my analysis to the mark's semantic content - largely by considering the dictionary defined (and generally accepted) meanings for those words which are found in the mark applied for, and assessing their collective impact as a phrase in its totality (inclusive of its punctuation) by reference to those goods and services applied for. In doing so, I have not identified any of those characteristics or qualities mentioned by the ECJ as being contributory to a finding of a *prima facie* distinctiveness.

24. Had the mark been applied for as "we're better connected" (i.e. without the comma), the Registrar may have felt it appropriate to interpret the sign as a more descriptive reference to the goods/service provider's position in the marketplace i.e. promoting the commercial connections enjoyed by the provider. Given the extent to which any business might wish to market its effectiveness by reference to the connections it has established in any particular sector, an objection against the mark

"we're better connected" may, therefore, have been directed towards a much broader range of goods and services than is the case in this decision.

25. As it stands, my analysis of the mark *has* taken into account all semantic content *including* the punctuation. I have assessed the mark as applied for, and must conclude that the phrase WE'RE BETTER, CONNECTED cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creative element which might endow it with the necessary capability to function as an indicator of trade origin - at least, not in respect of those goods and services which are likely to be characterised by their ability to connect or bring together one or more of the potential customer base i.e. those goods and services listed at paragraph 5 above. Applying the ECJ's guidance in *Vorsprung Durch Technik*, as well as those cases which have preceded it, I therefore have no hesitation in upholding the refusal under section 3(1)(b) of the Act.

### **Conclusion**

26. In this decision, I have considered all documents filed by the applicant/agent, and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is partially refused - for the goods and services listed at paragraph 5 above - under the terms of section 37(4) of the Act because it fails to qualify under section 3(1)(b) of the Act.

**Dated this 15 day of July 2010**

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