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Slogan mark rejected based on ECJ's *Audi* decision
United Kingdom - McDermott Will & Emery UK LLP

Examination/opposition
National procedures

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In *O2 Holdings Ltd's Application* (Case BL O-246-10, July 15 2010), the [UK Intellectual Property Office](#) has partially refused an application by [O2 Holdings Ltd](#) for the registration of WE'RE BETTER, CONNECTED on the grounds that it lacked distinctive character. The decision reiterated the inter-relationship between objections under Sections 3(1)(b) and 3(1)(c) of the [Trademarks Act 1994](#).

The mark WE'RE BETTER, CONNECTED was filed for goods in Class 9 of the [Nice Classification](#) and for a wide range of services over 10 further classes. The sign was refused registration on the grounds that it was devoid of distinctive character, being a "straightforward slogan/statement about customer services standards [which could be] applied to any undertaking".

O2 responded that the examiner had speculated about the mark's use in respect of customer service standards and that no explanation was provided as to its actual meaning. O2 submitted that the phrase was meaningless, grammatically incorrect and, at best, vaguely allusive of its intention to promote mobile communities. The case went before a hearing and O2 reiterated its arguments - it emphasised the impact of the comma in the sign which, it argued, contributed to the sign's *prima facie* distinctiveness by significantly affecting the relevant consumer's perception and understanding of the mark.

The hearing officer maintained that the mark was devoid of distinctive character in respect of the goods and services at issue. The relevant consumer would understand the mark to denote the provider's superior connections to other related businesses or to promote the benefits of being connected in a telecommunications/technical context. Accordingly, the mark was refused in respect of Classes 38 (telecommunication services) and 39 (transport services), and some of the goods and services in Classes 9 (scientific instruments), 35 (services related to computers, mobile telecommunications and sound equipment), 41 (entertainment services), 42 (rental services relating to telecommunications and computer equipment) and 45 (dating services), but was allowed in respect of services in Classes 36 (insurance services), 37 (construction services), 43 (hospitality services) and 44 (medical services).

The hearing officer found that the relevant consumer would understand the mark, with the comma, as denoting the benefits of being connected to others, via telecommunications products, travel, entertainment or any other activity characterised by the bringing together of people in a physical or virtual space. Without the comma, he considered that people would understand the mark as a laudatory reference to one's connections within a particular sector.

Either way, he concluded that the mark was inherently non-distinctive for those refused goods and services.

Following the ruling of the Court of Justice of the European Union (ECJ) in *SAT.1 SatellitenFernsehen GmbH* (Case C-329/02 P), it was noted that the public interest behind Section 3(1)(b) is that of the essential function of a trademark (ie, that of guaranteeing origin). This was distinct from the public interest behind Section 3(1)(c), which was to ensure that descriptive signs or indications may be freely used by all (see *Wm Wrigley Jr v OHIM* (Case C-191/01 P)). Following *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Case C-363/99), a trademark's distinctiveness must be assessed, first, by reference to the relevant goods or services and, second, by reference to the perception of the average consumers of those goods and services.

Guidance was taken from *Audi v OHIM* (Case C-398/08) (for further details please see "[VORSPRUNG DURCH TECHNIK springs to victory](#)"), in which the ECJ 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."

The hearing officer approached the matter from a purely semantic perspective in order to assess whether the phrase was capable of performing the essential function of a trademark.

The hearing officer held that the message 'We're better, connected' was particularly transparent when used in respect of telecommunications products and services. These products and services are commonly marketed in terms of their ability to facilitate connections and communications between people. In addition, the potential for the sign to be so easily understood was not limited to its use in respect of these goods and services. According to the hearing officer, with communications technology now permeating numerous

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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 could now be framed in the context of how we use technology to interact and connect with others. If the marketing aim of a company was to promote the benefits of being connected to others, then the phrase 'We're better, connected' clearly met that brief.

Accordingly, the hearing officer held that any product or service which could be characterised by its capacity to bring people into contact with one another for a productive end was 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 sign over a period of time.

The hearing officer found the mark to be a motivational statement intended to reinforce the personal benefits of being connected to others. He added that it was the sort of statement that consumers might expect to be used by any provider of communications technology, but in drawing this conclusion, he was at pains to explain that he was not supporting the objection by reference to a need to keep the statement free for others to use, which was the policy underpinning Section 3(1)(c), rather than 3(1)(b).

Following the ECJ's guidance in *Audi*, the hearing officer concluded that the phrase 'We're better, connected' could not 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.

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