

1 UK INTELLECTUAL PROPERTY OFFICE

2 Tribunal Room 2,  
3 Harmsworth House,  
4 13-15 Bouverie Street,  
5 London, EC4Y 8DP.

6 Tuesday, 30th October 2007

7 Before:  
8 MR. GEOFFREY HOBBS QC  
9 (Sitting as the Appointed Person)

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11 In the Matter of the Trade Marks Act 1994

12 -and-

13 In the Matter of International Registration No: 873858 in the  
14 name of INTERACTIVE INTELLIGENCE INC  
15 and the request to protect a Trade Mark in Class 9

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17 Appeal of the Applicant from the decision of  
18 Mr. Edward Smith, acting on behalf of the Registrar,  
19 dated 14th May 2007.

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21 MR. GUY TRITTON (instructed by Messrs. Taylor Wessing LLP)  
22 appeared as Counsel on behalf of the Applicant/Appellant.

23 DR. WILLIAM TROTT appeared on behalf of the Registrar.

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25 D E C I S I O N  
(As approved by the Appointed Person)

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1 THE APPOINTED PERSON: On 16th February 2006 the Registrar was  
2 notified of a request by Interactive Intelligence Inc. for  
3 the protection of international trade mark number 873858 in  
4 the United Kingdom.

5 The trade mark consists of the words "Deliberately  
6 Innovative", represented in standard characters.

7 Protection was requested in respect of the following  
8 goods in Class 9:

9 "Computer programs for combining and integrating voice  
10 and data communications with computer technologies,  
11 namely, relational databases and local area networks;  
12 computer programs for controlling internal and  
13 external voice and data communications for a computer  
14 network; computer programs for managing and  
15 integrating voice and data communication and computer  
16 technologies, namely, directory services, operator  
17 services, answering services, call routing, call  
18 distribution, unified messaging, out calling, faxing,  
19 voice response and customized applications, namely,  
20 call center automation and process re-engineering."

21 The applicant raised no claim to distinctiveness acquired  
22 through use. The request for protection was refused under  
23 sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994  
24 for the reasons given in a written decision issued under  
25 reference BL 0-129-07 by Mr. Edward Smith, on behalf of the

1 Registrar of Trade Marks, on 14th May 2007.

2 He based his refusal upon the following appraisal of  
3 the mark in question relative to the goods in question:

4 "14. The mark comprises two normal English dictionary  
5 words 'deliberately' and 'innovative' in that order.

6 The attorney submits that in combination the phrase is  
7 an oxymoron, or at the very least has no discernable  
8 meaning in relation to the goods. I cannot agree with  
9 this. I am unable to see any semantic or syntactic

10 tension or quirkiness in the combination, let alone  
11 that combination having the quality of an oxymoron.

12 Whilst there is no requirement for 'semantic or  
13 syntactic tension' to be registrable, we are  
14 nevertheless required to assess the mark in relation  
15 to the goods. The more apt the words are to be used  
16 to promote, including of course in advertising, a  
17 characteristic of the product or company responsible,  
18 the less capacity such words have to distinguish the  
19 goods of a single undertaking.

20 15. Being 'innovative' is a desirable quality which  
21 anyone in the software industry (and many other  
22 industries) would strive toward or claim to possess.  
23 For many it would be more than a desirable quality,  
24 rather an essential attribute or even *raison d'etre*.

1 To be 'deliberately innovative' simply reinforces the  
2 message to the (specialist) average consumer that the  
3 undertaking concerned, wilfully and single-mindedly,  
4 sets out to be innovative. I see the phrase as a  
5 readily understandable combination with some ellipsis  
6 (ie it's not "We are deliberately innovative"), but  
7 this ellipsis is common ellipsis, such that in the  
8 context of advertising especially, would not be such  
9 as to convey distinctive character.

10 16. However, even if I do share the examiner's view  
11 that the message conveyed by the mark is that of mere  
12 value statement, either in relation to the company  
13 itself or to the goods, I must address the critical  
14 submission that such marks are nevertheless capable of  
15 'dual' function. In other words, refusal under  
16 section 3(1)(b) cannot follow simply because a mark  
17 may be found to be 'promotional'. As I indicated at  
18 the hearing, in my opinion the case law teaches us  
19 that, in the prima facie, marks which are asserted to  
20 have dual function must be capable of being perceived  
21 immediately as an indication of origin of the  
22 goods/service. In other words, the essential 'origin'  
23 function is immediately recognisable alongside the  
24 other function of promotion (see para 35 of 'The  
25 Principles of Comfort').

1           17. In this particular case, I am unable to come to  
2           that conclusion. My assessment of the mark above  
3           places particular emphasis on the word 'innovative' as  
4           being a quality desired of almost everyone in the  
5           field of software, no less so for the particular  
6           software in question. It is hard therefore to see the  
7           words 'deliberately innovative', absent evidence,  
8           conveying anything but the promotional message that  
9           the undertaking using it sets out to be innovative. I  
10          do not see the words as capable of simultaneously  
11          functioning as a trade mark. In very simple terms,  
12          this mark says (to the sophisticated average consumer)  
13          'what' we (ie Interactive Intelligence) are concerned  
14          with and aspire to, and not 'who' we are.

15          ... 21. The word 'innovative' is surely a  
16          characteristic of software (albeit specialist) which  
17          other traders would wish to use, but how about the  
18          combined term 'deliberately innovative'? In view of  
19          my linguistic analysis of the words the capacity of  
20          the words to function as an indication of the nature  
21          and quality of the goods cannot be ruled out. As I  
22          have said, in my view there is no linguistic tension  
23          in the words. As the relevant authorities state (eg  
24          ECJ Case C-191/01P DOUBLEMINT), it suffices that the  
25          term may serve in trade descriptively, and there is no

1            obligation on the registry to prove that it currently  
2            is being used in such a way."

3            On 8th June 2007, the applicant gave notice of appeal  
4            to an Appointed Person under section 76 of the Act contending  
5            in substance that the designation "Deliberately Innovative"  
6            was acceptable for registration as having no directly  
7            discernible meaning in relation to goods of the kind  
8            specified.

9            The hearing officer was said to have erred by failing  
10           to appreciate that the designation is only capable of being  
11           used to describe the qualities of an individual or  
12           undertaking and not goods.

13           These points were developed in argument at the hearing  
14           before me. They were reinforced by the suggestion  
15           "Deliberately Innovative" should be categorised as a strap  
16           line or slogan for the purpose of assessing its eligibility  
17           for registration.

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

24           The simple question is whether in February 2006 the  
25           designation had the power, when used in relation to goods of

1 the kind specified, to individualise them to a single  
2 undertaking.

3 That question falls to be answered from the viewpoint  
4 of the average consumer of the goods concerned. The relevant  
5 average consumer is, for that purpose, taken to be reasonably  
6 well-informed and reasonably observant and circumspect.

7 I do not doubt that a designation can be descriptive of  
8 the qualities or characteristics of an economic operator  
9 without also being descriptive of his goods or services and  
10 vice versa. Even so, it is possible for a designation to  
11 straddle the dividing line between the two types of  
12 descriptiveness.

13 In the present case, it appears to me that the  
14 designation "Deliberately Innovative" is apt to be understood  
15 as an accolade with the word "Deliberately" having essentially  
16 the same meaning and significance to speakers of English in  
17 the United Kingdom as the words: decidedly, intentionally,  
18 purposefully or designedly, according to the viewpoint of the  
19 consumer to whom it was addressed.

20 I think the word "Innovative" is laudatory. In the  
21 context of the designation as a whole, the word "Deliberately"  
22 adds a measure of hyperbole to the praise that it bestows.

23 In relation to computer programs of the kind specified  
24 by the applicant, the designation would, in my view, be taken  
25 to be praising both the goods and the economic operator who

1 produced them. That is to say, the relevant average consumer  
2 of the computer programs would understand them to be promoted  
3 as the deliberately, decidedly, intentionally, purposefully  
4 or designedly innovative products of a deliberately,  
5 decidedly, intentionally, purposefully or designedly  
6 innovative producer.

7 The reference thus made to the qualities or  
8 characteristics of the computer programs would, as the  
9 applicant maintains, be largely uninformative as to what the  
10 defining attribute or attributes of the goods might be.

11 The hyperbole involved in a laudatory designation  
12 may well deprive it of any concrete significance. An  
13 example would be the designation "Best Ever". Another  
14 example would be the designation "Seriously Good".

15 The point here is that there is a steady stream of  
16 judgments from the Court of First Instance affirming that an  
17 objection to registration under Article 7(1)(c) of the  
18 Community Trade Mark Regulation (equivalent to section  
19 3(1)(c) of the 1994 Act) has to be based upon a direct and  
20 specific relationship between the designation in question and  
21 one or more characteristics of the relevant goods or services.

22 I was referred to the judgments in Case T-334/03,  
23 EUROPREMIUM and Case T-19/04, PAPERLAB. Other judgments  
24 could be cited for the same proposition.

25 The applicant relies on that case law for the



1 proposition that the designation "Deliberately Innovative" is  
2 too vague and elliptical to fall foul of the test for refusal  
3 under section 3(1)(c).

4 I have to say that I have misgivings as to the  
5 narrowness of an interpretation that would render section  
6 3(1)(c) inapplicable to laudatory designations such as "Best  
7 Ever" or "Seriously Good" on the ground that they lacked  
8 specificity as to one or more characteristics of goods or  
9 services. However, I do not think it is either necessary or  
10 appropriate to explore those misgivings further on this  
11 occasion.

12 Taking the case law of the Court of First Instance at  
13 face value, I think the designation "Deliberately Innovative"  
14 is, as the applicant contends, rather too vague and lacking  
15 in specific descriptiveness to be caught by the exclusion  
16 from registration in section 3(1)(c). I am therefore not  
17 prepared to uphold the objection under that section. That  
18 leaves the objection based on lack of distinctiveness under  
19 section 3(1)(b).

20 The applicant maintains that use of the designation  
21 "Deliberately Innovative" was likely to be understood as  
22 indicating that the computer programs to which it referred  
23 were the goods of a company which prides itself on adopting  
24 a programme of purposefully delivering state of the art  
25 technology to the public. I agree.

