

O-131-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2500980
BY SOLOMON TELEKOM COMPANY LIMITED
TO REGISTER THE FOLLOWING SERIES OF THREE MARKS :
IN CLASSES; 35, 38 and 41:
BRING THE WORLD CLOSER
Bring the world closer**



Bring the world closer

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IN THE MATTER OF AN APPLICATION NO 2500980
TO REGISTER A TRADE MARK
BY Solomon Telekom Company Limited
IN CLASSES 35, 38 and 41**

DECISION AND GROUNDS OF DECISION

Background

1. On 27 October 2008 Solomon Telekom Company Limited of PO Box 148, Honiara, Solomon Islands, SB, applied to register trade mark 2500980 under the provisions of the Trade Marks Act 1994. The marks consist of the following signs:

BRING THE WORLD CLOSER

Bring the world closer



2. Registration was sought in respect of the following services:

Class 35

Promotional, advertising and marketing services.

Class 38

Telecommunication, mobile and fixed telecommunication and telephone, satellite telecommunication, cellular telecommunication, radio and cellular telephone, radio facsimile, radio paging and radio communication services; radio broadcasting and transmission services; hire, leasing and rental of telecommunications, radio, radio telephone and radio facsimile apparatus, communication of data by radio, telecommunications and by satellite; automatic telephone answering services; personal numbering services, loan of replacement telecommunication apparatus in the case of breakdown, loss or theft; provision of internet services, in particular access time to global computer networks; telecommunication of information (including web pages) computer programmes and any other data; electronic mail services; provision of directory services; provision of wireless application protocol services including those utilising a secure communications channel; provision of information relating to or identifying telephone and telecommunications apparatus and instruments; provision of telephone directory services; data interchange services; messaging services, namely, sending, receiving and forwarding messages in the form of text, audio, graphic, images or video or a combination of these formats; unitised messaging services; voicemail services providing data network services, video conferencing services, video telephone services providing telecommunications connections to the internet or databases, providing access to digital music websites on the internet, providing access to mp3 websites on the internet, delivery of digital

music, by telecommunications; operation of search engines, computer aided transmission of messages, data and images, computer communication services; news agency services, transmission of news and current affairs information; provision of on-line access to exhibitions and exhibition services; provision and operation of electronic conferencing, discussion groups and chat rooms; provision of information relating to the aforementioned services.

Class 41

Entertainment services; provision of games; provision of on-line electronic publications, publication of electronic books and journals on-line; operation of quizzes via the Internet or other electronic networks; sporting and cultural activities, exhibition services; news reporting services for transmission across the Internet; ticket reservation and booking services for entertainment, sporting and cultural events, electronic library services for the supply of electronic information (including archive information) in the form of text, audio and/or video information; provision of digital music (non-downloadable) from the Internet; provision of digital music (non-downloadable from mp3 Internet websites); fashion information provided by telecommunication means from a computer database or via the Internet; provision of information relating to all the aforementioned services.

3. On 19 January 2009, the Intellectual Property Office issued an examination report in response to the application. In the report, an objection was raised under section 3(1)(b) and (c) of the Trade Marks Act 1994 ("the Act"), on the basis that the mark consists exclusively of the words "BRING THE WORLD CLOSER" in upper and lower case, being a sign which may serve in trade to designate the intended purpose of the services, e.g. services that 'bring the world closer'. The examiner also stated that; "The mark of application consists of words that would be used in the normal course of advertising. The words appear to be a natural abbreviation for the longer expressions "bring the world closer to you" or "bring the world closer to home" or "bring the world closer together".

4. To support the objection the examiner issued Internet references showing that the expression "bring the world closer" is used in a variety of areas, especially in an elongated form as in "bring the world closer to home".

5. At the hearing, which was held on 7 May 2009, at which the applicant was represented by Mr Gardner of The Trade Marks Bureau, their trade mark attorneys, the objection under Section 3(1)(c) was waived, but the objection under Section 3(1)(b) was maintained.

6. Notice of refusal was issued under Section 37(4) of the Trade Marks Act 1994 and I am now asked under Section 76 of the Act and Rules 69(2) of the Trade Mark Rules 2008 to state in writing the grounds of my decision and the material used in arriving at it.

7. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

The applicant's case for registration

7. Prior to the hearing, Mr Gardner provided written submissions in support of his claim that the mark is sufficiently distinctive for acceptance. In these submissions, Mr Gardner stated that the mark must be considered as applied for and not by adding or taking away words, which may then render the mark wholly descriptive or devoid of any distinctive character. He submitted that the sign is allusive only with no direct meaning for the services specified. He also provided definitions of the word 'world' from Collins English Dictionary. Regarding the third mark, Mr Gardner stated that he did not intend to argue that the stylisation brought any additional distinctiveness to the mark.

8. At the hearing, Mr Gardner reiterated his argument that the objection was not valid and did not agree with the examiners suggestion that the term would be considered as a natural abbreviation for longer expressions such as "bring the world closer to you", "bring the world closer to home" and "bring the world closer together". He considered that the term was allusive and did not describe the services. He argued that it isn't possible to bring the world closer and as such the term is distinctive. Mr Gardner also referred me to similar marks which had been accepted as Community Trade Marks.

9. In the decision that follows I will give my reasons for maintaining the objection to this sign; but first I wish to set out my understanding of recent case law in respect of Section , 3(1)(b).

The Law

10. 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,”

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

11. The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities – general principles

12. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for 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*).

13. 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 provisions referred to above) the Court has held that “...the public interest ... is, manifestly, in dissociable 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 judgment). 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-191/0P paragraph 31.

14. In terms of the relationship as between sections 3(1)(b) and (c), a mark which is subject to objection under section 3(1)(c) as designating a characteristic of the relevant goods or services will, of necessity, also be devoid of distinctive character under section 3(1)(b) – see to that effect para 86 of Case C-363/99 *Koninklijke KPN Nederland NV v Benelux – Merkenbureau (Postkantoor)*. But plainly, and given the public interest behind the two provisions, they must be assessed independently of each other as their scope is different, that is to say that section 3(1)(b) will include within its scope marks which, whilst not designating a characteristic of the relevant goods and services, will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin.

15. The question then arises as to how distinctiveness is assessed under section 3(1)(b). Para 34 of the *Postkantoor* case reads as follows:

“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 C-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).”

Decision

16. In assessing whether the mark applied for falls foul of section 3(1)(b), I refer to a judgement issued by the European Court of Justice in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8 April 2003) where, in paragraphs 37, 39 to 41, and 47, the following is stated:

"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 rule 1 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 judgement 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 those distinguishing it from those of other undertakings."

17. On the basis of those comments presented above, it is clear that any assessment of a mark's distinctiveness pursuant to Section 3(1)(b) must take into account both the nature of the goods and services claimed, and the likely perception of the relevant consumer using those goods and services. By considering such factors, I will be able to determine the likelihood of any potential consumer perceiving the sign applied for as a distinctive indicator of origin, or simply as an origin-neutral sign.

18. In addition to this assessment of consumer perception, I must also be aware that the test is one of immediacy or first impression as confirmed by the European Court of First Instance which in its decision on *Sykes Enterprises v OHIM (REAL PEOPLE REAL SOLUTIONS)* [2002] ECR II-5179, stated the following:

"However, 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."

19. The specifications cover a wide range of services from e.g., promotional and advertising services in Class 35 to telecommunication services in Class 38, some of which have been specified as to their precise nature and entertainment services at large in Class 41, amongst a wide range of other services. As such with regard to the relevant public, I consider that this consists not only of the general public but in relation to some of the very broad terms claimed in the specifications such as “telecommunication services”, these services could be highly sophisticated and which would be targeted at more specialist consumers rather than just the general public.

20. In addition to the Linde case, we now have a body of case law in relation to slogan marks. It is necessary to refer also to leading authorities on this type of mark. I might add that at the hearing I referred the attorney to a number of cases, which are helpful. By ‘helpful’ I mean that an important legal principle is being set out.

21. In case BL O-010-06 ‘YOU WON’T BELIEVE YOUR EYES’, the Appointed Person sets out the guidance she sees as being confirmed by ‘The Principles of Comfort’ case. This guidance is as follows:

(i) 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).

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

(iii) 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).

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

22. Based on this guidance I must address the question: how is this mark likely to be perceived by both the general public and also the relevant specialist consumer.

23. The mark comprises four normal English dictionary words ‘bring’, “the” “world” and “closer” in that order. Mr Gardner’s argument was that he did not agree with the examiners suggestion that the term would be considered as a natural abbreviation for longer expressions “bring the world closer to you” etc. He also considered the term to be allusive.

24. I cannot agree with these arguments. We are required to assess the mark in relation to the services. The more apt the words are to describe (including of course in advertising) a characteristic of the product or company responsible, the less capacity such words have to distinguish the services of a single undertaking.

25. ‘Bring the world closer’ is commonly used phrase that can mean uniting the people of the world in (for example) a shared endeavour (e.g. “Green Issues Brings

the World Closer”, equivalent to “The World unites around Green issues”). But the phrase has also found significant use in relation to technological communications that allow consumers, wherever they are, to easily receive and share information. There is a relatively long history of the latter type of usage (e.g. “the invention of the telephone has brought the world closer”) which is refreshed by the media every time the latest gismo and gadget makes its way to the marketplace. In short, the use of the phrase in relation to the services at issue simply sends a message to the average consumer that the services provided by the applicant’s will bring people together, that is, virtually, reduce the distance between them. I see the phrase as a readily understandable combination such that, in the context of advertising especially, would not be such as to convey distinctive character.

26. I have considered how the mark would be perceived by both the general public and in relation to more sophisticated services, more specialist consumers who are deemed to be well informed and aware of the goods and services available, but in order to further support my reasoning I refer to CFI Case T-130/01 Real People Real Solutions (paragraph 24) which states;

24. It must first of all be pointed out, with regard to the relevant public, that the services in question are aimed at a particular class of persons, namely users of goods and services connected with information technology. Those persons' awareness will thus be relatively high in relation to signs, and in particular marks, likely to indicate a commercial origin guaranteeing the compatibility of the goods or service purchased with their computing equipment (see, to that effect, the judgment in Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). Their awareness is liable to be relatively low, on the other hand, when it comes to purely promotional indications, which well-informed consumers do not see as decisive.

27. Regarding the Community Trade Mark precedents referred to by Mr Gardner, I am unaware of the circumstances surrounding their acceptance, and consider them to be of little assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] RPC 281 at 305 where he stated the following:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME* Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence."

28. Since refusal of this application, I have become aware also of the ECJ Case C-398/08P *Audi AG v OHIM* ("*Vorsprung Durch Technik*"), selected paragraphs of which I also quote 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, 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."

29. The message from this case is, I think, that one should avoid deeming an application as necessarily devoid of distinctive character by virtue of an assertion that it would be seen as entirely, or even primarily, a 'promotional' message as far as the average consumer is concerned. Moreover, that objective and simple messages may well also not necessarily be devoid of distinctive character by virtue, solely, of that characteristic. The issue for the ECJ seems to be that where such marks possess 'originality and resonance' capable of being remembered (which may, e.g. result from word play, imagination and creativity), they are unlikely to be devoid of distinctive character. The impact of the Judgment is, in effect, to urge the relevant authorities to undertake a full semantic analysis of the mark in question (as I have undertaken in this case), without preconception or pre-emption, and also take into account known and relevant surrounding circumstances.

30.. As regards the surrounding circumstances in the *Vorsprung durch Technik* case, plainly in paragraph 59 the ECJ factored into their analysis the fact that Audi's use over many years made it easier for the average consumer to identify the commercial origin of products sold under that slogan. I note that there is no evidence of use in this case. There are no other relevant surrounding circumstances that have been brought to my attention either by the examiner or the applicant. As far as my semantic analysis is concerned I have concluded that the phrase cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creativity which might help endow it with the necessarily capability to function. Applying the ECJ's guidance in *Vorsprung durch Technik* , as well as those cases which have preceded it, I have no hesitation in upholding the refusal under section 3(1)(b) of the Act.

Conclusion

31. In this decision I have considered all the documents filed by the applicants 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 Section 3(1)(b) of the Act.

**Dated this 29 April 2010
Bridget Whatmough
For the registrar**