

**TRADE MARKS ACT 1994
AND
THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 726145
AND THE REQUEST BY DEUTSCHE TELEKOM AG
TO PROTECT A TRADE MARK IN CLASS 38**

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TO PROTECT A TRADE MARK IN CLASS 38**

On 10 February 2000, Deutsche Telekom AG of 140 Friedrich Ebert-Allee, D-53113 Bonn, Germany, on the basis of International Registration no. 726145, requested protection in the UK under the provisions of the Madrid Protocol, of the mark



The International Registration is numbered 726145 and protection is sought in class 38 in respect of "communications services".

It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from registration by Section 3(1)(b) of the Trade Marks Act 1994. This is because the mark consists of the words "Global" and "Telecom" conjoined, together with other non-distinctive elements not regarded as being a sufficient degree of surplus in order to qualify for prima facie acceptance, the whole being devoid of any distinctive character for e.g. global telecommunications services.

At a hearing on 18 December 2000, Mr Stacey of Baron and Warren, the holder's representatives, made submissions in support of the application. He argued for the totality of the mark and he further argued that the slogan "The World is Yours" is acceptable as a slogan in its own right for these services in line with the Registrar's published guidance on slogans under Practice Amendment Circular 9/00. A copy is attached at Annex A. I maintained the objection under Section 3(1)(b) and notice of refusal under Article 9(3) was issued on 15 May 2001. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of decision and the materials used in arriving at it.

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

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

3. (1) The following shall not be registered
 - (b) trade marks which are devoid of any distinctive character.

The mark consists of the word "Global" conjoined with the abbreviation for the word "Telecommunications" i.e. "Telecom" and the words "The World is Yours" appearing underneath in a much smaller size. A non-distinctive curved line which appears to represent the top of the world appears above the word "GlobalTelecom".

All words are so well known that I do not need to set out any dictionary definitions. I am, in any case, bound to accept or reject the mark in its totality. I do not consider that the individual elements of the mark add up to a distinctive whole. This is overwhelmingly a "GlobalTelecom" mark, and the other matter appearing in the mark merely serves to emphasise global telecommunications. The slogan "the world is yours" indicates the quality of the services in my view in that the user can enjoy telecommunication services on a global scale. They are words that the general public would expect to see in an advertising context as opposed to any trade mark context.

The test for distinctiveness was clearly set out by Mr Justice Jacob in the *British Sugar PLC and James Robertson and Sons Ltd* decision (1996) RPC 281, page 306, line 1 (referred to as the *TREAT* decision):

"Next, is "Treat" within Section 3(1)(b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character."

Although Mr Justice Jacob's comments were made in relation to the word "Treat", they equally apply to marks which are combinations of words and/or devices. When all the component parts of this mark are viewed as a totality, the overall message which is likely to be conveyed to potential customers is that the mark identifies telecommunications services that are offered on a global scale.

I take the view that the general public would not perceive the mark applied for as being a trade mark without first being educated to that fact.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is

refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 22ND day of August 2001.

Janet Folwell
For the Registrar
The Comptroller General