

O-353-10

UK INTELLECTUAL PROPERTY OFFICE

Court Room 1  
21 Bloomsbury Street  
London, WC1B 3HF

Friday, 24th September 2010

Before:

**MR. GEOFFREY HOBBS QC**  
(Sitting as the Appointed Person)

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In the Matter of THE TRADE MARKS ACT 1994

- and -

In the Matter of UK Trade Mark Applications Nos. 2500980 &  
2500983  
for registration of **BRING THE WORLD CLOSER** and **NO WIRE, NO  
WORRIES**  
in the name of Solomon Telekom Company Limited.

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**Appeal from the decisions of Ms. B. Whatmough, acting on behalf  
of the Registrar, dated 29th April 2010 and 21st April 2010**

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*(Computer-Aided Transcript of the Stenograph Notes of  
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**MR. M. GARDNER** (of The Trade Marks Bureau) appeared on behalf of  
the Applicant.

**DR. W.J. TROTT** appeared on behalf of the Registrar.

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

THE APPOINTED PERSON: Solomon Telekom Company Limited filed two applications for registration on 27th October 2008. In application No. 2500980 it sought to register a series of three graphic representations of the expression BRING THE WORLD CLOSER as trade marks for use in relation to the following services in Classes 35, 38 and 41:

"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 programs 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."

In application No. 2500983 it sought to register a series of two graphic representations of the expression NO WIRES, NO WORRIES as trade marks for use, inter alia, in relation to the following services in Class 38:

"Class 38. Telecommunication services; provision of Internet chat rooms; provision of on-line access to exhibitions and exhibition services; provision and operation of electronic conferencing, discussion groups and chat rooms."

The first of the two applications was rejected by the

Registrar's Hearing Officer Ms. Bridget Whatmough for the reasons she gave in a written decision issued under reference BL O-131-10 on 29th April 2010. She rejected the application under section 3(1)(b) of the Trade Marks Act 1994, which prevents the registration of signs "devoid of any distinctive character". She found that the expression BRING THE WORLD CLOSER was excluded from registration in relation to services of the kind specified on the basis stated in paragraphs 23 to 25 of her written decision:

"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 examiner's 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 a 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."

The second application for registration was rejected

under section 3(1)(b) for the reasons given by Ms. Whatmough in a written decision issued under reference BL O-123-10 eight days prior to her decision rejecting application No. 2500980. She found that the expression NO WIRES, NO WORRIES was excluded from registration in relation to services of the kind specified in Class 38 on the basis stated in paragraphs 23 to 25 of her written decision:

"23. It appears reasonable when applying the normal rules of English language and grammar that the words NO WIRES and NO WORRIES when used in combination are readily comprehensible. As stated above, the services in Class 38 are 'Telecommunication services; provision of Internet chat rooms; provision of on-line access to exhibitions and exhibition services; provision and operation of electronic conferencing, discussion groups and chat rooms.'

24. The term 'telecommunication services' is an extremely broad term which would cover a multitude of different kinds of telecommunication services' from everyday use of a mobile phone that utilises a telecom service or a wireless broadband connection to far more sophisticated telecommunication services. As such, I consider that the average consumer of these services

would vary accordingly, depending on the actual services. In respect of the term 'provision of Internet chat rooms; provision of on-line access to exhibitions and exhibition services; provision and operation of electronic conferencing, discussion groups and chat rooms', I deem that the relevant consumer of these services would be the public at large. Depending on the kind of telecommunication services, the level of attention and knowledge of the consumer will also vary accordingly. However, irrespective of the telecommunication services, they are not an everyday purchase. I therefore consider that the average consumer of even the less sophisticated services will purchase the services with a moderate level of attention and knowledge.

25. In my view, the average consumer will understand the phrase as one which advises consumers that the undertaking provides wireless, worry free telecommunications. I do not agree with Mr. Gardner's submissions that to make the mark a wholly descriptive advertising slogan, additional words must be added and/or removed from the mark such as NO WIRES TO WORRY ABOUT or DONT WORRY ABOUT WIRES. It seems to me that the phrase is one which is plain, unambiguous; there are no alternative meanings possible. Similarly, I do not agree with Mr. Gardner's statement that symmetry between the marks' components endow the mark with a fanciful theme. Although not necessarily determinative on the question of distinctiveness, the phrase cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creativity such that its meaning becomes elusive or vague. There is some basic

alliteration and rhythmic structure (engendered by the repetition of NO) but this is simplistic and glib."

The Applicant subsequently appealed both decisions to an Appointed Person under section 76 of the 1994 Act. In each case the statement of grounds in the Form TM55 Notice of Appeal consisted of a bare statement to the effect that:

"The Applicant does not agree with the examiner's decision dated 21st April 2010 that the [sign in issue] should be refused registration ... in accordance with section 3(1)(b) of the Act."

This was simply an expression of dissatisfaction with the Hearing Officer's decisions. It was manifestly deficient for the purposes of rule 71(1) of the Trade Marks Rules 2008, which provides as follows: "Notice of appeal to the person appointed under section 76 shall be filed on Form TM55 which shall include the appellant's grounds of appeal and his case in support of the appeal."

It is important for appellants to address themselves to the question whether they have genuine grounds for appeal and not simply pursue an appeal for the sake of it. Rule 71(1) performs an important function in that connection. I regret that the provisions of the rule were not complied with in the present case.

The deficiency under rule 71(1) has only marginally been cured during the pendency of the appeals. Both appeals were listed for consideration at a single hearing. The Applicant's skeleton arguments for the hearing added to the



Notices of Appeal in the following terms:

"UK Trade Mark Application No. 2,500,980 BRING THE  
WORLD CLOSER

The section 3(1)(b) objection has been maintained against all the services covered by the application but the Hearing Officer has failed to provide thorough and full facts of refusal for all the individual services covered by the application. At best, there is a link between the reasons for refusal and 'telecommunication services and advertising services' covered by the application when the Hearing Officer stated:

'The term is significantly used in relation to technological communications that allow consumers, wherever they are, to easily receive and share information (e.g. the invention of the telephone has brought the world closer)'.  
  
and

'I see the phrase as a readily understandable combination such that, in the context of advertising especially, it would not be such as to convey

distinctive character'.

The Hearing Officer states at paragraph 24: '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'. This argument is incorrect as the assessment of the trade mark must be considered in relation to the services covered by the application and that such reasoning would be applicable to section 3(1)(c) that has already been waived.

The Hearing Officer also states at paragraph 25 that: 'Bring the world closer is a 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'. See paragraph 53 & 54 of Case C-265/09 P *BORCO-Marken-Import Matthiesen GmbH & Co. KG*.

It is irrelevant to whether a particular phrase is

commonly used as the test must be whether the phrase can denote origin. We could presume the objection relates to 'telecommunication services' by the Hearing Officer's reference to 'technological communications'. The Hearing Officer clearly indicates that, in her opinion, the mark would not convey distinctive character in respect to 'advertising' but this is the only service that is clearly defined. See paragraph 42 of Case C-265/09 P *BORCO-Marken-Import Matthiesen GmbH & Co. KG*.

If the term BRING THE WORLD CLOSER is to be seen by the relevant consumer as an objective message then some interpretation will be necessary to trigger the minds of the average consumer to such a finding. See paragraph 57 of Case C-398/08P *Audi AG v OHIM 'Vorsprung durch Technik'*.

The Hearing Officer states that the ECJ's guidance in the *Vorsprung durch Technik* case influenced her decision and that Audi's evidence of use was a factor in that decision (whereas there is no evidence of use to consider in this case). In fact, Audi only produced evidence in respect to the Class 12 goods that the mark

for the remaining Classes 09, 14, 16, 18, 25, 28, 35 and 43 was accepted for registration even though the mark may be seen as a simple message. Paragraph 58 of Case C-398/08P *Audi AG v OHIM 'Vorsprung durch Technik'* states: '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.'

UK Trade Mark Application No. 2,500,983 NO WIRES, NO WORRIES

At paragraph 25 of the Decision the Hearing Officer states that the mark cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creativity. However, the mark is linguistically imperfect because consumers must make, at least, some interpretation of the mark to transform the mark from one which is capable of denoting origin to one which is wholly devoid of distinctive character. See

Paragraph 57 of Case C-398/08P *Audi AG v OHIM*

*'Vorsprung durch Technik'*.

Consumers are well aware that wirefree telecommunication services are nothing new and simply because the services may be wirefree does not mean they do not suffer from technical faults. Consumers are therefore highly unlikely to see the mark by its literal meaning.

The Hearing Officer considers the mark to possess a basic alliteration and rhythmic structure.

Subsequently, it cannot be said that the mark is devoid of any distinctive character. Paragraph 41 of Case C-265/09 P *BORCO-Marken-Import Matthiesen GmbH & Co. KG* states: 'Similarly, as the General Court noted in paragraph 39 of the judgment under appeal, the Court of Justice also points out that, to prevent application of Article 7(1)(b) of the regulation, it is sufficient if the sign at issue has a minimum degree of distinctiveness.'

These points were covered in argument at the hearing before me. In relation to each of the rejected applications they boil down to the single proposition that the Hearing Officer's reasons for rejecting the application were not sufficient to establish that the sign in question lacked a distinctive character.

For the reasons I gave at greater length in Easistore Limited's application to register WE CREATE SPACE as a trade mark in Class 39 (21st September 2010), I think it is necessary to give effect to the case law of the Court of Justice relating to the scope and effect of the exclusion from registration contained in section 3(1)(b) by focusing on the question whether, from the perspective of the relevant average consumer, the sign in question would serve to individualise goods or services of the kind specified to a single economic undertaking.

Dr. Trott has indicated that the Registrar is prepared to waive the objection under section 3(1)(b) in relation to the specified services in Class 35, without prejudice to his contention that the Hearing Officer's assessment should be upheld in relation to the specified services in Classes 38 and 41 of application No. 2500980.

In my view, the Hearing Officer's assessment of the expression BRING THE WORLD CLOSER is neither unrealistic nor insufficient to establish that the application to register the expression was caught by the exclusion in section 3(1)(b). I am willing to accept that "world" is a versatile term. It can be used with various nuances of meaning as exemplified by the use of it in references to "the real world", "the outside world", "the world at large", "the way

of the world", "the world view", "his/her/their world" and so on, which is not to say that any of the possible shades of meaning it might be taken to possess when used as part of the expression BRING THE WORLD CLOSER would be sufficient to lead to the conclusion that the expression as a whole was possessed of a distinctive character.

Taken as a whole, the expression looks and sounds like a statement about an advantage flowing from the use of the services on offer. I agree that the advantage and the methodology or mechanism by which it is delivered are not thereby explained. However, a narrative statement can be uninformative in relation to an aspect of the services to which it refers without necessarily or inevitably being apt to serve as an indication of trade origin. I think that is the position here.

The expression BRING THE WORLD CLOSER is caught by the exclusion from registration in section 3(1)(b) because it is liable to be perceived and remembered by the relevant average consumer as nothing more than an origin-neutral statement about the services concerned. It appears to me to involve no verbal manipulation or engineering of the kind which, in other cases, has been recognised as sufficient to turn explanatory phraseology into a sign possessed of a distinctive character.

The appeal in relation to trade mark application No. 2500980 is therefore dismissed in relation to the determination in Classes 38 and 41.

I have set out above the Hearing Officer's reasons for holding that the expression NO WIRES, NO WORRIES was caught by the exclusion from registration in section 3(1)(b). Her reasoning appears to me to be correct and complete in relation to the services of the Class 38 specification. I do not accept that there is any substance in the points urged upon me by the Applicant in that connection. The appeal in relation to trade mark application no. 2500983 is therefore dismissed in relation to the determination in Class 38. That is my decision on these two appeals.

Thank you both very much for your submissions. That concludes it for today.

MR. GARDNER: Thank you, sir.

DR. TROTT: Thank you.

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