

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. **200006379**
APPLICANT: **ALEXANDER FORBES LIMITED**
CLASS: **36**
MARK: **“YOUR WORLD IS OUR WORLD”**

STATEMENT OF REASONS FOR DECISION

Background

1. On 24 March 2000, Alexander Forbes Limited of 25 Sauer Street Ext, Johannesburg, Gauteng Province, South Africa, applied to register the mark “YOUR WORLD IS OUR WORLD” in Class 36 under the Trade Marks Ordinance (Cap. 43).
2. The specification of services, after amendments, is as follows:

“insurance, assurance, reinsurance and consultancy services relating to the aforesaid services; actuarial services; financial evaluation, assessment, valuation, loss adjusting, agency, brokerage, exchange, savings, guarantee, security, swapping, deposit, clearing houses and underwriting services; provision of financial reports and analysis relating to risk management; estimating insurance risks, losses and liabilities; financial planning, auditing and consultancy services; claims settlement, management and control relating to insurance claims; investment and investment trust services; financial services; real estate agency; all included in Class 36.”
3. Objections were raised against the application, and on 26 June 2003, the applicant, pursuant to section 11 of Schedule 5 to the new Trade Marks Ordinance (Cap. 559) (“the Ordinance”), converted the application to an application under the Ordinance.
4. The application was re-examined in accordance with the provisions of the Ordinance. Objections were raised under section 11(1)(b) of the Ordinance.

5. The applicant called for a hearing which took place on 30 July 2004. Mr Philips Wong, counsel, instructed by Emily Yip & Co., appeared on behalf of the applicant. I reserved my decision at the end of the hearing.
6. The applicant did not file any evidence of use of the mark. I therefore have only the *prima facie* case to consider.

The Trade Marks Ordinance

7. Section 11(1) of the Ordinance is as follows:
 - (1) Subject to subsection (2), the following shall not be registered –
 - (a) signs which do not satisfy the requirements of section 3(1) (meaning of “trade mark”);
 - (b) trade marks which are devoid of any distinctive character;
 - (c) trade marks which consist exclusively of signs which may serve, in trade or business, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services; and
 - (d) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.

The applicant’s submissions

8. The case put forward for registration is as follows:
 - (a) The mark is an invented phrase intended to identify the trade origin of the applicant’s services.
 - (b) The literal meaning of the phrase does not denote the nature or the quality of the services. Alternatively, if the mark suggests that the applicant cares about customers’ needs, this meaning can only be perceived by a mental effort.
 - (c) There is no evidence of common usage of the phrase in the relevant

trade.

- (d) The distinctiveness of the mark must be considered in the context of the application – the average customer’s level of attention is no doubt higher when it comes to the selection of insurance, financial and other monetary services.

9. The following decided cases were cited by Mr Wong:

- (a) *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281
- (b) *Nestle SA’s Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2 (Court of Appeal)
- (c) *Nestle SA’s Trade Mark Application (“Have a Break”)* [2003] F.S.R. 37 (Chancery Division)
- (d) “*LASER TRACER*” (Case R62/1998-3), Decision of the Third Board of Appeal, OHIM.

Decision

- 10. The mark is a slogan comprising ordinary words. The words are so common that no dictionary definitions are necessary.
- 11. I agree with Mr Wong that the mark does not consist exclusively of signs which designate the characteristics of the applied for services, nor does it appear to be a customary phrase in the relevant trade. Sections 11(1)(c) and (d) are not applicable, and the only relevant objection in this case is section 11(1)(b).
- 12. Section 11(1)(b) precludes from registration signs which, even though not caught by sections 11(1)(c) and (d), are nevertheless incapable of distinguishing the goods and services of one undertaking from those of other undertakings. Section 11(1)(b) makes no distinction between different types of marks for the purpose of assessing their distinctiveness and there is nothing in the Ordinance which suggests that slogans should be treated any differently

from other types of marks. Accordingly the same test for assessing distinctiveness applies to slogan marks as it does other types of marks.

13. What does “devoid of any distinctive character” mean? In *British Sugar Plc v James Robertson & Sons Ltd*, Jacob J. explains the enquiry that this ground of prohibition entails:

“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?”

14. On appeal to the Court of Appeal in *“Have a Break”*, it was said that:

“The distinctiveness to be considered is that which identifies a product as originating from a particular undertaking. Such distinctiveness is to be considered by reference to goods of the class for which registration is sought and consumers of those goods. In relation to the consumers of those goods the court is required to consider the presumed expectations of reasonably well informed, and circumspect consumers. For my part I would particularly emphasise that the relevant distinctiveness is that which identifies a product as originating from a particular undertaking. Individual words and letters are used as inherently distinctive of other words or letters but this does not make them registrable as trade marks. If the mark for which registration is sought is distinctive in the relevant sense to any extent then its registration is not precluded by [s. 11(1)(b)].”

15. In assessing the distinctive character of the subject mark, I should consider it from the perspective of an average, relevant consumer of the applied for services who is reasonably informed and observant. An average consumer would be aware that slogans are commonly used in business for purely advertising purposes. I must therefore take into account the effect of the mark being used in advertising the services in question.

16. An average consumer is likely to perceive the mark simply as a promotional statement. The phrase “YOUR WORLD IS OUR WORLD” is an expression of empathy or connection with people. It is the kind of phrase that is apt for use in the promotion of a wide variety of services. In relation to the applied

for services, the phrase conveys the immediate message that the scope of a customer's financial or insurance needs is also "our world", or field of financial or insurance operations, or expertise. It is a phrase particularly apt for use in the promotion of insurance, financial and investment services because these are services in which customers need and can benefit from a personal touch and assessment. In the context of insurance, financial and investment services, the phrase is likely to be perceived as a general appeal to target customers; an appeal of the sort that any trader in the field might make, as opposed to a mark that specifically links the services with the applicant to distinguish the applicant's services from insurance, financial and investment services provided by anyone else.

17. In *Yakult Honsha KK's Trade Mark Application* [2001] R.P.C. 39, Laddie J. said that "[w]here inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is so used for that purpose." In respect of the applied for services, the subject mark is one that an average consumer is likely to see as nothing more than an origin neutral promotional statement, without first being educated that the mark is intended to be a badge of trade origin. The mark is therefore devoid of any distinctive character as it would not perform the essential function of guaranteeing the trade origin of the services in question.
18. I am unable to agree with Mr Wong's submission that "YOUR WORLD IS OUR WORLD" is an invented phrase. It is merely a sequence of ordinary dictionary words that come easily to mind in order to convey a promotional message. In any event, even if the phrase were invented it would not necessarily follow that the phrase would have distinctive trade mark character.
19. Mr Wong argued that if the mark suggests that the applicant cares about customers' needs, this meaning can only be perceived by a mental effort. I am unable to agree. Considering that a customer is likely to pay close attention when it comes to the selection of insurance, financial or investment services, I consider the promotional message conveyed by the mark to be readily apparent to the average customer of such services.
20. I was referred to the case of "*Laser Tracer*". In that case the Third Board of

Appeal of OHIM refused the appeal on the basis of objections under the equivalent provisions of our section 11(1)(b) and (c). However, as the mark “Laser Tracer” was found to be descriptive of the goods in question, it was also held to be devoid of any distinctive character. Mr Wong referred to paragraph 11 of the judgment in support of his arguments. The paragraph discusses the difference between a “descriptive” and an “allusive” trade mark in the context of section 11(1)(c). As the objection in this application relates to section 11(1)(b) only, the reasoning in paragraph 11 of the judgment does not assist the applicant.

21. Mr Wong submitted that the mark does not denote the nature or character of the services. This argument is misconceived as the mark is not objectionable under section 11(1)(c). The fact that a phrase is not a normal means of designating the goods or their characteristics does not necessarily mean that the phrase has any distinctive character.
22. Mr Wong further submitted that there is no evidence of common usage of the phrase in the relevant trade. However, as my finding that the mark is likely to be perceived as an origin neutral promotional statement is not founded on the basis of evidence of common usage of the phrase in the relevant trade, the submission does not assist the applicant.
23. I was also referred to an extract of a “Search and Advisory Report” issued by the UK Patent Office. The extract is undated but I was informed that it was issued on 1 July 2002. It appears to be part of a “preliminary advice” which suggests that no objection would arise under section 3 of the Trade Marks Act 1994 (UK). I have considered the “preliminary advice” but remain of the view that as explained above there are valid grounds of objection under section 11(1)(b) of the Ordinance.
24. For the above reasons I find that the mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance.

Conclusion

25. In this decision I have considered all the documents filed by the applicant and

all the arguments submitted in relation to this application. For the reasons given I refuse the application under section 42(4)(b) as the mark is precluded from registration by section 11(1)(b) of the Ordinance.

Andy Lau

for the Registrar of Trade Marks

10 September 2004