

1 THE PATENT OFFICE

2 Harmsworth House
3 Conference Room [A2]
4 13-15 Bouverie Street
5 London, EC4Y 8DP

6 Monday, 17th July 2000

7 Before:

8 MR. SIMON THORLEY 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 Trade Mark Application No. 2183690 by
14 MURGITROYD AND COMPANY LIMITED to
15 register a Trade Mark in Classes 16,
16 41 and 42

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18 Appeal of Applicant from decision of Mr. A.J. Pike,
19 acting for the Registrar, dated 15th October 1999.

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21 (Transcript of the Shorthand Notes of Marten Walsh Cherer
22 Ltd., Midway House, 27-29 Cursitor Street, London EC4A 1LT.
23 Telephone Number: 020 7405 5010. Fax Number: 020 7405 5026)

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25 MR. RON JENKINS (Murgitroyd & Company Limited) appeared for
26 the Applicant.

MR. M. KNIGHT appeared on behalf of the Trade Mark Registry

D E C I S I O N
(As approved)

1 MR. THORLEY: This is an appeal from a decision of Mr. Pike
2 dated 15th October 1999 in which he refused to register an
3 application by Murgitroyd & Company Management Services
4 Limited, now assigned to Murgitroyd & Company Limited, for a
5 trade mark in respect of the words "EVERY IDEA SAFELY
6 DELIVERED" in classes 16, 41 and 42 of the register.

7 The application was made on 4th December 1998 and there
8 was at that time no evidence of use. The question of
9 registration therefore has to be considered in relation to an
10 unused mark.

11 The primary classes in respect of which registration
12 is sought are classes 41 and 42. Class 42 registration is
13 sought for intellectual property services, patent, trade mark,
14 design and copyright advice and services and in class 41 for
15 seminar and training services, seminar and training services
16 relating to intellectual property. Mr. Jenkins who appeared
17 on this appeal on behalf of Murgitroyd & Company accepted that
18 the class 41 and 42 marks were the main area of proposed use
19 and that the class 16 mark in relation to printed matter was
20 an adjunct thereto. Murgitroyd & Company are, as is
21 well-known, a well established firm of patent and trade mark
22 agents in Glasgow.

23 Objection was taken to the application under sections
24 3(1)(b) and (c) of the Act because it was said that the mark
25 consists exclusively of the words "EVERY IDEA SAFELY
26 DELIVERED", the whole purpose being a sign which may serve in

1 trade to designate the kind, quality and intended purposes of
2 the goods and services.

3 On the appeal before me Mr. Jenkins drew no distinction
4 between section 3(1)(b) and section 3(1)(c) and, therefore,
5 I can consider the matter in the round.

6 The reasoning of the hearing officer for rejecting the
7 mark is set out succinctly on page 2 of his decision as
8 follows:

9 "The mark consists of ordinary dictionary words which
10 are so well known that it is not necessary to set out any
11 references for each of the individual words that constitute
12 the mark. I am, in any case, bound to accept or reject the
13 mark in its totality. I must, therefore, consider the meaning
14 of the mark as a whole. However, I consider it pertinent to
15 emphasise one of the dictionary definitions of the word
16 DELIVER.

17 "Collins English Dictionary (Third Edition Updated 1994)
18 defines the word DELIVER as

19 "'deliver the goods. Informal. To produce or perform
20 something promised or expected.'

21 "In my view the phrase EVERY IDEA SAFELY DELIVERED is
22 not invented but is one which indicates that the goods and
23 services provided by the applicant are provided with the
24 intention of 'delivering' a customers' idea. A customer may
25 secure the services of the applicant in order to protect that
26 idea so that any benefits accruing from it will not be lost to

1 a third party. Such ideas are often referred to as
2 intellectual property and the goods and services contained
3 within the specification applied for relate to the provision
4 of training and advice aimed at protection of such ideas.
5 The words EVERY IDEA SAFELY DELIVERED are ordinary dictionary
6 words which are devoid of any distinctive character and,
7 constitute a sign that may be used in trade to designate the
8 intended purpose of the goods and services."

9 Mr. Pike then went on to support the conclusion that he
10 had reached by reference to a brochure (the MARISTA
11 publication) which was put before him at the hearing, which
12 showed the way in which Murgitroyd & Company had used the mark
13 subsequent to the date of application. Since it was
14 subsequent to the date of application, it cannot be relevant
15 as showing use and, in my judgment, it cannot be relied upon
16 for any purpose other than supporting the initial view that
17 Mr. Pike reached. If Mr. Pike's initial view was correct,
18 then there is no need to rely upon the MARISTA publication.
19 If his original view is wrong, then nothing in the MARISTA
20 publication can change it.

21 It is common ground that when one is considering an
22 unused mark the first impression is an important one. In the
23 statement of grounds of appeal, in paragraph 5, it is stated
24 that it is necessary to consider the mark as a whole, without
25 artificially breaking it down into its component parts,
26 because it is as a whole that the mark makes its first

1 impression on the consumer. I agree that this must be the
2 correct approach with a mark which plainly is what could be
3 categorised as a slogan mark. Mr. Jenkins correctly
4 emphasized that the word "delivered" in natural parlance
5 relates to the delivery of something tangible. He referred to
6 a pizza on the one hand and a baby on the other. The latter
7 reference becomes plainer when one looks at the MARISTA
8 brochure, since that is plainly drawing a comparison between
9 the work of a patent agent in bringing to grant an application
10 for an intellectual property right with the eventual delivery
11 successfully of a baby. None the less, his argument before me
12 and before Mr. Pike was that ideas are not naturally tangible
13 articles. They cannot be delivered in the sense of handing
14 over and, indeed, the work of a patent and trade mark agent
15 does not involve the delivery of ideas at all. It involves
16 bringing to grant protection for intellectual property, which
17 may in some cases be protection for an idea, but need not be.

18 That said, undoubtedly one cannot consider the matters
19 raised in section 3(1)(b) and 3(1)(c) without having regard to
20 the field of business in relation to which registration is
21 sought. Plainly, in the present case it is in relation to the
22 business of intellectual property services, and in that area
23 the protection of ideas is obviously a paramount
24 consideration. Taken in that field, my first impression was
25 that the word "delivered" was being used in a clever way but
26 as undoubtedly creating the impression of protecting an idea.

1 It is to my mind more than an oblique reference to part of
2 the applicant's business. It is, in my judgment, a very
3 clear reference to part of the applicant's business.
4 Whilst I accept that it is oblique rather than being specific,
5 and that therefore it may be capable of becoming distinctive
6 as a result of use, my first impression was the same as that
7 of Mr. Pike, that there was too great an element of
8 descriptiveness in the words "EVERY IDEA SAFELY DELIVERED" for
9 it to have sufficient distinctive character without evidence
10 of use.

11 I have listened carefully to what Mr. Jenkins has had to
12 say and he has failed to satisfy me that my first impression
13 was wrong. Therefore, in the circumstances this appeal will
14 be dismissed.

15 MR. THORLEY: Mr. Knight, usual practice: no order as to costs
16 sought?

17 MR. KNIGHT: Yes.

18 MR. JENKINS: That is fine.

19 MR. THORLEY: There will be no order as to costs.

20 MR. KNIGHT: Thank you, sir.

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