

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 2183690
BY MURGITROYD AND COMPANY LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 16, 41 AND 42

DECISION AND GROUNDS OF DECISION

On 4 December 1998 Murgitroyd & Co Management Services Limited of Scotland House, 165 - 169 Scotland Street, Glasgow, G5 8PL applied under the Trade Marks Act 1994 for registration of the mark EVERY IDEA SAFELY DELIVERED in Classes 16, 41 and 42 of the register in respect of:

- Class 16 Printed matter; manuals; instructional and teaching materials; blueprints.
- Class 41 Seminar and training services; seminar and training services relating to intellectual property.
- Class 42 Intellectual property services; patent, trade mark, design and copyright advice and services.

On 22 January 1999 the name of the applicant was changed, by assignment, to Murgitroyd and Company.

Objection was taken to the application under Sections 3(1)(b) and (c) of the Act because the mark consists exclusively of the words EVERY IDEA SAFELY DELIVERED the whole being a sign which may serve in trade to designate the kind, quality and intended purpose of the goods and services.

At a hearing, at which the applicants were represented by Mr R Jenkins of Murgitroyd & Company, the objections were maintained. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of my 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. The agent did, however, submit evidence which demonstrated how the mark is used in relation to the goods and services applied for.

Section 3(1)(b) and (c) of the Act read as follows:-

“The following shall not be registered-

- (b) trade marks which are devoid of any character,

- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

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

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

“deliver the goods. Informal. To produce or perform something promised or expected.

In my view the phrase EVERY IDEA SAFELY DELIVERED is not invented but is one which indicates that the goods and services provided by the applicant are provided with the intention of “delivering” a customer’s idea. A customer may secure the services of the applicant in order to protect that idea so that any benefits accruing from it will not be lost to a third party. Such ideas are often referred to as intellectual property and the goods and services contained within the specification applied for relate to the provision of training and advice aimed at the protection of such ideas. The words EVERY IDEA SAFELY DELIVERED are ordinary dictionary words which are devoid of any distinctive character and, constitute a sign that may be used in trade to designate the intended purpose of the goods and services.

On 11 May 1999 the agent provided examples of the mark in use and submitted that this information was sufficient to allow the objections to be waived. I have taken full account of this information but remain of the view that the objections must be maintained. The examples of the mark in use are all contained within a brochure entitled “intellectual property guide for design and marketing specialists”. Beneath this heading is the stylised word MARISTA which is very prominent. MARISTA is a registered trademark of the applicants. The words EVERY IDEA SAFELY DELIVERED appear separately on the cover of this brochure in semi-circular form and adjacent to a rather complex device. This particular use of the mark is again found in a loose leaflet inside the brochure. Whilst the mark is again used towards the top of the inside page of this leaflet it does not appear that this use would be seen as use of these words as a trademark. Indeed, towards the bottom of that page the following passage appears:

“That is where MARISTA IP Guidelines comes in. With this Intellectual Property Guide for Design and Marketing Specialists, you prevent the pain, the sleepless nights and the scares - by making sure all your ideas are safely delivered.”

Although the wording may not be identical I take the view that use of the words “...ALL YOUR IDEAS ARE SAFELY DELIVERED” in this way supports the view that the words EVERY IDEA SAFELY DELIVERED are used in a descriptive sense and not as a trademark. On the introduction page of this brochure the mark is used in plain typeface as a sub-heading but, again, I do not see that this is use of the words as a trademark.

In my view this brochure does little to support the view that the words EVERY IDEA SAFELY DELIVERED would, through their use in this brochure, be seen as identifying the

origin of the goods and services applied for.

In this decision I have born in mind the comments in the unreported decision on the DAY BY DAY (Application No 2068646 dated 12 April 1994) appeal in which Simon Thorley in his role as The Appointed Person said:

“In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising”.

I also bear in mind the comments of Geoffrey Hobbs QC in the AD2000 decision (1997 RPC 168) at page 176, lines 9 to 23:

“Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacobs Esq, QC, in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC 511 at 517 in the following terms:

“That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Works Ltd's Trade Mark Application* (1954) lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.”

I therefore conclude that the mark EVERY IDEA SAFELY DELIVERED is devoid of any distinctive character and consists exclusively of a sign which may serve in trade to designate the intended purpose or other characteristic of the goods and services and is thus excluded from registration under Sections 3(1)(b) and (c) of the Act.

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 Sections 3(1)(b) and (c) of the Act.

Dated this 15 day of October 1999

A J PIKE

For the Registrar
The Comptroller General