

TRADE MARK ACTS 1994

IN THE MATTER OF APPLICATION NO: 2177650 BY WINTERTHUR DIRECT UK LIMITED TO REGISTER A TRADE MARK IN CLASS 36

DECISION AND GROUNDS OF DECISION

On the 19th of September 1998, Winterthur Direct UK Limited of Winterthur Way, Basingstoke, Hampshire, RG21 6SZ, applied under the Trade Marks Act 1994 for registration of the trade mark **PROMISE** in Class 36 in respect of:

"Mortgage services; brokerage services; insurance services; underwriting services; financial analysis; pensions; pension services; personal financial services; investment consultancy; financial consultancy; investment services; financing of loans; arranging unsecured loans; financial management; trustee services; financial valuation services; assurance services; estate agencies; estate management; real estate services; estate agency services; individual savings accounts."

Objection was taken to the mark under paragraph (b) of Section 3 (1) of the Act, on the grounds that it consists of a sign which is devoid of any distinctive character, for example, of services which promise to deliver good results. Objection was also taken to the mark under Section 5 (2) of the Act, on the grounds of the likelihood of confusion with earlier marks.

At the Hearing at which the applicants were represented by Mr B A Ramage of Alexander Ramage Associates their agents, the Section 5 (2) objections were waived and I will make no further reference to them in this decision. However, the Section 3 (1) (b) objection was maintained and 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 Marks Rules 1994 to provide a statement of the reasons for my decision. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

Section 3 (1) objection

The relevant part of Section 3 (1) of the Act reads as follows:

"The following shall not be registered -

(b) trade marks which are devoid of any distinctive character."

The mark consists of the common dictionary word "Promise". The word is so well known as to require no further explanation. However, for the sake of completeness, Collins English Dictionary (third edition 1994) defines the word as follows:

PROMISE:

1. to give an assurance of (something to someone); undertake (to do something) in the future.
2. to undertake to give (something to someone).
3. to cause one to expect that in the future one is likely (to be or do something).

5. to assure (someone) of the authenticity or inevitability of something (often in the parenthetic phrase {I promise you}, used to emphasize a statement.
6. an undertaking or assurance given by one person to another agreeing or guaranteeing to do or give something, or not to do or give something in the future.
7. indication of forthcoming excellence or goodness.
8. the thing of which an assurance is given.

At the Hearing Mr Ramage argued that the word PROMISE had no direct reference to the characteristics of the services claimed and was clearly meaningless. Mr Ramage believed that the mark PROMISE was on a par with the word "Profile" which according to established Registry practice is acceptable for financial services. Mr Ramage referred also to Sections 37 and 38 of the Trade Marks Act 1994, reminding me that the Registrar's role was to accept an application if it appeared to meet the requirements of Section 3 (1) and the mark could not be proven to be descriptive.

I do not believe that PROMISE is on all fours with the "Profile" practice. The word "Promise" has a very different meaning to "Profile" and could be said to have laudatory connotations (indication of forthcoming excellence or goodness, see meaning no.7).

With regard to the objection raised under Section 3 (1) (b) of the Act, the question as to what exactly "devoid of any distinctive character" means, was commented upon by The Hon. Mr Justice Jacob as follows:

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

In my view, and when used in connection with the services (mortgage, brokerage, insurance services etc.) for which registration is sought, the meaning that the word "Promise" is likely to convey to the general public is, here we have a range of mortgage products with a promise, i.e. an undertaking or assurance given as a guarantee, or an indication of forthcoming excellence or goodness. That being the case, the mark clearly offends under Section 3 (1) (b) of the Act as it is devoid of any distinctive character. It may also be said to be open to objection under Section 3 (1) (c) of the Act as it is the type of laudatory word that others may legitimately wish to use descriptively in the normal course of trade. My view is that one must also consider the use of the mark in the context of advertising and promoting the services. The applicant filed an example of its own marketing literature which refers to a "fixed rate and no hidden surprises for 5 years - promise". This would not appear to be trade mark use of the word "promise" and illustrates the word's capacity to serve as a description.

Mr Simon Thorley QC acting in his capacity as the Appointed Person in the DAY BY DAY application No: 2068646, supported this general approach. When considering whether other traders would wish to use the words DAY BY DAY in relation to milk products, either on the goods or in an advertising context, Mr Thorley 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 milk products and both Mr James and I responded to Mr Onslow's challenge to consider a natural descriptive use of the expression Day by Day in the ordinary course of trade in relation to milk products.

Mr James suggested that it would be perfectly natural for other traders to wish to use the expression as part of the commendation of products delivered as opposed to purchased at the supermarket.

"Don't rely on a weekly shop, have it delivered fresh day by day".

I do not believe this is unnatural. Likewise I suggested use of the expression "take day by day to provide the required daily in-take of vitamins" on the packaging of a vitamin enriched milk product".

I think many of the same considerations mentioned in the DAY BY DAY case apply equally to this application. At the hearing, and in correspondence after the hearing, I gave examples of how the word PROMISE is likely to be legitimately required by others in trade in much the same way as the words DAY BY DAY. Examples of such use might be:

"Our customer promise" (as used by Lloyds TSB)

"Price promise" (as used by ASDA)

"The Thomas Cook Foreign Exchange Promise" (see Annex A - copy passed to agent in post hearing correspondence)

The possibilities are endless. Moreover, I have to consider what the likely impact would be on other businesses if the mark was registered. In the AD2000 trade mark (1997) RPC 168, Geoffrey Hobbs QC said:

"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 Jacob Esq QC in his decision on behalf of the Secretary of State in Colorcoat Trade Mark (1990) RPC 551 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) RPC 150 at 154 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".

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 paragraph (b) of Section 3 (1) of the Act.

Dated this 17 day of November 1999.

ANGELA CHEESEMAN
for the Registrar
the Comptroller

Annex A.

Your Foreign Currency

Foreign Exchange

Thomas
Cook

Thomas Cook — for all the money in the world.



- We clearly show our exchange rate and any commission charges — there are no hidden extras.
- Our receipt clearly shows details of your transaction.
- You have the right to cancel any transaction with us before leaving our premises.
- We give efficient and courteous service at all times.