

TRADE MARKS ACT 1994

In the matter of
application no: 2159905
by Visio Corporation
to register a Trade Mark in
Class 09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION TO REGISTER TRADE MARK NO 2159905 IN CLASS 09 IN THE NAME OF VISIO CORPORATION

On 4 March 1998 Visio Corporation of 520 Pike Street, Suite 1800, Seattle, Washington 98101, United States of America applied under the Trade Marks Act 1994 for registration of the trade mark VISUALISE YOUR BUSINESS in Class 09 in respect of:-

“Computer software programs for creating drawings and graphics, and instruction manuals, sold as a unit”

The application was examined under the provisions of Section 37(1) of the Trade Marks Act 1994 and the applicants informed that the requirements for registration were not met in that objections arose under Sections 3(1)(b)&(c) of the Act, because the mark consists of the words VISUALISE YOUR BUSINESS the whole being devoid of distinctive character and which may serve in trade to designate the kind and intended purpose of the goods eg a software package to help one visualise your business.

At a hearing on 23 April 1999 at which the applicants were represented by Mr Peter Groves of Davis & Co (Solicitors) Ltd, the objections under Sections 3(1)(b)&(c) were maintained. The applicants were allowed a further two months in which to file exhibits showing examples of the mark as used on the goods, or to withdraw the application. On 24 June 1999 the agents for the applicant faxed to the registrar four exhibits with a covering message from Mr Groves saying that the applicant had sent him further information by courier which he would forward as soon as possible. In a letter from the examiner dated 29 June 1999 the applicant was allowed one further month to file the additional information. However by 19 August 1999 no response had been received and the application was therefore refused under Section 37(4) of the Act.

Following refusal of the application I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of 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.

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

3(1) The following shall not be registered -

(b) trade marks which are devoid of any distinctive 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, geographic origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

The mark consists exclusively of the words VISUALISE YOUR BUSINESS. The words YOUR BUSINESS are ordinary dictionary words whose meaning, it seems to me, is self evident when used in relation to any industrial, commercial or professional operation. Collins English Dictionary (3rd Ed. 1994) defines VISUALISE, *inter alia*, thus:

vb. to form a mental image of (something incapable of being viewed or not at that moment visible).

Firstly I consider the objection under Section 3(1)(c). The goods specified in the application include “computer software programs for creating drawings and graphics”. Such goods could include programs for use in creating diagrams or charts relating to any aspect of a business, and which could be said to enable the user to visualise how their business is performing at any given time. Therefore I consider that the mark VISUALISE YOUR BUSINESS as a whole is apt for use in advertising such goods. In doing so I bear in mind the comments of Mr Simon Thorley QC, acting as the Appointed Person in the, as yet unreported, decision on the DAY BY DAY application no. 2068646:

“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”.

As noted above, I agreed at the hearing to consider examples showing how the applicant actually uses the mark in relation to the goods. The examples which the agent faxed to me are reproduced at Annex A. Also reproduced at Annex B is a sample of the mark in use which was attached to the priority claim documents. In my opinion these examples show the mark being used as a slogan in just the sort of way that others may wish to use it in their advertising.

It appears to me therefore that the mark consists exclusively of a sign which may serve in trade to designate the intended purpose of the goods, and so is debarred from registration under Section 3(1)(c) of the Act.

For the same reason I consider the mark to be devoid of distinctive character and therefore not acceptable, *prima facie*, for registration under Section 3(1)(b). In this regard I take account of the comments in the British Sugar plc and James Robertson and Sons Ltd decision [1996] RPC 281, page 306, line 1 (the TREAT case):

“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 it 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 the word inherently from the old Act but the idea is much the same) devoid of any distinctive character.

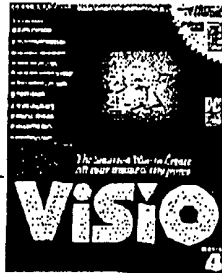
I take the view that these words apply equally to slogans which denote the intended purpose of the goods, and in the present case the public would have to be educated that the slogan VISUALISE YOUR BUSINESS is a trade mark.

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 22 day of November 1999.

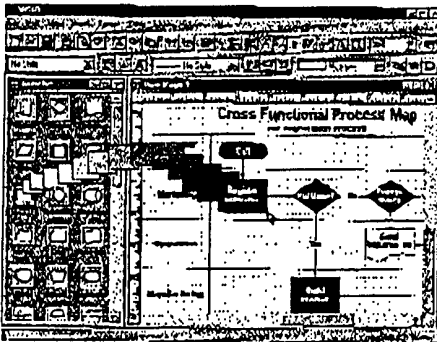
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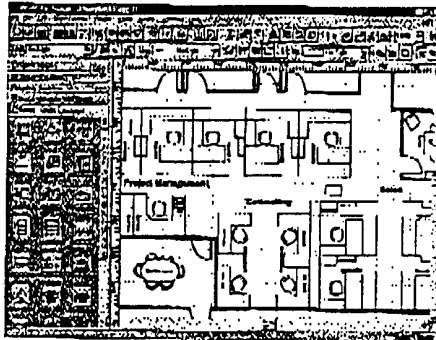
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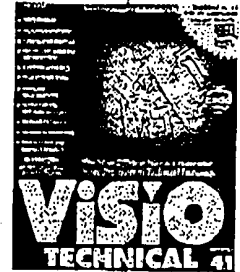


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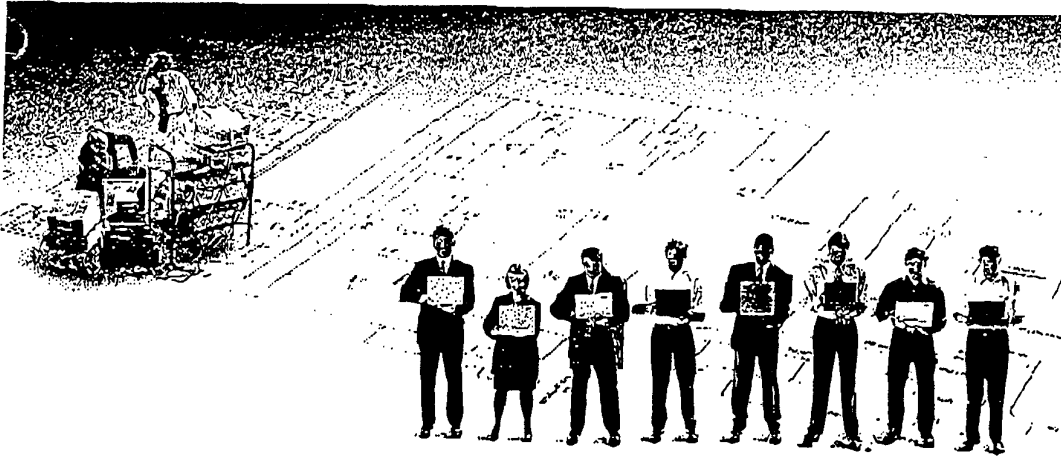
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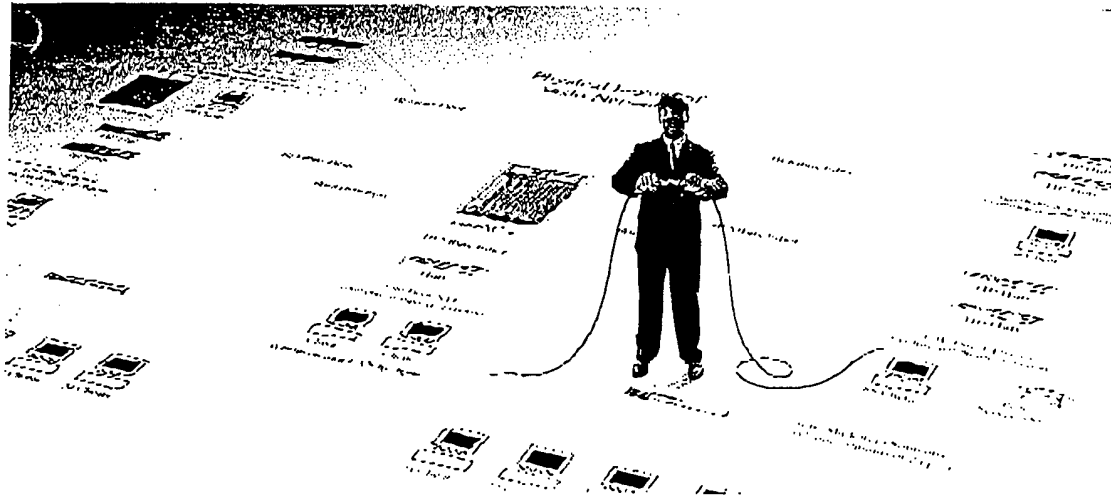
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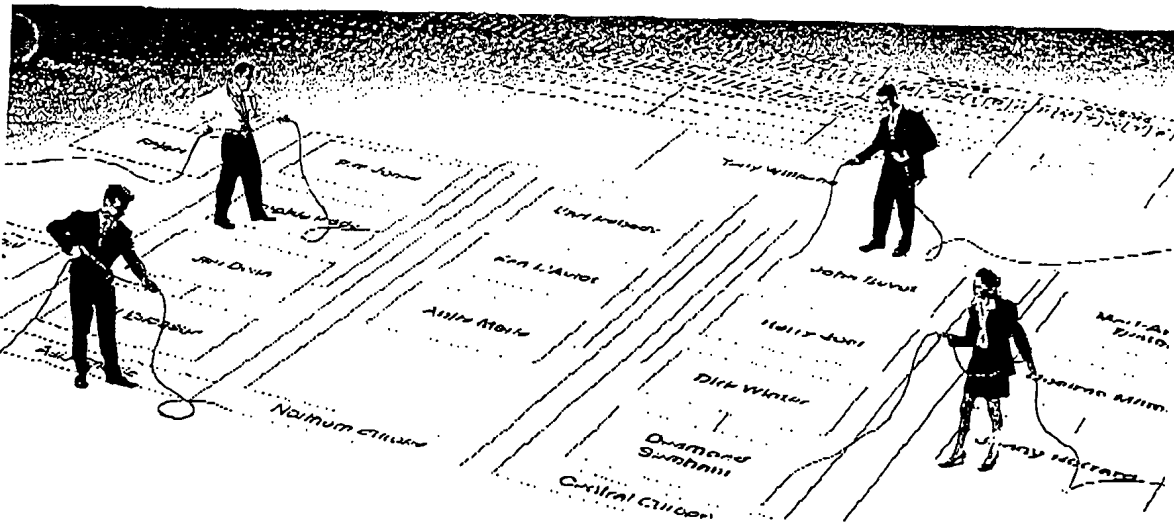
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