

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2173826 BY FORD MOTOR COMPANY TO REGISTER A TRADE MARK IN CLASS 19

DECISION AND GROUNDS OF DECISION

On 3 August 1998, Ford Motor Company of The American Road, Dearborn, Michigan 48121, United States of America applied to register the trade mark SEE THE POSSIBILITIES in respect of:

Class 19 Building materials (non-metallic), rigid pipes for building, asphalt, pitch and bitumen, non-metallic transportable buildings, monuments, not of metal, building glass, plate glass (windows) for building, window glass (except glass for vehicle windows), stained glass windows, insulating glass (building), glass granules for marking roads, alabaster glass, windows, not of metal, window glass for buildings.

Objection was taken under Sections 3(1)(b) and (c) of the Act on the grounds that the mark consists of the phrase "See The Possibilities" being devoid of any distinctive character and words others should be free to use in the context of eg "See the possibilities that arise if you use our goods".

At a hearing, at which the applicants were represented by Mr J A Caisley of Grant, Spencer, Caisley and Porteous, their trade mark agents, the objections were maintained but it was agreed that this application would be suspended to await the outcome of Application No 2140626 which was an application by the same applicant to register an identical trade mark in Classes 7, 9, 11, 12, 40 and 42. On 12 August 1999 the Registry informed Mr Caisley that Application No 2140626 had been refused and allowed a further period of one month until 12 September 1999 in which to receive details as to how the applicant wished to proceed. However, by 22 October 1999, no response was received and the application was therefore refused in accordance with Section 37(4) of the Act.

Following refusal of the application under Section 37(4) of the Act, I am now asked under Sections 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of the 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:-

"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,

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The mark consists of ordinary dictionary words which are so well known that I believe I do not need to set out any dictionary references for the individual components of 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 in its totality.

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From my own knowledge, the phrase SEE THE POSSIBILITIES is not invented and seems, to my mind, apt for use in advertising to draw attention to the many concepts or uses to which the goods can be put. The phrase seems apt to draw potential customers' attention to the possibilities available to them should they wish to obtain the goods at issue. As such, it seems to me that such an apt advertising "strap line" does not possess the necessary ability to identify goods or services from a single trade source.

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In this decision I have born in mind the comments in the, as yet unreported, decision on the DAY BY DAY appeal in which Simon Thorley QC in his role as the Appointed Person commented:

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"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"

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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:

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"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 511 at 517 in the following terms:

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"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 Work 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"."

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I therefore consider that the mark SEE THE POSSIBILITIES consists exclusively of a sign which is devoid of any distinctive character and is excluded from registration under Sections 3(1)(b) and (c) of the Act.

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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.

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Dated this 10 day of December 1999

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**A PIKE
For the Registrar
The Comptroller General**