

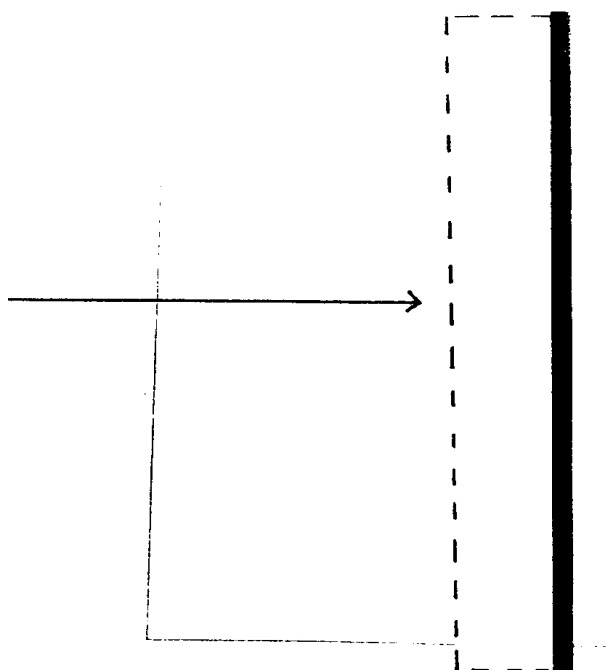
## TRADE MARKS ACT 1994

IN THE MATTER OF  
APPLICATION NO. 2103658  
BY MURGITROYD & CO LTD  
TO REGISTER A TRADE MARK  
IN CLASSES 16, 41 AND 42.

### DECISION AND GROUNDS OF DECISION

On 25 June 1996 Murgitroyd & Co Ltd of 373 Scotland Street, Glasgow, G5 8QA applied under the Trade Marks Act 1994 to register the trade mark shown below in Classes 16, 41 and 42:

The dotted outline is added to show the white portion of the mark.



It is important that I set down exactly what the mark is. The representation of the mark as filed on Form TM3 is reproduced above. The left hand portion of the mark is coloured white with the narrower right hand portion coloured red. There is no entry in Box 3 of Form TM3 and consequently the mark was examined as a two dimensional device mark.

The goods and services for which registration was sought were as follows:

- |          |  |
|----------|--|
| Class 16 | Printed matter; manuals; instructional and teaching materials; blueprints; all included in Class 16.   |
| Class 41 | Arranging and conducting at exhibitions, seminars, conferences, symposiums, publishing of texts; educational and information services; all included in Class 41. |

Class 42 Intellectual property services, patent, trade mark, design and copyright services; licensing of intellectual property; exploitation of patents, trade marks, designs and copyright; copyright management; all included in Class 42.

Objection was taken to the application under Sections 3(1)(a)(b) and(c) of the Act because the mark consists merely of a red stripe, being matter that is not considered capable of distinguishing, and which other traders may wish to use.

Evidence of use of the mark was filed on 1 April 1997 with the purpose of showing that the mark was used as a trade mark and that it had acquired a distinctive character as a result of that use. The evidence was not considered to overcome the objections and a hearing was requested by the applicant.

At the hearing, at which the applicant was represented by Mr Pattullo of Murgitroyd & Co Ltd, the objections were maintained. Consequently the applicants filed additional evidence but the objections were again 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 Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

At the hearing it was maintained that the application had been filed for a device mark. The agent requested that a clause should be entered on Form TM3 which would have had the effect of amending the mark to one consisting of a red line down the right hand edge of the goods in question and on promotional material and correspondence used in connection with the services at issue, but it was held that such an amendment would substantially affect the identity of the mark. The request was refused under the terms of Section 39(2) of the Act.

Firstly I must consider the prima facie case for acceptance.

Sections (1)(a)(b) and (c) of the Act are set out below:

3-(1) The following shall not be registered:

(a) signs which do not satisfy the requirements of Section 1(1),

(a) 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 rendering of services, or other characteristics of goods or services,

Section 1(1) of the Act reads as follows:

1-(1) In this Act “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one

undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

On reflection I do not believe that the mark is incapable of acquiring a distinctive character as a trade mark and I therefore waive the objection taken under Section 3(1)(a) of the Act. Furthermore, I do not consider that the objection under Section 3(1)(c) of the Act can be sustained and that objection is also waived. This leaves the objection under Section 3(1)(b), which is that the mark is devoid of any distinctive character.

In the TREAT trade mark case (1996 RPC 296), Jacob J remarked:-

“What does *devoid of any 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 other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent of use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act *inherently* but the idea is much the same) devoid of distinctive character. I also think “Treat” falls within section 3(1)(c) because it is a trade mark which consists exclusively of a sign or indication which may serve in trade to perform a number of the purposes there specified, particularly, to designate the kind, quality and intended purpose of the product.”

The mark consists of a device which is set out and described above. It is a rectangle consisting of two portions. The left hand portion is coloured white and is approximately eight times the width of the right hand portion which is coloured red. The specification in Class 16 is for goods which may well be white in colour and when applied to such goods the mark will appear as a red stripe. I note with interest that the applicants have made a claim to the colour red which may be seen as indicative that they see the mark as consisting primarily of the red portion of the mark.

It is my view that a vertical red stripe appearing (somewhere) on printed matter will not be taken as a trade mark without first educating the public to that perception. It follows that this application is debarred from prima facie acceptance registration by Section 3(1)(b) of the Act.

However, that is not the end of the matter since I have to consider the evidence filed which, the applicants contend, shows that the mark has acquired a distinctive character as a result of the use made of it.

The proviso to Section 3(1) is in the following terms:-

“Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

The evidence submitted prior to the hearing consists of a Statutory Declaration dated 28 March 1997 by Norman Patullo, a director of Murgitroyd & Co. Mr Patullo states at Paragraph 5 that the Trade Mark appears as a red line down the right hand margin on all stationery, printed matter, publications, business cards, invoices, advertisements, publicity materials and documentation in relation to the applicant's business. It is stated that the mark forms part of the applicant's corporate image.

Mr Patullo goes on to state that it was not considered relevant to show separate turnover figures for goods bearing the Trade Mark and the following figures refer to the applicant's total turnover and advertising expenditure in respect of the services specified in Classes 41 and 42.

DATE	TURNOVER
1995	3,925,611
1994	3,158,415
1993	2,628,785
1992	2,163,733
1991	1,912,924

DATE	ADVERTISING
1995	7,547
1994	5,167
1993	3,587

Exhibit A shows use of the mark as a red line down the right hand margin of a business card, company brochure, calendars, company handouts, map, letterhead, continuation and accounts/invoice papers.

It is my conclusion that this evidence is unsatisfactory. The evidence shows that a red line is applied to the right hand margin of the goods in question but, as I have already stated, I do not consider that this is the mark applied for. The mark applied for is a device only mark and I do not accept that use of this mark is the same as the application of a red line to the whole of the right hand side of these documents.

Leaving that aside, use of a mark does not, in itself, equate to distinctiveness.

In the TREAT trade mark case (1996 RPC 296), Jacob J remarked:-

“Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin. This is all the more so when the use has been accompanied by what is undoubtedly a distinctive and well recognised trade mark.”

I consider that this applies equally where the sign in question is something as inherently lacking in trade mark character as a red edge on e.g. a business card.

In this case the applicants do not only rely on evidence of use. They also rely upon the evidence from customers of the applicants that the mark is distinctive for the goods and services in question.

This evidence consists of 7 letters from customers of the applicants. I have set out below the relevant extracts from each of these letters together with an indication of the customer involved.

**Letter dated 15 January 1997 from Burn Stewart Distillers Plc.**

“The “red line” is very distinctive and I can think of no other correspondence which I receive which is similar to it. It certainly helps me to identify correspondence from Murgitroyd’s and sets it apart from other firm or company letterheads.”

**Letter dated 16 January 1998 from The Scottish Agricultural College.**

“I find the “red line” quite distinctive and know immediately that a letter is from yourselves. My office is extremely busy and as I am involved in IP protection letters from yourselves frequently require priority action. When I see the “red line” on correspondence I always scan the correspondence right away to ensure I am not about to miss a critical deadline.

Having dealt with Murgitroyd & Company for several years I now associate the “red line” as a brand on your stationery.”

**Letter dated 16 January 1998 from MacRoberts.**

“Our view is that it is possible to identify Murgitroyd correspondence by the red line down the left hand side of the page. Indeed when one is looking through some of our more voluminous files, it enables us very readily to ascertain which letters have come from you as they stand out from all other correspondence on the file.

I am not aware of any other party from whom the firm receive correspondence which has notepaper with a red line down the whole of the right hand side of the page.”

**Letter dated 16 January 1998 from Linn Products Limited.**

“We would like to confirm that the “red line” which appears on the right hand margin of all Murgitroyd & Company stationery is distinctive and that we are unable to identify Murgitroyd’s correspondence by sight of the “red line”.”

**Letter dated 20 January 1998 from The Rawlplug Company Limited.**

“The “red line” on your paperwork is very significant and does indicate clearly and easily that a particular document, even when amongst a pile of paperwork, has come from Murgitroyd.”

**Letter dated 05 February 1998 from Ratner & Prestia.**

“Throughout the years, our firm has had extensive correspondence with Murgitroyd & Company with respect to the filing of intellectual property rights in the United States and the United Kingdom. Therefore, the letterhead of Murgitroyd & Company with the red line is found on many desks of attorneys and staff throughout our office. Whenever I see a piece of correspondence with a red line on the right hand edge on my own desk or the desk of another, I immediately recognize that correspondence as coming from Murgitroyd & Company. I recognize this even without seeing the letterhead in full or any other identifying indicia. Within a stack of papers, I can immediately recognize those papers coming from Murgitroyd & Company. In addition, correspondence is often clipped to or otherwise attached to files in our office. Without other indicia, I can recognize that correspondence and identify the file as being a Murgitroyd matter by reference to the red line.

For sometimes I have found this red line as highly distinctive and associated only with correspondence from Murgitroyd & Company even upon a cursory view. To me, the red line identifies the correspondence as coming from Murgitroyd & Company.”

**Letter dated 27 January 1998 from Milliken Research Corporation.**

“Speaking for myself and the other lawyers in the office, the stationery having the red line along the right hand edge is recognized as originating from Murgitroyd & Company.

We do not receive correspondence from any others bearing a red line along the right hand edge. We do, however, receive correspondence from our associates in Australia bearing a blue line along the right hand edge.”

In my opinion this evidence is flawed in that, again, it nearly all refers to the red line down the right hand side of the documents, I note that the letter from MacRoberts refers to a “red line down the **left** hand side of the page.” As I have previously stated the mark applied for is not limited as to the position or extent of the red line or stripe.

It is my conclusion that the mark is devoid of any distinctive character. Furthermore there is no evidence that the mark has acquired a distinctive character as a result of the use made of it. I therefore conclude that the application is not acceptable for registration under Section 3(1)(b) of the Act.

The letters filed by the applicants in support of the application all appear to be from established customers and cannot, therefore, be regarded as necessarily representative.

The letters indicate that some customers of the applicants identify correspondence from the applicants by a red line down the right hand edge, but there is nothing to suggest that this feature distinguishes the intellectual property services of the applicants from other suppliers of the same services. There is therefore no evidence that this sign functions as a trade mark.

There is no suggestion the mark (or even a similar mark) has been used as a trade mark for goods in Class 16 or services in Class 41.

Dated this 12 day of October 1998

A J PIKE  
For the Registrar  
The Comptroller General