

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2140626  
BY FORD MOTOR COMPANY**

**TO REGISTER A TRADE MARK IN CLASSES 7, 9,11, 12, 40 & 42**

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5 **To register a trade mark in Classes 7, 9, 11, 12, 40 and 42**

### DECISION AND GROUNDS OF DECISION

10 On 31 July 1997, Ford Motor Company of The American Road, Dearborn, Michigan, United States of America applied to register the trade mark SEE THE POSSIBILITIES in respect of:

“Class 7

15 Class heading (engines and motors (not for land vehicles), turbines, bearings, pumps, valves, oil seals, filters, atomizers, driving belts, dynamo brushes, carburetors, cooling radiators for internal combustion engines, cooling fans, electric generators, cylinder heads, drive wheels, drive chains, dynamo belts, dynamos, ignition devices, ignition timers, injectors, silencers, fan belts, engine pistons, engine speed governors, compressors, taps being parts of motors, motor vehicle location devices; and parts, 20 components and accessories for motor vehicles).

Class 9

25 Class heading (sound systems and parts thereof, including radios, amplifiers, loud speakers, cassette and CD playback machines; communication apparatus and parts thereof, including telephone, radio telephones, cellular telephones, radio transceivers; battery chargers; cigarette lighter adaptors; electric batteries and accumulators, ammeters, anti-theft warning appliances, junction boxes for lighting, electric cables and wires, circuit breakers, speedometers, electric door openers, electric coils, electric 30 terminals and switches, water, fluid and fuel gauges, gradient indicators and metres; computers; microchips; controllers, thermostats, ignition systems and parts; and parts, components and accessories for motor vehicles).

Class 11

35 Class heading (air conditioning installations, air cooling devices, air heating apparatus, lamps, bulbs, reflectors, apparatus and installations for lighting, ventilation apparatus, apparatus for demisting and defrosting windows; heat exchangers, radiators, compressors). 40

Class 12

45 Motor land vehicles, parts, components and accessories thereof.

Class 40

Custom manufacture, modification, and conversion of motor vehicles, motor vehicle components; and motor vehicle parts.

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Class 42

Design engineering and consultation services in the field of motor vehicles, motor vehicle parts and motor vehicle component systems.

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Objection was taken under Section 3(1)(b) of the Act on the grounds that the mark was devoid of any distinctive character. Objection was also taken under Section 3(6) of the Act with regard to Classes 7, 9 and 11 on the grounds that the specifications were so wide that there was doubt whether the applicant is using, or intends to use the mark on all the goods applied for.

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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. A period of time was allowed for the filing of evidence of use of the mark. However, no evidence was forthcoming. 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.

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As mentioned earlier in this decision, no evidence of use has been put before me. I have therefore, only the prima facie case to consider.

25

Firstly, I turn to the objection under Section 3(6) of the Act. Section 3(6) states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

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This objection had been raised and maintained in relation to the breadth of the specifications in Classes 7, 9 and 11. In particular, objection was taken to the presence of the words “Class heading”. As a result of a subsequent discussion with the agent, it was agreed that these words can be deleted from the specification and therefore the objection under Section 3(6) has been waived.

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I now turn to the objections under Section 3(1)(b) of the Act which reads as follows:

“The following shall not be registered -

40

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

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, particularly for the goods and services at issue, to draw attention to the many concepts or uses to which the various models and accessories can be put and also in connection with the related services set out in this application. The phrase seems  
5 apt to draw potential customers' attention to the possibilities available to them should they wish to obtain the goods or services 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.

10 I also bear 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:

15 "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:

20 "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  
25 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:

30 "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"."

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

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**Dated this 15 day of April 1999**

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**R A JONES**  
**For the Registrar**  
**The Comptroller General**