

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO 2116866
BY THE REDAN COMPANY LIMITED
TO REGISTER A TRADE MARK
IN CLASS 16

DECISION AND GROUNDS OF DECISION

Background

On 27 November 1996 The Redan Company Limited of Appleton House, 139 Kings Street, London, W6 9JG applied under the Trade Marks Act 1994 for registration of the mark **FUN TO LEARN** IN RESPECT OF:

Class 16 Printed matter; books, publications, periodicals, magazines; posters, photographs; stationery, paper; articles made wholly or principally of paper; cardboard; articles made wholly or principally of cardboard.

Objection was taken to the application under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the words **FUN TO LEARN**, being a sign which may serve in trade to designate the kind and intended purpose of the goods.

Objection was also taken under Section 3(6) of the Act because the range of goods specified seemed so extensive as to call into question the statement on the form of application that the applicant had a bone fide intention to use the mark on all of them. However a recent change to office practice enables me to waive this objection and I will make no further mention of it in this decision.

Further objection was taken under Section 5(2) of the Act in respect of the following marks:

Number	marks	Class	Specification
1526821		16	Instructional and teaching material; stationery; writing materials and drawing materials; writing or drawing books, scrapbooks; writing and colouring instruments; drawing instruments; lettering stencils and template drawing aids; pens, pencils, crayons, pastels, inks, children's paintboxes, paint palettes; paint brushes, artists' materials; erasers, pencil sharpeners, pencil cases; rulers; all included in Class 16; but not including any such goods for producing a helix.

However, given the non-distinctive nature of the words FUN TO LEARN, and taking account of the fact that these words are disclaimed in their entirety in the earlier registration, I have concluded that this objection should be waived. In reaching this conclusion I have born in mind the decision by the Registrar in the Paco/Paco Life in Colour trade mark case RPC 2000 451page 467 where it was held that:

“the entry of a disclaimer should be regarded as an admission that.....the disclaimed matter is not to be regarded as in itself distinctive of the trade origin of the proprietor’s goods or services. In these circumstances, use of the disclaimed matter by another party, as a trade mark, cannot, without other similarities, be sufficient to give rise to a likelihood of confusion with the registered trade mark concerned.”

I will make no further mention of this objection in this decision.

Evidence of use of the mark was filed on 16 June 1997 with the purpose of showing that the mark had acquired a distinctive character as a result of that use. However, this evidence was not considered sufficient to overcome the objections which were maintained. Further evidence from independent members of the trade in question was filed in the period up to 6 April 1998 but, again, this was found to be insufficient to overcome the objection which were maintained. At this time the agent was sent copies of extracts from the Internet which were considered to support the objection. However, I am of the view that they add nothing to the prima facie case based upon the ordinary meaning of the words.

Hearing and decision.

On 20 May 1998 a hearing was requested. At that hearing, at which the applicants were represented by Mr Castle of Castles, their trade mark agents, the objections were maintained. On 17 February 1999 further evidence from an independent members of the trade was submitted but the objections were again maintained. The applicant was allowed further time in which to obtain and submit further evidence in support of this application. However, no further evidence was submitted and notice of refusal was issued on 29 February 2000.

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 of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

Section 3(1)(b) and (c) of the Act reads 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 rendering of services, or other characteristics of goods or services,

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.

Section 3(1): Absolute grounds for refusal of registration.

The prima facie case for registration.

Firstly I must consider the prima facie case for acceptance.

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 it's totality. I must, therefore, consider the meaning of the mark in it's totality.

The test of distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

“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?”

In my view the words FUN TO LEARN, when used on the goods covered by the specification filed with this application do no more than to indicate a characteristic of the goods. They inform prospective purchasers that the goods in question will enable knowledge to be gained or new skills acquired whilst experiencing enjoyment or amusement. The mark consists of ordinary dictionary words which are devoid of any distinctive character and, in my view, is a sign that may be used in trade to designate the kind of goods i.e. educational material which makes it fun to learn. For these reasons I do not consider the application to be acceptable, prima facie, for registration under Section 3(1)(b) or (c) of the Act.

I now go on to consider the use which has been made of the mark and whether it has in fact acquired a distinctive character as a result of the use made of it.

Acquired distinctiveness: the applicant's evidence.

The evidence of use of the mark submitted on 16 June 1997 consists of a Statutory Declaration by Mr R W Sutherland, Managing Director of The Redan Company Limited together with supporting exhibits. Mr Sutherland declares that the trade mark in question was first used in the United Kingdom in 1991 in relation to “Magazines”. Turnover and advertising figures for the period 1992 - 1996 are set out below:

TURNOVER		ADVERTISING	
Year	£	Year	No of copies sold
1992	1,674,000	1992	1,691,000
1993	2,786,000	1993	2,814,000
1994	4,170,000	1994	4,212,000
1995	5,378,000	1995	4,889,000

1996

8,265,000

1996

7,187,000

Mr Sutherland further declares that these goods are sold throughout the United Kingdom and states:

“- Such goods are available from supermarkets and newsagents situated throughout the length of the country such as *Tescos, Sainsburys, Asda, Safeway, W H Smith, John Menzies* and many smaller newsagents. In total, goods bearing the said trade mark are sold in approximately twenty thousand outlets throughout the United Kingdom.”

Exhibit RWS 1 consists of a copy of a children’s magazine dated 14 November 1996 which is numbered 35 together with eight copies of the front pages of the same magazine which are numbered 12, 14, 15, 34, 66, 109, 155 and 191. It is clear from the date of issue number 35 that magazines numbers 66, 109, 155 and 191 were all issued after the date of filing this application and therefore cannot be considered for the purposes of this decision.

Exhibit RWS 2 consists of a selection of advertisements in various publications. The first advertisement is in an undated publication, the name of which is not known. The second advertisement is in the MDP Magazine Directory for Winter/Spring 1997 and the remaining two advertisements are undated. In my view these exhibits are of limited support to this application.

Exhibit RWS 3 consists of examples of promotional literature, all of which is undated and therefore of little assistance.

As Morrith L.J. stated in *Bach Flower Remedies* 2000 RPC 513 at 530 lines 19-21 “First, use of a mark does not prove that the mark is distinctive. Increased use does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

Acquired distinctiveness: decision on the evidence.

In almost all instances the words FUN TO LEARN appear in a stylised way and always in very close proximity to the word REDAN which is enclosed within the device of a balloon. The only instance where the words FUN TO LEARN appear as applied for is in the small print at the bottom of the inside page of the magazine where it is referred to as a trademark of the applicant. This evidence is insufficient to prove that the mark has, in fact, acquired a distinctive character. In my view this evidence simply supports the objection to the trade mark that the mark is descriptive of the goods in question. The magazines submitted as evidence are clearly designed to enable children to learn by gaining knowledge or acquiring new skills whilst still having fun.

There is, of course, further evidence in the form of Statutory Declarations from independent declarants. These consist of three Statutory Declarations from managers of companies who are, or have been, distributors for the applicant. In assessing the evidence in the Statutory Declarations from the distributors I have born in mind the guidance contained in the Registry Work Manual dated August 1998 at Chapter 6, Section 7.4.6 (Page 80) the relevant section of which reads as follows:

“Where the goods or services are not specialised, the fact that trade experts (who by

definition, are likely to be much more familiar than the general public with the signs used in the trade) regard the applicants' sign as a trade mark may not be representative of the public at large. However, such evidence may still assist an application to the extent that it establishes that the applicants' mark is unique in the trade.

Evidence from any party under the control of the applicant, or in respect of whom the applicant is likely to be able to apply commercial pressure for supporting statements, such as those who manufacture, **distribute** (my emphasis) or provide the goods or services on the applicant's behalf (other than independent retailers), or with a vested interest in securing registration (such as licensees), should be given little weight."

This guidance echoes a point made by Lloyd J in *Dualit toasters* 1999 RPC 890 at para 33 on pages 898 and 899.

Furthermore, it is clear that these three Statutory Declarations are virtually identical in their presentation and wording. There is no evidence as to how these declarants were selected nor is there any indication that other distributors would not provide substantially different statements. Taking all of these factors into account I am of the view that the declarants cannot speak for how the customers may perceive the mark applied for.

The final Statutory Declaration is from Mr I Locks who is the Chief Executive of the Periodical Publishers Association who declares that he recognises the trade mark applied for as the trade mark of the applicant when used in relation to children's magazines. I accept that that is his view and it may represent the views of a proportion of the trade. Again, it does not mean that the purchasing public see the sign in question in the same way.

In my view the evidence filed has not established that the mark FUN TO LEARN has acquired a distinctive character as a trade mark in its own right. The sign is almost always used in a slightly stylised version and in close proximity to the mark REDAN together with the device of a balloon. Many of the exhibits are undated or are dated after the relevant date. I have, however, taken full account of all of the evidence submitted and of the information contained in the Internet references which were copied to the applicants' trade marks agents on 27 April 1998. In my view this evidence does not prove that the mark applied for has acquired a distinctive character as a result of the use made of it and I conclude that the applicant has failed to satisfy the proviso of section 3(1) of the Act.

I am fortified in this conclusion by the following extract from the judgement of the Hon Mr Justice Jacob in the "TREAT" case (1996 RPC 281, at page 299) where he said:

"I turn to consider how the word "Treat" is used here. I have no evidence from the public in relation to this question. I have some evidence of internal thinking at Robertson's, but the most important thing of all must be my own impression from the label and all the surrounding circumstances. Looking at the label I think the average customer would not see "Treat" used as a trade mark. It is true that it is written as part of a phrase "Toffee Treat" but this is done in a context where the maker's name is plain. It is of course the case that you can have two trade marks used together ("Ford Prefect"), but whether the secondary word is used as a trade mark is a question of fact. If it is a fancy word, then obviously it is a trade mark because it could not be taken as anything else. But where it is highly descriptive I see no reason why a member of the

public should take the badge of origin. And that is particularly so where the product is a new sort of product, as here. The public are apt to take the name of a novel product as a description rather than a trade mark, particularly where the name is not fancy but is descriptive or laudatory. I do not think Robertson's use is as a trade mark."

Conclusions.

The mark is not acceptable prima facie because it is debarred from registration under Sections 3(1)(b) and (c) of the Act.

The evidence filed to substantiate the claim that the mark has acquired a distinctive character is not sufficient to satisfy the proviso to Sections 3(1)(b)(c) and (d) 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 above it is refused under Section 37(4) of the Act.

Dated this 3 Day of August 2000.

A J PIKE
For the Registrar
The Comptroller General