

O/294/13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2587665

**BY ANNE FRANK-FONDS TO REGISTER THE FOLLOWING MARK IN CLASSES 9, 16,
39 AND 41:**

THE DIARY OF ANNE FRANK

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Background

1. On 20 July 2011, Anne Frank-Fonds ('the applicant') applied to register trade mark application number 2587665 consisting of the words 'THE DIARY OF ANNE FRANK' for the following goods and services in classes 9, 16, 39 and 41:

Class 9: Recorded optical, magnetic or electronic data media containing sounds and/or images, particularly compact disks; DVDs; sound recording disks; video cassettes; magnetic audio tapes; exposed films, exposed cinematographic films, electronic publications.

Class 16: Printed matter; periodicals; magazines; newspapers and books.

Class 39: Arranging of guided tours for cultural or educational purposes.

Class 41: Theatre productions; showing of films.

2. On 29 July 2011, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection under sections 3(1)(b) and (c) of the UK Trade Marks Act 1994 was raised. The objection was worded as follows: "*The application is not acceptable in classes 9, 16 and 41 as there is an objection under section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of 'The Diary of Anne Frank', being a sign which may serve in trade to designate the subject matter of the goods & services e.g. DVDs, films and text books about 'The Diary of Anne Frank'.*" A period of two months was granted for the agent to respond.

3. As the applicant had originally included the terms 'arranging of guided tours for cultural and educational purposes' in class 41, the examiner informed Kilburn & Strode ('the agent') that these services are proper to class 39. On 22 September 2011, the agent responded by submitting a form TM3a to add class 39 to the application, and at the same time requested a three-month extension of time in which to file evidence of acquired distinctiveness. This request was granted, and confirmed in writing on 3 October 2011. Two further extensions of time were granted (totalling six months in all), and the agent was informed that the second of these two extensions should be considered final.

4. On 5 July 2011, the agent submitted evidence with a view to overcoming the objection raised under Section 3(1) by proving distinctiveness acquired through use. The examiner concluded that the evidence was insufficient to overcome the objection, and responded to the agent on 10 August 2012 maintaining the objection. As the agent had requested an *ex parte* hearing in the event of the objection being maintained, a hearing took place by video conference link on 25 October 2012. The agent did not discuss the mark's inherent capacity to denote trade origin. As I did not consider that the mark had become distinctive because of

the use made of it, I maintained the objection at the hearing. A formal notice of refusal was issued on 30 January 2013, and on 12 February 2013 the agent submitted a form TM5 requesting a statement of reasons for the Registrar's decision.

5. I am now asked under section 76 of the Trade Marks Act 1994, and rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it.

6. My assessment of the evidence is shown in later paragraphs of this decision. However, it is important that I first set out the Registrar's position in respect of the *prima facie* case.

The *prima facie* case for registration under Section 3

7. Section 3(1) of the Act reads as follows:

3.-(1) The following shall not be registered –

(a) ...

(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, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ...

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 above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988 (subsequently codified as Directive 2008/95/EC of 22 October 2008) ('the Directive'). The proviso to section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities – general considerations

8. The Court of Justice of the European Union ('CJEU') has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 (subsequently codified as Council Regulation (EC) No 207/2009 of 26 February 2009) on the Community Trade Mark (the Regulation), in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P, paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).

9. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. For example, in the case of

the registration of colours *per se* not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark" (*Satelliten Fernsehen GmbH v OHIM C329/02 (SAT. 1)*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment).

Section 3(1) (c)

10. There are a number of CJEU judgments which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, whose provisions correspond to section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P (Doublemint)*, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*, paragraph 31);
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word 'exclusively' in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 (Postkantoor)*, paragraph 57);
- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

11. In *Matratzen Concord AG v Hukla Germany SA, C-421/04*, the CJEU stated that:

"...to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in

trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied...”.

I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM*, T-67/07 where it was stated that:

“...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”.

12. I must also be aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)*, [2002], ECT II-5179, stated:

“...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.”

13. It is clear from the aforementioned case law that I must determine whether, assuming notional and fair use, the mark applied for will be viewed by the average consumer as a means of directly designating essential characteristics - where, in this case, ‘essential characteristics’ means the *subject matter* of the goods and services. In relation to identifying the relevant consumer, it is reasonable to assume that the goods and services claimed will be purchased by the general public. ‘The Diary of Anne Frank’ is a book of the writings from the Dutch language diary kept by Anne Frank while she spent two years in hiding with her family during the Nazi occupation of the Netherlands. I believe it is safe to say that this is an extremely well known piece of literature, and I consider it unlikely that many members of the general public would not have heard of it. The work was originally entitled ‘The Diary of a Young Girl’ and its popularity inspired the 1955 play ‘The Diary of Anne Frank’ which was subsequently adapted for a film in 1959. The work has been published in more than 70 languages. I consider the following extract from The Daily Telegraph newspaper dated 31 December 2008 confirms my view that the work is well known to the general public:

“The Diary of Anne Frank, first published in 1947, has become the best-selling book in the world after the Bible. It is perhaps the most celebrated book of the 20th century. Written with wit and insight, the diary presents the best-known life story of all the six million people who lost their lives during the Holocaust...”

14. ‘The Diary of Anne Frank’ was placed at number 26 in UK book retailer Waterstone’s list of Books of the Century, published in 1997. The work is also referred to as ‘The Diary of a Young Girl’ and under this title appeared in The Guardian newspaper’s ‘The 100 Greatest Non-Fiction Books’ list published in June 2011. It also appeared at number 76 in online retailer Amazon’s bestseller list in the category ‘Society, Politics and Philosophy’.

15. I have to consider whether the sign put forward for registration is so descriptive in relation to the goods and services for which registration is sought that it would *not* be perceived by consumers as anything more than the subject matter of the goods and services. Given the book's fame, I consider the average consumer will only see the sign 'The Diary of Anne Frank' as indicating the subject matter of the goods and the services, and consider it highly unlikely that the consumer would give it any significance as an indicator of trade origin. At the *ex parte* hearing, the agent stated that the diary is a critically acclaimed work, and submitted that consumers would be upset if they were to pick up the books and find out that they were not about Anne Frank. I fully agree with this point, but consider that it only adds weight to my belief that the average consumer would identify the phrase 'The Diary of Anne Frank' as being the *subject matter* of the goods and services, not as an indicator of their commercial origin.

16. Although, in some cases, personal names can be assumed to function as *prima facie* indicators of trade origin ('Laura Ashley', 'Harry Ramsden' and 'Dorothy Perkins', for instance), this may not be the case where the personal name or title is well known to the extent that, at first instance, it only serves to signify the subject matter of the goods or services. The *Elvis* case before the Court of Appeal (1999 RPC 567) serves as a useful example of this type of mark. Having upheld Laddie J's decision, Walker LJ explained the reasoning which led to refusal of the marks when he said the following at page 585, lines 17-26):

"In my judgement the judge was right to conclude that the ELVIS mark has very little inherent distinctiveness. That conclusion was reached by a number of intermediate steps, one of which was the judge's finding that members of the public purchase Elvis Presley merchandise not because it comes from a particular source, but because it carries the name or image of Elvis Presley. Indeed the judge came close to finding (although he did not in terms find) that for the sort of goods advertised by Elvisly Yours (or by Enterprises in the United States), the commemoration of Elvis Presley is the product, and the article on which the name or image appears (whether a poster, a pennant, a mug or a piece of soap) is little more than a vehicle."

17. In presenting this reference to the *Elvis* decision, I acknowledge the fact that the mark under consideration is not a 'famous name' *per se*. Rather, it is the title of a famous work of literature. Nevertheless, I think the logic that was applied to the consideration of a musician/celebrity who enjoyed an almost unprecedented amount of international fame and reputation is equally relevant to the consideration of an equally famous book title. Similar conclusions were reached by Arnold J in his decision on *Linkin Park* [O-035-05] where, in respect of a mark consisting of the name of a famous US rock band, he stated:

"First, if one imagines a consumer who wants a poster depicting 'Linkin Park' asking a shop assistant whether that shop stocks such things, he would be very likely to say "Do you have any 'Linkin Park' posters?". I accept that he might use the alternative formulation, but in my judgment this is less likely. In the question "Do you have any 'Linkin Park' posters?" the mark is clearly being used to describe a characteristic of the goods being sought, namely their subject matter. Secondly, even in the alternative formulation, "Do you have any posters of Linkin Park?" the mark is still being used descriptively."

18. In respect of famous works of literature (whether dealing with fictional or non-fictional characters), the Court of Appeal's decision in respect of *TARZAN* [1970 RPC 450] is also relevant:

"In the present case, there is nothing at all in the word 'Tarzan' which would suggest to the public or to the trade that a film or magnetic tape recording had anything to do with the applicant or with anyone else. The word 'Tarzan' when used in connection with a film suggests - and suggests only - that the film has something to do with the well-known fictional person, Tarzan, a man of great strength and agility."

19. Applying this reasoning to the current application, consumers wishing to read 'The Diary of Anne Frank' are likely to walk into a bookshop and ask "Do you have the Diary of Anne Frank?", or, if they wished to see a stage version of the work, they would approach the ticket office and ask "Do you have any tickets for the show The Diary of Anne Frank?". If purchasing on line, it is probable that they would look for the title of the work, rather than look for the name of the publisher. The same would apply where that consumer sees the phrase printed onto a publication or ticket. In such circumstances, the Registrar considers such use to be in reference to subject matter, rather than commercial origin.

20. Having come to the conclusion that the mark does indicate the subject matter of the goods and services, I have to also consider whether or not the concept of 'subject matter' can - in principle - be deemed to be a 'characteristic' of goods and services as referred to in section 3(1)(c) of the Act. That provision precludes from registration those signs 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' (my emphasis). I do consider the phrase 'other characteristics' to encompass subject matter, as was confirmed by Arnold J in the aforementioned *Linkin Park* decision:

"...a considerable diversity of characteristics is embraced by section 3(1)(c). In my judgment, the purpose of the words 'other characteristics' is to make it clear that section 3(1)(c) extends beyond the specific types of characteristics mentioned. I see no reason why subject matter should not qualify."

21. Taking into account all of the above, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate a characteristic of the goods i.e. subject matter, and is therefore excluded from registration by section 3(1)(c) of the Act.

22. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since the objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character

Section 3(1)(b)

23. I approach this ground of objection on the basis of the following principles derived from the CJEU cases referred to below:

- An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) (see *Linde AG (and others) v Deutsches Patent-und-Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

24. Furthermore in relation to section 3(1)(b), it was held in *Postkantoor* that:

"In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive" (paragraph 8).

25. I do not consider that a mark should necessarily escape objection where it is considered too imprecise a term to indicate a direct and specific relationship with the goods or services at issue without further thought, but is, in some sense, more generally non-distinctive. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, O-363-09, conveniently summarised the leading case law in respect of this part of the Act:

"It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: Procter & Gamble Ltds Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be

devoid of any distinctive character under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]”.

26. For reasons already given, the Registrar considers the sign to be descriptive of specific characteristics of the goods. It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). As I have found that the mark in question *is* open to objection under section 3(1)(c) of the Act, it follows that it is also open to objection under section 3(1)(b).

Claim to distinctiveness acquired through use - Witness statement of Yves Kugelmann

27. A witness statement and exhibits relating to both application numbers 25667665 ‘The Diary of Anne Frank’ and 2587662 ‘The Diary of a Young Girl’ was submitted by Yves Kugelmann, a member of the Board of Anne-Frank-Fronds (AFF) on 5 July 2011. AFF is a charitable foundation which, amongst various roles and responsibilities, administers the copyright for Anne Frank’s literary work (see Exhibit AFF2). This witness statement gives background information relating to Anne Frank and her diary: it confirms that the book was first published in 1947 entitled ‘Her Achterhuis’; that it was translated into English in 1952 and published as ‘The Diary of a Young Girl’; and that the signs ‘The Diary of a Young Girl’ and ‘The Diary of Anne Frank’ have been specifically used as titles to indicate the works of Anne Frank, the two books having largely the same context, having been derived from the same writings. In 2009, the book was added to a list of items of documentary heritage of exceptional value on UNESCO’s ‘Memory of World’ Register (see Exhibit AFF1).

28. As far as sales are concerned, paragraph 12 of the Witness Statement contains a table which presents the UK national sales figures for the two book titles between 2004 and 2010. Total sales during that period are 659,751 for ‘The Diary of a Young Girl’, and 167,032 for ‘The Diary of Anne Frank’

29. In terms of publicity for the two book titles, one of the book covers submitted as part of Exhibits AFF5 and AFF6 makes reference to a BBC television series called ‘The Diary of Ann Frank’ which was aired in 2008, whilst Exhibit AFF7 shows extracts from that series taken from the BBC archives. The BBC has stated that the rights to ‘The Diary of Anne Frank’ rarely become available and that both the corporation and Darlow Smithson Productions worked closely with the applicant to ensure complete authenticity for the drama. The series is still currently available for sale on DVD, with the title ‘The Diary of Anne Frank’ clearly prominent on the cover.

30. Exhibit AFF11 contains extracts from online articles concerning celebrated books from the 20th Century. An article from www.guardian.co.uk of 2nd June 2007 (i.e. the Guardian newspaper’s website) includes ‘The Diary of a Young Girl’ by Anne Frank as being one of the 10 books which the public felt best defined the 20th Century. An article by ‘GoodReads’, meanwhile, listed ‘The Diary of a Young Girl’ at number 7 in the list of best books of the 20th Century.

Claim to distinctiveness acquired through use - Summary of Exhibits

31. The Exhibits summated with Ms Kugelmann's Witness Statement were as follows:

- AFF1 A copy of the UNESCO press release dated 31 July 2009.
- AFF2 An extract from the AFF website highlighting the responsibilities of the foundation.
- AFF5 Copies of a selection of book covers.
- AFF6 Copies of a selection of book covers.
- AFF7 Extracts from the BBC archives concerning the television show.
- AFF11 Extracts from online articles concerning celebrated books from the 20th century.

32. Confidentiality was requested for exhibits AFF3, AFF4, AFF8, AFF9 and AFF10 and therefore I have not included details of these exhibits in this statement. I confirm, however, that the information included in these exhibits, if taken into account, would *not* have affected my decision regarding the matter of acquired distinctiveness.

The case for registration based on acquired distinctiveness

33. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods for which registration is sought. In doing so, this question must be asked through the eyes of the average consumer who is reasonably well informed, observant, and circumspect (*Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV*, C-342/97[1999] ECR I-3830 para.26). In this case, at paragraph 13, we have identified the average consumer as being the general public.

34. The key authority for acquired distinctiveness is *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Wlater Huber*, C109/97 (*Windsurfing*); the relevant test being set out in paragraph 55:

"...the first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:

- A trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*
- In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*

- *If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;*
- *Where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”*

35. I am also mindful of the CJEU’s decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau (Europolis C-108/05)* where it was held that a trade mark may be registered on the basis of acquired distinctiveness “...*only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state*”.

36. Taking into account all the information in the Witness Statement and Exhibits, I do not consider that, at the time of application, the evidence shows that the mark has become distinctive because of the use made of it. In particular, in the context of the guidance set out in case law, I am not convinced that a significant proportion of the relevant class of persons identify the goods and services as originating from the applicant.

37. The evidence of use, detailed in paragraphs 27-31 above, has confirmed that both ‘The Diary of Anne Frank’ and ‘The Diary of a Young Girl’ are well known works of literature. However, the evidence has *not* shown that the average consumer would see the title of the work as indicating the *trade origin* of the goods and services. The evidence makes it clear that the books have been published and marketed by a number of different publishers such as Penguin, Puffin and Anchor Books. It is the names of these publishers which, in the Registrar’s opinion, are far more likely to denote the books’ trade source. There is little in the evidence to demonstrate that, when used on books, television dramatisations, and/or theatre productions, the sign ‘The Diary of Anne Frank’ would be seen as anything other than a descriptive reference to content.

38. The Registrar does, of course, acknowledge that an extremely large number of books have been sold under this title. However, in considering the extent these sales should affect my assessment of alleged acquired distinctiveness, I have borne in mind the comments made in *British Sugar PLC and James Robertson and Sons Ltd* (1996, RPC 281) (i.e. the *Treat* decision, page 302, line 22):

“I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product not a trade mark. Examples from old well known cases of this sort of thing

abound. The Shredded Wheat saga is a good example. Lord Russell said: "A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else".

Conclusion

39. In the case of 'The Diary of Anne Frank', the evidence clearly shows that the mark has been used by a number of different publishers to indicate the title of the work. This is not use in a trade mark sense, but instead use which indicates to a potential reader the subject matter of the book. The title is not being used to distinguish the goods of one publisher from those of another. As a result, taking into account the guidance set out in relevant case law and the documents and exhibits filed, I consider the evidence has failed to show that, at the date of application, the average consumer had been educated into seeing the sign as indicating the trade origin of the good and services. The mark is therefore excluded from acceptance because it fail to qualify under section 3(1)(b) and (c) of the Act.

Dated this 24 day of July 2013

**Linda Smith
For the Registrar
The Comptroller-General**