

TRADE MARKS ACT 1938 (AS AMENDED)

**In the matter of application No 1589463
by Ocean Software Limited
to register a Trade Mark in Class 9**

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**IN THE MATTER OF APPLICATION TO REGISTER
TRADE MARK NO 1589463 IN CLASS 9 IN THE NAME
OF OCEAN SOFTWARE LIMITED**

On 28 October 1994, Ocean Software Limited of 2 Castle Street, Castlefield, Manchester, applied under the Trade Marks Act 1938 to register the trade mark HUNCHBACK OF NOTRE DAME in Class 9 in respect of:-

Computer programs and carriers therefor; computer game programs, video game programs, interactive computer/video game programs on computer disks, CD-rom or other data carrying media.

Objection was taken under Sections 9(1)(c)(d)&(e) of the Act on the grounds that the mark is descriptive of and non-distinctive for computer programs relating to the character/book "The Hunchback of Notre Dame". Objection was also taken under Section 10 of the Act on the grounds that the mark is not capable of distinguishing the applicants' goods from other similar goods.

At a hearing at which the applicants were represented by Mr Alan Boss, of Maguire Boss, their trade mark agents, the objections under Section 9(1)(c)(d)&(e) and Section 10 were maintained. Following refusal of the application I am now asked under Section 17(1) of the Act and Rule 35 of the Trade Marks and Service Marks Rules 1986 to state in writing the grounds of my 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.

Section 9 of the Act read as follows:

9(1) In order for a trade mark (other than a certification trade mark) to be registerable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or surname;

- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registerable under the provisions of this paragraph except upon evidence of its distinctiveness.

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The mark consists of the words “HUNCHBACK OF NOTRE DAME”. It is not an invented word or words, nor a signature so does not qualify under sub-sections (b) or (c). It is the name of an individual, albeit fictitious, and has been handwritten on the form of application in ordinary block capitals, and I take the view are not represented in a “special” or “particular” manner to qualify under sub-section (a). No evidence has been placed before me and it therefore follows that if the mark qualifies for registration, it must be under Section 9(1)(d).

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The Registrar's current practice in relation to the names of well known fictional characters can be found in Chapter 6, paragraph 4.6, and reads as follows:-

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“4.6 Names of well known fictional stories/characters

The names of fictional characters/stories may be accepted prima facie for any goods/services provided that they are likely to be taken as a sign indicating the goods/services of one trader. See the Tarzan case 1970 RPC 450 for useful guidance.

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If the name in question is both long established and well known it may have passed into the language. In that case its primary signification is likely to be as the name of the story/character concerned. In these circumstances the name should be regarded as a sign which may serve in trade to designate a characteristic of goods/services featuring the story/character concerned and objection should be raised under Sections 3(1)(b) & (c) of the Act.

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If it appears that other traders had become accustomed to using the name in trade without the applicant's consent (eg in relation to printed matter or films) prior to the date of application, the examiner should also raise an objection under Section 3(1)(d) of the Act on the ground that the mark has become customary in the bona fide and established language of the trade.

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For example, SHERLOCK HOLMES is a name that has been used by many traders over the years in order to describe a story and a character who appears therein. No-one these days would expect all material bearing this name to originate from Conan Doyle or his estate. In these circumstances the name of the character is devoid of any distinctive character and descriptive of books, films etc featuring that character. In other cases, such as SPIDERMAN, where the name appears to have been used by one party as a trade mark for magazines, the name may be capable of identifying the goods of one trader notwithstanding that it is also the name of a well known fictional character. The question of who coined the name is not decisive if it has subsequently come to be seen purely as the name of a character/story. Similarly, the question of whether the applicant has copyright or some other exclusive right to publish the printed material commonly associated with the title/character concerned is not of itself decisive. The question is whether the sign is likely to be taken as a badge of origin.

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5 *In some cases it may be difficult to determine the position in trade without evidence. The applicant may be asked to provide evidence under Rule 51 to illustrate his own use or proposed use of the name as a trade mark in order to assist the Registrar in deciding whether the name is either inherently capable or has become capable of identifying goods/services from a single source.*

10 *Where it appears that the fictional name applied for is unable to distinguish the goods/services of one trader the application is likely to face objections under Section 3(1)(b) & (c) of the Act. Depending upon the nature of the mark in question, this objection may be taken in respect of printed matter; posters; photographs; figurines; films; videos; TV programs; organisation of plays and shows; toys, badges and fancy dress costumes (this is not an exhaustive list).*

15 *Further, the use of well known and long established (particularly childrens) fictional characters, such as CINDERELLA, on goods such as personal cleaning products (soap, bubble bath), clothing, mugs, tooth brushes, jewellery, etc, may be seen as purely for the purpose of attracting potential customers, rather than trade mark use. Accordingly, marks such as CINDERELLA are open to objection under Section 3(1)(b)& (c) of the Act in respect of these goods also.*

20 *In deciding whether a fictional character is 'well known and long established' to the extent that it has entered the language, care should be taken to avoid taking into account the applicant's own efforts to promote the name after the date of application. On the other hand, if the name in question had entered the language prior to the date of application, subsequent concerted promotional activity by the applicant should not benefit the applicant even if it has brought about a temporary high level of association with the applicant."*

30 The practice is largely founded on the TARZAN trade mark case and although relates to sections under the 1994 Trade Marks Act, the considerations in relation to the distinctiveness or otherwise of such marks are equally applicable under the 1938 Trade Marks Act. In the TARZAN case, Salmon L.J. considered the question of whether the mark was inherently adapted to distinguish the goods connected with the applicant in the course of trade, and on page 456, line 19 he said:-

35 "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 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."

40 And at line 43:-

45 "Just as in those two authorities, the words in question, Yorkshire in one case and Weldmesh in the other, had nothing standing on their own feet inherently apt to distinguish the applicants' goods, so here, in my view, TARZAN has nothing standing on its own feet, upon which it would be possible to find that it is inherently apt to distinguish the applicants' films or magnetic recordings as being the applicants' or anyone else's

goods....Even if the word could be stated to be to some extent inherently adapted to “distinguish”, the court still has to have regard to the extent to which it is so inherently adapted. I do not think, however, that we get as far as that point, because I can see nothing upon which this court could hold that the word TARZAN is to any extent inherently adapted to “distinguish” any goods in connection with what it is used as the plaintiff’s or anyone else’s goods. I therefore hold that the application to register the mark under Part A in respect of films and magnetic tape recordings fails.

As far as the other application is concerned, which relates to games, toys, playthings, and gymnastic and sporting articles, the case was fought upon the basis that these goods were all of a kind closely connected with the character of “TARZAN”. It seems to me that the application stands or falls with the application made in respect of films and tape recordings.”

The character of the HUNCHBACK OF NOTRE DAME is not an invention of the applicants, but that in itself is not decisive. The character first appears in the Victor Hugo novel “Notre Dame de Paris” dating from 1831, and to the Registry’s knowledge there have been at least four cinematographic films made about or incorporating the character of the Hunchback of Notre Dame, with at least one to my knowledge having been shown on terrestrial television. In two of these films, dating from 1923 and 1939 the character was played by two well known actors who achieved recognition for their portrayals.

The Disney Corporation have also recently released an animated film under this name which has brought the character firmly into the minds of the public. While I acknowledge that this occurred after the relevant date, I would contend that the character was already well known even before this film. Being a character which first appeared in 1831 it is reasonable to say that the name HUNCHBACK OF NOTRE DAME is long established. From the literature, films and television broadcasts, I take the view that at the time of application the primary signification of HUNCHBACK OF NOTRE DAME was as the name of a story or character, and as in the case of Sherlock Holmes, had passed into the English language and the public domain.

I consider the goods for which this mark is intended to be used to be similar to those covered by the application in the TARZAN case, That being the case, I am inevitably drawn to the same conclusion that in relation to such goods the mark HUNCHBACK OF NOTRE DAME is not inherently adapted to distinguish the applicants’ goods.

This is not, however, the end of the matter as consideration must be given to whether the name HUNCHBACK OF NOTRE DAME has a direct reference to the character or quality of the goods. In the TARZAN case two applications had been filed, in class 9 and class 28. In relation to the goods in class 28, Edmund Davies L.J. was considering goods which were one step removed from books or films, as in this application. At page 459, line 4 he said:-

“But I do not find the class 28 application quite as straightforward. It relates to “games, toys, playthings, and gymnastic and sporting articles”. Some such article seven though carrying the label TARZAN, could conceivably have no connection with that well known fictional character. For example, I suppose that a chessboard could be so labelled, even though I do not seem to recall that TARZAN was ever caught out playing such a

5 sedentary a game. But Mr. Burrell accepts - and, in any case, it is well established - that
10 the onus is on the applicants to show that the word TARZAN has no direct reference to
the character or quality of the goods sought to be covered by the registration. Here again,
the affidavit of Mr Weintraub has a bearing referring as it does to “merchandise....centred
on the fictional character TARZAN”. In the light of this, I consider that the learned judge
was probably entitled to conclude, as he did, that the articles covered by the Class 28
application were “all presumably intended to portray or relate to the character TARZAN
in one way or another”. That being so, it was open to him to proceed to hold that “...the
word TARZAN has a very distinct reference to the character or quality of the goods in
classes 9 and 28 in which it is sought to be registered”.

15 This application includes “computer programs” at large, and “programs for video and computer
games” recorded on various types of recording media. The term “computer programs” would
include programs for playing games, as well as possibly even publications such as books and
magazines in electronic form. These goods are, in my view, new technology versions of the
goods included in the TARZAN applications. Adapting that case to this application, I come to
the position that if these goods portrayed or related to the character HUNCHBACK OF NOTRE
DAME, then the mark has a very distinct reference to the character or quality of the goods.

20 For the reasons given I take the view that the mark HUNCHBACK OF NOTRE DAME does not
come under the provisions of Section 9(1)(d), and consequently, is not acceptable for registration
in Part A.

25 I now turn to consider whether the mark qualifies for registration under Section 10 of the Act,
which reads:-

30 **10 (1)** In order for a trade mark to be registerable in Part B of the Register it must be
capable, in relation to the goods in respect of which it is registered or proposed to be
registered, of distinguishing the goods with which the proprietor of the trade mark is or
may be connected in the course of trade from goods in the case which no such connection
subsists, either generally or, where the trade mark is registered or proposed to be
registered subject to limitations, in relation to use within the extent of registration

35 **(2)** In determining whether a trade mark is capable of distinguishing as aforesaid the
tribunal may have regard to the extent to which

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

40 **(b)** by reason of the use of the trade mark or any other circumstances, the
trade mark is in fact capable of distinguishing as aforesaid.

In the TORQ-SET case (1959) RPC 344, Lloyd-Jacobs J said:-

45 “Part B of the Register is intended to comprise marks which in use can be demonstrated
as affording an indication of trade origin without trespassing upon the legitimate freedom
of other traders.”

In the appeal to the High Court (1969, Graham J. decided that as other traders may wish to use TARZAN on films and toys, the mark was not capable of distinguishing the goods of the applicants so as to justify registration in Part B. In the appeal to the Court of Appeal, Salmon L.J. confirmed this decision saying:-

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“I do not think there is anything about the word TARZAN which would make it inherently incapable of distinguishing the applicants' goods in any circumstances at any future time. On the other hand, there is no evidence of use or any other circumstances which makes the mark now in fact capable of distinguishing the applicants' goods. Nothing that has urged before us can, so far as I am concerned, undermine the conclusion at which the learned judge arrived on this point.”

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I can find no good reason to depart from this position and as no evidence of use has been filed or any claim to “other circumstances” put forward, I take the view that the mark is not acceptable in Part B of the Register.

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The final matter to consider is the applicants claim to a registration which gives them a prior right by which the application should be allowed to proceed. The Registrar's practice in respect of prior rights is to allow an otherwise unacceptable mark to proceed where the applicants have a mark already registered and are seeking to register the same mark in respect of goods of a very closely similar description by reason of “special circumstances”.

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The applicants rely on registration number 1564966 for the mark HUNCHBACK, which is registered in Class 9 in respect of “Computer programs and carriers therefor.” I accept that the goods covered by the specification are the same or come within the description as being “of a very closely similar description”. I do not, however, consider that the marks are the same. The term HUNCHBACK is an ordinary English word and solely relates to a physical disorder. While to some it may bring to mind the character of the HUNCHBACK OF NOTRE DAME, that does not make it the same mark, but would, I believe be an indication of the public awareness of the character and lend support to the objection. For the reasons I have given, I believe that the objections to the registration of the mark at issue are considerably stronger than any objection that could have been raised against the mark HUNCHBACK solus. Consequently, I do not consider that the application qualifies for acceptance by reason of special circumstances.

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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 17(2) of the Act because it fails to qualify under the provisions of either Section 9 or Section 10 of the Act.

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Dated this 24 day of March 1999

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MIKE FOLEY
For the Registrar
The Comptroller General