

1 THE PATENT OFFICE

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Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP

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Thursday, 30th August 2001

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Before:

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MR. S. THORLEY Q.C.
(Sitting as the Appointed Person)

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In the Matter of the Trade Marks Act 1994

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and

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In the Matter of Trade Mark Application 2116866
IN THE NAME OF ROBERT THE REDAN COMPANY

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An appeal to the Appointed Person from the decision of
MR. A.J Pike dated 3rd August 2000

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(Computer-aided Transcript of the Stenograph Notes of Marten
Walsh Cherer Ltd., Midway House, 27-29 Cursitor Street,
London, Telephone No. 020 7405 5010)

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MR. D. CAMPBELL (instructed by Messrs Castles) appeared as
Counsel on behalf of the Appellant.

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MR. A. JAMES (instructed by The Registrar) appeared on behalf
of the Respondent.

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DECISION

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(As approved by the Appointed Person)

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1 MR. THORLEY: This is an appeal to the appointed person from a
2 decision of Mr. Pike acting on behalf of the Registrar dated
3 3rd August 2000. In that decision he refused the application
4 to register the trade mark, Fun to Learn, in respect of a wide
5 range of printed matter, including magazines, included in
6 class 16.

7 The application was made on 27th November 1996 by The
8 Redan Company. Objection was taken to registration under the
9 provisions of section 3(1)(b) and (c) of the Act, because it
10 was contended that the mark consists exclusively of the words,
11 "Fun to Learn", being a sign which may serve in the trade to
12 designate the kind and intended purpose of the goods.
13 Mr. Pike upheld that objection and he also rejected a
14 submission that having regard to the evidence of use made of
15 the mark that the same would qualify for registration, having
16 regard to the proviso to section 3 of the Act. Before me it
17 was common ground that the correct objection to have regard to
18 was that under section 3(1)(c), there being no additional
19 arguments to be considered under section 3(1)(b).

20 Section 3(1)(c) provides that the following shall not be
21 registered: "Trade marks which consist exclusively of signs or
22 indications which may serve in trade to designate the kind
23 quality, quantity, intended purpose, value, geographical
24 origin, the time of production of goods or rendering of
25 services, or other characteristics of goods or services." The
26 proviso reads: "Provided that, a trade mark shall not be

1 refused registration by virtue of paragraphs (b), (c) or (d)
2 above if, before the date of application for registration, it
3 has in fact acquired a distinctive character as a result of
4 the use made of it."

5 Mr. Campbell, who appeared before me on behalf of the
6 applicant, contended, first, that the mark itself did not fall
7 foul of the provisions of section 3(1)(c). He said it had
8 sufficient capricious addition to be inherently registerable
9 pursuant to section 3(1)(a) and that any illusion to the
10 characteristics of the goods were indirect and not direct.

11 He drew my attention to the recent opinion of the
12 Advocate General in the Baby-dry case, case C-383/99, Proctor
13 & Gamble v Office for Harmonization in the Internal Market.
14 In that case the office had declined to register the mark
15 Baby-Dry. That refusal had been upheld both by the appeal
16 tribunal at OHIM and by the Court of First Instance. The
17 Advocate General expressed the view that the words,
18 "Baby-Dry", might qualify for registration without evidence
19 of use having regard to the provisions of Article 3(1)(c).

20 Mr. Campbell drew my attention particularly to paragraph
21 84, where the Advocate General stated: "However, it may be
22 doubted whether any reasonably aware person who had not yet
23 encountered the brand name 'Baby-Dry' would think
24 unhesitatingly of diapers when first confronted with it or,
25 hearing it used in connection with such goods, would regard it
26 as a designation of their intended purpose."

1 Mr. James, who appeared on behalf of the Registry, drew
2 my attention to paragraph 96 where the Advocate General in
3 reaching his conclusion stated this: If that type of
4 approach, with which I agree, had been followed in the present
5 case, consideration of the factors to which I have referred
6 above -- extreme ellipsis, unusual and opaque grammatical
7 structure, incompleteness as a description and inventiveness
8 -- might very well have led to the conclusion that Article
9 7(1)(c) of the Trade Mark Regulation does not preclude
10 registration of the brand name 'Baby-Dry' in respect of
11 babies' diapers even if, by virtue of Article 12(b), the
12 degree of protection afforded would be considerably
13 limited."

14 Mr. Campbell submitted that I should regard Fun to Learn
15 in the same light. He drew a distinction between expressions
16 such as "make learning fun" and "have fun while learning",
17 which he accepted would not qualify for registration under
18 section 3(1)(c) and the words, "Fun to Learn", which he said
19 allude to the characteristics of goods but do so indirectly.

20 Of course any opinion of the advocate general, and
21 particularly of Advocate General Jacobs, is of considerable
22 persuasive authority, but it is not binding upon me. The law
23 is clear that I must have regard to the language of section
24 3(1)(c) and ask myself whether or not, taken alone, the mark
25 applied for may serve in trade to designate the intended
26 purpose, and so on, of the goods.

1 Mr. Campbell did not criticize the test for
2 distinctiveness quoted by Mr. Pike and taken from the judgment
3 of Jacob J. in the Treat case, [1996] RPC 281, p. 306 when
4 Mr. Justice Jacob said: "What does devoid of any distinctive
5 character mean? I think the phrase requires consideration of
6 the mark on its own, assuming no use. Is it the sort of word
7 (or other sign) which cannot do the job of distinguishing
8 without first educating the public that it is a trade mark?"
9 In my judgment, that is, and remains, the correct approach,
10 although I must bear in mind that there will be cases such as
11 that considered by Advocate General Jacobs in Baby-Dry where
12 the approach is sufficiently elliptical to render the mark
13 inherently registerable.

14 Mr. Pike, in reaching a decision on this aspect of the
15 case, concluded as follows: "In my view the words FUN TO
16 LEARN, when used on the goods covered by the specification
17 filed with this application do no more than to indicate a
18 characteristic of the goods. They inform prospective
19 purchasers that the goods in question will enable knowledge to
20 be gained or new skills acquired whilst experiencing enjoyment
21 or amusement. The mark consists of ordinary dictionary words,
22 which are devoid of any distinctive character and, in my view,
23 is a sign that may be used in trade to designate the kind of
24 goods, i.e. educational material which makes it fun to learn."

25 I have reached the same conclusion. I do not believe
26 that the words, "Fun to Learn", contain any of the elliptical

1 unusual or opaque grammatical structure or incompleteness as a
2 descriptive term of the sort that influenced Advocate General
3 Jacobs in Baby-Dry. They are, in my judgment, directly
4 referable to the characteristics of the goods as being
5 educational material, which makes learning fun. It is a
6 matter of perhaps common appreciation that learning is that
7 much more digestible if it is fun and that to encourage the
8 purchase of a product on the basis that it will render
9 learning that much more enjoyable is a natural indication of
10 the character of the goods. That this is so I think can be
11 shown by reference to certain promotional material forming
12 exhibit RWS 3 to the statutory declaration of Robert Wilson
13 Sutherland, who was the managing director of The Redan Company
14 at the relevant time. It is sufficient, I think, to cite from
15 two of the documents. One is a promotional brochure, which
16 starts: "Now your child can have fun and get a head start in
17 school too. Your child can have fun while learning and
18 acquiring the basic skills needed for school." The next one
19 says: "Fun to learn -- Mr. Men. Your favourite Mr. Men
20 characters make learning fun with stories and activities."

21 Taken without any evidence of use, I have concluded
22 without any hesitation that the words "Fun to Learn" would be
23 perceived by the average consumer as indicating a
24 characteristic of the goods, namely that they will assist in
25 learning by making the learning enjoyable. In my judgment,
26 there is no difference between the expressions "Fun to Learn"

1 and "Make Learning Fun". The two carry exactly the same
2 natural meaning. I, therefore, have concluded that the
3 hearing officer was entirely correct in reaching his
4 conclusion that this mark did not qualify for registration
5 without evidence of use.

6 I turn then to the second aspect of the appeal that
7 registration would be proper having regard to the proviso. I
8 should state at the outset that Mr. Campbell made it plain
9 that were I to find in his favour on this aspect, then the
10 category of goods in respect of which registration should be
11 allowed should be limited to magazines, since it was only in
12 respect of magazines that the use was shown.

13 The major part of the evidence is contained in the
14 statutory declaration of Mr. Sutherland. It is paraphrased in
15 some detail in Mr. Pike's decision. That paraphrasing was
16 only qualified in a limited way in that Mr. Campbell sought
17 also to draw my attention to the fact that there had been
18 expenditure on promoting goods bearing the trade mark
19 amounting to approximately five per cent of the turnover.
20 Taking all these matters into account, it is plain that the
21 words "Fun to Learn" have been used on a large number of
22 publications over a number of years since 1981. By 1996 the
23 turnover in magazines bearing the words, "Fun to Learn", was
24 in excess of £8,000,000 and the circulation of the goods in
25 terms of copies sold, was in excess of 7,000,000. Plainly,
26 this is very extensive use.

1 The question, however, that I have to decide is whether
2 that use is such as to constitute sufficient evidence of use
3 as a trade mark rather than mere use. Mr. James reminded me
4 of the ECJ's judgment in the Lloyd Schuhfabrik Meyer case, and
5 in particular of paragraph 22 where the court stated: "In
6 determining the distinctive character of a mark and,
7 accordingly, in assessing whether it is highly distinctive,
8 the national court must make an overall assessment of the
9 greater or lesser capacity of the mark to identify the goods
10 or services for which it has been registered as coming from a
11 particular undertaking, and thus to distinguish those goods or
12 services from those of other undertakings." There was then a
13 reference to the well-known Windsurfing Chiemsee case.

14 The judgment continued in paragraph 23: "In making that
15 assessment, account should be taken, in particular, of the
16 inherent characteristics of the mark, including the fact that
17 it does or does not contain an element descriptive of the
18 goods or services for which it has been registered; the market
19 share held by the mark; how intensive geographically
20 widespread and long-standing use of the mark has been; the
21 amount invested by the undertaking in promoting the mark; the
22 proportion of the relevant section of the public which,
23 because of the mark, identifies the goods or services as
24 originating from a particular undertaking; and statements from
25 chambers of commerce and industry or other trade and
26 professional associations." Mr. Campbell did not dissent from

1 that as being a proper statement of the law, and indeed
2 approached this case on that basis.

3 When one turns to consider the evidence in support, it
4 is plain, as Mr. Pike points out, that in the majority of
5 cases the words, "Fun to Learn", are used in conjunction with
6 the word "Redan", the word "Redan" being itself in a stylised
7 form of a balloon, the string of which loops round the words
8 "Fun to Learn". I am directed to have regard to the average
9 consumer of these goods, which in this case I believe must be
10 the parents of children in the three to six years of age area,
11 and to ask myself the question whether as a result of the use
12 that has been shown such people will have come to regard the
13 mark, Fun to Learn, as distinctive of the goods of Redan and
14 none other.

15 Plainly, the evidence of Mr. Sutherland is evidence of
16 use, but it does not of itself assist me as to whether that
17 use is regarded as trade mark use. In order to try and assist
18 on this, the applicants filed three declarations from
19 distributors of the goods and two declarations, one from a
20 Mr. Locks and another from Mr. Perry, who were representatives
21 of trade associations. So far as the three distributors were
22 concerned, Mr. Campbell initially invited me to put little
23 weight on them and in his reply address suggested I should
24 place very little weight on them.

25 I think, even with Mr. Campbell's enthusiasm, the
26 submission of Mr. James that I should place no weight on them

1 was the correct submission. It is quite plain that these were
2 proforma declarations prepared by distributors. In those
3 circumstances remarkably little weight could be placed on
4 them, even if I were to be of the view that they represented
5 the opinions of the average consumer. I am not so convinced
6 and propose to place no weight upon them.

7 Different matters arise in relation to the declarations
8 from the trade association witnesses. Mr. Campbell placed
9 more weight upon that of Mr. Perry than that of Mr. Locks, but
10 I shall consider both of them. Mr. Perry is the managing
11 director of the Association of Newspaper and Magazine
12 Wholesalers, which is a position he has held since June 1999.
13 Prior to that he worked for 29 years for John Menzies, who
14 distributed, amongst other things, the Redan magazines. He
15 has been aware of the use of the name, Fun to Learn, in
16 respect of children's magazines since 1995. He has concluded
17 that if he were to see the name, "Fun to Learn", used in
18 respect of a children's magazine, "I would automatically
19 assume that it had been published by the Redan Company Limited
20 in view of their overwhelming reputation."

21 Mr. James criticized this evidence, whilst not
22 suggesting that I should place no weight upon it, because of
23 Mr. Perry's close association as a distributor before he
24 became a representative of the Association of Newspaper and
25 Magazine Wholesalers. I do not believe this criticism is well
26 founded. Mr. Perry is giving evidence in his capacity as the

1 managing director of the association. He is obviously drawing
2 upon his experience as a distributor. As I understand it, the
3 relevant practice direction correctly directs that caution
4 should be used when obtaining evidence from people who are
5 with the applicant in the sense that they are distributors of
6 the product. This is correct, but it does not mean to say
7 that somebody who has ceased to have such a connection and is
8 employed by a trade association cannot draw upon his
9 experience gained whilst a member of the distribution chain.

10 His other objections to Mr. Perry's evidence are, I
11 think, more well founded. Mr. Perry swore his declaration in
12 November 1999, some three years after the date of application
13 for the mark. It is apparent that he had only been aware of
14 the use of the mark for a period of some one year prior to
15 1996. He does not give any detailed information as to how I
16 could seek to extrapolate his experience on to the general
17 public so as to reach a conclusion as to the approach of the
18 general public. No doubt, because of his close involvement
19 with Redan and his knowledge of the Fun to Learn range, he has
20 come to associate those words with Redan. But that does not
21 mean that the average consumer does likewise. I am left
22 wholly in the dark from this declaration as to whether or not
23 the average consumer had come to regard in November 1996 the
24 words, "Fun to Learn", as being descriptive of the type of
25 product or as being distinctive of a product coming from
26 Redan. That is the decision I have to reach. I do not find

1 any information in Mr. Perry's declaration that assists me in
2 reaching that conclusion over and above the fact that by
3 virtue of his involvement in its distribution he had become
4 familiar with the product.

5 Mr. Locks' evidence falls into the same category. He
6 has been the chief executive of the Periodical Publishers
7 Association since 1989. He has come exclusively to associate
8 the words, "Fun to Learn" as a trade mark of the applicant
9 company. Again his declaration was made in February 1999,
10 more than two years after the relevant date. He bases his
11 conclusion on the fact that he was apparently aware of the
12 applicant's trade mark, "Fun to Learn", since 1989, some two
13 years before it was first used. Again that evidence does not
14 help me to answer the question that is before me. The proviso
15 directs that I must be satisfied that it has in fact acquired
16 a distinctive character as a result of the use made of it.
17 The evidence shows use, but it is not sufficient merely to
18 show use. That use must be sufficient to satisfy me that the
19 use is use as a trade mark.

20 Mr. Pike concluded on this aspect of the case, as
21 follows: "In my view the evidence filed has not established
22 that the mark FUN TO LEARN has acquired a distinctive
23 character as a trade mark in it's own right. The sign is
24 almost always used in a slightly stylised version and in close
25 proximity to the mark Redan together with the device of a
26 balloon. Many of the exhibits are undated or are dated after

1 the relevant account. I have, however, taken full account of
2 all of the evidence submitted and of the information contained
3 in the Internet references which were copied to the
4 applicants' trade mark agents on 27 April 1998. In my view,
5 this evidence does not prove that the mark applied for has
6 acquired a distinctive character as a result of the use made
7 of it and I conclude that the applicant has failed to satisfy
8 the proviso of section 3(1) of the Act".

9 I agree. The evidence filed whilst showing use is not
10 sufficient to satisfy me that the approach of the hearing
11 officer was wrong. It does not satisfy me that the average
12 consumer has, as a result of the use, come to recognize the
13 expression "Fun to Learn" as being an indication of origin in
14 Redan rather than being an indication of the educational value
15 of the goods in question.

16 Accordingly, this appeal will be dismissed. In
17 accordance with the usual practice, there will be no award as
18 to costs. Is there anything else?

19 MR. CAMPBELL: There is one tiny point, which makes no difference
20 at all to the decision, sir. I think once I had thought about
21 it I limited my concessions to the two phrases: "makes
22 learning fun" was one of them.

23 MR. THORLEY: Thank you. I will check that.

24 MR. CAMPBELL: It makes no difference at all.

25 MR. THORLEY: I will check when I go through my judgment and make
26 sure.

1 MR. CAMPBELL: I think also, sir, you may have referred to Mr.

2 Perry once or twice when it was Mr. Locks, but you will pick

3 that up, sir. It is trivial.

4 MR. THORLEY: If I did, I shall. Is there anything else?

5 MR. JAMES: No sir.

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