

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1469847
BY THE ALL CHILDREN'S COMPANY LIMITED
TO REGISTER A MARK IN CLASS 16**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 39857
BY AUSTRALIAN BROADCASTING CORPORATION**

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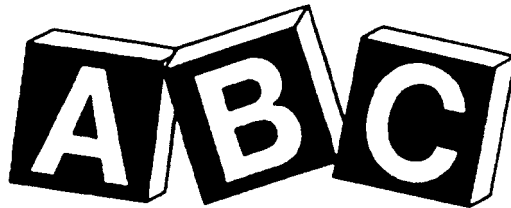
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DECISION

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On 8 July 1991 The All Children's Company Limited applied to register the following mark for "children's story books" in Class 16:-

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The application is numbered 1469847.

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On 15 June 1994 Australian Broadcasting Corporation filed notice of opposition to this application. The grounds of opposition are, in summary, as follows:-

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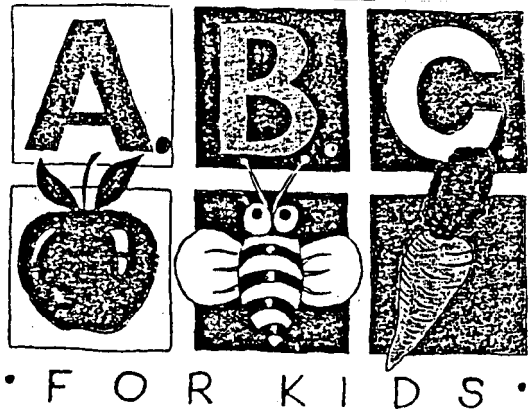
- (i) under Sections 9 and 10 of the Act in that the mark at issue is neither adapted to distinguish or capable of distinguishing within the meanings of these Sections;
- (ii) under Section 11 by reason of the opponents' reputation in the mark ABC (device and word) and generally;
- (iii) under Section 12 by reason of the opponents' registration No 1393067 (see below for details);

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(iv) under Section 17 in that the applicants cannot claim to be the proprietor of the mark at issue;

(v) under Section 68 in that the mark applied is not a trade mark within the meaning of that Section.

Details of the mark referred to above are as follows:-

No	Mark	Class	Journal	Specification
10	1393067	9	5919/ 3004	Apparatus and instruments for the recording, transmission or reproduction of sound or images; records; audio cassettes; video discs and video cassettes; parts and fittings for all the aforesaid goods; all included in Class 9.
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The opponents also ask the Registrar to refuse the application in the exercise of his discretion.

The applicants filed a counterstatement denying these grounds and saying that in view of the use which has been made of the mark for the goods at issue the mark is a good and registrable mark. Both sides seek an award of costs in their favour.

Only the opponents filed evidence in these proceedings. Neither side has requested a hearing. I, therefore, give this decision on the basis of the material before me.

By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents' evidence

The opponents filed two statutory declarations. The first, dated 29 September 1995 comes from Judith Kathryn Walker, the Head of the Legal and Copyright Department and Secretary of Australian Broadcasting Corporation, positions she has held since October 1992 and March 1994 respectively. She has been associated with the company since 1978.

Ms Walker firstly gives details of three of her company's registered marks. Two appear to be device marks and I cannot see that they have any relevance to these proceedings. Details of the third mark (No 1393067) have been given above. She says that her company has been the national broadcaster of Australia for over sixty years and is involved in a number of trading/commercial activities including merchandising a range of goods such as printed matter, audio and video cassettes, toys etc. She exhibits (3) her company's Annual Report for 1993/4 detailing the extent and success of these activities. Also exhibited (4 to 8) are:

- a schedule showing the international awards won by the company
- television ratings for ABC programmes for 1995
- product catalogues displaying the company's trade marks
- a list of ABC Centres (these are licensing outlets for the company's goods)
- information on licensing fees and the value of goods sold under the mark ABC Centre for 1992/3 and 1993/4
- a list of retail outlets using the trade mark ABC Shops. Again information is given on the value of goods sold and advertising expenditure.

I do not think I need review the above evidence in any greater detail as it bears primarily on the company's activities in Australia.

Ms Walker goes on to say that her company has made continuous use of the ABC logo trade mark in the United Kingdom since at least as early as May 1985 and the ABC FOR KIDS logo since at least as early as July 1989. Details of sales of the company's television programmes in the United Kingdom are given at Exhibit 9. Ms Walker adds that the company has sold digital editing systems to the BBC and licenses the BANANAS IN PYJAMAS logo in this country though it is not clear how this assists the current action.

Dealing with the mark at issue Ms Walker says that ABC are the first three letters of the alphabet which are understood as being the rudiments of a subject. In support of this she exhibits (11) extracts from three dictionaries. She expresses the view that, having regard to the opposed mark, ABC logo, it would be understood as meaning elementary books for assisting children in learning the alphabet and is therefore not distinctive of childrens' books.

She also says that the letters ABC are an abbreviation of both the Australian Broadcasting Corporation and its predecessor the Australian Broadcasting Commission. In support of this she exhibits (12) an extract from two Abbreviations dictionaries. As a result she suggests that the applicants cannot claim to be the true proprietors of the mark ABC and logo. She concludes by saying:

"There is now produced and shown to me marked "Exhibit 13" a number of books with the following titles of children's story books:

	Title	Publication Date
	Brian Wildsmith's ABC	1962
	Dr Seuss's ABC	1963
5	Colin McNaughton's ABC and Things	1976
	The Bean abc	1981
	Lucy & Tom's a.b.c.	1984
	The LETTERLAND ABC	1985
10	Mr. Lion's I Spy abc	1976, 1989

The number of children's books with titles including the letters ABC are very common and use of the letters ABC in relation to building blocks as a mark cannot be regarded as distinctive of the applicant's goods. Their proposed use of the mark is the normal manner of use of the letters among book titles published to assist children in learning the alphabet."

The opponents' second statutory declaration is dated 4 October 1995 and comes from Bana Nuseibeh, a solicitor and trainee Trade Mark Agent with Haseltine Lake Trade marks, the opponents' representative. The purpose of her declaration is to exhibit the following:-

- BAN 1 - a copy of a search carried out through the records of the Science Reference Library for books published with the titles consisting of or including the letters ABC
- BAN 2 - a copy of a search carried out through a database of the Trade Mark records for marks incorporating the letters ABC in respect of printed publications.

I take all this material into account in reaching my decision and refer to it in more detail where necessary.

That concludes my review of the evidence.

Although the opponents have raised a number of grounds of opposition, on the basis of the evidence filed I consider that the core of the opposition are the objections based on Sections 9 and 10 of the Act. I should, briefly, say however in relation to Sections 17 and 68 that I do not consider that the objections have been fully particularised or supported by the evidence. In particular there is insufficient information for me to come to the view that the applicants are not the proprietors of the mark. The fact that ABC is an abbreviation of the name of the opponents (or their predecessors) does not in itself prevent other traders from adopting the letters as a trade mark or an element within a trade mark. Indeed I think it is clear from Ms Nuseibeh's Exhibit BAN 2 that other traders have so adopted the letters. The opponents, therefore, fail on these grounds. In relation to the Section 11 ground also the opponents have failed to either particularise their objection or to establish that they have used their mark and gained a reputation in this country in relation to the goods at issue (as distinct from their activities in Australia). They thus fail on the Section 11 ground as well.

I go on to consider the objections based on Sections 9 and 10 of the Act which read as follows:-

5 9. - (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- 10 (a) the name of a company, individual, or firm, represented in a special or particular manner;
- 15 (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 a surname;
- 20 (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 registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

25 (2) For the purpose of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of 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 the registration.

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35 (3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- 40 (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

45 10 - (1) In order for a trade mark to be registrable 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 goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is

registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

5 (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

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

15 (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

20 The applicants' mark consists of the letters ABC arranged in a slightly irregular pattern and framed within what appear to be building blocks or at least block-like shapes. The opponents have filed dictionary definitions to indicate the significance of the letters. To the extent that any confirmation is needed on this point the Oxford Illustrated Dictionary gives, inter alia, the following meanings, "alphabet; rudiments of a subject ...". The opponents draw from this the conclusion that the mark would signify elementary books for assisting children in learning the alphabet. I accept that view. In doing so I do not forget that the specification of goods applied for is not children's books in general but children's story books. However there is ample evidence in Ms Walker's Exhibit 13 that traders commonly develop stories around the letters of the alphabet no doubt to make a pleasurable learning experience for young children. To indicate the nature and content of such books it appears to be not uncommon to incorporate the letters ABC in the titles. In the prima facie case at least I, therefore, regard the letters ABC as being non-distinctive for the goods at issue.

30 The mark is not, of course, for the letters ABC simpliciter and in coming to a view on the mark as applied for I must consider the whole content and presentation. In this respect the letters themselves, whilst in my view the overwhelmingly dominant element are, as indicated, set within block shapes. The shapes aided by the way they "lean" against one another suggest building blocks and the presentation is one that is likely to be attractive to younger children. I do not regard their use in the manner indicated (albeit that the goods are books and not blocks) as contributing sufficiently to enable the mark as a whole to qualify for registration under either Section 9 or Section 10.

40 I do not think the above is likely to be a particularly controversial view of the mark and I note from the applicants' counterstatement that in denying the Section 9 and 10 grounds it is said that "it will be shown that, in view of the use which has been made of the mark for the goods for which registration is sought, the mark is a good and registrable mark". Whilst the applicants, therefore, make no explicit concession it seems likely that they recognised the

weakness of their mark in terms of its inherent capacity to distinguish for Section 9 and 10 purposes. In the event, and despite the marker put up in the counterstatement, the applicants filed no evidence in support of their case. It follows, therefore, that the opposition succeeds under Sections 9 and 10.

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In finding against the opponents on various other grounds for want of adequate evidence I did not deal with the Section 12 ground. The latter is essentially a matter for the tribunal and does not usually require evidence. I will, therefore, deal briefly with this ground. The relevant Section reads as follows:-

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12. - (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

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(a) the same goods;

(b) the same descriptions of goods; or

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(c) services or a description of services which are associated with those goods or goods of that description.

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The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

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As the opponents' registered mark, No 1393067, is in Class 9 it is clear that the same goods are not involved but I take the view that the opponents' goods are of the same description as the applicants' books. They could, for instance, be audio versions or recordings of books. It is also clear that the letters ABC feature in both marks and the applicants' mark can thus be said to incorporate a feature of the opponents' mark. On the other hand the opponents' mark is a composite one and I note from the Trade Marks Journal advertisement at Exhibit 1 that it contains a disclaimer to the letters ABC. That, of course, is not conclusive as it has been held (see the GRANADA case 1979 RPC 303) that disclaimed elements are not to be ignored in making comparisons between marks not least because disclaimers do not go into the marketplace and do not affect the significance which a mark conveys to others when used in the course of trade. However I have in the event come to the view that the opponents, having established a compelling case against the letters ABC for Section 9 and 10 purposes, face some difficulty in then claiming that the ABC element of the mark should then found an objection under Section 12(1). In the absence of submissions at a hearing that might have led me to a different view I, therefore, hold that in the circumstances of this case the opposition fails under Section 12.

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There remains the matter of the Registrar's discretion but the applicants have advanced no reason as to why this should be exercised in their favour and I decline to do so.

As the opponents have been successful in these proceedings they are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of **£350**.

Dated this 29th day of May 1998

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M REYNOLDS
For the Registrar
the Comptroller-General