

**IN THE MATTER OF Application No 2049205
in the name of Frank Schaffer Publications Inc
to register a trade mark in Classes 9,16,41 and 42**

AND

**IN THE MATTER OF Opposition thereto
under No 46850 by Addison Wesley Longman Limited**

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10 **BACKGROUND**

On 19 December 1995, Frank Schaffer Publications Inc, applied under the Trade Marks Act 1994 for the registration of the trade mark HOMEWORK HELPERS in respect of:

15 Class 9

Electronic publications;electronic books; prerecorded media; audio, video,audiovisual and data discs, tapes, cassettes, CD-roms, and other types of electronic, magnetic, optical or electrico-optical media for transmitting and reproducing text, sound and/or images; computer software; video, computer and computer network software.”

20 Class 16

Educational books on a variety of topics, geared to the nursery, pre-kindergarten and elementary levels.

25 Class 41

30 Entertainment services, namely provision of multi player or role playing games and chat-rooms via computer network; production of programmes via television, computer or other telecommunications.

Class 42

35 Providing access to electronic publications, and other digital data via computer network for down loading purposes; providing access to a remote computer containing electronic publications, games, bulletin boards, chat-rooms, databases relating to various topics, and other information all accessible via computer; on-line electronic publication services.

On the 16 May 1997, Addison Wesley Longman Limited filed notice of opposition. The Grounds of Opposition are, in summary, as follows:

5 1) the mark applied for is not capable of distinguishing the goods or services of one undertaking from those of other undertakings and therefore does not satisfy the requirements of Section 1(1) of the Act and should be refused under Section 3(1)(a) of the Act;

10 2) the mark is devoid of any distinctive character and the application should be refused under the provisions of Section 3(1)(b) of the Act;

15 3) the mark applied for consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose or other characteristics of the goods claimed and should be refused under the provisions of Section 3(1)(c) of the Act.

The applicants deny these Grounds of Opposition. Both sides seek an award of costs.

20 The matter came to be heard on the 25 September 1998 when the applicants were represented by Mr Edenborough of Counsel, instructed by R.G.C. Jenkins & Co, and the opponents were represented by Mr Silverleaf of Her Majesty's Counsel instructed by Marks & Clerk.

25 On 15 September 1998, the opponents sought leave to amend the pleadings by adding a further ground of opposition under Section 3(6) of the Act. It had come to the opponents' attention that the record of an ex-parte hearing on 9 October 1996 on the public file indicated that the applicants' agent had argued that the words "Homework Helpers" were not words that other traders would require for use in relation to the goods and services specified in the application. The Hearing Officer apparently accepted this submission and, as a consequence, accepted the application. The opponents point out that, by the date of the hearing, the applicants had already become aware of their intended use of the term in relation to Study Guides. As a result, the
30 opponents' contend that the application was made in bad faith and/or acceptance of the application achieved by fraud.

I considered the request to amend the pleadings as a preliminary point at the hearing. I decided not to allow the amendment for the following reasons:

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1) records of ex parte hearings are not a transcript and cannot be assumed to precisely reflect the submissions made to the Hearing Officer;

2) in this case that is important because if, as the applicants contend, the term “Homework Helpers” is not a natural term to use as a description of Study Guides, the applicants could quite properly have submitted that the term was not one which other *bona fide* traders would wish to use;

3) the matter could not be finally determined without the applicants being given the opportunity of filing evidence from the Trade Mark Agent who attended the hearing;

4) the opponents’ proposed new ground of opposition was not really that the application was originally made in bad faith, than that it was subsequently prosecuted in bad faith;

5) there is doubt about whether such a ground of refusal can be sustained unless the conduct complained of results in acceptance contrary to one of the substantive grounds of refusal set out in the Act;

6) whether “Homework Helpers” is a natural and apt description of a characteristic of the goods and services at issue is already the central issue in the opposition;

7) the proposed new ground of opposition was therefore likely to result in delay but was unlikely to produce a different outcome to those grounds of opposition which already existed.

OPPONENTS’ EVIDENCE

The opponents’ evidence includes a Statutory Declaration dated 23 September 1997 by Christopher Howard Gordon Harrison, who is the Director of the department of AddisonWesley Longman Limited (hereinafter, AWL) responsible, inter alia, for the production of educational study guides. In summary, Mr Harrison says that:

1) the practice of prefacing a descriptive title with a brand name is common in the Study Guides' market;

2) the changes associated with the National Curriculum, the introduction of School League Tables based on Standard Assessment Tests, concern about class sizes and political concern about educational standards, has resulted in an increase in the demand for home study books;

3) AWL produce a Study Guide under the name Longman's Homework Handbook;

4) before adopting this name the title Longman's Homework Helpers was chosen from a number of possible titles for a new Study Guide because it was considered that Homework Helpers was the best suited description of the purpose of the goods;

5) the definition of "Helper" in the Oxford English Dictionary is "one who (or thatwhich) helps or assists."

6) in about May 1996, AWL began to promote the forthcoming launch of the Longman's Homework Helpers series in September of that year.

7) on 1 August 1996, the applicants' trade mark agents wrote to AWL pointing out that they had applied to register Homework Helpers as a trade mark and called upon the applicants to use another name for their forthcoming publication;

8) AWL had committed itself by this time to supplying a new series of Study Guides to major high street retailers, and it was important that these were available for the beginning of the forthcoming academic year;

9) AWL decided that it could not afford to take the commercial risk of a protracted dispute with the applicants at that time, and so it decided to use the name Longman Homework Handbook instead;

10) AWL still intends to use the name “Homework Helpers” when it can lawfully do so because it considers that younger children in particular, will better understand the meaning of this term;

5 Exhibit CHGH4 to Mr Harrison’s declaration consists of copies of actual advertisements promoting the mark Longman Homework Helpers, as described in 6) above. The following passage is an extract from an advertisement which appeared in Blackwell’s Summer Choice Magazine around May of 1996;

10 *“Homework is a fact of life for all school children, and, what’s more, with increasing emphasis on the importance of course work, and the overall performance of schools, its vital that your child not only does his or her homework, but that it is done well.*

15 *Enter Longman Homework Helpers! Written specifically to help Key Stage 3 students (ages 11-14) with their homework, these lively books are set out in a friendly, easy to use alphabetical style.”*

The opponents’ evidence also includes ten Statutory Declarations from teachers. Typical of these is a declaration by Almas Agha dated 29 September 1997. Ms Agha has been a teacher at 20 White Friars Primary School for ten years. In her view:

25 *“Homework Helpers means something to help children do their homework. I think that the phrase “Homework Helpers” would be an appropriate description of AWL’s Study Guides and would be an ideal title for the series.”*

APPLICANTS’ EVIDENCE

The applicants’ evidence consists of a Statutory Declaration by Donna Hayes dated 22 April 1998. Ms Hayes is the Vice President of Frank Schaffer Productions Inc. In summary 30 she says:

- 1) the sale of printed matter is central to the applicants’ business;
- 2) however, the applicants’ marks are used in conjunction with other media, such a video 35 and audio cassettes and tapes and CD-ROMS, and the applicants’ also provide

educational services via computer networks on-line services;

3) the trade mark Homework Helpers was first used in the United Kingdom in March 1996 in relation to educational publications;

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4) it has not so far been used in relation to any other goods or services in the UK;

5) the trade mark Homework Helpers has been promoted at various exhibitions and shows since March of 1996;

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6) the trade mark Homework Helpers is used in the UK under licence by Brighter Vision Education Limited;

7) “Homework Helpers” is registered in the United States of America in relation to educational books;

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8) Chambers English Dictionary defines ‘Helper’ as “someone who helps” - the word ‘Helper’ is not commonly used in connection with inanimate objects.

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9) thus, whilst it is not denied that Homework Helpers alludes to the nature of the type of publication at issue, it is not directly descriptive;

SECTION 1(1) & SECTION 3(1)(a) OF THE ACT

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Section 1(1) of the Act is in the following terms:

In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

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A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals of the shape of goods or their packaging.

Section 3(1)(a) is as follows:

The following shall not be registered-

5 (a) signs which do not satisfy the requirements of section 1(1),

In *Phillips Electronics NV v Remington Consumer Products Limited* (1998 RPC page 283), Jacob J said (at page 301) that the appropriate test is:

10 *“Whether no matter how much the sign may be used and recognised, it can really serve to convey in substance only the message: “here are a particular traders goods”.”*

Mr Silverleaf took the position that, whilst “Homework Helpers” may not be so incapable of distinguishing as the example of a word mark used by Jacob J. (“soap” for soap), it was
15 nevertheless highly descriptive. He suggested that it was the sort of word that should only be registered on the basis of overwhelming evidence of factual distinctiveness as a trade mark.

For his part, Mr Edenborough pointed out that there was no evidence of any other trader having used the term “Homework Helpers” before the date of the application. In his submission, the
20 mark is not so descriptive as to be incapable of properly distinguishing the goods or services or one undertaking even with the benefit of extensive use and promotion.

I believe that Mr Edenborough is right about this. I do not think that the mark HOMEWORK HELPERS is so descriptive that I can say now that the applicants will never be able to educate
25 the public to regard the words as a trade mark denoting only their goods or services. The opposition under Section 3(1)(a) therefore fails.

SECTION 3(1)(b)& (c)

30 Section 3(1)(b) & (c) of the Act are as follows:

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, intrade, 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,

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The applicants' claim to have used their mark in the United Kingdom since March 1996. That is after the date of this application. The applicants' mark was an unused mark at the date of application, and this is how I must consider it. Mr Silverleaf submitted that the mark primarily conveys the message "Here is something which helps you with your homework." He pointed to the evidence from teachers as support for this submission. Mr Edenborough criticised this evidence. He suggested that the use of similar phraseology by the declarants indicated that "words had been put into their mouths." He also pointed out that the evidence was not collected through a survey and may not therefore be representative.

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The evidence was not collected through a survey and, to that extent, I accept that it cannot be regarded as necessarily representative. As far as the wording of the declarations is concerned, I do not consider that the phraseology used to be so similar that the declarations can be said to be self-evidently of a "pro-forma" nature. I take the evidence at face value as representing the views of ten experienced teachers with some experience of educational printed matter. The ultimate decision is, of course, mine to make.

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The applicants pray in aid the entry in Chambers English Dictionary as support for their contention that the word 'helper', whilst apt for application to a person, is inapt for application to an inanimate object. The opponents counter that the definition in the Oxford Dictionary entertains use of the word in relation to a thing as well as a person.

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I take due note of these points, but I do not consider that entries in dictionaries can be decisive. Section 3(1)(c) excludes from registration "signs or indications which may serve, **in trade**, to designate" characteristics of the goods or services (emphasis added). If the words "Homework Helpers" consist of a sign which is likely to be used honestly, in trade, to describe characteristics of the goods or services at issue, the sign is excluded from registration by Section 3(1)(c), whether or not such use is correct from an academic viewpoint. Words excluded from registration by Section 3(1)(c) will also be excluded by Section 3(1)(b).

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I do not believe that the words “Homework Helpers” can be said to be a fanciful or unusual combination of words. In my view the words form a natural and apt term for use in trade to describe the intended purpose of a series of books (or other media) designed to help students with their homework. This finding is consistent with the evidence that the opponents initially (and independently) adopted the same term as a description of the intended purpose of their Study Guides. Mr Edenborough suggested that the opponents had simply adopted the same trade name at a later date. By this I understood him to mean that the opponents adopted the words “Homework Helpers” as part of a trade mark, rather than as a bona fide description of their goods. I have not overlooked the fact that the evidence shows that the words “Homework Helpers” were used with capital first letters, but then so were the words “Treat” and “Toffee Treat” in the case of British Sugar plc v. James Robertson & Sons Limited (1996 RPC page 281). Nevertheless, Jacob J. decided that such use was purely descriptive. That is also my impression here.

Mr Edenborough invited me to take account that Section 11(2)(b) of the Act provides a defence to infringement where it can be shown that the use complained of is honest and an indication concerning characteristics of the goods or services. Mr Silverleaf took the position that Section 11 is irrelevant to questions of registrability that arise under Section 3 of the Act. That was also the view that the Appointed Person took of the matter in AD2000 trade mark (1997 RPC page 168). I have no hesitation in adopting the same position. If it is really necessary to consider what defence might be available to safeguard honest use of the words applied for by other traders as an indication of a characteristic of the goods and services at issue, it is almost certainly inappropriate to register those same words as an unused trade mark for those same goods or services. That is the view I have come to. The opposition under Section 3(1)(b) & (c) of the Act succeeds.

The opposition having succeeded, the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £1100.

Dated this 6 Day of October 1998

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Allan James

For the Registrar

The Comptroller General