

BEFORE:

MR M G CLARKE QC

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND

**IN THE MATTER OF APPLICATION NO 2032941
BY IPC MAGAZINES LIMITED TO REGISTER
THE MARK LET'S TALK IN CLASS 16**

**APPEAL OF APPLICANT FROM THE DECISION OF THE
HEARING OFFICER (MS ANNE PRITCHARD) DATED 8TH AUGUST 1997**

**M A P BERNARD (of Messrs F J Cleveland & Company, London EC2A 1JA)
appeared as Agent for the Applicant**

MR A JAMES appeared for the Comptroller-General of Patents etc

**D E C I S I O N
(as approved)**

Mr Clarke: This is an appeal to the appointed person under Section 76 of the Trade Marks Act 1994 by IPC Magazines Limited, the applicants for registration of Trade Mark No 2032941, against the decision of Anne Pritchard, the Hearing Officer, acting on behalf of the Registrar dated 8 August 1997. Before me the applicants were represented by Mr A P Bernard of
5 Messrs F J Cleveland and Mr A James represented the Registrar.

The trade mark was applied for in Class 16 in respect of “Printed Publications”. The trade mark consists of the words “Let’s talk”. The Hearing Officer initially took objection to the mark under Section 3(1)(b) and (c) of the Trade Marks Act 1994. She, however, suspended
10 the original application for three months to allow the applicants to provide examples of how the mark was proposed to be used. A dummy copy of a magazine was filed, which was included among the papers before me. This showed the words with an exclamation mark on the heading of the front page of the copy. No evidence of use was placed before the Hearing Officer. The Hearing Officer maintained the initial objection under Section 3(1)(b) and (c) and
15 refused registration. Section 3(1)(b) is to the following effect:

“The following shall not be registered - - -

trade marks which are devoid of any distinctive character.”

Section 3(1)(c) states:

“The following shall not be registered - - -

trade marks which consist exclusively of signs or indications which may serve,
25 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.”

In her grounds of decision the Hearing Officer pointed out that the mark consisted of the
30 ordinary dictionary word “talk” preceded by the appreciation “let’s”. After referring to definitions of these words in the Collins English Dictionary, she stated:

“The phrase “let’s talk” in totality, therefore, can have the meaning of an invitation to the reader to express their thoughts and feelings in words or to exchange ideas and opinions.”

5 In the applicants’ statement of case, the applicants accepted the Hearing Officer’s view that the words “Lets talk” are meaningful and “accept the Registrar’s account of this meaning”. They, however, pointed out that they are seeking registration for magazines and intend to use the mark as a title of a magazine. In that respect they further contended that since magazines rely solely on the written word, and so do not involve speech, and cannot literally engage in
10 talk nor act as a forum for talk, the use of the word “talk” in relation to a magazine is fanciful.

In my view, following very much the approach of the Hearing Officer, that is to adopt altogether a too narrow approach to the definition and use of the words “Let’s talk” in modern commercial and marketing conditions. The dummy magazine filed by the applicants indicates
15 that the type of publication proposed is one which will use contributions from readers in which they will relate, in a somewhat conversational or “chatty” style, personal experiences, offer their own household and beauty tips and seek advice on a problem page. Money is apparently to be offered in return for their stories, experiences and advice.

20 Before me Mr Bernard argued that the mark did not directly describe the intended purpose or use. I am not persuaded that is so. It seems to me that the use of “Let’s talk” in relation to this kind of publication, having regard to its style and content, can readily be regarded as descriptive of the kind of publication, notwithstanding that it refers to communication by a written or printed medium as opposed to an oral medium. The words, in my view, are just the
25 very kind of expression which, in modern usage, may be applied to describe such a publication, rather than perhaps technically more correct expressions, such as, “Let’s correspond” or “Let’s write”.

Applying the well-known test set out by Lord Russell in the case of *The Shredded Wheat Company Limited v Kellogg Company of Great Britain Limited* [1940] 57 RPC 137, 145
30 namely: “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”, it is my view that it cannot be said that the words “Let’s talk” are incapable of fair and honest application to written publications of persons other than the applicants. In my opinion the mark “Let’s talk” would only have been possessed of a distinctive character, at the date of the application had it been used in a manner, and to an extent sufficient to have endowed it with a distinctive character. There was no evidence of such use at the date of the application, nor was there any such evidence before me. I accordingly agree with the Hearing Officer that it is excluded from registration by virtue of Section 3(1)(b) of the Act.

Moreover I consider that the Hearing Officer was entitled to hold that, in the circumstances, the mark was excluded from registration by virtue of the provisions of Section 3(1)(c) of the Act. Both Mr James and Mr Bernard, I think, ultimately accepted that the correct approach to be applied under Section 3(1)(c) was to ask the question whether it was reasonably likely that other bona fide persons might wish to use the mark in relation to their own products. It appears to me other legitimate traders may well independently come to the view that the words were an appropriate description, either in relation to a written publication as a whole which, for example, was designed to promote an exchange of views and opinions, or in relation to page or pages within a publication such as a magazine. In doing so, it is my view, that they could well be regarding the words as a good description of such published material and not as the applicants contend because it was an attractive fanciful name for them to use.

In their statement of case the applicants contended that the magazine titles are not typical trade marks and that even very descriptive names are quickly accepted as distinctive. They furthermore contended that the Registrar’s practice is to accept such marks for registration of evidence of just modest use. I do not consider that these contentions assist the applicants. In the first place, in the present case, there is no evidence of use at all and, secondly, it has often been said that the state of the register is, in principle, irrelevant for the purpose of determining whether a sign is capable of distinguishing.

Before me Mr Bernard appeared to accept that was the position. He did, however, refer to the Registry’s Word Manual and to examples contained therein which he contended supported

his submission that the Hearing Officer had applied too strict a test in the present case. In my view, however, the content of the manual cannot be ultimately decisive of the matter, which has to be decided by reference to the proper test, having regard to the statutory language, and then reaching a judgement as to whether the mark meets that test or not, which is what I have
5 endeavoured to do in the present case. In the result, therefore, the appeal fails.

I propose to follow the now established practice in such cases of making no award as to costs.