

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2027013A
BY ASSOCIATED NEWSPAPERS LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50260
BY IPC MEDIA LIMITED**

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IN THE MATTER OF Opposition thereto under No 50260
by IPC Media Limited

Background

1. On 14 July 1995, Associated Newspapers Limited applied under the Trade Marks Act 1994 to register a series of two trade marks. The application was given the number 2027013. The applicants applied to divide the trade mark application and that in suit here, proceeded under the number 2027013A for the trade mark IDEAL HOME EXHIBITION. Following amendment, the specification of goods and services reads:

Class 16

Printed matter, printed publications, magazines, newspapers, guides, books, supplements, periodicals, brochures, catalogues, holiday and travel guides.

Class 35

Organisation, arrangement of and conducting exhibitions for commercial or advertising purposes; demonstration of goods; distribution of samples; advertising and business information services; advertising and business information services provided on line from a computer database or from the Internet; compilation of advertisements for use as web pages on the Internet; public relations services; classified advertising services.

Class 41

Organisation of exhibitions for cultural or educational services; provision of information relating to education and entertainment; publishing services; publication of printed matter and printed publications; education, entertainment, publishing, publication and sports information services, all provided on line from a computer database or from the Internet.

Class 42

Syndicated writing concerning the Internet and on-line computer services; information services relating to the Internet; providing facilities for exhibitions; catering for the provision of food and drink.

2. The application was accepted and published on the basis of distinctiveness acquired

through use and on the basis of honest concurrent use with registration numbers 620673 and 1260437. On 7 October 1999, IPC magazines Limited, filed notice of opposition to the application. On 21 July 2000, the opponents' representatives fJ Cleveland informed the registry of the opponents' change of name to IPC Media Limited, a copy of the Certificate of Incorporation on Change of Name was attached to the letter. The statement of grounds accompanying the notice of opposition set out three grounds of opposition, these can be summarised as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is similar to the opponents' earlier trade marks IDEAL HOME registration number 1260437 and IDEAL HOME & GARDENING, registration number 620673 and covers goods and services identical or similar to the goods for which the earlier trade marks are protected;
- (b) under section 5(3) of the Act in that in so far as any goods or services listed in the application are not similar to those for which the opponents' earlier trade marks are protected, having regard to the opponents' reputation in the United Kingdom, use of the Applicants' mark would take advantage of, or be detrimental to, the distinctive character or repute of the opponents' earlier trade marks; and
- (c) under section 5(4)(a) having regard to the opponents' goodwill and reputation in the earlier trade marks, the application is liable to be prevented by the law of passing off.

3. The applicants filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs. The matter came to be heard on 4 October 2001. The applicants were represented by Ms Sarah Lambeth of Haseltine Lake Trademarks, the opponents were represented by Mr Thomas Mitcheson of Counsel, instructed by fJ Cleveland. Both parties filed evidence in the proceedings.

Opponents' Evidence

4. The opponents' evidence consists of a statutory declaration dated 20 July 2000 by Yvonne Ramsden, Publishing Director of the IDEAL HOME publication owned by IPC Media Limited (formerly IPC Magazines Limited).

5. Ms Ramsden states that IDEAL HOME was first used in 1920 and has been continuously used since its launch. The trade mark IDEAL HOME is, she states, principally used as a title of a magazine and also appears on all publicity material, advertising and merchandise, as well as all administrative stationery used in relation to the magazine. Ms Ramsden refers to her company's two earlier registrations for IDEAL HOME and IDEAL HOME & GARDENING. In respect of the latter, she notes that it was registered in 1942 and at YR1 she exhibits copies of the statutory declarations filed in support of this application.

6. At YR 2 Ms Ramsden exhibits an extract from her company's own media pack providing

facts and figures pertaining to the opponents' magazine title IDEAL HOME. Ms Ramsden states that a substantial amount of revenue is derived from the provision of advertising and promotional services to others under the trade mark IDEAL HOME. I note that the media pack refers to circulation figures from July-December 1999, after the relevant date. At YR3 she exhibits a table showing advertising and circulation revenues together with annual promotional expenditure relating to the opponents' IDEAL HOME trade mark for the years 1994 to 1999. Again, the majority of the figures are after the relevant date, but I comment on this further in my decision. At YR4, she exhibits a table showing the unitary volume of IDEAL HOME publications sold at news stands in the United Kingdom and exported. These are average units sold per issue for six month periods from 1988 - 1999. She states that the figures have been sourced from the Audit Bureau of Circulation.

7. Ms Ramsden makes various comments concerning the trade mark IDEAL HOME, which in her view, is a well-known title and brand and has a stylish and upmarket association with an emphasis on quality. In Ms Ramsden's own words, it is:

“Britain's best loved 'home interest' magazine and has a readership of one million five hundred and seventy-three thousand which reflects its status as a market leader. It is currently outperforming all other magazine titles in its target market and from October 1998 to March 1999 it enjoyed a 3% increase in circulation figures whereas every other title in the same market showed a decrease in circulation.”

8. At YR5, Ms Ramsden exhibits example of the opponents' trade press advertising; display posters for retail outlets such as W H Smith's and other independent newsagents; a copy of a promotion run with The Times newspaper in Spring 1999 in the form of a supplement distributed with the newspaper and a leaflet promoting subscriptions for some of the opponents' magazine titles including IDEAL HOME.

9. Ms Ramsden states that the brand IDEAL HOME has also come to be associated with “spin-off” merchandise associated with the IDEAL HOME magazine including other IDEAL HOME publications. At YR6 Ms Ramsden exhibits what she describes as, “prime examples of such merchandise”. This exhibit consists of:

- the cover of an IDEAL HOME “Christmas Trivia Quiz” cassette tape
- the front cover of a publication entitled IDEAL HOME ENTERTAINING
- the cover of a Dorling Kindersley publication entitled “IDEAL HOME COMPLETE BOOK OF KITCHEN PLANNING

10. Taking each of these in turn, I note the following. The Christmas Trivia Quiz tape itself is undated and Ms Ramsden does not give any publication date. However, I note that question 14b is, “Which sporting event used this as one of its music themes?” The answer given on the back cover of the tape is “Olympic Games Atlanta 1996.” From this I infer that the tape was issued sometime after the Atlanta Games in 1996. Thus, this is outside the relevant date in these proceedings which is of course, 14 July 1995, the date of application. Ms Ramsden states that the publication IDEAL HOME ENTERTAINING was printed by Macmillan Publishers in 1999, again after the relevant date. In respect of the last publication I am given no information at all on which to base any inference.

11. At YR7, Ms Ramsden exhibits examples of use of the opponents' trade mark IDEAL HOME within the editorial pages of the IDEAL HOME magazine. At YR8, she exhibits copies of the IDEAL HOME web page from the opponents' website. The page shows a date of 4 May 2000. At YR9, Ms Ramsden exhibits a video tape of a pre-recorded television programme entitled IDEAL HOME COOKS made in association with the opponents' IDEAL HOME magazine in 1997, for transmission on cable television. Ms Ramsden states that the programme went out on the Carlton Food Network channel. This is again after the relevant date.

12. Ms Ramsden states that over recent years, the publishing industry has undergone and continues to undergo considerable expansion, extending into other growing technological media, such as the Internet. Ways of presenting information and images have evolved in particular over the last few years and many conventional magazines are now either available in formats such as CD-ROMs or they are accessible via the internet. Accordingly, she submits that a person seeing the title IDEAL HOME or IDEAL HOME in combination with non-distinctive matter such as the word "exhibition" used on, for example, a CD-ROM or on an Internet website would inevitably associate this with the opponents on the basis of their longstanding reputation in the mark IDEAL HOME.

13. Ms Ramsden makes various assertions as to the reputation of the opponents and notes that the IDEAL HOME magazine has received many accolades over the years. She lists the most recent awards which are all after the relevant date. Ms Ramsden goes on to make various submissions about the trade marks in dispute and the goods and services for which the applicants' seek registration. I need not summarise these.

Applicant's Evidence

14. The applicant's evidence consists of a witness statement dated 21 February 2001 by Ms Sally Muddiman, Company Secretary of DMG World Media Limited (the Licensees). Ms Muddiman states that the licensees are an associated company of Associated Newspapers Limited (the applicants).

15. Ms Muddiman states that the mark IDEAL HOME EXHIBITION has been used by the licensees and or the applicants in Great Britain and Northern Ireland since the year 1908 in relation to national consumer exhibitions and related goods and services. At SM.1 she exhibits front pages of official catalogues and guides from the IDEAL HOME EXHIBITION. The catalogues start with 1908 and 1912 and cover numerous years up to and including 1997. All except 1908 and 1912 are for the DAILY MAIL IDEAL HOME EXHIBITION. Those for 1908 and 1912 state IDEAL HOME EXHIBITION organised by the DAILY MAIL.

16. Ms Muddiman states that the IDEAL HOME EXHIBITION is very well known and has a long standing reputation pre-dating that of the opponents. Therefore, she states that the element EXHIBITION is of huge significance in the mark as it distinguishes all "spin-off" products and services associated with the IDEAL HOME EXHIBITION from goods and services of any other party. At SM.2 Ms Muddiman exhibits examples of press cuttings from 1991 to 1992 referring to the IDEAL HOME EXHIBITION including extracts from IDEAL HOME magazine. This, she states, demonstrates that as a result of the massive reputation of

the IDEAL HOME EXHIBITION, everyone knows that there is no link between the IDEAL HOME magazine and the IDEAL HOME EXHIBITION. In Ms Muddiman's opinion, any publications by the licensees or the applicants are a reasonably expected element of or extension to the IDEAL HOME EXHIBITION. Ms Muddiman states that the public have become used to merchandising and spin-off products and services of one sort or another from any event, particularly, one as well known as the IDEAL HOME EXHIBITION.

17. Ms Muddiman states that the extent of advertising in Great Britain and Northern Ireland has been considerable in publications such as The Daily Express, the Independent on Sunday Review, Woman and Prima. She states that advertising campaigns have also taken place on radio and television and on buses, underground trains and roadside hoardings. At SM.3 Ms Ramsden exhibits material which she states demonstrates use of the trade mark. This consists of various tables showing the advertising campaign for 1995. One is headed "1995 DAILY MAIL IDEAL HOME EXHIBITION ADVERTISING CAMPAIGN NATIONAL NEWSPAPERS". Tables are exhibited headed for MAGAZINES, TV & RADIO, BUS SIDES & TUBE CARDS. Further tables with the same headings are submitted for 1996. In addition there is a table headed "1996 DAILY MAIL IDEAL HOME EXHIBITION ADVERTISING CAMPAIGN PR ACTIVITY" and another with the same heading but showing "OTHER TICKET OFFERS". There is a further one for 1996 showing the timetable for the "MOBILE SITTING ROOM".

18. No details are given for the content of the advertisements in 1995, however, I note that the table states "1995 DAILY MAIL IDEAL HOME EXHIBITION.....". The same heading is used for 1996 but on some of these there is also shown a logo. This may or may not be an example of the advertisement used in 1996, it again shows "DAILY MAIL IDEAL HOME EXHIBITION...", the picture showing the "MOBILE SITTING ROOM" also shows "DAILY MAIL IDEAL HOME EXHIBITION EARL'S COURT LONDON MARCH 14TH - APRIL 8TH".

Opponents' Evidence in reply

19. This consists of a witness statement by Yvonne Ramsden dated 22 May 2001. This consists of various comments concerning the evidence of Ms Muddiman. I need not summarise it.

20. That concludes my review of the evidence.

Decision

21. The grounds of opposition refer to sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

"5.- (1)

(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade

mark is protected, or

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

22. The term 'earlier trade mark' is defined in section 6 of the Act as follows:

"6.- (1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

23. I will deal first with the opponents' ground of opposition under section 5(2)(b). In

determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

24. Under section 5(2), the test is a composite one, involving a global appreciation taking

into account a number of factors. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

25. The opponents' have two earlier trade marks within the definition of section 6 of the Act. It was common ground that their best case fell to be considered with reference to trade mark 1260437. For convenience, I reproduce the opponents' and applicants' trade marks below:

Applicants' trade mark

Opponents' trade mark

IDEAL HOME EXHIBITION

IDEAL HOME

Class 16

Class 16

Printed matter, printed publications, magazines, newspapers, guides, books, supplements, periodicals, brochures, catalogues, holiday and travel guides.

Printed publications and periodicals

Class 35

Organisation, arrangement of and conducting exhibitions for commercial or advertising purposes; demonstration of goods; distribution of samples; advertising and business information services; advertising and business information services provided on line from a computer database or from the Internet; compilation of advertisements for use as web pages on the Internet; public relations services; classified advertising services.

Class 41

Organisation of exhibitions for cultural or educational services; provision of information relating to education and entertainment; publishing services; publication of printed matter and printed publications; education, entertainment, publishing, publication and sports information services, all provided on line from a computer database or from the Internet.

Class 42

Syndicated writing concerning the Internet and on-line computer services; information services relating to the Internet; providing facilities for exhibitions; catering for the provision of food and drink.

Inherent Distinctiveness/Reputation of the Opponents' Earlier Trade Mark

26. The opponents did not contend that their mark possessed a high degree of inherent distinctive character. However, in their submission, the duration of their use, together with its extent and the market share enjoyed by the opponents' publication under the trade mark entitled them to claim an enhanced level of recognition. I did not understand Ms Lambeth to disagree with the opponents' claim and indeed, they may have a reputation in this area. However, is it supported by the evidence? In my summary of the evidence I noted that much of the information concerning turnover, market share and advertising revenue were after the relevant date. In order for reputation to be taken into account in any consideration under section 5(2) or to satisfy the requirements of section 5(3) or 5(4)(a), the opponents must show that they enjoyed the reputation at the relevant date. In these proceedings, that is the 14 July 1995. What am I left with if I discard matter after that date? It seems to me, I am left with the following.

- the opponents' claim of use of the trade mark 1920 which seems to be supported by the claim in their media pack YR2 and the use of the claim on the masthead of their magazine;
- 1994 revenue of £5,994,000 and promotional expenditure of £272,000; see exhibit YR3. Figures for 1995 are also given. Although I can only take into account part of the year, the figures are revenue of £5,403,000 and promotional spend of £139,000.
- average sales figures per issue for 6 month periods between 1988 and 1994 all in the region of 250,000; see exhibit YR4. I note that this figure is consistent with the figure for circulation given in the media pack at YR2 for July - December 1999.

27. Whilst much of the evidence is after the relevant date, I am satisfied on the basis of the evidence which can be taken into account, that the opponents' trade mark enjoyed an enhanced level of recognition in respect of a magazine publication at the relevant date.

Concessions

28. Before going on to consider the similarity of the marks and goods/services, I should mention a concession made by the applicants. At the commencement of the hearing, Mr Mitcheson informed me that, in the light of the applicants' acceptance of the opponents' reputation, the applicants had agreed to remove from their specification, the terms magazines and periodicals and printed publications in so far as these cover magazines. The opponents in the skeleton and in argument also made a concession in that they did not oppose registration in so far as it covered organisation, arrangement of and conducting of exhibitions appearing in classes 35 and 41 and the terms providing facilities for exhibitions in class 42.

29. These concessions seem sensible and reasonable to me and I proceed on the basis that the specification of the application has been amended accordingly.

Identity/Similarity of Goods

30. The opponents' trade mark is registered in class 16 for printed publications and

periodicals. The applicants are seeking protections for a wide range of goods and services. Which if any, are similar or identical to the goods covered by the opponents' earlier trade mark?

31. As noted above, the likelihood of confusion must be assessed globally. In *Canon*, the ECJ indicated that this implied some interdependence between the relevant factors. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks (and vice versa); *Canon* paragraph 17, page 132.

32. That said, it has been recognised by the ECJ that section 5(2), (Article 4(1)(b) of the Directive) requires that the goods/services are similar. In particular in *Canon* at paragraph 22 the court stated:

“22. It is however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

33. How are these two statements to be resolved. It seems to me that Mr Hobbs Q.C., sitting as the Appointed Person in *Raleigh International* (SRIS O-253-00) indicates the appropriate way to deal with these statements, he stated:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

34. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- (a) the uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) the physical nature of the goods or services;
- (d) the trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

35. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French

and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

36. In analysing the applicants’ specification and identifying those goods and services that he considered similar or identical, Mr Mitcheson tried to cast his net as far as possible. In contrast, Ms Lambeth argued that the majority of the applicants’ specification covered goods or services dissimilar to those of the opponents. I will start with the applicants’ goods in class 16.

37. The applicants’ specification covers printed matter and printed publications and a range of other goods. These include, magazines, newspapers, guides, books, supplements, periodicals, brochures, catalogues, holiday and travel guides. The opponents’ specification covers printed publications and periodicals. In so far as both specifications cover printed publications and periodicals then the goods are identical. In so far as the other goods listed within the applicants specification are covered by the terms printed publications and periodicals then again the goods are identical. In that regard, it is my view that the terms ‘magazines, newspapers, guides, books, supplements, brochures, catalogues, holiday and travel guides’, all fall within the terms printed publications and periodicals. As for the other term, ‘printed matter’, in my view a number of items which fall within the term ‘printed matter’ will also be identical goods to goods covered by the term ‘printed publications’, however, it seems to me that ‘printed matter’ will also cover other items outside the opponents’ specification. That said, in my view those goods not identical to the opponents’ specification all being printed matter, will be very similar. Thus, I reach the view that the goods covered by the applicants’ specification falling within class 16 are either identical or very similar to the goods for which the opponents’ trade mark is protected in the same class.

38. I turn now to consider the services covered by the application in suit. These are in classes 35, 41 and 42. The mere fact that the opponents’ registration covers goods and these classes cover services is not sufficient for a finding of dissimilarity; Jacob. J. *British Sugar* at page 297.

39. I start with Class 41. The applicants seek protection for a range of services falling within this class. The opponents took no objection under section 5(2)(b) to the following services: “provision of information relating to education and entertainment; education, entertainment and sports information services, all provided on line from a computer database or from the Internet”. They did however, object to “publishing services; publication of printed matter and printed publications; publishing, publication services, all provided on line from a computer database or from the Internet.”

40. I questioned Ms Lambeth as to whether these terms to which the opponents objected, covered services similar to the goods for which the opponents’ earlier trade mark is registered. In her view they did not. She submitted that the service of publishing and publication were a very different matter to the publication itself and the public would not expect a publisher of a magazine or periodical to also be responsible for publishing and publication services. In her view this would also be true of any publishing or publication

services provided on line from a computer database or from the internet. Mr Mitcheson did not agree and argued that the public would expect a publisher of a magazine to produce that magazine in electronic form, for example, on the internet. Mr Mitcheson referred to the exhibit 8 in the opponents' evidence, a print out of the opponents' website, but this print out is dated 4 May 2000 and is after the relevant date. That said, I think that there is much force in Mr Mitcheson's argument on this point.

41. It seems to me that the users and uses of publishing and publications on line are potentially the same as those who prefer to view their favoured publication in paper form. Whilst the physical nature of the product would be different, one is electronic the other paper, the content of both would be the same. The trade channel would be different but the goods/services would be in direct competition with each other. A consumer is unlikely to purchase his paper copy and then view it online. The more technical consumer is equally unlikely to view a publication on the internet and then go out and purchase a 'hard copy'. Ms Ramsden gives evidence as to the tendency for the publishing industry to move into internet use and use in other mediums such as CD-ROM. I do not give too much weight to Ms Ramsden's evidence on this point but I do not find her conclusions surprising. At the relevant date, it seem to me that it would not have been surprising that the opponents or other competitors in the field would be looking to provide their publications in a more up to date format. Therefore, in relation to "publishing, publication services, all provided on line from a computer database or from the Internet" and falling within class 41, I reach the view that these services are very similar to the goods covered by the opponents' specification.

42. Whilst there is in my view less similarity between "publishing services; publication of printed matter and printed publications" and the goods themselves; I agree with Ms Lambeth that those responsible for the act of publication would not always be responsible for the content of the goods. It seems to me that there is still a degree of similarity. Publication is the action by which the goods are released to the public.

43. The opponents also maintained their objection under section 5(2)(b) to the services set out in class 35, although no objection under this section was taken to the terms "demonstration of goods; public relations services". Objection was therefore taken to the following services:

44. 'distribution of samples' - Mr Mitcheson drew my attention to the opponents' evidence which he suggested showed that free samples were frequently given away with the opponents' publication. The evidence is at exhibit YR6 and consists of the "Christmas Quiz tape". This is the only example and as noted in my summary of the evidence, it seems to have been distributed around Christmas 1996, after the relevant date. Mr Mitcheson asked me to rely on my own personal experience as a consumer and to take note of the fact that it is common for magazines to offer free samples to their readers. Certainly from my own knowledge, I am familiar with samples being provided either by the magazine or as part of a third party's advertisement within the magazine.

45. That said, I do not believe that this assists Mr Mitcheson in his arguments under section 5(2)(b). If the opponents' had shown that their own publication had a reputation for giving away such samples then it may have been of assistance to their claim under section 5(4)(a).

However, under section 5(2)(b) I must consider whether the distribution of samples is a services similar to the goods covered by the opponents' specification. In my view, whilst magazines do sometimes distribute samples, the uses, physical nature of the services/goods are very different. Even the users and trade channels will not always be the same. Samples may be distributed on the street, at an exhibition, in a shop or via the post to the consumer's home or business address. If the applicants' had wished to show that these services and goods were similar then, in my view, this would have required evidence. Absent such evidence I find that they are dissimilar.

46. The applicants' remaining services in class 35 relate to advertising and business information. In relation to the latter, I again have no evidence directed to this point. It seems to me, prima facie, that there is no similarity between printed publications and periodicals and the terms business information services. The uses, users, physical nature and trade channels are all different.

47. Mr Mitcheson suggested that the opponents would be in a stronger position when considering advertising services. He pointed to the opponents' evidence showing the revenue generated through offering advertising space in the opponents' publication. The evidence does in my view show that the opponents generate turnover with regard to the advertisements placed in their publication. However, in my view that does not inevitably lead me to the conclusion that the goods and services here are in all cases very similar. It seems to me that the wording used in the applicants' specification could cover advertising services not connected to a magazine whether provided in paper form or on line. Consequently, in my view, there is a lesser degree of similarity if one considers use on advertising per se whereas, there is a greater degree of similarity when one considers use on advertising, whether or not they are provided on line, and on classified advertising services when these services are provided in relation to a magazine publication.

48. Finally, I consider the applicants' services in class 42. In so far as the specifications covers 'catering for the provision of food and drink', Mr Mitcheson noted that his clients had provided evidence showing collaboration on a television series relating to cookery. There are several problems here, firstly, the evidence provided at exhibit YR9 shows a television programme broadcast after the relevant date. Had the opponents' shown a reputation for food and drink at the relevant date, then that may have assisted them under section 5(4)(a). However, under section 5(2)(b), the opponents' reputation is as a publisher of IDEAL HOME and their specification covers printed publications and periodicals. As stated above, for section 5(2)(b) there is a requirement of similarity of goods/services. Applying the test set out above, it seems to me that the users of a magazine will not necessarily be the same persons who use catering services, the uses, physical nature and trade channels are very different. Therefore, I reach the view that these services are dissimilar to the goods covered by the opponents' specification.

49. The application also covers 'syndicated writing concerning the Internet and on-line computer services; information services relating to the Internet'. In so far as these cover services relating to magazines and publication of magazines on the internet, then, as per my comments in relation to the services in class 41, it seems to me that the services are similar to the goods covered by the applicants' specification. However, in so far as these terms cover

syndicate writing not relating to magazines or publication of magazines then the services are in my view dissimilar.

Comparison of the Trade Marks

50. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components.

51. Visually, the opponents' earlier trade mark is IDEAL HOME, the applicants' is IDEAL HOME EXHIBITION. In my view, there are clear visual similarities which are there for all to see. The applicants' trade mark consists of the entirety of the opponents' mark with the addition of the word EXHIBITION. The visual similarity occurs at the beginning of the trade mark and so its visual impact is increased. Whilst, the opponents' trade mark does not possess a high degree of distinctive character, in my view, the words, IDEAL HOME are the dominant and distinctive elements of the applicants' trade mark, the word exhibition being a descriptive element of the applicants' mark.

52. Aurally, it seems to me that the same considerations apply. Again, the applicants' mark consists of the entirety of the opponents' and the dominant and distinctive elements of the applicants' mark are the words IDEAL HOME.

53. Conceptually there is also some similarity. The opponents' trade mark calls to mind an IDEAL HOME, whilst the applicants' calls to mind an EXHIBITION about an IDEAL HOME.

54. To conclude on this point, I reach the view that, taking into account the visual, aural and conceptual similarities between the applicants' and opponents' trade marks, there is a high degree of similarity between the respective marks.

Effect of any use of the applicants' trade mark

55. Ms Lambeth argued that in assessing the likelihood of confusion I should have regard to the fact that the applicants' and opponents' marks have co-existed for approximately eighty years and yet no evidence of confusion had been adduced. Ms Lambeth did not seek to rely on the provisions of section 7, honest concurrent use, but argued that co-existence together with an absence of confusion were factors that I should take into account when making any assessment of the likelihood of confusion under section 5(2)(b). Whilst the registrar has found that such co-existence can be one factor in the global appreciation under section 5(2); see *Codas* (SRIS 0/372/00), it is not in my view a factor that I can take into account in this case. In order for such co-existence to be taken into account in the global appreciation there must in my view have been:

- (a) co-existence in the market place in respect of the goods and services covered by the application; and
- (b) such co-existence must have been under the trade mark the subject of the application.

56. In my view the applicants fail on both points. Dealing with point (b), the applicants' evidence shows use of the trade mark DAILY MAIL IDEAL HOME EXHIBITION on show guides for the said exhibition. Only those for 1908 and 1912 refer to the 'IDEAL HOME EXHIBITION organised by THE DAILY MAIL'. The details of advertising in 1995 and 1996 also seem to show use of DAILY MAIL IDEAL HOME EXHIBITION. The only evidence submitted by the applicants showing use of the mark as applied for consists of exhibit SM2. This consists of six press articles published by third parties which refer to the IDEAL HOME EXHIBITION. There is no evidence that the applicants themselves make use of the mark as applied for and on the basis of six references in third party publications, I am unwilling to find that there has been any, or any significant, use of the mark in the market place. The public may refer to the applicants' exhibition as the IDEAL HOME EXHIBITION but I have no evidence to support this contention.

57. Even if I am wrong on this point, and use of DAILY MAIL IDEAL HOME EXHIBITION is use of IDEAL HOME EXHIBITION, the applicants' evidence does not show use on the full range of goods and services covered by the application. The evidence at SM.1 shows use of that trade mark on show guides from 1912 through to the present day. Such use might support a claim to use in respect of a limited range of goods in class 16. This would also no doubt support a claim to use in relation to the organisation and provision of exhibitions, but the opponents take no objection to those terms in the specification. Ms Lambeth suggested that there had been use on advertising services. When I asked whether there was evidence on this point, Ms Lambeth submitted that exhibitions were nothing more than a huge opportunity to advertise. She asked me to infer that exhibitors paid her clients to attend. This may be a reasonable inference but it seems to me it would have been a simple matter for the applicants to have put in details of the amount of revenue generated by advertising etc. However, as I have found that the applicants have not shown use of the trade mark the subject of the application, the issue does not arise.

Conclusions under section 5(2)(b)

58. Together with my finding in relation to the recognition of the opponents' mark, how do my findings in respect of the similarities of the marks and the similarities of the goods and services come together under section 5(2)(b). As noted above, the ECJ has stated that a lesser degree of similarity between the goods or services can be offset by a greater degree of similarity between the marks (or visa versa).

59. Mr Hobbs, Q.C., sitting as the Appointed Person *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, he found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the "earlier trade mark", IDEAL HOME and the sign subsequently presented for registration, IDEAL HOME EXHIBITION, were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?

60. Having considered all these factors and given the recognition that the opponents' trade

mark enjoys, and the high degree of similarity of the marks, I reach the view that the above question must be answered in the affirmative in so far as the applicants' specification covers goods or services identical or similar to those for which the earlier mark is protected.

61. Thus, in my view use of the applicants' mark on all the goods falling in class 16 would result in a likelihood of confusion. In class 35, 41 and 42, I find that use of the applicants' trade mark on the following services would result in a likelihood of confusion

Class 35

Advertising services; advertising services provided on line from a computer database or from the Internet; compilation of advertisements for use as web pages on the Internet; classified advertising services.

Class 41

Publishing services; publication of printed matter and printed publications; publishing and publication services, all provided on line from a computer database or from the Internet.

Class 42

Syndicated writing concerning the Internet and on-line computer services; information services relating to the Internet (all in so far as they relate to the publication or publishing of magazines on the internet).

62. I will deal with the consequences of my decision under section 5(2)(b) when I have considered the opponents' other grounds of opposition.

Section 5(3)

Goods and services not similar

63. The first requirement for section 5(3) is for an earlier trade mark to be identical or similar to the trade mark the subject of the application. In that regard, I refer to my findings above and reach the view that there is a high degree of similarity between the opponents' trade mark IDEAL HOME and the applicants' mark IDEAL HOME EXHIBITION. The provisions also require that the mark is to be registered for goods or services which are not similar to those for which the earlier mark is protected. Under this section in his skeleton and in oral submissions, Mr Mitcheson referred to the following service which in his view were not similar to those for which the earlier mark is registered. These were "demonstration of goods; public relation services" in class 35, and "provision of information relating to education and entertainment; education, entertainment and sports information services, all provided on line from a computer database or from the Internet" in class 41. I would agree with Mr Mitcheson that these services are not similar to the goods for which the opponents' mark is registered

64. Under section 5(2)(b) Mr Mitcheson had argued that the other goods and services covered by the application were similar. If and to the extent that I found against him on that point, Mr Mitcheson invited me to make a finding under section 5(3). I can refer to my findings above and note that I reached the view that the following services were not similar for the purposes of section 5(2)(b); “distribution of samples; business information services; business information services provided on line from a computer database or from the Internet” in class 35. In class 42 I found that syndicate writing concerning the Internet and on-line computer services and information services relating to the Internet in so far as they do not relate to magazines or the publication of magazines on the internet and catering for the provision of food and drink were not similar to the goods for which the earlier mark is registered.

Reputation

65. The next requirement is that the earlier trade mark has a reputation in the United Kingdom. Guidance as to the extent of knowledge required to establish the necessary reputation was given by the ECJ in *General Motors Corporation v. Yplon SA* [1999] E.T.M.R. 122. The court concluded that the requirement implies a certain degree of knowledge among the public. The relevant public is that concerned by the earlier trade mark; paragraph 24. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that mark; paragraph 26. In deciding whether this requirement is fulfilled, all relevant factors should be considered including the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it; paragraph 27. The stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it; paragraph 30.

66. Earlier in my decision I analysed the evidence on this point submitted by the opponents. Despite some criticism of the evidence I concluded that the opponents’ trade mark IDEAL HOME does enjoy a reputation with the public in respect of a magazine publication. So I go on to consider whether the other requirements of section 5(3) have been met.

Without due cause

67. Mr Mitcheson next took me to the phrase “without due cause”. Both parties made submissions on this aspect of section 5(3). Mr Mitcheson relying on the judgment of Mr Justice Neuberger in *Premier Brands UK Ltd v. Typhoon Europe Ltd* [2000] F.S.R. 767 argued that it was for the defendant (applicant) to show due cause as to why it should be allowed to continue to use the mark. The relevant passages can be found on pages 789 to 792 of the judgment. Ms Lambeth argued that the applicants’ use of their mark from 1908 gave them due cause to use the mark and I refer to my comments above in relation to the evidence of use put forward by the applicants. However, for reasons that will become apparent I find that I do not need to determine whether the applicants’ use is without due cause and so make no finding on this point.

Takes unfair advantage, or be detrimental to the distinctive character of the earlier trade mark

68. Mr Mitcheson did not argue that this was a case where the applicants were attempting to trade off the goodwill of the opponents. He submitted that if the applicants' mark was used on the goods and services applied for it would lead to an inevitable blurring and tarnishing of the opponents' established reputation. Use of the applicants' mark would dilute the distinctiveness of the opponents' mark.

69. Mr Mitcheson noted that confusion was not a necessary requirement; this appears to be well settled see *Sabel* at page 223. But he went on to suggest that merely questioning the origin of the goods or services used under the mark is sufficient for an objection to be made out. This would be the sort of non origin association referred to and rejected in relation to the test under section 5(2)(b) by the ECJ in cases such as *Sabel v. Puma*. I find that submission surprising. The provision talks about detriment or damage to the distinctive character, there is no mention of confusion or association. Pumfrey J in *Daimlerchrysler AG v. Javid Alavi* [2001] All ER (D) 189, an infringement case on the parallel provisions of section 10(3), made obiter comments to the effect that it would seem odd to drive that head of infringement so enthusiastically out by the door [under Article 5(1)(b) (section 10(2))], if it were only to re-enter by a window obviously present in the same Article [Article 5(2) (section 10(3))], albeit for marks with a reputation. Neuberger J. in *Typhoon* found that the claimants' case established that some members of the public would make an association between the marks but noted that in order to succeed the claimants had to establish that the association was such as to be detrimental to the character or repute of the mark; page 798. Neuberger concluded:

“As I see it, the mere fact that a proportion of the public associate the allegedly infringing sign with the claimant's mark does not of itself mean that the sign infringes the rights of the proprietor of the mark by virtue of section 10(3): something more, namely detriment is required.”

70. I would agree with the comments of Neuberger J and Pumfrey J, it seems to me that mere association, in that the earlier trade mark is called to mind, is not sufficient for a finding under section 5(3). In addition, it has been stated many times that section 5(3) is not there to give marks unduly extensive protection. It is not a question of a risk of unfair advantage or detriment: there must be actual unfair advantage or detriment; see Pumfrey in *Daimlerchrysler AG v. Javid Alavi* at paragraph 86 referring to Jacobs AG in *General Motors Corp*. That does not mean that actual damage must have occurred, the applicants as in this case, may not be using the trade mark in respect of some or all of the services for which the application is made. However, the allegation that damage or detriment would occur if use was made must be properly made out.

71. Mr Mitcheson argues that this is a case where use of the applicants' mark on goods not similar to those for which the earlier trade mark is protected would result in dilution, blurring or tarnishing of that earlier mark. Mr Mitcheson referred to the judgment of Neuberger J. In *Typhoon* and argued that the judge agreed with the American definition of dilution as lessening the capacity of a famous mark to identify and distinguish goods. Whilst this is so, the judge went on to state:

“[W]hile dilution is a useful concept to bear in mind, it does not necessarily follow that every case of infringement under section 10(3) will necessarily involve dilution, nor does it follow that the proprietor of a mark will necessarily succeed in establishing infringement under section 10(3) in every case where he establishes dilution.”

72. Blurring, Mr Mitcheson suggested was when the distinctiveness of the earlier mark is eroded and in dealing with tarnishing in his skeleton he referred to the Benelux case of *Lucas Bols v. Colgate Palmolive* (1976) 7 IIC 420.

73. I can deal with the claim of tarnishing quite briefly. It seems to me that this implies some damaging connotations and not simply because a similar or identical sign has been used in relation to dissimilar goods. The case of *Lucas Bols* is a good example with an unattractive association between gin and detergent. No evidence has been brought forward as how use of the applicants' mark on catering for the provision of food and drink, or any of the other services that I have found to be dissimilar, could result in any such negative connotation or tarnishing of the opponents' trade mark.

74. Blurring and dilution seem to me to have much in common, they both imply some loss in the capacity of the earlier trade mark to distinguish goods and services. However, any use of a similar or identical sign on goods which are not similar to those for which the earlier mark is protected will inevitably lead to some blurring or dilution. Commenting on the words “detriment to the distinctive character”, in *Daimlerchrysler AG v. Javid Alavi* at paragraph 92, Pumfrey J. stated:

“The presence of two similar marks where there was only one before seems to me to be detrimental to the distinctive character of the first. I am satisfied that this is not what the words are talking about.”

75. The public are accustomed to the use of similar or identical trade marks on dissimilar goods and services with no detriment to the distinctive character of the various marks. It seems to me that there must be some positive benefit gained to the applicant through use of the mark or some negative effect on the opponents' mark. Neither in my view is shown to be present in this case. Indeed, the opponents themselves took no objection to the application proceedings in respect of organisation and arrangement of exhibitions in classes 35, 41 and 42. This to my mind shows that the opponents acknowledge that use of the applicants' mark on these dissimilar services would not result in any damage to the distinctive character of their earlier mark. I see no reason to make any different finding in respect of the other services in the application that I have found to be dissimilar and the opponents' ground of opposition under section 5(3) is dismissed.

76. At the hearing I was not addressed on the question of whether this was a case of inhibition or fettering of future expansion; concepts raised by the opponents in the *Loaded* case and dealt with by Mr Simon Thorley Q.C. sitting as the Appointed Person in his decision (unreported SRIS 0/455/00) and I need make no comment.

Section 5(4)(a)

77. Mr Mitcheson also sought to rely on his client's ground of opposition under section 5(4)(a). The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

78. The opponents have shown that they have a reputation and goodwill in the trade mark IDEAL HOME in respect of a magazine. The considerations under section 5(4)(a) with regard to misrepresentation are very similar to those under section 5(2)(b). In discussing the opponents' case under section 5(2)(b), I noted that had evidence been filed to show that the opponents' reputation extended beyond a magazine publication then this might have assisted them under section 5(4)(a). However, the evidence relied upon by Mr Mitcheson to show that the opponents' had a reputation for cookery and so catering for the provision of food and drink, was in my view insufficient to support such a claim. Therefore, it seems to me that this is a case where the opponents cannot be in any better position under section 5(4)(a) than they were under section 5(2)(b) and I need not consider this ground of opposition any further.

Conclusions

79. The opponents ground of opposition under section 5(2)(b) has succeeded in part. The application will be refused in class 16. In so far as the other classes are concerned, the applicants should file a Form TM21 within one month of the expiry of the appeal period from this decision, restricting their specifications in Classes 35, 41 and 42 to the wording shown below. If no Form TM21 is filed, the application will be refused in its entirety. The application should be amended to read:

Class 35

Organisation, arrangement of and conducting exhibitions for commercial or advertising purposes; demonstration of goods; distribution of samples; business information services; business information services provided on line from a computer database or from the Internet; public relations services.

Class 41

Organisation of exhibitions for cultural or educational services; provision of information relating to education and entertainment; education, entertainment and sports information services, all provided on line from a computer database or from the Internet.

Class 42

Syndicated writing concerning the Internet and on-line computer services, none relating to magazines or the publication of magazines on the internet; information services relating to the Internet, none relating to magazines or the publication of magazines on the internet; providing facilities for exhibitions; catering for the provision of food and drink.

80. The opponents have succeeded in part and are entitled to a contribution towards their costs. I order that the applicants pay the opponents the sum of £835-00 as a contribution towards their costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10 day of January 2002

**S P Rowan
For the Registrar
the Comptroller General**