

O-050-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos. 2292709, 2292720, 2292722,  
2292723, 2292724, 2292726, 2292742, 2292746 & 2292747**

**BY IDEAL HOME LIMITED  
TO REGISTER TRADE MARKS  
IN CLASSES 16, 35, & 41**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER Nos. 90900, 90901, 90902, 90903, 90904, 90905, 90906, 90907 & 90908  
BY IPC MEDIA LIMITED**

## BACKGROUND

1) On 14 February 2002, Ideal Home Limited applied under the Trade Marks Act 1994 for registration of the nine trade marks shown at Annex A:

2) Registration of eight of the marks was sought in respect of the following goods and services, the exception being 2292747 which was sought in respect of Classes 35 and 41 below only:

In Class 16: Paper, cardboard and goods made from these materials; printed matter; printed publications, catalogues, magazines, stationery, plastic materials for packaging.

In Class 35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise Internet website, the bringing together, for the benefit of others, of a variety of goods, through a television shopping channel or general merchandise catalogue, enabling customers to conveniently view and purchase those goods by means of telecommunications or by mail order.

In Class 41: Entertainment; production of radio and television programmes, provision of television and radio entertainment.

3) On 31 July 2002 IPC Media Limited filed notices of opposition to the applications. The grounds of oppositions are identical in each case and are in summary:

- a) The opponent is the proprietor of the following earlier trade marks. The specifications shown reflect the goods and services which the opponent identified as those which it believes are identical and/or similar to the goods and services applied for by the applicant:

Mark	Number	Effective Date	Class	Specification
IDEAL HOME	1260437	14.02.86	16	Printed publications and periodicals.
Proceeding because of prior rights in Registration No 1260437.	2121954	28.01.97  Revoked 19.09.02	9	Sound, video and data recordings, cinematographic films prepared for exhibition, CD-Roms.
			41	Entertainment, education and instruction by or relating to television, radio or films; production, presentation and rental of television and radio programmes, of films and of sound and video recordings.
Proceeding because of prior rights in Registration No. 1260437	2218623	05.01.00	9	Computer software; CD-Roms containing information for presentation on a screen in magazine-type format; information stored in or on electronic, magnetic and/or optical media; all being information in magazine-type

				format.
			38	Transmission of sound, vision and data by electronic means; services for the transmission, provision and/or display of information on-line from a computer database or from facilities provided on the Internet or other networks (including web sites); all provided in magazine format.
			41	Information and advisory services relating to homes, home decoration and improvement and lifestyle all provided on-line from a database or from facilities provided on the Internet or other networks (including websites); all provided in magazine format.
IDEAL HOME AND LIFESTYLE Proceeding because of prior rights in Registration No 1260437	2068888	16.04.96	16	Printed publications.
THE IDEAL HOME AND GARDENING  Advertised before acceptance. Section 18(1) (proviso).	620673	22.10.42  Revoked 18.12.02	16	Periodical printed publications
IDEAL HOME  Proceeding because of distinctiveness acquired through use.	2253401	17.11.00	35	The bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods by mail order from a magazine.

- b) The marks in suit are similar to the opponent's marks and the goods and services which the applicant is seeking to register its marks for, are similar to the goods and services of the opponent's marks. The marks in suit therefore offend against Section 5(2)(b) of the Trade Marks Act 1994.
- c) In the alternative if the goods and services applied for are found to be dissimilar to the goods and services for which the opponent's marks are registered then the opponent claims that the marks applied for would take advantage of, or be detrimental to, the distinctive character or the repute of the opponent's marks and so offend against Section 5(3) of the Trade Marks Act 1994.

- d) In view of the goodwill in the opponent's business under the mark IDEAL HOME, use of the marks in suit would be liable to be prevented by virtue of the law of passing off under Section 5(4)(a).
- e) The opponent also claims that the applications were filed in bad faith since the applicant was aware of the opponent's reputation in the mark IDEAL HOME and that the applicant is seeking to exploit any misassociation between the marks in suit and the opponent's IDEAL HOME magazine. The applications therefore offend against Section 3(6) of the Trade Marks Act 1994.

4) The applicant subsequently filed counterstatements denying the grounds of oppositions.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. In my opinion, these cases should have been consolidated. However, this was not requested so they remain technically separate oppositions even though I have dealt with them in one decision. The matter came to be heard on 23 November 2005 when the applicant was represented by Ms Ennison and the opponent by Mr Malynicz of Counsel instructed by Messrs F J Cleveland.

#### **OPPONENT'S EVIDENCE**

6) In the first opposition (90900) the registered proprietor filed six witness statements. In the subsequent eight oppositions it filed copies of the second witness statement of Ms Ramsden and the statements by Jude Daniels, Kieran Killeen, Mark Harper and Gavin Hyde-Blake as exhibits to two witness statements by the opponent's Trade Mark Attorney Joanna Larkey. The evidence in each of the nine cases is therefore identical and a single summary can suffice.

7) The first two witness statements, dated 9 June 2003 and 10 October 2003, are by Yvonne Ramsden the Publishing Director of the IDEAL HOME publication owned by IPC Media Ltd, a position she has held since March 1999. She states that the Ideal Home magazine is Britain's "leading "home interest" magazine". She states that at the relevant date the magazine had a readership of more than 1.4 million. Ms Ramsden states that the mark IDEAL HOME was first used in 1920 and has been continually used since that date principally as a title of a magazine but it has also appeared on publicity material and merchandising. She states that the magazine outsells its nearest rival by over 100,000 copies per month.

8 Ms Ramsden provides the following exhibits to her first statement:

YR1: An example of a trade advertisement and circulation figures printed from a web-site are provided which are said to be from the period 1999-2000 but the only dates these carry are the date they were printed from the web-site, which is 8 May 2003.

YR2: This is said to be an extract from the opponent's media pack. It is not dated.

YR3 & YR4: These provide the following figures for the IDEAL HOME magazine:

Year	Total Revenue	Promotional expenditure	Average circulation per month in UK
1994	5,994,000	272,000	211,533
1995	5,403,000	139,000	182,225
1996	5,444,000	194,000	202,257
1997	6,875,000	277,000	196,388
1998	4,697,000	224,000	181,684
1999	6,495,000	439,000	217,923
2000	7,189,000	854,000	210,745
2001	8,103,000	972,000	213,564
2002	9,583,000	792,000	232,490

YR5: Examples of trade press advertising of the magazine IDEAL HOME. Those items which are dated are prior to the relevant date and show use of the opponent's mark advertising its magazine.

YR6: These show use of the opponent's IDEAL HOME mark on a cassette and two books, however none are dated.

YR7: This exhibit is said to show use of the mark IDEAL HOME within the opponent's IDEAL HOME magazine. However, none of the exhibits are dated.

YR8: A copy of a page from the opponent's web-site dated 1999 is shown. This shows use of the opponent's IDEAL HOME mark.

YR9: Copies of statutory declarations and other materials supporting the registration application in 1943 are supplied. I do not intend to detail these as I do not find them useful in reaching my decision.

YR10: Examples of special offers on goods for the home and garden offered in the IDEAL HOME magazine are shown. Of the five offers, one is dated December 1997, three are dated October 2002 and one is dated April 2003.

YR11: This shows an advertisement for IDEAL HOME wallpaper which is dated September 2002, after the relevant date.

9 Ms Ramsden states that the magazine has won many awards and accolades over the years including two awards for Consumer magazine of the year in 2000. She states that:

“Without taking into account the background of usage and reputation, the words IDEAL HOME are not terribly distinctive, in trade mark terms. At the same time, it is true that the IDEAL HOME brand has become 100% distinctive of the Opponents in the United Kingdom in the “home interest” publications and retail sector and that the words IDEAL HOME have acquired a secondary meaning as a trade mark denoting the opponents' goods in the home interest sector ie those goods which pertain to home decoration, design and lifestyle, garden design and

lifestyle and information provided in visual or published format on these subjects including information on the retail of “home interest” goods.”

10) Ms Ramsden states that the drawing in the mark in suit is the “visualization of the IDEAL HOME Girl and refers back to the element and concept which underpins the entire mark, ie THE IDEAL HOME GIRL”. She states that it personifies the brand IDEAL HOME and calls the brand to mind. She states that she believes it is the applicant’s intention to target the female readership of the opponent’s magazine, and that “It is no secret that the vast majority of readers of home interest/lifestyle magazines including the IDEAL HOME readership are women (“girls”)”.

11) Attached to her second statement Ms Ramsden provided the following exhibits:

YR2: A set of figures showing the “brand awareness” of customers of magazines. Ms Ramsden states that 3% of those questioned (unprompted) stated that they were aware of the IDEAL HOME magazine whereas the average for other magazines was 1%. She states that 38% of the respondents affirmed their awareness of IDEAL HOME.

YR3: This shows the results of a survey carried out in 2001. Apparently 1000 “DIY enthusiasts” were telephoned and questioned. Ms Ramsden provides the views of the seventy-seven out of this sample who were readers of the magazine. I am not entirely sure what this is intended to show and regard it as being of little consequence.

12) Ms Ramsden states that in her view “there is a clear cross-over between popular lifestyle magazines and magazine-format television programmes. We have not yet progressed to television, but I do believe there is a heightened public interest at present in consumer and home interest television. Increasingly, television programmes are adopting a magazine-type format and are also now described as “magazines”, to indicate a style of programming with specific subjects and interests. A magazine style programme or web-site with a home interest theme, providing a shopping directory of goods and services would perform a very similar function to the opponents’ IDEAL HOME magazine, with its integral IDEAL HOME shopping directory”.

13) Ms Ramsden refers to a previous opposition by her company to Associated Newspapers registering the trade mark IDEAL HOME EXHIBITION. As each case is determined on its facts I do not find this of assistance in my decision. She states that she knows of no other magazine which has the words IDEAL HOME within the title. She states that “According to figures produced by the National Readership Survey, 72% of IDEAL HOME magazine readers are female”. She states that the average IDEAL HOME reader is typically female and could be referred to as the IDEAL HOME girl. She states that use of the mark IDEAL HOME by another party will adversely affect the opponent’s advertising revenue and would devalue the opponent’s brand. Ms Ramsden also provides her opinion on the confusability of the marks which do not assist me in my decision.

14) The opponent’s third witness statement, dated 24 October 2003, is by Jude Daniels the advertising director of the IDEAL HOME publication, a position she has

held since November 2000. At exhibit JD1 she provides figures for the top one hundred advertisers who have bought advertising space in IDEAL HOME magazine during the period January 2001-December 2003. These figures show that in the calendar year 2001 the opponent received over £2 million in advertising.

15) The fourth witness statement, dated 7 November 2003, is by Kieran Killeen the Head of Client Sales for the IDEAL HOME publication. He states that as part of his job he has daily contact with clients who are advertisers or potential advertisers. He states that he has been asked by clients whether IDEAL HOME provides an on-line advertising facility.

16) The fifth witness statement, dated 11 November 2003, is by Mark Harper the Head of Agency Sales for the IDEAL HOME publication. At exhibit MH1 he provides a copy of a letter from COM2 who he states is "one of our agency clients". The letter, dated 10 November 2003, states that the writer, Roy Chegwin of Com2 has become aware of a website entitled [www.idealhomegirl.co.uk](http://www.idealhomegirl.co.uk) which the writer believes is not connected to the opponent company. The writer provides his view that this may mislead customers into believing that the website is from the producers of the IDEAL HOME magazine and that this could undermine the credibility of the opponent's brand.

17) The sixth witness statement, dated 4 November 2003, is by Gavin Hyde-Blake a manager employed by Carratu International Plc, an investigation agency. At exhibit GH-B/1 he provides a copy of his report into the applicant company. The report shows that there are a number of companies all of which have Maureen Ennison shown as the Company Secretary and Director. All the company names begin with the words IDEAL HOME. Only one company, Ideal Home Ltd, has filed accounts and these show no turnover for the two years ending 31 December 1999 and 2000. He states:

"During the course of our conversation, Ms Ennison informed us that part of their services included the provision of models to support product launches, exhibitions and events. These were branded under the names "The Trendsetters" and "The Ideal Home Girls"."

And

"Ms Ennison said that the Ideal Home Girls had been used to open the Licensing Exhibition of 2002 and that they were in talks to use the Ideal Home Girls to launch the Ideal Home Show. During our conversation, Ms Ennison also informed us that Ideal Home would launch an online shopping channel through Ideal Home Broadcasting during 2004."

#### **APPLICANT'S EVIDENCE**

18) The applicant filed the same witness statement, dated 17 June 2004, by Maureen Ennison the Managing Director of the applicant company in each of the nine oppositions. She states that her company:

“4...creates develops and implements Innovative ideas, we have registered numerous companies within the Ideal Home Group to implement and launch our intellectual properties some of which are images developed for licensing media and TV.

5. We own the images of The Trendsetters- Kidz Kool and The Ideal Home Girls whom represent the company Ideal Home Limited. All images are protected by copyright, trademark; company logos are used in all advertising, which features the girls, and clearly display the company’s logo, and name So all association of The Ideal Home Girls are continually associated with Ideal Home Limited as the owner of The Ideal Home Girls as properties, and of the brand.”

19) Ms Ennison states that there are several companies who use the name Ideal Home “as a very small part of their brand”. She provides various exhibits relating to the Registry examination which do not assist me in my decision as the parties seem to be the two in the instant case or connected to the Ideal Home show. In any case there is no evidence of use of the trade marks provided and so it is effectively “state of the Register” evidence. She also provides copies of lists of attendees from various exhibitions which show both parties taking part in exhibitions although not at the same time. The exhibits also show how the applicant uses its brand. As part of the literature the name “ideal home ltd” is displayed inside a house which also contains a depiction of the globe which has an arrow across it with some writing. Unfortunately the image is so small that the writing cannot be read, indeed even the name of the company is extremely difficult to read. Ms Ennison appears to be claiming that the use of the company name along with the mark in suit and the manner in which it is used will serve to associate the mark with her company. As she puts it “This practice continues to provide the public with a distinctive association Of the product to the company, the general public are familiar with a brand That is widely used by different companies, without any confusion caused. Coca cola a prime example”.

20) In exhibit 609 the applicant’s advertisement appears in the same publication as one for the Ideal Home Show which is owned by a third party. The publication was printed by the opponent company. Ms Ennison claims that “This does not constitute confusion, neither does this provide any unfair Advantage between companies, It offers individual and distinctive properties That is distinguishable and unique to the individual companies whom Currently co-exist without any confusion by the public”.

21) Ms Ennison also states that “Confusion may arise if a company provides a questionnaire to the public, Which questions the distinctiveness or association of there own brand? Which is depicted in the following exhibit 611”. Exhibit 611 is a questionnaire apparently handed out by the opponent company at the Ideal Home Show which asks questions as to the magazines which the respondent reads and also asks the questions “Is Ideal Home magazine involved in organising the show you have visited today?” and “Would you be disappointed if Ideal Home magazine did not exhibit at the Daily Mail Ideal Home Show?”.

22) Ms Ennison contends that:

“36. I therefore submit that The Ideal Home Girls are now distinguishable And associated with Ideal Home Limited. They provide a wide spectrum Which is beyond the radius of home/lifestyle as the “name” of the girl Determines her field – I.T Technology/ Jetset- Travel/ Beauty-Cosmetics- Through their images on products /dolls/ cloths/ merchandise/ books/ TV For which It would be highly unlikely that “a magazine” for the home. Would compete or incur any loss of trade, or business.

37. A consumer whom buys the magazine, may have a computer, they may use Make up attend the ideal home show, purchase a treadmill or leotard that “fitness” promotes. However, in the twentieth century they are aware “brands Are bought and sold, just as IPC Media is now an AOL Time Warner Company. Ownership is distinguishable through advertising the product And the company name logo, for IDEAL HOME no individual can claim Total association unless this is as proprietor that is Ideal Home Limited.”

23) Most of the exhibits provided which relate to the activities of the applicant company show that they refer to themselves as the Ideal Home group and refer to the availability of the Ideal Home Girls to promote products. At exhibit 605 an advertisement for the applicant company states that “New Ideal Home Girls ...Mean Business”. It refers to “A brand new digital shopping channel”, “An online shopping portal” and “A quarterly shopping magazine with a circulation in excess of 10 million”.

#### **OPPONENT’S EVIDENCE IN REPLY**

24) The opponent filed another witness statement, dated 15 April 2005, by Ms Ramsden in each of the nine oppositions. She claims that the applicant’s evidence shows that the applicant is attempting to pass off its activities as being connected to the opponent. She also claims that the evidence shows that the applicant is using THE IDEAL HOME GIRL/S *solus*. She comments that the Ideal Home Show and The Daily Mail Ideal Home Show have existed for decades and co-exist with the opponent in the marketplace as their business activities do not overlap as the opponent is not involved in the provision of exhibitions. She also points out that Ideal Shopping Direct Plc’s application to register the mark IDEAL HOME HOME SHOPPING has been refused.

25) Ms Ramsden refers to the use by the applicant of “THE IDEAL HOME GIRLS” without the various prefixes such as TECHNO which she states are non-distinctive elements which do not distract from the central concept. She claims that the applicant’s evidence shows that the applicant is trying to break into the opponent’s market by exhibiting at the same shows and licensing events as the opponent and should not be considered as being on a par with IDEAL HOME SHOW or THE DAILY MAIL IDEAL HOME SHOW which have been in existence for many years. She points to exhibit 605 as an example of the applicant implying a link with the opponent with reference to a magazine with a circulation of over 10 million.

26) That concludes my review of the evidence. I now turn to the decision.

## DECISION

27) A number of preliminary points were raised. The first was regarding the evidence of Mark Harper. The applicant sought to have this evidence struck out. It was contended that the evidence given was false and the applicant sought to provide evidence to back up this contention. Mr Malynicz for the opponent pointed out that the evidence of Mr Harper had been submitted two years previously and had the applicant wished to file evidence in reply there had been ample time. However, as he did not rely upon evidence of confusion Mr Malynicz indicated that he was content that I should not rely upon Mr Harper's evidence. I will therefore take no regard to this evidence in my decision.

28) The applicant also attached a number of exhibits to the skeleton argument provided. Whilst most of these have already been provided as part of the applicant's evidence some were new to the case and so cannot be taken into account as they have not been correctly filed as part of the applicant's evidence.

29) The final point raised was regarding the issue of those trade marks which the opponent had sought to rely upon but which had been subsequently revoked. This issue affects trade mark no. 2121954 which was revoked with effect from 19 September 2002 and trade mark no. 620673 which was revoked with effect from 18 December 2002. This issue was considered by Mr James in *Franco's Riviera Cone* BL O/214/03 where he stated:

“12. The matter in dispute is whether the subsequent revocation of Stella's registration with effect from 21 May 2001 has the effect of either retrospectively extinguishing the earlier trade mark right or else preventing or limiting the proprietor's ability to continue to rely upon it.

13. Section 46(6) of the Act states that:

“Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

14. This appears to me to make it clear that the rights of the proprietor of a revoked registration continue to exist up until the date of the application for revocation, unless the Registrar is satisfied that the grounds for revocation existed at an earlier date. It is difficult to see how the Registrar could be so satisfied in the absence of a pleaded request from the applicant for the registration to be revoked at an earlier date. Failing this the Registrar is in most cases likely to be unsure as to whether, if challenged, the proprietor could have produced evidence of use of the trade mark in the five year period preceding the earlier date.

15. The “rights of the proprietor” cannot be deemed to have ceased only at the date of the application for revocation if the rights in the trade mark become unenforceable for any period following the act of revocation. Consequently, the trade mark remains enforceable in respect of matters arising at any time prior to the date at which the rights of the proprietor cease to have effect.

16. The position appears to be different when it comes to trade marks which lapse due to non-renewal or surrender. Unlike revocation, both of these situations stem from decisions of the trade mark proprietor himself. I do not find it surprising that the consequences of allowing a registration to lapse or to surrender it, might be different from the consequences of revocation forced on the proprietor by an application made by a third party.

17. As the Hearing Officer in *Transpay* [2001 RPC10] pointed out, section 6(3) of the Act expressly provides that:

“A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later trade mark for a period of one year after the expiry unless the Registrar is satisfied that there was no *bona fide* use of the mark during the two years preceding the expiry.”

18. It is noticeable that, unlike section 46(6), this provision does not specify a date from which the rights of the proprietor of the earlier trade mark are deemed to have ceased to have effect. Instead the provision governs the period within which the expired registration must “continue to be taken into account”. After that period has passed the expired registration need not be taken into account irrespective of the date of expiry. I agree with the Hearing Officer in *Transpay* in this respect.

19. The Act is silent on the consequences of surrender of a registration, although as the Hearing Officer in *Sundip* [BL O/021/02] pointed out, there are strong equitable grounds for holding that a proprietor who surrenders a registration (and thus shields the registration from subsequent revocation proceedings) should not thereby find himself in a stronger position than a proprietor who faces an application for revocation, which carries with it the possibility of a back dated revocation of the proprietor’s trade mark. I agree with the Hearing Officer in *Sundip* that a registration should no longer be taken into account once it is surrendered. To find otherwise would be to provide proprietors with a means of frustrating applications, or potential applications, for revocation under the terms of section 46(6)(b) of the Act.

20. The net result of this is that it is vital for a party seeking to revoke an earlier trade mark in order to clear the way for its own application, or to resist an application to have its own registration declared invalid on the basis of the earlier trade mark, to make a request in its application for the conflicting earlier trade mark to be revoked with effect from a date which precedes the date of its own application for registration.

21. That did not happen here and I cannot accept Franco's tentative invitation to speculate about what the outcome might have been if revocation had been sought from an earlier date."

30) I adopt the position set out above which means that as the opponent's marks have been subject to revocation proceedings but were revoked after the date of the applications, the opponent's marks were valid at the relevant date and must be taken into account in these proceedings.

31) I now consider the first ground of opposition under Section 5(2)(b) which reads:

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

- (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."

32) An "earlier trade mark" is defined in Section 6, the relevant parts of which state:

"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,"

33) The opponent's six trade marks have effective dates between 22 October 1942 and 17 November 2000 and are plainly "earlier trade marks".

34) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] E.T.M.R. 1, *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* ;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel BV v Puma AG*, 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.*;

- (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*;
- (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*;
- (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.*;
- (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*;
- (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*;
- (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*;
- (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.*

35) In essence the test under Section 5(2) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion, I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the marks applied for and the opponent's marks on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

36) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the

European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those trade marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

37) The opponent’s marks are inherently distinctive when used on the goods and services for which they are registered, with the exception of books, magazines, radio and television programmes about the home. The opponent has also filed evidence of use of its “IDEAL HOME” mark on magazines since 1920. They have provided revenue, promotional and circulation figures for the magazine which shows that it has a substantial readership in the UK as well as significant advertising revenues. The applicant does not contest that the marks have been used on a “life style magazine”. Although the applicant does contend that it has used its marks concurrently for a number of years without any evidence of confusion. However, the applicant did not provide evidence of such concurrent use and the opponent has filed evidence to show that the accounts filed at Companies House show that the applicant company is not trading. The applicant also claimed that other companies use the mark “IDEAL HOME”. Apart from the use by the Daily Mail newspaper on its annual exhibition there was no evidence of others using the mark in the UK. I believe that the opponent has shown that, in relation to magazines, it can benefit from an enhanced reputation.

38) I now turn to the comparison of the specifications of the two parties and take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, 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 intended purpose and their method of use and whether they are in competition with each other or are complementary.”

39) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

40) In my view the opponent’s strongest case is under three of its IDEAL HOME marks. Trade Mark no.1260437 for Class 16, 2121954 for Class 41 and 2253401 for Class 35. These identical marks will therefore be used in the comparison of goods and services. The specifications in all nine of the applications are identical in respect of Classes 35 and 41 whilst eight are identical in relation to Class 16 (the ninth mark, 2292747, does not have Class 16 as part of its specification) and so only one specification has been reproduced. For ease of reference the relevant parts of the two parties’ specifications are reproduced below:

Opponent’s specifications	Applicant’s specification
1260437: Class 16: Printed publications and periodicals.	Class16: Paper, cardboard and goods made from these materials; printed matter; printed publications, catalogues, magazines, stationery, plastic materials for packaging.
2253401 Class 35: The bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods by mail order from a magazine.	Class 35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise Internet website, the bringing together, for the benefit of others, of a variety of goods, through a television shopping channel or general merchandise catalogue, enabling customers to conveniently view and purchase those goods by means of telecommunications or by mail order.
2121954 Class 41: Entertainment, education and instruction by or relating to television, radio or films; production, presentation and rental of television and radio programmes, of films and of sound and video recordings.	Class 41: Entertainment; production of radio and television programmes, provision of television and radio entertainment.

41) To my mind the opponent’s specification in Class 16 encompasses the applicant’s specification with the exception of “Paper, cardboard and goods made from these materials; stationery, plastic materials for packaging”. Despite the goods that I have listed being in the same Class as the goods in the opponent’s specification I do not regard them as similar and this point was not contended by the opponent at the hearing.

42) With regard to the Class 35 specifications of the two parties there is clearly identity with regard to the mail order element. Ordering by use of the Internet or via the television by way of an interactive screen and/or a telephone connection must be considered similar in that it is the same essential service simply using a different medium.

43) Lastly, regarding the Class 41 specifications the opponent’s specification clearly encompasses the whole of the applicant’s services.

44) I now move on to consider the marks of the two parties. The opponent contended that the applicant's marks are essentially a name followed by "THE IDEAL HOME GIRL". Mr Malynicz contended that "The name will be perceived as the name of the character, but her association will be IDEAL HOME. She is the IDEAL HOME GIRL. We say that it is that part of the mark that has the trade mark significance".

45) The opponent referred me to the decision of the European Court of Justice in case C-3/03 P *Matratzen Concord GmbH v. OHIM* dated 28 April 2004. In this case the Court stated that the assessment of the similarity between two marks must be based on the overall impression created by them, in light, in particular, of their distinctive and dominant components. This does not mean taking only one component of a complex trade mark and comparing it with another mark, but, on the contrary, it entails examining the marks in question, each considered as a whole. However, it pointed out that that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.

46) The applicant's trade marks all consist of a drawing of a female attired in a manner which serves to emphasize the character so that "Fitness" is dressed for the gym, "Jooles" is festooned in jewellery and so forth. The nine characters, "Techno", "Fitness", "Money", "Jooles", "Gadget", "Beauty", "I.T.", "DIY" and "Jetset" all have the words "THE IDEAL HOME GIRL" after their name. To my mind none of the "names" of the characters is particularly descriptive when used on the goods and services for which the marks have been applied for. They could be said to relate to the subject matter of a magazine or TV/radio programme or to reflect the category of goods or services for sale but this is highly generalised. To my mind the large drawing of the female character will be largely ignored once the average consumer notices the characters name. It is an accepted principal that words speak louder than devices and in this case the name of the character will linger in the memory rather than the stylised representation. Clearly, the average consumer will also note that the character portrayed is "THE IDEAL HOME GIRL".

47) Clearly, there are significant visual differences between the marks of the two parties, but in terms of the dominant and distinctive characteristics these differences are considerably reduced. It is notable that the distinctive and dominant aspect of the applicant's marks incorporates the opponent's mark. Aurally there are differences as well as similarities. Conceptually the applicant's marks promote the idea of a female who irrespective of her name is "THE IDEAL HOME GIRL". The drawing and naming of the character is the embodiment of the idea of "THE IDEAL HOME GIRL". There is therefore a conceptual link between the marks of the two parties.

48) In making the above comparisons I have treated all of the applicant's marks as though they were the same. Whilst the drawings are clearly different as are their names I do not believe that the opponent has a stronger case against any of the marks and that the dominant and distinctive characteristics are essentially identical in being a name followed by the phrase "THE IDEAL HOME GIRL".

49) Taking into account all the factors that I have outlined above it is my opinion that in relation to the goods and services that I found to be similar earlier in this decision

that the marks of the two parties are similar enough that there is a likelihood of confusion or an association in that the public would wrongly believe that the respective goods and services come from the same or economically linked undertakings. The opposition under section 5(2)(b) succeeds in relation to the following goods and services:

In Class 16: “Printed matter; printed publications, catalogues, magazines.”

In Class 35: “The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise Internet website, the bringing together, for the benefit of others, of a variety of goods, through a television shopping channel or general merchandise catalogue, enabling customers to conveniently view and purchase those goods by means of telecommunications or by mail order.”

In Class 41: “Entertainment; production of radio and television programmes, provision of television and radio entertainment.”

50) But the opposition under Section 5(2)(b) fails in relation to the following goods in Class 16 “Paper, cardboard and goods made from these materials; stationery, plastic materials for packaging”.

51) I now consider the ground of opposition under Section 5(3) which in its original form reads:

“5-(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 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.”

52) By virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, Section 5(3)(b) has now been repealed. The equivalent provision in Section 10 of the Act dealing with infringement has also been amended. As the explanatory note indicates:

"These amendments implement the decision of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* of 9th January 2003 (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* of 23rd October 2003 (C-408/01). Those decisions determined that Article 5(2) of the Directive, which on the face of it, grants a right to the proprietor of a trade mark to prevent third parties from using an identical or similar trade mark in relation to goods or services which are *not similar* where the earlier trade mark has a reputation and

use of that sign takes unfair advantage or is detrimental to the distinctive character of that earlier trade mark, also applies to goods or services which are similar or identical to those for which the earlier trade mark is registered."

53) Notwithstanding the broader interpretation of Section 5(3) (Article 5(2)) that has now been confirmed by the ECJ, the opponent's claim here is based on the fact that the respective goods and services are dissimilar.

54) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* BL/455/00 and, more recently *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2004] EWHC 1498 (Ch).

55) Mr Malynicz made it clear at the hearing that he was contending that the applicant's marks were parasitic and undermine the distinctive character of the opponent's marks. The opponent does not claim that the applicant's marks would cause detriment or tarnishing.

56) The first hurdle that the opponent has to get over is the question of reputation. I have dealt with this earlier in this decision but reiterate for clarity that the opponent has established that it has amongst the general public of the UK a significant reputation built up over decades with regard to its "life style" magazine. The applicant did not contest that the opponent has such a reputation for magazines, although the applicant did dispute that there has been concurrent use without confusion, and also that other parties also use the mark "IDEAL HOME". However, the applicant did not provide evidence to corroborate such assertions (other than the use by the Daily Mail in relation to its annual exhibition) whilst the opponent has filed evidence in relation to the accounts filed at Companies House by the applicant which show that it is not trading. The applicant also claimed that other companies use the mark "IDEAL HOME" (see paragraph 19). The opponent has therefore, to my mind, established that it has the reputation necessary under the *Chevy* test for an action under this ground to succeed.

57) Earlier in this decision I found that the following goods in Class 16 were not similar to the opponent's goods in the same Class: "Paper, cardboard and goods made from these materials; stationery, plastic materials for packaging". In addition, I should also consider the applicant's services under Class 41 in case I am found to be wrong regarding the revoked trade mark 2121954. The applicant's Class 41 services cannot be said to be similar to any of the services that the opponent has registered under its other marks 1260437 or 2253401.

58) I therefore have to consider whether registration of the applicant's marks would harm the character or repute of the registered marks or give the applicant some benefit to which they are not entitled. The opponent's reputation is for a lifestyle magazine. To my mind the average consumer would assume that any radio or television programmes using any of the applicant's marks had an association or connection with

the opponent as the production of so called “magazine” programmes was, at the relevant date, common practice. Thus the applicant would benefit from the reputation of the opponent and such use on Class 41 services would be parasitic.

59) Similarly, any use of the applicant’s marks on the goods in Class 16 detailed in paragraph 56 above would reduce the distinctiveness of the opponent’s marks and the applicant would benefit from the opponent’s reputation.

60) In considering the issue under this Section I have to also consider whether the applicant had due cause to use the marks it seeks to register. The applicant is silent as to why these particular marks were chosen, and why it is seeking to register them for the goods and services specified. The applicant cannot therefore gain relief under this provision of the Section. The opposition under Section 5(3) is therefore successful with regard to the goods in Class 16 and the services in Class 41.

61) I now turn to the other ground of opposition under Section 3(6) which reads:

“3.(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

62) Section 3(6) has its origins in Article 3(2)(d) of the Directive, the Act which implements Council Directive No. 89/104/EEC of 21 December 1988 which states:

“Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that...

(c) the application for registration of the trade mark was made in bad faith by the applicant.”

63) The Directive gives no more clue as to the meaning of “bad faith” than the Act. Subsequent case law has avoided explicit definition, but has not shirked from indicating its characteristics. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J stated at page 379:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

64) In *Harrison v Teton Valley Trading Co* [2004] EWVA Civ 1028, the Court of Appeal confirmed that bad faith is to be judged against a combined objective and subjective test. At paragraphs 25 and 26 of their decision they said:

“25. Lord Hutton went on to conclude that the true test for dishonesty was the combined test. He said:

“36. ....Therefore I consider.....that your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he sets his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct.”

26. For my part, I would accept the reasoning of Lord Hutton as applying to considerations of bad faith. The words “bad faith” suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However, the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.”

65) Finally, more recently the Privy Council considered earlier authorities in *Barlow Clowes International Ltd (in liquidation) & Others v Eurotrust International Limited & Others*, (Privy Council Appeal No 38 of 2004 on which judgment was delivered on 10 October 2005 - not reported at the time of writing). In particular, their Lordships considered a submission from Counsel that an inquiry into the defendant’s views about standards of honesty is required. The following passage from Lord Hoffman’s judgment sets out the position as follows:-

“[Counsel for the defendant] relied upon a statement by Lord Hutton in *Twinsectra Ltd v Yardley* [2002] 2 AC 164, 174, with which the majority of their Lordships agreed:

“35. There is, in my opinion, a further consideration which supports the view that for liability as an accessory to arise the defendant must himself appreciate that what he was doing was dishonest by the standards of honest and reasonable men. A finding by a judge that a defendant has been dishonest is a grave finding, and it is particularly grave against a professional man, such as a solicitor. Notwithstanding that the issue arises in equity law and not in a criminal context, I think that it would be less than just for the law to permit a finding that a defendant had been ‘dishonest’ in assisting in a breach of trust where he knew of the facts which created the trust and its breach but had not been aware that what he was doing would be regarded by honest men as being dishonest.

“36. .... I consider that the courts should continue to apply that test and that your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he set his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct.”

15. Their Lordships accept that there is an element of ambiguity in these remarks which may have encouraged a belief, expressed in some academic writing, that *Twinsectra* had departed from the law as previously understood and invited inquiry not merely into the defendant's mental state about the nature of the transaction in which he was participating but also into his views about generally acceptable standards of honesty. But they do not consider that this is what Lord Hutton meant. The reference to "what he knows would offend normally accepted standards of honest conduct" meant only that his knowledge of the transaction had to be such as to render his participation contrary to normally acceptable standards of honest conduct. It did not require that he should have had reflections about what those normally acceptable standards were.

16. Similarly in the speech of Lord Hoffmann, the statement (in paragraph 20) that a dishonest state of mind meant "consciousness that one is transgressing ordinary standards of honest behaviour" was in their Lordships' view, intended to require consciousness of those elements of the transaction which make participation transgress ordinary standards of honest behaviour. It did not also require him to have thought about those standards were."

66) It is clear from the above that an allegation of bad faith is a serious matter and the threshold test is a relatively high one. It is equally clear that there is a clear onus on the party making the allegation of bad faith to establish their case. Normally this would require evidence to be filed if the allegation is to get to first base. Where the case involves determining the other party's motives, this raises obvious difficulties. However if relevant basic facts can be established then, to my mind it is permissible to draw conclusions by inference. The basic facts in this case are:

- The opponent made a specific charge in the pleadings that the applicant had no bona fide reason to choose the trade marks it was seeking to register. The opponent claimed that the applicant was aware of the opponent's reputation in the mark IDEAL HOME and was seeking to exploit any mis-association between the opponent's mark IDEAL home and the marks in suit.
- The applicant in its counterstatement denied that the opponent's magazine IDEAL HOME was well known and enjoys a substantial reputation.
- The applicant claimed to have been using the name Ideal Home Limited for several years without confusion between the two parties.
- The applicant contends that use of its company name, Ideal Home Ltd, on its literature in conjunction with the trade marks in suit will serve to associate the mark with her company.
- The applicant has registered numerous company and domain names all centred around the words IDEAL HOME. The applicant has also claimed to have been using the marks and the company name for a number of years. It has filed photographs associating itself with the Ideal Home Show by the provision of models dressed in costumes similar to those shown in the trade marks.

- The applicant has provided copies of its advertising where reference is made to “A quarterly shopping magazine with a circulation in excess of 10 million”. Even in the skeleton argument the applicant claims that “The Ideal Home Girls are currently existing within their own right within the licensing industry. And have been promoted worldwide over the past three years without any evidence of confusion.” Yet the opponent has filed evidence that only one of the applicant’s companies has filed a return at Companies House and this showed that it was not trading.
- The applicant has been silent on the reasons for choosing the words IDEAL HOME as the main identifier in its various company names, domain names and trade mark applications. Equally it has been silent on the subject of why it should seek registration in goods and services which so closely shadow those of the opponent and which do not appear to reflect the actual activities in which the applicant is engaged.

67) Despite the clear attack the applicant has not responded, other than by denials. The applicant has made claims of extensive use which have not been substantiated. Equally, it could have met the charge that it is not trading by filing invoices or company accounts. The registration of so many company and domain names has not been explained nor has the applicant answered the simplest charge as to why it chose IDEAL HOME as the basis for its identity. The decision not to provide such must result in the opponent succeeding under the ground of opposition under Section 3(6).

68) In view of the above I do not need to consider the ground under Section 5(4)(a), although I have no doubt that it would have followed my decision under Section 5(2)(b).

69) As the opponent has been successful it is entitled to a contribution towards its costs. In considering the costs I take into account the serious nature of the allegation under Section 3(6) which was proven, although I have not exceeded the normal Registry scale. I have taken into account the fact that although the nine oppositions were filed separately there has been only one hearing and that the evidence was, broadly speaking identical. I order the applicant to pay the opponent the sum of £10,050. This sum 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 14<sup>th</sup> day of February 2006**

**George W Salthouse  
For the Registrar  
the Comptroller-General**

**ANNEX A**

**MARKS APPLIED FOR:**

Number	Trade Mark
2292709	 <p>TECHNO THE IDEAL HOME GIRL</p> <p>techno the ideal home girl</p>
2292720	 <p>FITNESS THE IDEAL HOME GIRL</p> <p>fitness The ideal home girl</p>
2292722	 <p>MONEY THE IDEAL HOME GIRL</p> <p>money the ideal home girl</p>

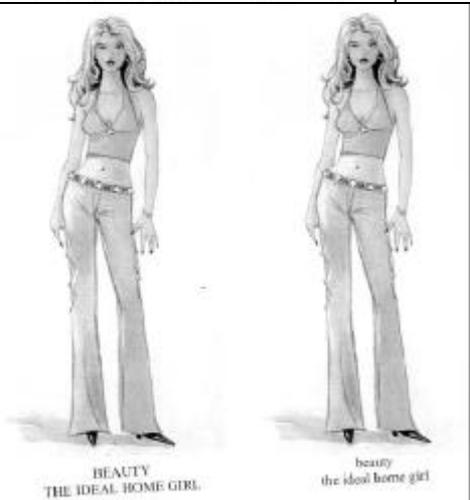
2292723



2292724



2292726



2292742



I.T.  
THE IDEAL HOME GIRL

II.  
the ideal home girl

2292746



DIY  
THE IDEAL HOME GIRL

diy  
the ideal home girl

2292747



JETSET  
THE IDEAL HOME GIRL

jet set  
the ideal home girl