

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

**IN THE MATTER OF APPLICATION NO 1568121
IN THE NAME OF GLOBE SPA**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45679 IN THE NAME OF
ADVANCE MAGAZINE PUBLISHERS INC**

**TRADE MARKS ACT 1938 (AS AMENDED)
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**IN THE MATTER OF Application No 1568121
in the name of Globe S.p.A.**

AND

**IN THE MATTER OF Opposition thereto
under number 45679 in the name of
Advance Magazine Publishers Inc.**

Background

On 8 April 1994, Globe S.p.A. of Via Andrea Doria, 17, Milano, Italy, applied to register a series of two trade marks in Class 25 in respect of the following goods:

Stockings, tights, socks; all included in Class 25.

The application is numbered 1568121 and the mark applied for is as follows:



The application was accepted on a limitation of the first mark to the colours blue and black, and on the basis of a disclaimer to the exclusive use of the letter “G” and the words “Glamour”, “Calze e Collants”.

On 10 October 1996, Advance Magazine Publishers Inc. filed notice of opposition to this application. The grounds of opposition are in summary:-

Under Section 10(3) Because use of the applicants' mark would constitute an infringement of the opponents' trade mark numbered 1459751.

5 **Under Sections 9(1)(d)** Because the word GLAMOUR is a laudatory epithet.

10 **Under Sections 9(1)(d)(e) and Section 10(1)** Because the word CALZE means socks, stockings and/or tights and the word COLLANTS means stockings or tights in English and are descriptions of the goods.

15 **Under Section 11** Because the opposed mark is no more than a description of the goods and is laudatory and descriptive.

The applicants for registration filed a counterstatement in which they deny the grounds of opposition. They ask that the registrar exercise his discretion and refuse the opposition and that they be awarded costs.

20 Both sides filed evidence in these proceedings. The matter came to be heard on 7 February 2000 when the applicants were represented by Mr Alan Rackham of Lloyd Wise Tregear, their trade mark attorneys, the opponents were represented by Mr John Rubenstein of Manches, their trade mark attorneys.

25 By the time this matter came to be determined, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Trade Marks Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the 1938 Trade
30 Marks Act.

Opponents' evidence

35 This consists of a Statutory Declaration dated 9 July 1997 and comes from Eric Campbell Anderson, a Company Director and Executive Vice president of the opponents' company. Mr Anderson confirms that unless otherwise stated the facts in the Declaration come from his own knowledge or derived from the company records.

40 Mr Anderson says that his company is the owner of trade mark registration number 1459751 for the word GLAMOUR registered in respect of magazines being printed periodicals, and refers to exhibit ECA1 which is a copy of the registration certificate. He says that since January 1982 the opponents have been the publisher of a magazine in the United Kingdom under the name GLAMOUR. He says that in March 1995 the title was incorporated into French Vogue published by Les Publications Conde Nast SA, a subsidiary of the opponents, and that the mark GLAMOUR
45 appears of the spine of that magazine. Mr Anderson says that by a registered user agreement recorded on 10 November 1994, an Italian edition of GLAMOUR has been published in the United Kingdom by Edizioni Nast SPA, a subsidiary of the opponents.

Mr Anderson refers to exhibit EAC2 which consists of a marketing system title analysis report dated 10 October 1996 listing the monthly copy sales for editions of GLAMOUR magazine from January 1982. The figures are very modest in terms of copies sold and shows no sales in some months. Mr Anderson says that the number of copies sold reflects the number of purchasers but that more people will actually read the magazine.

Mr Anderson next refers to exhibits EAC3 and EAC4 which consist of copies of the cover of GLAMOUR magazine. The first exhibit shows a cover dating from February and although no year is shown he says that he has been told the edition is from 1981. The second exhibit includes the contents page from editions said to have been published in 1996 and Mr Anderson refers to the extent to which fashion is featured. Mr Anderson sets out his understanding of the magazines identity which he says is representative of high quality and style and is a leading publication within the women's lifestyle market, and goes on to refer to the famous names from the fashion industry that have been associated with or featured in the magazine.

Mr Anderson says that the overseas editions of the magazine carried extensive fashion coverage and refers to exhibit EAC5 and EAC6 which consists of the cover, contents page or articles from the Italian and French editions of GLAMOUR magazine. He says the magazine is well known for its coverage and analysis of fashion and frequently advertises the products of clothing manufactures, referring back to exhibit EAC4. Mr Anderson says that the Italian, French and the US editions are read in the United Kingdom and he recounts information that he has been given relating to the readership and availability of the Italian edition of the magazine.

Mr Anderson goes on to set out his understanding of the details of the application based on information provided by his professional representative. He describes the mark as GLAMOUR CALZE E COLLANTS, a word logo, and that he is not aware of any disclaimer of the word GLAMOUR, although in fact, all rights to the words mentioned have been disclaimed. He contends that the positioning of the word GLAMOUR at the beginning of the mark will deceive the public and cause confusion by being linked to the cachet of the opponents' registered mark and its association with the magazine. He notes that CALZE and COLLANTS are both descriptive saying that CALZE is the Italian word meaning socks, stockings and/or tights in English and that the word COLLANTS is the French word for stockings or tights, and that the mark means GLAMOUR STOCKINGS AND TIGHTS. Mr Anderson goes on to say that the word GLAMOUR on its own is not descriptive although when used in connection with clothing is laudatory and that there is an association with the opponents' goods and reputation in the United Kingdom..

Applicants' evidence

This consists of two Statutory Declarations, the first dated 3 April 1998 comes from Giampiero Borroni, Sales Manager of Globe S.p.A., a position he has held since 1996. Mr Borroni says that from 1969 he held positions with other Italian companies where he had special responsibility for dealing with tights and stockings. He says that he has full access to company records and that he has, as far as possible, verified the facts contained within his statement.

Mr Borroni says that the applicants adopted and first used the trade mark in 1993 and sets out their activities to register the trade mark in the United Kingdom and elsewhere. He says that the

mark has been used in relation to stockings, tights and socks, and was first used in the United Kingdom in 1966, (which from the earlier date appears to be a typographical error) and that to date the applicants have sold more than \$60,000 which represents more than 40,000 units. He says that they have sold goods in more than 38 countries and are not aware of any instances of confusion. Mr Borroni says that between 1993 and 1995 the applicants have spent some 2,000 million lira (£679,117) and a further 1.3 billion lira on promotion and he cannot see how the customers shared by the opponents and the applicants cannot have come into contact with the trade mark.

Mr Borroni says that the lack of confusion can be attributed to the parties being in separate fields of activity. He says that the only similarity between the respective marks is the word GLAMOUR which is descriptive and synonymous with fashion, clothing and appearance, saying that the description fashion magazine used by Mr Anderson to describe the opponents publication could equally have been glamour magazine. Mr Borroni goes on to say that the applicants use the word GLAMOUR to promote the glamorous nature of their goods, but that the mark must be looked at as a whole, referring to the elided letters G. He repeats his arguments based on his view that the word GLAMOUR is so descriptive of the content of the magazine and the nature of the goods that anyone seeing the word used as a magazine title and as part of the applicants trade mark would not be confused.

Mr Borroni goes on to refer to exhibits 1 and 2 which he says demonstrate the descriptive nature of the word GLAMOUR, and notes that the article refers to the GG GLAMOUR brand. He next goes to Mr Anderson's Declaration drawing on the fact that he only refers to the applicants' trade mark as being the word GLAMOUR. He sets out the elements comprising the mark concluding that when considered as a whole there is no risk of confusion with the opponents registration for the trade mark GLAMOUR. He ends by referring to a Declaration filed by Anthony Charles Rackham which I shall come to next.

The second Statutory Declaration is dated 28 April 1998 and comes from Anthony Charles Rackham, a Registered Trade Mark Agent and fellow of the Institute of Trade Mark Agents. Mr Rackham says he is a partner in the firm of Lloyd Wise Tregear & Co and that he has been responsible for the handling of the trade mark application which is the subject of these opposition proceedings.

Mr Rackham goes to the claim to a reputation in the word GLAMOUR in respect of a magazine made by Eric Campbell Anderson in his Statutory Declaration, saying that he recently noticed a magazine which used the word GLAMOUR on the cover, a copy of which is shown as exhibit ACR1. This consists of the cover and contents pages from the March 1998 edition of a magazine called RED and which bears the words MODERN GLAMOUR - HOW TO GET IT - WHERE TO BUY IT, noting the descriptive use of the word GLAMOUR.

Opponents' evidence in reply

This consists of a Statutory Declaration dated 1 November 1998 and comes from John Stanley Yerbury Rubenstein, a partner in the firm of Manches & Co, the solicitors and agents for the opponents in these proceedings. Mr Rubenstein says that unless otherwise indicated the Declaration comes from his own personal knowledge.

Mr Rubenstein goes to the Declaration filed by Mr Borroni in which he says that they chose the trade mark in 1993 noting the inconsistency with the later date of 1966 claimed as the date of first use in the United Kingdom. He expresses his opinion that the extent of the applicant's trade in the United Kingdom is of little significance and notes that the company profile shown as exhibit 1 to Mr Barroni's Declaration does not mention, nor contain any evidence that the applicants had traded in the United Kingdom prior to filing the application.

Mr Rubenstein highlights that the promotional expenditure given by Mr Barroni posts date the date of application, does not apportion the amount spent in relation to the United Kingdom, nor show any examples of the promotional materials. He draws the conclusion that the lack of confusion can be attributed to the lack of any evidence of use or advertising in the United Kingdom.

Mr Rubenstein next refers to the registration of the trade mark GLAMOUR by the opponents which he says was accepted on the basis of the long use they had made of it. He agrees that the word GLAMOUR can be used descriptively, and goes on to consider the example of the use of the word on the cover of RED magazine shown at exhibit ACR1. He returns to the use that the opponents have made of the word GLAMOUR and detailed in Eric Campbell Anderson's Declaration. Mr Rubenstein refers again to the use of the word GLAMOUR in the company profile and in exhibit 2, asserting the although the word is disclaimed it is a principal part of the mark, the device being of minor importance and the words CALZE E COLLANTS being de minimis.

He refers to his knowledge of the Italian language on which he basis his opinion that the words CALZE E COLLANTS mean socks, stockings and tights and consequently describe the applicants' goods. Mr Rubenstein makes a number of points about the exhibits to Mr Borroni's Declaration relating to the applicant's advertising activities, noting that none relate to the United Kingdom.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

I will turn first to the ground founded under Section 10(3) of the 1994 Trade Marks Act. Schedule 3 paragraph 10 of that Act makes it clear that a trade mark application which is pending at the commencement of that Act, as was the position in this instance, is to be dealt with under the 1938 Trade Marks Act. Consequently, Section 10(3) does not constitute a valid ground for opposition and is dismissed accordingly.

Turning next to the ground founded under Section 9(1)(d)(e) and Section 10(1). Although Section 9 has been included in the grounds of opposition I do not consider it necessary to determine whether the application meets the requirements of that section, as to do so would not make any material difference to this decision. The application was found to be acceptable under Section 10 which poses a lower test than Section 9, and it follows that if a mark fails to qualify for registration under Section 10 it must also fail under Section 9. I therefore need only consider whether the mark qualifies for registration under Section 10 of the Act, which reads as follows:

5 **10.-(1)** In order for a trade mark to be registerable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

10 **(2)** In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which:-

10 **(a)** the trade mark is inherently capable of distinguishing as aforesaid; and

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

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

20 The opponents' objection under Section 10(1) is directed towards the words CALZE and COLLANTS which they say are mere descriptions of the goods and add nothing to distinguish. Mr Rackham did not dispute the meanings ascribed by the opponents and accepted that they and also the word GLAMOUR were devoid of any distinctive character for the goods covered by the application, a position acknowledged by the fact that the application had proceeded with a disclaimer of these elements.

25 In the mark as applied for, the most dominant element is in my view the device of two elided letters G. In the Forde-Werke AG case (1955) 72 RPC 191, Lloyd-Jacob J referring to the Registrar's practice in relation to monograms said:

30 Whilst it is plain that in each case the Hearing Officer cannot avoid (and, so far as I know, never seeks to avoid) the ultimate responsibility of deciding on the presence or absence of such distinctiveness as the type of application requires for its acceptance, rules of practice are in operation in the Trade Marks Registry to facilitate his task; and the Registrar, by his Counsel, has informed the Court of those which are relevant to the cited applications.

40 They are as follows: (1) Monograms, if of three or more letters, are prima facie considered to be adapted to distinguish; and, if of two letters, are prima facie considered capable of distinguishing. Capacity to distinguish may also be inferred if two letters not monogrammed, and therefore showing a definite sequential order, are so run together as to involve an elision of part of one of the letters. (2) If to a letter or letters some additional features are added (other than borders or decorative features of non-distinctive character), so as to create a combined device, the presence of such letter or letters will not prevent a finding of distinctiveness, but in general their exclusive use will need to be disclaimed. (3) If to some other integer a letter is introduced in such a manner which does not plainly identify it as such letter, the combination may be adapted to distinguish, although the exclusive use of the letter may need to be disclaimed. (4) A combination of non-distinctive

integers, one of which consists of one or two letters, may in the totality possess distinctiveness, although disclaimer may be required of some or all of the component parts.

5I have heard no argument on the propriety of these categories and I am far from certain that, in expressing them in my own language, I have accurately delimited them. It is suffice for the present purposes to say that I can see no objection to the system of practice directions as at present operating in the Trade Marks registry, nor any prima facie reason for questioning the four rules of practice to which I have referred.”

10 Consisting as it does of two elided letters it is clear that on the above the element qualifies prima facie for registration as a mark capable of distinguishing. Setting aside the practice and considering the marks as at first sight, it seems to me that the element has more of the appearance of a device, particularly as the letters are elided back to back in the form of a mirror image. I do not see how other traders would, without improper motive wish to use the trade mark in the ordinary course of trade, and with this, and my earlier comments in mind I have no difficulty in accepting the element as a trade mark rightly accepted as capable of distinguishing and the objection founded under Section 10(1) fails accordingly.

20 This leaves the matter of the ground founded under Section 11. That section reads as follows:-

25 **11** It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

30 The objection set out in the statement of grounds is not that clear and seems to allege that the mark is laudatory and descriptive of the goods applied for and would be deceptive if not used in relation to such goods. However, the evidence and Mr Rubensteins’ submissions at the hearing go wider than this to allege a likelihood of confusion or deception based on the opponents’ user of the mark GLAMOUR. Neither party disputes that the words GLAMOUR and CLAZE E COLLANTS are descriptive or laudatory but as the mark is sought to be registered in respect of the goods described, namely socks, tights and stockings, I consider the allegation that the mark would be deceptive to be unfounded. I will therefore turn to consider the position with regard to the opponents’ use.

40 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd’s application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

45 Having regard to the opponents’ user of the mark GLAMOUR, is the tribunal satisfied that the mark applied for if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

The test requires me to consider the user established by the respective parties at the relevant date,

that is, the date of the application for registration of the trade mark under opposition. The opponents claim to have first used their mark in the United Kingdom in January 1982 in relation to a magazine sold under the title GLAMOUR. There is nothing in the evidence showing the mark in use at that date, and much of what has been provided is either undated or dated after the
5 relevant date and is of little assistance. However, exhibit EAC2 lists copy sales for GLAMOUR magazine dating from 1982 and which, if considered in conjunction with other exhibits showing GLAMOUR being used as would be expected as a magazine title I am prepared to accept are representative of, and substantiate use of the trade mark GLAMOUR from the date claimed. The
10 monthly copy sales up to 1991 rarely reached above 2,000 and thereafter averaged between 3 - 4,000, which is not a particularly significant figure for an inexpensive, general interest magazine for women. The opponents seek to bolster this by including sales of French and Italian language editions although the figures given show an even smaller circulation for these editions and consequently they add little.

15 The opponents point to the features and advertisement related to fashion that appear in their magazine which they say establishes a link with clothing, the goods covered by the application. That the opponents' magazine contains advertisements and features related to clothing does not in my view create an expectation in the minds of the public that the magazine itself would also sell
20 clothing, nor is there any convincing evidence that it is customary for magazines to do so. The most that can be said is that the use of the trade mark GLAMOUR on an item of clothing may remind purchasers familiar with the opponents publication of that magazine, but in my view they would not be deceived or confused into thinking that there is some connection.

25 Titles of magazines by their nature tend to make varying degrees of reference to their subject matter or target readership, and consequently many have a low level of distinctiveness. The word GLAMOUR is no exception. It is an ordinary and well known word in the English language which readily conveys the idea of clothing, make-up, etc, and given that the opponents say that their magazine sold under the GLAMOUR trade mark is well known for its features relating to
30 fashion and related topics I consider that it falls into the category of a mark with a low degree of distinctiveness. I make this observation only insofar as to say that as it is not the strongest of marks this is likely to impact on customer perception of the mark and the issue of confusion.

35 The opponents point to an advertisement forming exhibit 2 to Giampiero Borroni's Declaration which shows that the applicants have used their trade mark with the word GLAMOUR in larger text relative to the device than in the version applied for. They argue that the form in which it has been used the word has a greater degree of significance and should be taken into account when considering the likelihood of confusion. The exhibit is an example of the way the applicants may represent their mark in normal and fair use and I have no argument with the contention that the
40 word GLAMOUR is a more prominent element than in the mark applied for. I am also aware that in composite marks it is said that "words talk" although I cannot ignore the impact of the device element.

45 The question posed by the test referred to above is whether there will be deception and confusion amongst a substantial number of persons. Taking all of the above factors into account the opponents have not persuaded me that there is a real tangible risk of confusion. They may well have a significant priority over the application but their use is very limited, and although their mark is part of the mark applied for it is a commonly used word which is likely to be regarded as

5 a reference to both the content of the opponents' magazine and the nature of the applicants' goods. There is also the matter of the device element in the applicants' mark which is the only distinctive element and must be taken into account. While I do not primarily seek to decide the matter on the basis of the goods themselves, it seems to me that the distance between the respective goods and fields of activity places an onus upon the opponents to establish that the trade or the relevant customer base will assume a connection such that confusion may arise. This they have failed to do. The opposition, therefore fails under Section 11 also.

10 The opposition having failed on all grounds I order that the opponents pay the applicants the sum of £635 as a contribution towards their costs. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

15 **Dated this 7 day of March 2000**

20 **Mike Foley
for the Registrar
The Comptroller General**