

O-118-11

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 945701
IN THE NAME OF REVOLUTION INTERNATIONAL LTD IN RESPECT OF THE
TRADE MARK**

REVOLUTION

IN CLASS 16

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 71711
BY HAYMARKET MEDIA GROUP LTD**

AND

**IN THE MATTER OF TRADE MARK REGISTRATION 2212436 IN THE NAME
OF HAYMARKET MEDIA GROUP LTD IN RESPECT OF THE TRADE MARKS
(AS A SERIES OF TWO)**

Revolution

Revolution
Business and marketing in the digital economy

**AND IN THE MATTER OF AN APPLICATION FOR REVOCATION THERETO
UNDER NO 83557 BY REVOLUTION INTERNATIONAL LTD**

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF International registration no. 945701
In the name of Revolution International Ltd in respect of the trade mark**

REVOLUTION

AND

**IN THE MATTER OF Opposition thereto under No. 71711
by Haymarket Media Group Ltd**

AND

**IN THE MATTER OF trade mark registration no. 2212436
In the name of Haymarket Media Group Ltd in respect of the trade marks**

Revolution

Revolution
Business and marketing in the digital economy

As a series of two

AND

**IN THE MATTER OF an application for revocation under no 83557 by
Revolution International Ltd.**

BACKGROUND AND PLEADINGS

1. These are consolidated proceedings in which the applicant for the opposed mark has sought to revoke the earlier mark relied on by the opponent. The evidence filed is common to both proceedings and all issues will be dealt with in the same decision.
2. On 27th December 2007 the UK was notified by WIPO of international registration 945701 (having an international registration date of 31st October

2007 and a priority date of 28th June 2007), in respect of which it had been designated under the relevant provisions of the Madrid Protocol. The relevant trade mark registration is as above. The mark is described on the international register as follows:

“The mark consists of a distinctive star on the first letter “O”, the letters “I” and “T” are merged and the last letter “N” is inverted.”

- The designation stands in the name of Revolution International Ltd, 4th Floor, IBL House, Caudan, Port-Louis, Mauritius (hereafter “RIL”). Following a limitation in respect of the goods of the international registration, it is registered for the following goods in the UK:

Class 16:

Magazines (printed publications) relating to watches; magazines (printed publications) relating to the motor car trade; periodical publications relating to cars; periodical publications relating to travel; printed publications relating to wine; all included in this class.

- The designation was accepted and advertised for opposition purposes in the Trade Marks Journal on 14th March 2008. On 9th June 2008, Haymarket Media Group Ltd of 174 Hammersmith Road, London W6 7JP (hereafter “Haymarket”) filed notice of opposition. Haymarket has based its opposition on sections 5(1), 5(2)(a), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (hereafter “the Act”). Under sections 5(1) and (2), they rely on one earlier registered mark, UK 2212436, in respect of which, on 10th December 2009, Haymarket voluntarily surrendered certain goods (compact discs in Class 9 and photographs, posters and stickers in Class 16). Following the surrender, the full details of the registered mark relied upon are as follows:

Mark, filing and registration dates	Goods relied upon
<p>UK 2212436</p>  <p>Filed on: 26th October 1999</p> <p>Registered on: 4th October 2002</p>	<p>Class 9:</p> <p>Down-loadable on-line electronic publications from the data base or from facilities provided on the Internet or other networks; all relating to marketing, information technology and the Internet.</p> <p>Class 16:</p> <p>Printed matter; newspapers, periodical publications; journals and magazines; re-print articles of periodical publications; all relating to marketing, information technology and the</p>

	<p>Internet.</p> <p>Class 41:</p> <p>Publishing services; providing on-line electronic publications; publication of printed matter and periodical publications on-line; organising, arranging and conducting shows, conferences, exhibitions, seminars, award ceremonies and competitions; consultancy and advisory services relating to the aforementioned services; all in the field of marketing, information technology and the Internet.</p>
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5. Haymarket's pleaded case does not go beyond recital of the grounds of opposition, except to provide a statement of their own use of the earlier mark in which they say their mark has been used on all the goods and services of the then specification save those which were voluntarily surrendered. Moreover, under section 5(4)(a) they say their mark was first used in 1999.
6. RIL filed a counterstatement denying the grounds of opposition under section 5(1), in respect of which it said its mark has a star device on the first letter 'O', the letters 'T' and 'I' are merged and the letter 'N' is inverted. In contrast, the opponent's mark is in plain script save that the letter 'I' is inverted. Given these differences in the marks, RIL also denies the ground under section 5(2)(a). Under section 5(2)(b), RIL say the marks are not similar and so there cannot be likelihood of confusion. The ground under section 5(4) is also denied. RIL says, finally, that the word 'revolution' is a well known and widely used word which cannot be monopolised by Haymarket and their rights must accordingly be limited to the mark only in the form registered. Given the differences between the respective marks, there is sufficient to differentiate them in the market place.
7. RIL put Haymarket to proof of use of their mark in the opposition, but shortly after filing their counterstatement, on 9th October 2009, they also filed an application to revoke Haymarket's mark. The application was against all the goods specified in Haymarket's registration and it was made under both section 46(1)(a) and 46(1)(b) of the Act. Under section 46(1)(a) they sought revocation with effect from 5th October 2007 (the relevant five year period being from 5th October 2002 to 4th October 2007). Under section 46(1)(b) they sought revocation with effect from 1st August 2009 (the relevant five year period being from 1st August 2004 to 31st July 2009).

8. Haymarket filed a counterstatement to the application for revocation, saying its mark had been used on all goods except compact discs in Class 9 and photographs, posters and stickers in Class 16, all of which had, as I have said, been voluntarily surrendered on Form TM23 filed on 10th December 2009.
9. Evidence, as I have said, common to both sets of proceedings, has been filed by both parties, the salient facts of which I shall summarise below. Neither party asked to be heard and so this decision is based only on the papers filed and after a careful assessment of those papers. Both parties request costs.

Opponent/registered proprietors' evidence

10. This takes the form of a witness statement dated 9th March 2009 by Philip Goodman, Group Accountant with Haymarket. He says Haymarket started using the mark, REVOLUTION, in 1997. It is principally a magazine which focuses on the digital world and especially its impact on business, marketing and advertising. Exhibit PG1 comprises specimen copies of the magazine. There are two magazines contained in this exhibit, dated September and October 2008. The magazine title is 'REVOLUTION', and although the font differs as between the two specimens, both share the inverted and lower case 'i' in the word REVOLUTION. The image below reproduces the cover page of the October 2008 edition:



11. The leader article in the October 2008 edition speaks of the magazine undergoing a 'make over' after "11 years at the cutting edge of digital marketing". Inside, the magazine is a mix of features. It is described as having four 'core' sections: "download", being the latest news; "opinion" being "thought leadership" articles; "features", being "in depth insight and best practice"; and "work", being the "best the digital marketing industry has to offer". The magazine is published monthly, carries advertising and subscriptions are available.
12. Mr Goodman says the sales of the magazine can be verified by an independent organisation called ABC Ltd¹. Exhibit PG2 comprises a copy of the ABC Certificate for the circulation of REVOLUTION between 1st July 2007 and 30th June 2008. The certificate describes the magazine as a "Business Magazine", and the "Primary Market Sector" for the publication is described as being "marketing". The total average net circulation per issue for the relevant period is given as 11,812, comprising 11,724 in the UK and 88 in other countries. The 'audit issue', priced at £10.00 (this varies with concessions), is dated May 2008 and a breakdown is given as to sales of that particular issue. 10,000 copies were sold, of which 1,592 were single copy subscription, 66 multiple copy subscription, and 8,342 'controlled free' circulation.
13. The term 'controlled free' is then subdivided into various categories such as: individual written requests (113 sold); individual electronic requests (2,950 sold); and individual telephone requests (5,279 sold). Controlled circulation appears to comprise requests from directors, managers, and individuals in client marketers/corporates, agencies, consultancies, or new media companies. There is also a geographical analysis as to where the controlled free copies originate from, London and the South East being most favoured.
14. The certificate refers to the areas of operation of the client companies, such as manufacturing, entertainment, financial and so forth. There are the job titles of the people requesting copies which are mainly 'marketing managers'.
15. Mr Goodman says the ABC website can be found at www.abc.org.uk and that there are no other publications containing the word REVOLUTION.
16. He says his company operates a very successful awards ceremony under the REVOLUTION brand. Exhibit PG3 is a shortlist of those nominated for the 2009 Innovation awards.
17. He says his company owns and operates the websites www.revolutionmagazine.com and www.revolutionawards.com and Exhibit

¹ ABC is run by the media industry and governed by a Board of representatives from advertising, media agencies, media owners and trade bodies. All data is prepared to independent and industry agreed standards.

PG4 comprises copies of the WHOIS records for those sites. The WHOIS record for www.revolutionmagazine.com shows the domain name registered to Haymarket and having been created on April 12th 2007. The WHOIS record for www.revolutionawards.com also shows the domain name registered to Haymarket and also as having been created on April 12th 2007.

18. Mr Goodman says his company also operates a number of conferences under its REVOLUTION brand; next of these was a seminar on 4th March 2009 concerning 'Forward Thinking Search Strategies'.

19. Mr Goodman has filed a second witness statement which sets out the revenues derived from the brand through its exploitation, as well as advertising and promotional spend in the UK and this is as follows:

Revenue from	Advertising £'000	Subscriptions £'000	Events £'000	Other £'000	Total £'000
2009	392.7	96.4	390.7	26.8	906.6
2008	491.1	114.3	899.0	20.2	1524.6
2007	680.0	107.1	707.0	0.0	1494.1
2006	713.5	68.6	845.0	15.0	1642.1
2005	652.1	53.9	684.0	9.1	1399.1
2004	530.1	48.2	213.3	5.7	797.3

Advertising/promotional spend	Advertising £'000	Circulation £'000	Total £'000
2009	2.4	34.7	37.1
2008	24.4	33.8	58.2
2007	15.1	27.5	42.6
2006	11.9	19.8	31.7
2005	9.9	18.4	28.3
2004	31.2	29.0	60.2

Applicant's evidence

20. This takes the form of a witness statement dated 24th August 2010 by Bruce Lee, a director of RIL. In essence it is submission rather than fact.

21. Nonetheless he concedes that Haymarket has used its mark in respect only of magazines "focussing on the digital world and especially its impact upon business marketing and advertising". And also he concedes use in respect of awards ceremonies. This, he says, is use only in respect of a highly specialised magazine and a related awards ceremony.

22. He states that RIL intends to use its mark on what would be described as 'lifestyle' magazines, which are totally different in terms of content, style and readership.

Opponent/registered proprietor's evidence in reply.

23. This takes the form of a witness statement by Steven Jennings, who is a Trade Mark Attorney with the firm acting for Haymarket. This is entirely legal submission of which I shall take account in due course.

DECISION

Application for revocation

24. The relevant parts of section 46 of the Act read as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c)

(d)

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for

the commencement or resumption began before the proprietor became aware that the application might be made.

(4)....

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) 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.”

25. Consideration has to be taken, also, of section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

26. Consequent upon section 100, the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

27. The leading cases on genuine use are well known: *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85 (“*Ansul*”), *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38 and [2005] ETMR 114 (“*La Mer*”), *The Sunrider Corp v OHIM*, Case C-416/04P (“*Sunrider*”). A helpful synthesis of the ‘legal learning’ from these cases and several more recent ones has been provided in the appointed person case, *Sant Ambroeus* (BL O-371-09), as follows:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR 28 (*Silberquelle*) where relevant:

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it

appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

The mark as used; Haymarket’s own use and what the evidence shows

28. Whilst I do not understand RIL to be taking any point on whether there has been genuine use as described by the case law above, or that that use has been of an ‘acceptable variant’ (my paraphrase of section 46(2)) of the mark as registered, nonetheless I want to deal with those matters briefly.
29. Haymarket’s use of their mark started in 1997, and according to the evidence went up to 2008 at least. There is no question that it is ‘genuine’ in the sense that it is not ‘token’ or ‘de minimis’, and that it is consistent with the essential function of a trade mark – to guarantee the identity of the origin of the relevant goods or services. In short, the use made meets the legal tests I have outlined above in para 27.
30. In addition, I consider it to be use of an ‘acceptable variant’ of the mark as registered, that is to say the characteristic inverted ‘i’ of the word REVOLUTION is evident in use on the specimen samples of the magazine. This can be seen for example in the image I have reproduced at para 10 above. It would be true to say that in actual use, the inverted letter ‘i’ tends to stand out more than on the mark as registered, for example different colours are used. This has the visual effect that it assumes more closely the role of an exclamation mark than perhaps would be the case with the mark as registered. Nevertheless, I do not believe this alters the distinctive nature of the mark as registered, such that it assumes a different identity (as per section 46(2) of the Act).
31. Of course, I recognise at this point that Haymarket have two marks registered as a series, and that one of those marks has a ‘tag’ line below the word REVOLUTION and in much smaller lettering, reading ‘Business and Marketing in the Digital Economy’. Although I have not found an example of usage with the ‘tag’ line, the tag line contributes nothing to the distinctiveness of the mark overall, and as such its absence is not material. My conclusion then is that the evidence plainly shows genuine use of an acceptable variant of the mark as registered.

Fair specification

32. As I understand RIL’s position, it is that Haymarket is only entitled to maintain their mark in respect of the somewhat limited range of goods upon which use is asserted. In effect, they say Haymarket is only entitled to a specification along the lines of ‘highly specialised (or some such narrow definition) magazines’ in Class 16.

33. The question of what is a 'fair specification' is a sometimes tricky 'value judgment', and I am aware there is some discussion that the various UK and European authorities on this point are wholly consistent (see, eg the appointed person's recent decision in BL O-217-10 *Extreme*, especially para 15). The potential difference is said to be that the English Courts' approach is based upon the perception of the average consumer (and may therefore be more generous in outcome) and the General Court's approach provides no clear yardstick for determining when a 'sub-category' of products cannot be further divided.
34. I need to remind myself of Haymarket's specification in Classes 9, 16 and 41 which is as follows:

Class 9:

Down-loadable on-line electronic publications from the data base or from facilities provided on the Internet or other networks; all relating to marketing, information technology and the Internet.

Class 16:

Printed matter; newspapers, periodical publications; journals and magazines; re-print articles of periodical publications; all relating to marketing, information technology and the Internet.

Class 41:

Publishing services; providing on-line electronic publications; publication of printed matter and periodical publications on-line; organising, arranging and conducting shows, conferences, exhibitions, seminars, award ceremonies and competitions; consultancy and advisory services relating to the aforementioned services; all in the field of marketing, information technology and the Internet.

Class 9

35. I can see no persuasive evidence that REVOLUTION magazine has been available to download online, as well as in print. The ABC Certificate relates only to traditional printed media. There is the website www.revolutionmagazine.com but this was only created on 12th April 2007 according to the WHOIS record. In addition, the simple creation of the website does not necessarily prove that an electronic version of the magazine under the name REVOLUTION was available from the date. Moreover, nowhere in the two specimen magazines is there any record of the magazine being also available online. In the circumstances, no genuine use of the goods of Class 9 has been established.

Class 16

36. Haymarket produces a 'magazine'. It is not a newspaper, periodical, journal or reprint, as the consumer would understand those terms. Periodicals and journals for example tend to be of academic interest and newspapers containing, normally daily news. According to the ABC Certificate it is classified as a 'business magazine'. In other words, its audience is not the general public but businesses with an interest in particular in digital marketing. That much is clear from the ABC Certificate. The broader term 'printed matter' is far too broad to reflect a fair specification in this case.
37. It is noted that all terms in the Class 16 specification are qualified by the words, "all relating to marketing, information technology and in the Internet".
38. In all the circumstances I believe the term, 'business magazines relating to marketing, information technology and the Internet' to be a fair specification in this case. I have said 'business magazine' is a term recognised by the industry, as represented by the organisation, ABC Ltd, but also I think the average consumer would understand that term, in that it distinguishes such magazines from those that may (usually) be readily available to, and aimed at, the general public.
39. I should just mention that in terms of the relevant period(s) for which revocation has been sought, Haymarket's position is that they have used (I assume, continuously) the REVOLUTION mark since 1997. This is substantiated by reference to the October 2008 edition of the magazine submitted in evidence which refers to a 'make over' after 11 years (see para 11 above). Assuming continuous use of the mark on magazines from 1997 through to at least 2008, this would span both periods for which revocation is sought.

Class 41

40. I have already commented on the lack of evidence supporting electronic versions of the magazine being available. The mark is used as the title of a magazine and not to designate 'publishing services'. There is however evidence that the mark has also been used in relation to conferences and award ceremonies. Figures are given in evidence under the heading 'events' relating to associated costs (see para 19 above) and these span the period 2004 – 2009. Again this would span both periods for which revocation is sought. The 'events' appear from the evidence to specifically be conferences, seminars and award ceremonies. On that basis, I consider that a fair specification in this Class would be, 'organising arranging and conducting

conferences, seminars, award ceremonies and competitions, all in the field of marketing, information technology and the Internet.' Haymarket are not entitled to 'consultancy and advisory services' as there is no evidence of that particular service.

41. To sum up my findings in relation to a 'fair specification', these are that Haymarket is entitled to the following:

Class 16

Business magazines relating to marketing, information technology and the Internet.

Class 41

Organising arranging and conducting conferences, seminars, award ceremonies and competitions, all in the field of marketing, information technology and the Internet.

42. Given that the proceedings comprise an application to revoke Haymarket's mark, as opposed to a simple request to prove use, I formally revoke the mark for goods and services other than those specified above in para 41.

43. On that basis, I order that registration 2212436 be revoked, with effect from 5th October 2007, being the earliest of the two dates applied for. The mark shall be revoked in respect of the following:

Class 9

Down-loadable on-line electronic publications from the data base or from facilities provided on the Internet or other networks; all relating to marketing, information technology and the Internet.

Class 16:

Printed matter; newspapers, periodical publications; journals and magazines; re-print articles of periodical publications; all relating to marketing, information technology and the Internet.

Class 41

Publishing services; providing on-line electronic publications; publication of printed matter and periodical publications on line; organising, arranging and conducting shows and exhibitions; consultancy and advisory services relating to the aforementioned services; all in the field of marketing, information technology and the Internet.

44. I will now go on to further consider the opposition based upon the specifications of the earlier mark as outlined in para 41.

Section 5

45. Section 5(1) and (2) of the Act read:

5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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.

Section 5(1) and 5(2)(a)

46. Sections 5(1) and 5(2)(a) require that the respective trade marks are identical.

47. In the European Court of Justice (“CJEU”) Case C-291/00 (*LJT Diffusion SA v Sadas Vertbaudet SA*) (“*Sadas*”), the Court said in relation to Art 5(1)(a):

“Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

48. *Sadas* is the leading authority on the question of whether marks are ‘identical’. Whilst Art 5(1)(a) of the Directive 89/104 EEC, referred to in the quote above, relates to the scope of rights available to a proprietor once a mark is registered, the Court says the same interpretation given to Art 5(1)(a)

applies also to Art 4(1)(a), being the relevant (equivalent) provision for my purposes.

49. In this case, the respective trade marks contain differences. The earlier mark contains an inverted 'i' in the word REVOLUTION (some, but not all, consumers may see this inversion as creating an exclamation mark) and the international registration contains a star device, as well as the letters 'T' and 'I' being merged and the letter 'N' inverted. Seeking to apply the *Sadas* test, these are differences which are not so insignificant that they would go unnoticed by the average consumer, even if, under normal trading circumstances, he or she were not comparing the marks side by side.
50. The opposition under section 5(1) and 5(2)(a) therefore fails.

Section 5(2)(b)

51. The opposition is also founded upon Section 5(2) (b) of the Act, which requires the marks to be similar, the goods to be identical or similar, and taken together, a likelihood of confusion to be found.
52. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

The average consumer and nature of the purchase

53. Haymarket’s best case under section 5(2)(b) clearly resides with its Class 16 specification and as such, my continued analysis will concentrate on that Class only. The average consumer for Haymarket’s goods will be businesses, specifically those having an interest in digital marketing. Of course, whilst Haymarket’s magazine may well be bought or ordered on behalf of business, it will be read by individuals, most especially marketing managers according to the evidence of the ABC Certificate. RIL’s publications are defined by reference to their subject matter and content: watches, cars, the motor car trade, wine and travel. This does not necessarily reflect the ‘type’ of magazine or publication they are, so much as its content. As such, they could be for the general public, but also there is nothing to prevent such publications also (or alternatively) being trade and business based. Indeed, one item in the specification directly refers to the motor car *trade*. Moreover, the readers of Haymarket’s magazine could also be readers of RIL’s magazines.

54. There is therefore potential commonality as far as the question as to who the respective reader is concerned.

55. As far as the purchasing process is concerned, both parties’ products are, if not everyday purchases, then purchased on a regular basis either by subscription or other request. I will factor these observations into my overall assessment of likelihood of confusion.

Comparison of marks

56. The case law makes it clear that I must undertake a full comparison of both marks in their totalities, taking account of all differences and similarities. The comparison needs to focus on the visual, aural and conceptual identities of both marks. The respective marks to be compared are as follows:

RIL’s mark	Haymarket’s mark
	

57. Visually, RIL's mark presents as a single word mark comprising ten letters, REVOLUTION. The word is in light grey coloured and in plain script using capital letters. The 'O' of REVOLUTION has a dark star in the middle, whilst the 'N' is inverted. The 'T' and 'I' are joined at the tops of the letters. Haymarket have two marks in their series, the only difference being an entirely descriptive 'tag' line beneath the word, REVOLUTION, reading 'Business and marketing in the digital economy'. The word 'REVOLUTION' is in dark script using upper and lower case. The 't' and 'i' of the word are also joined, as in RIL's mark. The lower case 'i' is inverted, which presents as an exclamation mark. Taking the visual similarities and dissimilarities into account, I find there is a very high level of visual similarity between all (ie including both Haymarket's marks) respective marks.
58. Phonetically, RIL's mark will be pronounced 'REV-O-LOO- SHUN'. The inverted 'i' will make no difference to pronunciation. Haymarket's mark will be pronounced in the same way. It is unlikely that in the version of Haymarket's mark that contains the 'tag' line, that line will be enunciated in normal usage. On that basis, I consider the respective marks to be phonetically identical.
59. When the authorities talk of conceptual similarity, it is meant 'semantic' conceptual similarity. I must also remember that we are viewing matters from the perspective of the average consumer who is unlikely to be an expert linguist.
60. 'Revolution' is a dictionary word, meaning:

revolution

noun

1. a forcible overthrow of a government or social order, in favour of a new system. ■ (often **the Revolution**) (in Marxism) the class struggle which is expected to lead to political change and the triumph of communism. ■ a dramatic and wide-reaching change in conditions, attitudes, or operation: *marketing underwent a revolution.*

2. an instance of revolving: *one revolution a second.* ■ [mass noun] the movement of an object in a circular or elliptical course around another or about an axis or centre: *revolution about the axis of rotation.* ■ a single orbit of one object around another or about an axis or centre².

² "revolution *noun*" *Oxford Dictionary of English*. Edited by Angus Stevenson. Oxford University Press, 2010. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 24 February 2011 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t140.e0707660>>

61. There is a question whether the 'additional matter' in the respective marks may vary, or otherwise disturb, the semantic context as described above. In my view, the 'additional matter', being the star in RIL's mark and the respective inversions, will not vary the underlying concept behind all the respective marks. The letter inversions shared by the respective marks, even if not the same letters, tend to amplify the underlying definition of the word, REVOLUTION, in the sense that such a word suggests upheaval, or the established order being turned on its head.
62. It is worth mentioning that the concept behind Haymarket's second mark with the 'tag' line will be slightly modified by having that 'tag' line. That is to say, that the subject of the magazine will have been clearly identified which would not be the case with RIL's mark. In the circumstances I find that RIL's mark and Haymarket's first mark are conceptually identical and RIL's mark and Haymarket's second (tag line) mark are very highly similar conceptually.

Overall assessment of marks

63. I need to bring these findings together in an overall assessment of the marks, taking into account distinctive and dominant characteristics as wholes. Plainly it is the word 'REVOLUTION' which dominates all the respective marks, including Haymarket's 'tag line' mark. The various additions and embellishments to both parties' marks do not vary or otherwise disturb that distinctive element. It is worthwhile noting that *both* parties' respective marks make use of an inversion of letters, albeit that different letters are involved and also that Haymarket's inversion results in the creation of an exclamation mark, whereas RIL's inversion will have no such effect. The fact is that inversion is used by both parties, and this is a factor which I will need to take into account both at this point and in my overall assessment of likelihood of confusion.
64. Taking all factors into account, I find that the parties' respective marks are, overall, similar to a very high degree.

Comparison of the goods

65. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the Judgment:

'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.’

66. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

67. It is important to recognise that even though the factual evidence on similarity is sparse or even non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the appointed person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.

68. I should also mention a further case in terms of the application of legal principle, and that is the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

69. The respective goods to be compared are as follows:

Haymarket’s goods, on which use has been shown	RIL’s goods
<p><i>Class 16</i></p> <p>Business magazines relating to marketing, information technology</p>	<p><i>Class 16:</i></p> <p>Magazines (printed publications) relating to watches; magazines (printed publications) relating to the motor car</p>

<p>and the Internet.</p> <p><i>Class 41 (For information only)</i></p> <p>Organising arranging and conducting conferences, seminars, award ceremonies and competitions, all in the field of marketing, information technology and the Internet.</p>	<p>trade; periodical publications relating to cars; periodical publications relating to travel; printed publications relating to wine; all included in this class.</p>
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70. RIL say, in essence, their magazines are ‘lifestyle’ magazines which will not be read by, have the same outlets as or be published by the same people as ‘business magazines’. The difficulty here is that RIL’s goods are not described as ‘lifestyle’ magazines in the specification. They are described by reference to their content or subject matter. Haymarket’s business magazines are also limited by reference to subject matter – ‘marketing, information technology and the internet’, and, assuming notional and fair use, there is potential for ‘overlap’ as far as the respective specifications are concerned. RIL’s specification contains, within its scope, ‘business’ as well as ‘lifestyle’ magazines, and such magazines could, for example, contain articles on the marketing of cars, watches, travel or wine. This is RIL’s key difficulty here. The specifications as stated, and phrased as they are, do not result in distance between the goods. On the contrary, applying the *Meric* case, the respective goods are identical on the basis that Haymarket’s more narrowly defined goods ‘business magazines relating to...’ are, in fact, a subset of RIL’s goods, notwithstanding that RIL have limited these to subject matter, rather than ‘type’ of magazine.

71. Applying *Meric*, I find that the respective goods are identical.

72. I would just add that even if I had arrived at another, more narrow, ‘fair specification’ for Haymarket’s goods, such as, eg ‘marketing magazines’ this would not have affected my conclusion in relation to similarity of goods. This is because there would still be overlap in terms of the subject matter to which both specifications would have been limited. That is to say that a marketing magazine may also have the same content as the subject matter to which RIL’s publications have been limited.

Likelihood of confusion

73. Before proceeding to bring all my findings together in an overall global assessment I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness. In terms of its inherent distinctiveness, I regard Haymarket's marks to possess at least a moderate degree of inherent distinctiveness. The word 'Revolution' is a known dictionary word and, eg as a title of a magazine or conference, it would not be 'out of place' or surprising.
74. I need to consider also whether this level of inherent distinctiveness can be said to be enhanced through use in the UK market. Plainly, use has been shown but it is hard from the evidence to assess what relative exposure to the UK market the mark has had. Although the magazine is established, its circulation has been somewhat limited and it is not clear what relative share of the overall market in business magazines Haymarket has had. On that basis, I am not able to find that the degree of inherent distinctiveness is enhanced through use.
75. I have found above that the respective marks are similar to a very high degree (even to the point of using letter inversion) and that the respective goods are identical. I have also found the earlier mark to be at least moderately distinctive and the identity of the respective average consumers to have identity and commonality. I have also made observations on the nature of the purchase.
76. I must also bear in mind I need to consider marks as a whole of course, and factor in the notion of 'imperfect recollection'. That is to say, consumers may rarely see marks in use side by side but, in real life, retain an imperfect picture of them.
77. In this case, taking all factors into account, as well as imperfect recollection, I find that the consumer will assume that the goods provided under the respective marks originate from the same or linked undertaking and as such there is a likelihood of confusion is made out in respect of all goods.
- 78. The opposition under section 5(2)(b) of the Act therefore succeeds in relation to all the goods opposed.**

Section 5(4)(a)

79. Given the views expressed and conclusions reached under section 5(2)(b) I would have arrived at the same conclusion under section 5(4)(a). That is to say that by the relevant date (the date of designation of the UK, being 27th December 2007), Haymarket would have been able to make good their claim to goodwill, misrepresentation and damage under their sign, such that use by RIL of their mark would be liable to be prevented under the common law action for passing off. In this regard I note also that RIL has not demonstrated its own use of its mark in the UK such that an equitable defence may have arisen by the relevant date. Indeed, from my understanding of its evidence, RIL has not even commenced use in the UK of its sign.

80. For these reasons, shortly stated, I also find that the opposition succeeds in relation to all goods under section 5(4)(a).

Costs

81. Haymarket Media Group Ltd has been totally successful in its opposition. Even though the evidence has been common to both sets of proceedings, Haymarket has also incurred costs as far as the application for revocation is concerned. On balance, and although I did revoke the mark for certain goods, Haymarket retained the mark for its 'core' goods as a fair specification, which were then successful against the application in the opposition. Accordingly, it is entitled to a contribution towards its costs, both in relation to the revocation and the opposition. I take account of the fact that the decision has been reached without a hearing. In the circumstances I award Haymarket the sum of £1000 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Filing fee for opposition - £200
2. Preparing a statement and considering counterstatement in both the opposition and the revocation - £300
3. Preparing evidence and considering and commenting on other side's evidence - £500

Total £1000

82. I order Revolution International Ltd to pay Haymarket Media Group Ltd the sum of £1000. The sum should 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 29 day of March 2011

**Edward Smith
For the Registrar,
the Comptroller-General**