

O-140-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2136517A
IN THE NAME OF IPC MEDIA LIMITED
TO REGISTER A TRADE MARK IN CLASSES 9, 16 & 35**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 50532
BY LIBERTY MEDIA FOR WOMEN LLC**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
AGAINST THE DECISION OF MR. M. FOLEY
DATED 19 JUNE 2003**

DECISION

Background

1. This is an appeal against a decision of Mr. Mike Foley, the Hearing Officer acting on behalf of the Registrar, dated 19 June 2003. In that decision, Mr. Foley rejected an opposition against UK Trade Mark Application No. 2136517A in the name of IPC Media Limited (“IPC”) for MIZZ in respect of the following goods and services:

Class 9: Electronic publications provided in magazine format

Class 16: Magazines for teenage girls and young women

Class 35: Advertising and marketing services and information services relating thereto; all provided through a magazine.

2. Opposition No. 50532 was filed on 16 December 1999 by Liberty Media for Women LLC (“Liberty”). Several grounds of opposition were raised. But at the hearing Liberty decided only to proceed with the ground of opposition under section 5(2)(b) of the Trade Marks Act 1994 (“TMA”). Liberty is the proprietor of UK Trade Mark No. 2041354 concerning the series:

Ms.

MS

MS .

Ms

Ms .

UK Trade Mark No. 2041354 has a filing date of 13 October 1995 in Class 16 for “periodical magazines for women”. On opposition, Liberty argued that because MIZZ is similar to the earlier trade mark Ms. and is to be registered for goods and services in Classes 9, 16 and 35 similar to those for which Ms. is protected, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier trade mark. Application No. 2136517A must therefore be refused registration under section 5(2)(b) of the TMA.

The appeal

3. On 14 August 2003, having been granted an extension of time by the Registry within which to do so, Liberty filed notice of appeal to an Appointed Person under section 76 of the TMA. At the hearing of the appeal before me, Mr. Simon Malynicz of Counsel appeared on behalf of Liberty and Mr. Michael Edenborough of Counsel represented IPC. Counsel were agreed that the appeal was by way of review and that I should be reluctant to interfere with the Hearing Officer’s decision in the absence of an error in principle. In particular, I should not treat the decision as containing an error of principle merely because of infelicitous expression on the part of the Hearing Officer (*REEF Trade Mark* [2003] RPC 101, per Robert Walker L.J. at paragraphs 28 and 29).
4. Liberty’s skeleton argument on appeal (but not the Grounds of Appeal) identified the following paragraph in the Hearing Officer’s decision as containing a number of material errors:

“39. Although not mentioned in the cases cited above, the use that the applicants may have made of their mark can be a factor relevant to the determination of whether there is a likelihood of confusion between their mark, and the opponents’ earlier mark. If the applicant is able to show, to the satisfaction of the Trade Marks Registry, that there has been honest concurrent use of the trade mark the subject of the application, with the earlier mark, this is a relevant factor in determining whether there is likelihood of confusion. The evidence establishes that the applicants have been using their mark since April 1985, some 12 years prior to the relevant date in these proceedings. The applicants have provided details relating to turnover for the years 1991 on, which if extrapolated at a cover price of around 50p indicate that they have made significant copy sales of their magazine and I have little difficulty in accepting that they have a long standing and substantial use albeit amongst a customer base of teenagers and young women. Setting aside the fact that there is no actual evidence that the opponents have used their mark in this country, but accepting that they have used the mark from at least 1990 (exhibit MG2), the two parties will have been co-existing for some considerable time, yet the opponents have not cited or even claimed that there have been any instances of confusion.”

4. Liberty contends that the errors in this passage are threefold. First, when assessing likelihood of confusion, the Hearing Officer erred in taking into account actual use by the applicant because IPC's actual use was aimed at teenagers and the specification claimed is not so limited. Second, the Hearing Officer's reference to "honest concurrent use" is wrong. Section 7 of the TMA 1994 cannot withstand an opposition. Third, the apparent conclusion that lack of instances of actual confusion was telling in the present case contradicted the Hearing Officer's earlier finding that there was no evidence that Liberty had used Ms. in the UK. I reject any suggestion that IPC's failure to deal with these alleged errors in their skeleton argument somehow amounts to corroboration. As I have already indicated, the alleged errors were not identified with any clarity in the Grounds of Appeal.
5. Taking Liberty's three points in turn, I do not understand the first. The evidence showed that IPC had used their MIZZ mark since 1985 in relation to magazines for teenage girls and young women (the Willings Press Guides for 1990, 1991 and 1992, for example, state that the target readership for MIZZ magazine is 15 – 19 or 15 – 24 year olds, exhibit IOW1 to the statutory declaration of Imogen Wiseman, dated 10 July 2001). The goods in Class 16 claimed by Application No. 2136517A are "magazines for teenage girls and young women". Any distinction Liberty is seeking to draw here between teenage girls and young women is unhelpful.
6. The Hearing Officer's use of the phrase "honest concurrent use" was plainly not meant to introduce section 7 of the TMA. Section 7 provides that where there has been honest concurrent use (in the sense of section 12(2) of the Trade Marks Act 1938) of a later trade mark, the Registrar shall not refuse the application during ex officio relative ground examination even though inter alia the conditions of section 5(2) pertain. As Liberty rightly points out, the allowance does not apply if the relative ground is raised on opposition (section 7(2)). The Hearing Officer in the present case was merely stating that co-existence in the market can be a relevant factor in the global assessment of likelihood of confusion.
7. Liberty's final point is that the absence of actual confusion cannot be indicative in this case because the Hearing Officer held that use of Ms. in the UK had not been proved. Again, I do not believe that this is an accurate reflection of the Hearing Officer's decision. The only finding the Hearing Officer made in conjunction with use of the Ms. mark in the UK is that it was insufficient to support a claim of enhanced distinctive character through use (paragraph 34). Liberty's evidence claimed use since 1972 of Ms. in relation to magazines throughout the UK (exhibit MG3 (affidavit of Anne Finn, dated 14 January 1998) to the statutory declaration of Marcia Ann Gillespie, dated 17 July 2000 contained in exhibit A to the statutory declaration of Marcia Ann Gillespie, dated 3 August 2000). Although there was no actual evidence of sales (e.g. magazine covers with UK prices), a book written about the Ms. magazine written by Mary Thom (exhibit MG2 to the earlier statutory declaration of Ms. Gillespie) speaks of sales in the UK of Ms. magazine in the three years preceding 1993. The Hearing Officer considered that the book provided some corroborative evidence as to use of Ms. in this country.

8. I should mention that there is a “sister” appeal to these proceedings involving the same parties and the same marks. The cases were not consolidated below and I indicated that I preferred to hear the appeals sequentially rather than together because of the different issues involved. The only questions of use decided by the Hearing Officer in the sister case were that Liberty had failed on the evidence to establish either: (i) acquired distinctive character through use in the UK of the Ms. mark for the purposes of the proviso to section 3(1) of the TMA, or; (ii) UK reputation and goodwill in the Ms. mark prior to 1985 when MIZZ magazine was launched onto the market.
9. Nevertheless, I do believe that Liberty is correct in saying that paragraph 39 of the Hearing Officer’s decision (quoted at paragraph 3 above) is opaquely worded. For that reason, bearing in mind the overall objective to deal with the case justly, I have carefully considered the Hearing Officer’s decision in the light of the evidence and the arguments submitted by the parties.
10. The Hearing Officer correctly instructed himself as to the application of section 5(2)(b) of the TMA by reference to the rulings of the Court of Justice of the European Communities (“ECJ”) in Case C-251/95, *SABEL* [1997] ECR I-6191, Case C-39/97, *Canon* [[1998] ECR I-5507, Case C-342/97, *Lloyd* [1999] ECR I-3819 and Case C-425/98, *Marca Mode* [2000] ECR I-4861. He determined that the Class 16 goods were identical, those in Classes 9 and 16 (publications in electronic and printed form) similar and the Class 35 services (advertising) and Class 16 goods (magazines) closely allied. After noting that the application in Class 16 was limited to magazines for teenage girls and young women whereas Liberty’s earlier trade mark covered periodicals for women in general, the Hearing Officer observed: “the term “women” would encompass some females in their teens, and certainly would cover “young women”. Accordingly, they notionally share the same channels of trade, from publication to consumer”, which militates against Liberty’s contention that the Hearing Officer failed to consider notional and fair use of IPC’s and Liberty’s marks.
11. Moving to the marks themselves, the Hearing Officer noted that the marks were visually different but thought that they were orally and conceptually similar. I differ with the Hearing Officer over his finding as to conceptual similarity. In my view, Ms. conveys a rather staid image whereas MIZZ conjures up something altogether zanier in relation to the products. But that does not assist Liberty. In *SABEL*, the ECJ makes clear that the perception of the marks in the mind average consumer of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion (paragraph 23). Accordingly, where appropriate, the importance of any degree of visual, aural or conceptual similarity between the marks must be evaluated taking into account the category of goods or services concerned and the circumstances in which they are marketed (*Lloyd*, paragraph 27). The Hearing Officer said (at paragraphs 36):

“36. Magazines are primarily obtained by self-selection, which makes the visual appearance of the title (or trade mark) of primary importance. They are usually displayed alongside other magazines,

grouped according to subject matter. It is possible that a women's magazine could be displayed alongside, or in the proximity of one for teenagers and young women, which would afford a side-by-side comparison. I cannot, however say that that would necessarily be the case, particularly in circumstances where the magazine is obtained by subscription. There are circumstances where oral use, such as a consumer making an enquiry regarding the availability of a publication will be of relevance. Although magazines are relatively inexpensive items, the consumer is, I consider, reasonably discerning in the selection, where able, often picking up the magazine to glance through its contents prior to making the decision to purchase”.

12. In *Reed Executive Plc v. Reed Business Information Ltd* [2004] EWCA Civ 159, Jacob L.J. remarked (at paragraphs 83 – 84):

“83. Finally, although I agree with the Judge's questioning of the Court's proposition of fact that “there is a greater likelihood of confusion with very distinctive marks” there is some truth with the opposite proposition. The Court in *Lloyd* said:

“In determining the distinctive character of a mark, and accordingly in assessing whether it is highly distinctive, it is necessary to make a global assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings. In making that assessment account should be taken of all the relevant factors and in particular of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered.”

84. The last sentence is an acknowledgement of a fact that has long been recognised: where a mark is largely descriptive “small differences may suffice” to avoid confusion (*per* Lord Simonds in *Office Cleaning Services v. Westminster Window and General Cleaning* (1946) 63 RPC 30 at 43). This is not a proposition of law but one of fact and is inherent in the nature of the public perception of trade marks.”

13. It will be remembered that the Hearing Officer held that Liberty failed on the evidence to show acquired distinctiveness in Ms. such that the mark should enjoy an enhanced level of protection (paragraph 34). The Hearing Officer continued (at paragraph 38):

“38. The opponents say that they chose Ms. as a title for their magazine because they considered it to provide an image that suggested its female-centred focus, format and mission. I believe that the use of a title to convey an image, be it related to the subject matter of the magazine or the intended readership is, I believe, commonly used by publishers. This being the case, it is not surprising that a

number of publications may be available under similar names. Publishers must be aware of this circumstance of the trade, and accept that they run the risk of some limited confusion arising. Notwithstanding this, it would appear that the consumer is well able to distinguish one title from another.”

14. I find it telling that Liberty has not sought to challenge any of the above findings confining the appeal to the Hearing Officer’s observations regarding the parties’ apparent co-existence on the marketplace. For the reasons outlined above, I remain unpersuaded that Hearing Officer fell into error.

Conclusion

15. In the result, the appeal fails. The Hearing Officer ordered that Liberty should pay IPC the sum of £635 in respect of the opposition and I direct that a further sum of £635 be paid to IPC towards the costs of this appeal to be paid on the same basis as indicated by Mr. Foley.

Professor Ruth Annand, 10 May 2004

Mr. Simon Malynicz of Counsel instructed by R.G.C. Jenkins & Co. appeared on behalf of Liberty Media for Women LLC

Mr. Michael Edenborough of Counsel instructed by fJ Cleveland appeared on behalf of IPC Media Limited