

**IN THE MATTER OF APPLICATION NUMBER 2041354
IN THE NAME OF LIBERTY MEDIA FOR WOMEN LLC
TO REGISTER A TRADE MARK IN CLASS 16**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 48858
BY IPC MAGAZINES LIMITED**

**IN THE MATTER OF application number 2041354
in the name of Liberty Media for Women LLC
to register a trade mark in Class 16**

And

**In the matter of opposition thereto under number 48858
by IPC Magazines Limited**

Background

1. On 13 October 1995, McDonald Communications Corporation filed an application to register a series of five trade marks in Class 6 in respect of the following goods:

Periodical magazines for women.

The marks applied for are as follows:

A large, bold, black serif font logo for 'Ms.' with a period at the end. The 'M' is significantly larger than the 's'.

MS

MS .

Ms

Ms .

The application was assigned to Liberty Media for Women LLC with effect from 29 November 1999.

2. On 29 July 1998, IPC Magazines Limited filed notice of opposition in which they say that since 1985 they have published a magazine for women under the title MIZZ, and have established a substantial reputation and goodwill. The grounds of opposition are in summary:

1. **Under Section 3(1)(a)** because the mark is devoid of distinctive character.
2. **Under Section 3(1)(b)** because the mark consists exclusively of a sign or indication which may serve in the trade to designate the kind, quality, intended purpose or other characteristic of the goods.
3. **Under Section 5(4)** by virtue of the law of passing-off.

3. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.

4. Both sides filed evidence in these proceedings. The matter came to be heard on 16 September 2002, when the applicants were represented by Mr Simon Malynicz of Counsel, instructed by Fj Cleveland, their trade mark attorneys, the opponents by Mr Michael Edenborough of Counsel, instructed by R G C Jenkins & Co, their trade mark attorneys.

Opponents= evidence

5. This consists of two Statutory Declarations. The first is dated 3 August 1999, and comes from Sarah Christine Fisher, a publisher with IPC Magazines Limited, a position she has held since November 1996.

6. Ms Fisher refers to exhibit SF1 which consists of a Statutory Declaration dated 26 March 1998 and exhibits filed during the Registrar's examination of an application by her company to register the trade mark MIZZ. She explains that the current Declaration supplements the information contained in the earlier Declaration. For convenience I have combined the two into one summary, where appropriate, indicating whether the information comes from the earlier or later Declaration. Exhibits from the earlier Declaration have the prefix SCF, those from the later SF.

7. Ms Fisher says that the trade mark MIZZ was first used in the United Kingdom in 1985 in relation to magazines for teenage girls, and has been used in relation to advertising and marketing services, stationery, make-up and toiletries and also in connection with road shows. Exhibits SCF1 and SF2 consist of copies of the front covers of two MIZZ magazines, although only that shown at SF2 is dated, being the 12-25 April 1985 edition. Exhibit SF3 consists of copies of the covers of further editions. Exhibits SCF2 and SCF3 are described by Ms Fisher as samples of stationery, and an extract promoting the advertising and marketing services sold through MIZZ magazine, respectively. None of these exhibits can be dated. so can be given no weight.

8. Exhibit SCF3 consists of an extract from a publication entitled Willings Press Guide 1996, which contains an entry for MIZZ stating it to have been established in 1985, and indicating that publication carries advertisements.

9. Exhibit SCF4 contains extracts from the magazine, inter alia, giving details of a MIZZ road show held in 1996.

10. Exhibit SF5 consists of a paperback book entitled MIZZ-True life stories, stated to have been first published in 1996

11. The exhibits shown at SF4, SF5 and SF6, consist of a make-up mirror, a watch and samples of a body spray. Ms Fisher states that although none had been available prior to the relevant date, they are said to demonstrate the growth of the brand.

12. Ms Fisher refers to an audit of her company's titles conducted in 1997 that had recognised MIZZ as one of the top three brands with merchandising potential, but in the absence of specific details this is of no relevance.

13. Ms Fisher states that her company offers advertising space for third parties to promote their products, some examples of which were shown as exhibit SF4. She refers to exhibit SF10, which she describes as the Young Women's Group Business Review of November 1997, which contains a review of the business derived from advertisements sold in MIZZ magazine in comparison to other magazines produced by her company. Ms Fisher says that third parties are also able to place inserts in MIZZ magazine, an example (undated) being shown as exhibit SF11. Exhibit SF12 is a further extract from Willings Press Guide 1996, also shown as exhibit SCF3.

14. Ms Fisher lists the turnover from the sales of the magazine, advertising revenue and revenue from sources other than these:

Year	Revenue from sales of magazine	Advertising revenue	Other revenue
1991	£1,208,000	£618,000	£32,000
1992	£1,256,000	£741,000	£51,000
1993	£1,208,000	£907,000	£5,000
1994	£2,300,000	£752,000	£59,000
1995	£2,300,000	£714,000	£36,000
1996	£2,100,000	£702,000	£67,000
1997	£1,700,000	£690,000	£29,000

15. Ms Fisher says that road shows have been held annually between 1994 and 1998 at venues throughout the United Kingdom, each turning over approximately £140,000, with 500 T-shirts being sold. She says that the trade mark has been used and promoted throughout the United Kingdom, giving the total marketing budget for the years January-December 1994 as £274,800 rising year on year to £342,500 for the year January-December 1997.

16. Exhibits SCF5 and SF13 give examples of advertisements relating to MIZZ placed in a magazine entitled 19 (also published by the opponents) published between 1994 and 1997, in which MIZZ magazine and a paperback book under the name MIZZ are advertised. Ms Fisher lists other publications in which MIZZ is also said to have been advertised, and mentions the promotion of MIZZ on Kiss FM in March 1996, and Capital Radio. Exhibit SF14 is said to be point-of-sale materials available from September 1997, which is after the relevant date.

17. Exhibits SCF8/ SF15 are extracts from the MIZZ magazine website. The prints post-date the relevant date and Ms Fisher does not say when it was started, nor give any details of its usage by which to gauge its impact. Exhibit SCF7 consists of an advertisement promoting the MIZZ road shows to be held in April 1997, so presumably the advertisement is prior to that date.

18. Ms Fisher refers to her company using an external research company to review the strengths and weaknesses of the brand or title in the context of its competitors, details of the report published in April 1997 being shown as exhibit SF16. The report is entitled “Young Women’s Magazines-Purchase and Image Study” is noted as having been published in April 1997. The survey was aimed at the 12 to 20 year age group, and whilst it shows a degree of awareness of MIZZ, there is insufficient detail of the actual survey to be able to assess its relevance. Two further studies are shown as exhibit SF17 showing a strong brand awareness amongst teenagers although there is insufficient detail as to how they came to this conclusion.

19. Ms Fisher concludes her Declaration saying that despite her experience within the publishing field she had not been aware of any publication under the name Ms, and having become aware, has not been able to locate any copies.

20. The Declaration from Imogen Wiseman is dated 14 June 1999. Ms Wiseman begins her declaration by confirming that the evidence she gives comes from her own personal knowledge and experience from the field of trade marks. She summarises the grounds on which the opposition is based, stating that the aim of her Declaration is to demonstrate that the element “MS” is non-distinctive for printed publications, and further, because the term “MS” has only been in common parlance relatively recently, to also establish the descriptive nature of the corresponding term “Miss”.

21. Ms Wiseman states that the element “MS” is increasingly used as a title preceding the surname of a woman regardless of marital status. In support she refers to exhibit IOW1 which consists of references from three dictionaries. By way of example, the reference in the Collins Concise English Dictionary provides a definition reading “a title substituted for **Mrs** or **Miss** to avoid making a distinction between married and unmarried women”. It should be noted that the definitions are for the word “Ms” and not “MS”.

22. Ms Wiseman states that the title is frequently used in letters addressed to women. Exhibit IOW2 consists of 9 letters received by Ms Wiseman in the post on 4th May 1999, 8 of which use the title “Ms”. Reference is then made to exhibit IOW3, which consists of a search conducted using the Waterlow Signature trade mark searching product across all classes of goods and services. Ms Wiseman states that a large number of registrations have been obtained for this element in combination with other matter.

23. Ms Wiseman states that searches were undertaken through a variety of media and press dictionaries and directories. The searches revealed four publications, but only one of these (Ms London Magazine) could be interpreted as use of the word “MS” as a title. Exhibit IOW4 consists of a search for trading names containing the element “MS”. A large number of hits were returned, however there appears to be little or no use of the element being used as a title. In most cases the letters are used as initials or as an abbreviation.

24. Exhibits IOW5 & 6 consist of the results of a search of domain names containing “MS” and a search of usage on the Internet of this element. This shows there to be usage in respect of initials or abbreviations, including as a title in relation to individual female names.

25. Ms Wiseman goes on to describe the use of the word “MISS” which she considers to be analogous to the word “MS”. The remainder of the exhibits to her declaration consist of searches similar to those undertaken for the word “MS”. It is fair to say that they evidence a wide usage of the word “MISS” as a title (normally in conjunction with other matter) in trade marks, trade names and internet usage.

26. Ms Wiseman concludes her evidence by giving her view that the mark “MS” is descriptive for publication intended for female readership and that, as a result, MS is an element which is commonly used by traders in this field.

Applicants’ evidence

27. This consists of an Affidavit dated 17 July 2000, and comes from Marcia Ann Gillespie, Editor in Chief of Ms. magazine, a position she has held since 1993. Ms Gillespie confirms that she was employed as Contributing Editor from 1981 to 1993, thereafter as Editor in Chief. She confirms that the information contained is based upon her personal knowledge and her company’s records.

28. Ms Gillespie says that Ms magazine was founded in 1971, as a feminist magazine, the title Ms being chosen to provide an image that suggested its female-centred focus, format and mission. She says that the magazine was first published as an insert in New York magazine in December 1971, with the first full or preview issue being published in spring 1972. A copy of the cover of the full issue is at exhibit MG1, and shows the title Ms. but not the date of issue, nor circulation details.

29. Ms Gillespie refers to exhibit MG2 which consists of a book entitled *Ms.- 25 years of the magazine and the feminist movement*. The first edition of the book is shown as having been printed in 1997. The retail price is shown in \$US and \$Canadian, so cannot be taken to have been available in the United Kingdom. The copy of the book exhibited makes reference to sales of Ms. magazine in the United Kingdom in the three years preceding 1993, and to a short period when the publication of Ms. magazine was temporarily suspended.

30. Ms Gillespie refers to exhibit MG3 which consists of an Affidavit dated 14 January 1998 from Ann Finn, formerly a Vice president of MacDonald Communications Corporation, a previous owner of Ms. magazine. The Affidavit relates to an application to register the trade mark MS in the United Kingdom, number 2041354, that MacDonald had acquired by an assignment dated 7 June 1996. The applicants claim use of MS in the United Kingdom dating from around 1972, by MacDonald or their predecessors in title, in connection with magazines/publications. Exhibit 1 to the Affidavit contains a copy of the assignment document, exhibit 2 consists of a copy of the cover of the July 1972, March/April 1992 and March/April 1993 editions of Ms. magazine. Cover prices where shown are in \$US or \$ Canadian, there being nothing to show that these magazines were available within the United Kingdom. Ms Finn

gives circulation figures for Ms. magazine although does not state that these relate to the United Kingdom. She does say that the magazine has been sold throughout the United Kingdom and has a retail price of , 2.95.

31. Ms Gillespie refers to an expired registration for the trade mark Ms. that a predecessor, Ms. Foundation for Education and Communication had obtained in the United Kingdom, in respect of Amagazines (periodicals) for women, all for sale in England. A copy of the registration certificate is shown as exhibit MG4. Exhibit MG5 consists of a copy of the December 1999/January 2000 issue of Ms. Magazine. The cover price is shown in \$US and \$Canadian. Although there is no indication that the magazine is, or has been available within the United Kingdom, Ms Gillespie says that the current distribution exceeds 1,000 copies bi-monthly. She says that her company is interested in expanding the readership and in 1999 they mailed 40,000 letters to UK residents, exhibit MG6 being a copy of the letter.

Opponents' evidence in reply

32. The second Declaration is dated 10 July 2001 and comes from Imogen Wiseman, a Trade Mark Attorney with Fj Cleveland.

33. Ms Wiseman refers to exhibit IOW1, which consists of extracts taken from Willings Press Guide, which Ms Wiseman says is a guide to the newspaper and periodical industry, published annually, that inter alia, lists titles that are published at least once each year in the United Kingdom and other countries. The extract from 1986 contains an entry for MIZZ published by IPC Magazines, describing it as Ateenage literature@that had been published since 1985. The extracts date from 1985 through to 1998. There are no entries for the opponents=Ms. magazine, but the guide appears to relate to periodicals actually published in the United Kingdom and not to include those published outside of, and imported. Exhibit IOW2 contains extracts from the US editions, the earliest being 1985. This contains an entry for Ms. showing it to have been founded in 1972.

34. Ms Wiseman refers to the 1911 The Copyright Act, Section 15 of which requires publishers with a commercial establishment or distributor in the United Kingdom to deposit one copy of every title published or distributed in the United Kingdom with the British Library. Ms Wiseman says an edition of Ms. was lodged in 1985 and again in 1995, but not as official Legal Deposit items. A copy of the cover of the 1995 edition is shown as exhibit IOW3. The cover bears the title Ms. and shows a cover price of US\$5.95 and Canada \$6.95, there being nothing to indicate that this edition was on sale in the UK.

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

Decision

35. The Statement of Grounds set out the opposition as being based upon Sections 3(1)(a), 3(1)(b) and 5(4)(a). In his skeleton argument Mr Edenborough sought a revision of the grounds on which the opposition was based, saying that it was clear from the Statement of Grounds that the opponents had meant to allege that there was an infraction of Sections 3(1)(b) and 3(1)(c) rather than Sections 3(1)(a) and 3(1)(b), and that no prejudice can be suffered by the applicants

in allowing the opponents to correct this typographical mistake. I consider that on any reasonable reading of the grounds of opposition the intent would have been plain. I could not see any prejudice in allowing the correction, and as Mr Malynicz did not object the correction was accepted. Turning first to the grounds under Section 3(1)(b) and (c). Those sections read as follows:

“3.-(1) The following shall not be registered -

- (a) ...
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

36. The basis of the objection is that the mark applied for, Ms (with or without a terminal period), is in common usage as an appellation for a woman who does not herself wish to indicate or enable others to distinguish her marital status, or in circumstances, such as in correspondence, where the marital status is not known. The opponents allege that given this meaning, when used in relation to a publication for women, Ms is descriptive of the intended recipients, and consequently, is devoid of any distinctive character. Although the mark applied for consists of a series of these letters in various forms, I do not consider that the mode of representation materially affects my consideration, save perhaps that where shown as MS this may affect the consumers perceptions because of other possible significations.

37. The applicants do not dispute that the letters have this meaning, saying that it is an imaginative mark for the title of the magazine, and does not describe any feature, nor is it a usual or familiar way of describing any of the essential characteristics of such goods. But in any event, they say that the use that they have made of the mark over many years falls within the proviso to Section 3(1).

38. Turning first to the prima facie case. Both the applicants and the opponents have drawn my attention to a number of cases that they say support their contentions. So how stands the law? In relation to Section 3(1)(b), Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 said:

“Next is “TREAT” within Section 3(1)(b). What does devoid of distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

39. In *Procter and Gamble v OHIM, Case C-383/99* (the BABY-DRY case), the ECJ indicated that Section 3(1)(c) should be regarded as follows:

“The signs and indication referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

As regards marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.

And

In order to assess whether a word combination such as BABY-DRY is capable of distinctiveness, it is therefore necessary to put oneself in the shoes of an English-speaking consumer. From that point of view, and given that the goods concerned in this case are babies’ nappies, the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance.”

40. Mr Edenborough submitted that use of Ms in relation to “periodical magazines for women” is descriptive of the intended recipients of such a product and is therefore devoid of any distinctive character. He referred me to, inter alia, the *Cycling IS...* trade mark case [2002] RPC 729, in which Geoffrey Hobbs QC sitting as the Appointed person gave consideration to the current position with regard to assessing whether a sign possesses a distinctive character. In summary, Mr Hobbs set the stage as follows:

- i. The question must be considered in relation to the goods or services for which registration has been requested. *Merz & Krell* Case C-517/99 paragraphs 29 & 30;

- ii. In order to be registrable in that connection, the sign must possess enough of a distinctive character to be regarded as a badge of origin by the relevant class of persons or at least a significant proportion thereof. *Windsurfing* paragraph 52;
- iii. The relevant class of persons consists of the trade and average consumers of the goods or services in question in the territory covered by the application. *Windsurfing* paragraph 29;
- iv. The average consumer is to be regarded as reasonably well informed and reasonably observant and circumspect. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* paragraph 26;
- v. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* paragraph 25;
- vi. The average consumer's level of attention is likely to vary according to the category of goods or services in question. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* paragraph 26;
- vii. When assessing the capacity of the sign to distinguish, account should be taken of the inherent characteristics of the sign including the fact that it does or does not contain an element descriptive of the relevant goods or services. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* paragraphs 22 and 23;

41. Mr Hobbs went on to say:

“It is implicit in this approach to the assessment of distinctiveness that the perceptions of the average consumer are to be assessed in context with and with due regard for the realities of the market place. In cases where the application for registration contains no limitations as to how the sign in question is to be used, it will be relevant to have regard to the various methods and practices of marketing that the average consumer of the goods or services is likely to encounter under normal and fair trading conditions.”

42. The term Ms is not an apt or normal way of referring to the magazines, nor is it a term that represents the essential characteristics of such goods “in common parlance”, the general and usual description being “women’s magazines”. Nor is it a direct reference to a characteristic of a magazine. If it says anything, it is about the intended consumer rather than the magazine itself, but is not such a direct statement as, for example the word WOMAN. Potential purchasers may see the title as an indication that the magazine is aimed at women, possibly those with an interest in feminism, and may contain articles relating to this area. But Ms. is not a term used exclusively in relation feminism; it is used where the marital status of a woman is not known, and also by women who are not feminists but as a matter of personal preference, choose not to reveal their marital status. The position as I see it is that whilst the term Ms may, to some, bring to mind feminism, it does not delineate any particular group of women, nor say anything specific about the magazine.

43. Ms Gillespie says that Ms was chosen as the title for the applicants' magazine because they considered the name to provide an image that suggested its female-centred focus, format and mission. The opponents have not said how or why they came to use the name MIZZ for their magazine, but given that it is phonetic similarity to the title Ms, and that it is not too dissimilar from another title MISS, it is possible that it was for a similar reason to that of the applicants. It seems to me that it is by this use of semi-descriptive or allusive titles that the publisher informs, and attracts the interest of its target consumer. Not surprisingly this practice can lead to traders adopting visually, orally or conceptually similar titles, but I believe the consumer is well aware of the way in which publishers use titles and is able to discern one publication from another.

44. Mr Edenborough made reference to the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in the *Mister Long* trade mark case [1998] RPC 401. Referring to the decision in the *Mr Donut* trade case [1983] RPC 117, Mr Hobbs considered the common usage of the appellation Mister/Mr in combination with other words to suggest that someone or something is notable for possessing a particular quality or characteristic. He cited with approval the registrar's practice of accepting marks consisting of the title Mister/Mr combined with the name of the goods or services as being capable of distinguishing. I see no reason why Ms should be considered any differently to Mr.

45. In this case the mark is the appellation on its own, but does that make any difference? I accept that two elements that in themselves may be devoid of distinctive character can combine to create a distinctive whole, but I fail to see how "Ms Magazine" could be considered any more distinctive than "Ms" for magazines; if the former is possessed of a distinctive character, in my view, so must the latter.

46. Taking all of the above into account I take the view that the trade mark Ms. is prima facie registrable for use in respect of periodical publications, and the grounds under Section 3(1)(b) and (c) are dismissed accordingly.

47. Although my findings render it unnecessary for me to go on to consider the question of distinctiveness acquired through use, I will for completeness, set out my views on the issue. Ms Gillespie claims that the applicants first used the trade mark Ms in the United Kingdom in 1971, presumably as an insert in New York magazine. Miss Finn gives the date of first use as 1972 which would relate to the first stand-alone edition. Beyond these claims there is no conclusive evidence that corroborates either of these dates. The earliest established appearance of Ms. magazine in the UK is provided by Ms Wiseman as part of the opponents evidence, being a copy lodged with the British Library in 1985, although this does not establish that at that time the magazine was available for purchase in this country.

48. Circulation figures have been provided from 1993, which at best gives approaching 3 years of trade on which to assess the extent of the use. Sales of the first three editions of 1993 are by far the highest of those given, ranging from 23,400 copies of the Jan/Feb 1993 edition, falling to 10,200 for the May/June edition. Even allowing for the fact that this is, I believe what could be termed as a niche market publication, when taken in the context of the total number of potential readers, that is all women, these figures are modest. Later editions show a

marked decline in the circulation, falling progressively to a low of 2,100 editions of the Sept/Oct

1995 publication.

49. I do not doubt the veracity of either Ms Gillespie's or Ms Finn's statements regarding the date of first use claimed by the applicants. However, the lack of early detail by which to gauge the extent of any use they may have made of the mark, or any conclusive corroborative evidence gives me some difficulty in determining whether they can legitimately claim that the name Ms. has acquired a distinctive character by virtue of the use they may have made of it. What use they have shown is, as I have already said, modest to say the least. The onus is on the applicants to make their case, and I would have to say that on my assessment the evidence falls short. If I had not found the mark to be prima facie distinctive, on the evidence before me I would not have been persuaded that the mark had acquired a distinctive character through use.

50. Turning to the ground under Section 5(4)(a). That section reads as follows:

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

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

51. Mr Geoffrey Hobbs QC, sitting as the Appointed Person in the *Wild Child* trade mark case (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

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

52. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are

considerably more stringent than the enquiry under Section 11 of the 1938 Act (See Smith Hayden (OVAX) (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

53. Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign, either at the date that the application to register was made, or at an earlier date, if appropriate. There is no claim that the passing-off occurred at a date earlier than the date of application, so it is as at that date that I must view the opponents' reputation and goodwill.

54. The extract from Willings Press Guide (exhibit SCF3) states that the opponent's magazine under the title MIZZ was first published in 1985. A more precise date can be found in exhibit SCF2 which consists of a copy of a cover showing the magazine to have been available for purchase from at least as early as 12 April 1985. Although no figures relating to circulation have been provided, at a cover price of around 50p (extrapolated from the exhibits) turnover figures given for the years 1991 onwards show significant copy sales, from which I consider it reasonable to infer that the opponents have established a reputation and goodwill in the name.

55. The applicants claim to have first used their trade mark in the United Kingdom in 1972, much earlier than that of the opponents. But as I have indicated in my consideration of the grounds under Section 3(1), there is nothing that I can see that conclusively establishes this to have been the case, nor that they were using their trade mark from a date earlier than that of the opponents, and I must therefore conclude that based on the evidence before me, it is the opponents that have an earlier goodwill and reputation.

56. The opponents aim their publication at teenage females, whereas the applicant's target group appears to be feminists or those with an interest in feminism. I see no reason why teenagers, particularly those at the older end of this age range should not be interested in feminism, and accordingly there is some overlap in the customer base. But in any event, the specification of the application is limited to women in general, which must encompass both feminist and non-feminist consumers, including those in their teens.

57. Magazines are primarily obtained by self-selection which makes the visual appearance of the title (or trade mark) of primary importance, but I do not discount the potential for oral use, such as a consumer making an enquiry regarding the availability of a publication. Although magazines are relatively inexpensive items, the consumer is, I believe, discerning in the selection, where able, often picking up the magazine to glance through its contents prior to making the decision to purchase.

58. The words Ms and MIZZ are visually different, but are indistinguishable when spoken. Ms has a clear and known meaning as a gender title, and although the same cannot be said of MIZZ, I take the view that where an invented word parallels a known word in some way, in this case, in its phonetic similarity, it is capable of creating the same idea in the minds of the consumer, and particularly so when used in relation to goods linked to the idea, as in a magazine for girls. Although the applicants had clearly begun using their mark in connection with their publication well before the opponents put theirs into use, they have not established that this was the case in this jurisdiction.

59. I have already stated that from my own knowledge (and as illustrated by the applicants) I believe that publishers of magazines adopt titles that are allusive or semi-descriptive of their intended readership or content. In such circumstances it is not surprising that other publications elect to use names that are visually, aurally or conceptually similar. Whilst the consumer appears well able to discern one title from another, in adopting names with a reference to a characteristic of the magazine or its intended readership, traders knowingly run the risk of others adopting similar titles and some limited confusion arising.

60. In my view the consumer desirous of obtaining MIZZ magazine who selects or is handed a copy of Ms. will not have been deceived into purchasing the goods of the applicants believing it to be the product of the opponents; I do not consider that there is much in the way of source motivation in the purchase of a magazine, the selection being primarily based on the content. They and/or the trader will have been confused because of the similarity in the descriptive connotation of the title which I believe to be a circumstance of the trade. I do not see that in electing to use a title with some similarity to that of the opponents' magazine the applicants could be found to be guilty of misrepresentation, or to have trespassed onto the opponents' goodwill, or that the opponents will suffer damage in some material way. Accordingly I dismiss the ground under Section 5(4)(a).

61. The opposition having failed on all grounds, the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £635 as a contribution towards their costs. 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 19 day of June 2003

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