

**IN THE MATTER OF APPLICATION NUMBER 2136517A
IN THE NAME OF IPC MAGAZINES LIMITED
TO REGISTER A TRADE MARK IN CLASSES 9, 16 & 35**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 50532
BY LIBERTY MEDIA FOR WOMEN LLC**

**IN THE MATTER OF application number 2136517A
in the name of IPC Magazines Limited
to register a trade mark in Classes 9, 16 & 35**

And

**In the matter of opposition thereto under number 50532
by Liberty Media for Women LLC**

Background

1. On 20 June 1997, IPC Magazines Limited filed an application to register the trade mark MIZZ in Classes 9, 16 and 35 in respect of the following goods:

- 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. On 16 December 1999, Liberty Media for Women LLC filed notice of opposition in which they say they are the proprietors by assignment of the trade mark number 2041354 for the trade mark Ms/MS registered in Class 16. The grounds of opposition are in summary:

- 1. Under Section 5(2)(a) & (b)** because the mark offends against the provisions of the Act
- 2. Under Section 5(3)** to the extent that the services applied for are not identical or similar to the goods and services for which the opponents' earlier mark is protected and the mark applied for is identical or similar.
- 3. Under Section 5(4)** because use of the mark is liable to be prevented by virtue of the opponents' earlier right.
- 4. Under Section 3(1)(b) & (c)** because the mark is devoid of distinctive character and consists exclusively of a sign that serves to designate the kind, quality, intended purpose and other characteristics of the goods and services for which registration is sought.

3. The opponents rely on one earlier trade mark as follows:

Number	Mark	Class	Specification
2041354		16	Periodical publications for women

4. 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.

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

Opponents' Evidence

6. This consists of an Affidavit dated 3 August 2000, and comes from Marcia Ann Gillespie, Editor in Chief of Ms magazine owned by the opponents, a position she has held since 1993. Ms Gillespie says that she is the same Marcia Ann Gillespie who completed an Affidavit dated 17 July 2000 in connection with United Kingdom Trade Mark number 2041354 for the mark MS in the name of MacDonald Communications Corporation (assigned to the opponents), and which is shown as exhibit A. This exhibit confirms Ms Gillespie's involvement with the opponents, 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.

7. 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 shown as exhibit MG1, and shows the title Ms. but no date of issue or circulation details.

8. 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 and shows a retail price in \$US and \$Canadian so cannot be said to have been available in the United Kingdom. The book 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.

9. Ms Gillespie goes 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 Affidavit claims use of MS in the United Kingdom dating from 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 again in \$US or \$ Canadian and nothing to indicate 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.

10. 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 “magazines (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 once again shown in \$US and \$Canadian and 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.

Applicants’ evidence

11. This consists of two Statutory Declarations. The first is dated 4 May 2001, and comes from Sarah Christine Fisher, Publishing Director for IPC Media Limited, a position that she has held since June 2000. Ms Fisher gives her responsibilities as including the management of the strategy and direction of a number of brands, inter alia, MIZZ, the development of these in the media and product areas, initiating and overseeing market research into brand perception. Ms Fisher says that she had previously been employed as a publisher with IPC from November 1996 through to June 2000, also having responsibility for MIZZ magazine.

12. Ms Fisher refers to exhibit SF1 which consists of a Statutory Declaration dated 26 March 1998, and accompanying exhibits, filed during the Registrar’s examination of the application. She explains that the current Declaration supplements and updates 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.

13. The trade mark MIZZ was first used in the United Kingdom in 1985 in relation to a magazine, and has subsequently been used in relation to advertising and marketing services, stationery, books, make-up and toiletries and watches and also in connection with road shows at which T-shirts were sold. Exhibits SCF1 and SF2 consist of copies of the front covers of the 10 September 1997 and 12-25 April 1985 editions (respectively) of a magazine entitled MIZZ although only that shown at SF2 bears a date. Exhibits SF3 and SF4 consist of copies of the covers of further editions. Exhibits SCF2/SF6 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, although all but one item cannot be dated; a pocket diary from SF6 dated for 1996 and bearing the name MIZZ.

14. 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. Exhibit SCF4 contains extracts from the magazine, inter alia, giving details of a MIZZ road show held in 1996. Exhibit SF5 consists of a paperback book entitled MIZZ-True life stories, stated to have been first published in 1996.

15. Of the exhibits shown at SF7, SF8 and SF9, (consisting of a make-up mirror, watch and a body spray) sold under the MIZZ brand, only the mirror is claimed to have been available prior to the relevant date, but there is nothing to show this to have been the case. The watch and spray are provided to show the development of the applicant's merchandising. 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 significance.

16. 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 exhibit SCF3).

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

Year	Revenue from sales	Advertising revenue	Other revenue of magazine
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

18. 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.

19. Ms Fisher 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.

20. Exhibits SCF5 and SF13 give examples of advertisements relating to MIZZ placed in a magazine entitled 19 (also published by the applicants) 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. 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.

21. 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" noted as being 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.

22. 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.

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

24. 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 "teenage 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 does not 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 as having been founded in 1972.

25. 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 summary of the evidence insofar as it is relevant to these proceedings.

Decision

26. In his skeleton Mr Malynicz stated that the opponents would not be relying on the grounds under Section 3(1)(b), Section 3(1)(c), Section 5(3) or Section 5(4)(a). This leaves the grounds under Section 5(2)(a) and (b), although as the marks are clearly not identical the matter cannot come within subsection (a) and I dismiss that ground. The substance of the opposition therefore rests on subsection (b) of Section 5 which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

27. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an earlier trade mark means-

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

28. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723, in particular, that the likelihood of confusion must be appreciated globally and take into account all relevant factors.

29. The opponents rely on one earlier trade mark. This is for the word Ms which is registered in Class 16 in respect of “periodical publications for women”. 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.

30. The application also includes Class 16, seeking to register the mark in respect of magazines, albeit limited to being for “teenage girls and young women”. The term “periodical publications” would encompass “magazines” and self-evidently, the term “women” would include those considered to be “young”. Accordingly, in respect of Class 16 of the application there is identity in respect of goods.

31. Turning to the question of whether the goods and services in Classes 9 and 35 of the application are similar to those of the opponents’ earlier mark, I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 and in the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) the nature of the goods or services;
- (b) the end-users of the goods or services;
- (c) the way in which the goods or services are used;
- (d) whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) 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.

32. Class 9 of the application is in respect of “electronic publications published in magazine format”. Being “electronic” they must be different to the usual “paper” version, and accessed through different channels, although I am aware that it is possible to purchase subscriptions to printed publications via the internet, and also that certain printed publications are also published in electronic form. I see no reason why the end users should not be identical, and would consider the two modes of publication to be in competition and/or complementary. Taking a view in the round, I consider publications in printed and electronic form to be similar goods.

33. The Willings Press Guide exhibited in the evidence, states that MIZZ magazine carries advertising. The service of advertising is clearly not the same as the publishing of a magazine, but I do not consider that it would be going too far in saying that advertising is a common activity in magazines. Whilst the service is most likely to be used by a trader wishing to bring their goods or services to the attention of the reader, I am aware that some magazines also offer the service to its readership through a “classified” section. Insofar as magazines usually carry advertisements for products or services likely to relate to, or be of interest to their readership, could be regarded as complementary. Whatever the case, I take the view that the magazine and

the advertising service it provides can be regarded as closely allied, but whether this would lead to confusion is (as is the question of all of the goods and services covered by the application) a matter for determination as part of the “global” appreciation of all relevant factors.

34. The opponents claim to have first used their trade mark in the United Kingdom in 1972, much earlier than that of the applicants, but there is nothing that I can see that establishes this to have been the case, nor that they were using their trade mark from a date earlier than that of the opponents. There are the editions of Ms. magazine lodged with the British Library in 1985 and 1995, albeit apparently not as official Legal Deposit items, but this does not establish that the magazine was available to the consumer in at or between those dates. There is the reference in exhibit MG2, a book entitled “Inside Ms.” written by Mary Thom, which 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. Whilst this does provide some corroborative evidence as to use in this jurisdiction, there is insufficient detail in this, and the other evidence, from w to be able to deduce that the mark has been used to the extent that it has acquired a reputation deserving of a wide penumbra of protection.

35. The goods covered by Class 16 of the application and those covered by the opponents’ earlier mark are one and the same, the only difference being that the applicants have limited their publication to being for teenage girls and young women, whereas the opponents’ earlier mark is limited to women in general. As I have already said, the term “women” would encompass some females in their teens, and most certainly would cover “young women”. Accordingly, they notionally share the same channels of trade, from publication to consumer.

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 when 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.

37. The words Ms and MIZZ are visually different, but indistinguishable when enunciated in the usual or most likely manner. 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.

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.

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 a 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.

40. Taking the best view that I can on the evidence before me, and adopting the Aglobal@ approach advocated, I come to the view that the similarities may cause the consumer to bring to mind a publication available under a similar name, but that this will not lead to a belief that the two are in some way connected or that they will be confused into believing that they are from the same source. Accordingly, the ground under Section 5(2)(b) fails.

41. The opposition having failed, the applicants are entitled to an award of 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**