

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2230904  
BY MR PETER IMUWEDIYI AKPOROH  
TO REGISTER A TRADE MARK IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 51441 BY TIME OUT GROUP LIMITED**

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### **BACKGROUND**

1. On 11 March 2000 Mr Peter Imuwediyi Akporoh applied to register the trade mark TIME UP MAGAZINE in Class 16 for a specification of:- "Magazines and printed publications."

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal On 20 September 2000 Abel & Imray, on behalf of Time Out Group Limited filed a Notice of Opposition against the application on the following grounds:-

- (i) Under Section 5(2)(b) of the Act because the mark is similar to the following earlier UK registered trade marks owned by the opponent and is to be registered for the same and similar goods and there is therefore a likelihood of confusion on the part of the public:-

<b>NUMBER</b>	<b>MARK</b>	<b>REGISTRATION EFFECTIVE</b>	<b>GOODS</b>
1101611	TIME OUT	18 September 1978	Class 16 - Guide books and printed journals, all relating to events and entertainment in the United Kingdom.
1365525	TIME OUT	21 November 1988	Printed matter, magazines and periodical publications, all included in Class 16.

- (ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off as a result of the substantial use, reputation and goodwill in the opponent's TIME OUT trade mark

- (iii) Under Section 3(6) of the Act because the application was made in bad faith as the applicant would have been aware of the opponent's trade mark and the similarities between the marks

3. The applicant, through his agent Albert Olafare, filed a Counterstatement denying the grounds of opposition. Both sides filed evidence and asked for an award of costs in their favour. Neither party requested a hearing.

### **Opponent's Evidence**

4. This consists of an affidavit by Michael Hardwick dated 19 March 2001. Mr Hardwick is a director of Time Out Group Limited, the opponents and proprietor of the trade mark TIME OUT.

5. Mr Hardwick draws attention to Exhibit MH1 to his affidavit which is the 2000/2001 brochure of Time Out Group Limited which describes its activities, publications and services under the trade mark TIME OUT. He explains that the London TIME OUT magazine was first published in 1968 and is the best selling guide to London with an audited circulation of over 90,000 per week and a readership of more than 380,000. The magazine is an information guide to, *inter alia*, events, entertainment, sport, consumer news and the arts and includes many other features. Mr Hardwick adds that it is available at newsagents throughout the UK and is also available by subscription. It is published weekly at a price of £1.95 per issue.

6. Mr Hardwick goes on to state that

"There are several other London information guides sold under the trade mark TIME OUT including:-

- a) TIME OUT Eating & Drinking;
- b) TIME OUT Shopping Guide;
- c) TIME OUT Pubs & Bars;
- d) TIME OUT London Visitors Guide;
- e) TIME OUT Student Guide;
- f) TIME OUT Diary; and
- g) TIME OUT Kids Out;

and he explains that Guides a to f are referred to on pages 10 and 11 of Exhibit MH1 which give details of, *inter alia*, the content, pagination, format, frequency of publication, price, print runs and distribution. Their annual sales range between 20,000 for the TIME OUT Diary and 80,000 for the TIME OUT Eating & Drinking Guide. Guides a) to f) are sold throughout the UK and worldwide. Full details of the TIME OUT Kids Out information guide for parents are provided on pages 16 and 17 of Exhibit MH1 from which it can be noted that it is published monthly, costs £2,25, has a print run of 20,000 copies and is sold throughout the UK.

7. Mr Hardwick points out that TIME OUT also publish a number of further guides which are available in the UK. In 1990 the TIME OUT City Information Guides were launched and TIME OUT guides are now published for Amsterdam, Barcelona, Berlin, Bilbao (June 2001), Brussels, Copenhagen, Dublin, Edinburgh & Glasgow, Florence & Tuscany, Lisbon, London, Madrid, Naples, Paris, Rome, South of France, Venice and Vienna.

8. Other TIME OUT publications include: TIME OUT Film Guide, TIME OUT Country Walks, TIME OUT London Walks, TIME OUT Weekend Breaks and TIME OUT London Short Stories.

9. Mr Hardwick concludes that the TIME OUT trade mark is famous in the UK and he draws attention to the following quotations by third parties, taken from Exhibit MH1 (the Time Out Group Limited's brochure):-

- a) Campaign (page 5): "TIME OUT's 20 year history is inextricably bound up with that of London; a lifetime devoted to delivery and often instigating the very best of metropolitan culture"
- b) About TIME OUT New York: "London-based Time Out Group ..... has proven itself in the very difficult New York market ....[it has] parleyed its well-known and highly regarded brand and concept from London into one of the most successful American launches of the past decade" - Folio (page 7)
- c) National Geographic Traveller (page 8): "TIME OUT Paris stands out for its hip addresses"
- d) About TIME OUT Eating & Drinking: "Informative and excellent value" - Egon Ronay (page 11)
- e) Metro (page 11): "Sorry to gush but TIME OUT's annual London Shopping Guide is a bible"
- f) The Times (page 13): "The TIME OUT guides still lead the pack"
- g) About the TIME OUT City Guides: "These books are the most hip and culturally savvy I've used" - The New York Times (page 13)
- h) About the TIME OUT Guide to New York: "Great coverage of anything and everything from eating and drinking to culture and the best places to stay. An ideal companion to that last minute shopping trip" - The Daily Telegraph (page 13)
- i) The Independent on Sunday (page 14): "Anyone with a film nut in their life will find their prayers answered by the TIME OUT Film Guide - [it] boasts brainy critics by the bucketload and exemplary coverage of world cinema"
- j) About TIME OUT Kids Out: "One of the best sources of information [for families] in London" - The Independent (page 17)
- k) La Repubblica (page 18): "timeout.com is the bible for all metropolitan travellers"
- l) About "timeout.com": "The website is hip and essential, taking in a plethora of city guide, restaurants and entertainment reviews" - New Media Age (page 18)
- m) About "timeout.com": "The judges were all impressed by the site's 'awesome' amount of content and its high-speed search facility" - as another judge concluded: "This site shows that TIME OUT was born for the web" - Winner Best Entertainment Site, Yell UK Web Awards 2000 (page 18)

10. Mr Hardwick also points out that the magazine TIME OUT is often referred to as TIME OUT magazine and Exhibit MH2 to his declaration contains copies of pages downloaded from The Times and The Guardian websites in which TIME OUT magazine is referred to. He adds that as a result of such use the risk of confusion with TIME UP MAGAZINE would be increased.

### **Applicant's Evidence**

11. This consists of a statutory declaration by Peter Imuwediyi Akporoh dated 7 August 2001. Mr Akporoh is the editor and publisher of TIME UP MAGAZINE.

12. Mr Akporoh submits that the mark in suit and the opponents TIME OUT mark are not similar and only share the word TIME. He adds that the underlying expressions "TIME UP" and "TIME OUT" are different and he points out the existence of other publications such as "Time Magazine" and "The Times".

13. Mr Akporoh states that the applicant's and opponent's magazines are directed to entirely different markets, with the opponent's magazine being directed towards leisure and the applicant's magazine towards news, education, politics, religion and moral issues. He goes on to state that the applicant has at all times acted in good faith.

### **Opponent's Evidence in Reply**

14. This consists of a Witness Statement by Patrick James Barry dated 4 January 2002. Mr Barry is a Chartered Patent Attorney and the partner in Abel & Imray responsible for acting on behalf of the opponent.

15. Mr Barry draws attention to Exhibit PJB1 to his statement which is a copy of a letter from Abel & Imray to the applicant's professional representatives which is dated 4 January 2002. This letter contains an offer to settle the matter on the following basis:-

"Your client undertaking:

- a) not to use "TIME UP MAGAZINE" as a trade mark other than as a composite mark including the words "Nigeria's International News Magazine" and the "raised warning finger" logo;
- b) not to use the composite trade mark other than in respect of a magazine addressed to Nigerians or other ethnic minorities in the UK or overseas;
- c) not to use the composite trade mark other than in respect of religious, educational, political, scientific, humanitarian and moral issues and Nigerian news affairs; and
- d) upon the trade mark TIME UP MAGAZINE being registered by Application No 2230904, to make application on Form TM24 to register a memorandum stating that the trade mark proceeded to registration subject to an agreement with Time Out Group Limited.

Our client undertaking:

- a) to withdraw the Opposition on the basis of each party meeting its own costs."

16. This completes my summary of the evidence filed in this case. I now go to the decision.

## DECISION

17. I turn first to the ground of opposition under Section 5(2) which reads as follows:-

"5.-(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."

18. An earlier right is defined in Section 6, the relevant parts of which state:

6.-(1) .....

- (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,

19. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 27;
- (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*, paragraph 23;

- (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*, paragraph 23;
- (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*, paragraph 17;
- (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*, paragraph 24;
- (g) 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*, paragraph 26;
- (h) 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*, paragraph 41;
- (i) 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*, paragraph 29.

20. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection afforded to such a mark. The opponent has filed evidence relating to the reputation of the mark TIME OUT covered by their prior registrations and on the basis of this evidence it is my view that the trade mark has a reputation in relation to magazines and guide books/booklets. Indeed, the repute of the opponent's TIME OUT trade mark does not appear to be disputed by the applicant.

21. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. In this case it is accepted that the opponents TIME OUT mark has a reputation. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

"The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."

22. Furthermore, in addition to making comparisons which take into account the opponent's actual use (the applicant's have no use prior to the relevant date), I must also compare the marks applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

23. The goods specified within the application in suit and the opponent's registrations both cover "magazines and printed publications" and are accordingly, identical. I must take this into account in relation to normal and fair use of the respective marks. Turning to actual use, the applicant submits that the opponent's magazine and the applicant's magazine are directed to entirely different markets - paragraph 13 of this decision refers. However the applicant's mark has not been used prior to the relevant date (11 March 2000), and the opponent's magazine is of relatively general interest and is not a specialised and narrowly focussed publication as such. On the basis of the evidence before me, I do not believe the applicant's submissions on this point to be of any great assistance.

24. The application in suit consists of three common dictionary words "TIME", "UP", and "MAGAZINE". "MAGAZINE" merely describes the goods. The remainder ie. "TIME UP", in totality has it's own obvious signification, meaning that time has run out. On the other hand, the opponent's registrations comprise the common dictionary words "TIME" and "OUT" and the totality ie. "TIME OUT", is a well known term which can be found in the dictionary and refers to a break taken during work or to a break in play taken in some sports. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind in my considerations.

25. Turning first to a visual comparison of the marks, I find them quite different overall. While the word "MAGAZINE" in the application in suit does not assist in distinguishing the marks, as it merely describes the goods, and although both marks share the word "TIME", I see no reason why the word "UP" in the applicant's mark and the word "OUT" in the opponent's registrations would be ignored, marginalised or imperfectly recollected by customers in visual use. It seems to me that the different connotations of TIME UP and TIME OUT are likely to be retained in the customers mind and I will consider this under conceptual similarity in due course.

26. On the consideration of aural use of the marks it is my view that the respective marks in their totality are aurally distinct as, once again, I do not believe that the elements comprising the words UP and OUT would be ignored or that the marks would be imperfectly recollected by customers.

27. Conceptually, I consider the marks different. The applicant's mark indicates that time has run out while the opponent's registrations brings to mind a break from work or routine. I note that, in their submissions, the opponent's argued that TIME UP is grammatically incorrect as the correct expression is TIME'S UP. While this may be so, I do not believe this has any real bearing on how the mark would be perceived by customers in the normal course and circumstances of trade.

28. I now go on to consider the relevant customer for the goods and while I have no evidence before me on the point, it seems to me that the relevant customer for magazines is likely to be reasonably but not unduly careful in their purchase. My own knowledge and experience tells me that, customers are usually fairly selective in their choice of reading material, but perhaps not overly selective in the case of general interest magazines. Although magazines are often bought in a hurry, this is not a "bag of sweets" case.

29. On a global appreciation I have come to the conclusion that, while it is possible that some people encountering the applicant's mark may think it reminiscent of the opponent's mark it does not follow that a likelihood of confusion exists. Given the visual, aural and conceptual differences between the marks and after taking into account all the relevant factors (including reputation, imperfect recollection, the category of goods and the customer for the goods), it seems to me that the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood. The opposition under Section 5(2)(b) fails.

30. Next, I consider the ground of opposition under Section 5(4)(a), which states:-

"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

(b) .....

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."

31. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the WILD CHILD case (1998) 14 RPC 455. In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

"A helpful summary of the elements of an action for passing off can be found in

Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) 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
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

32. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed .....". The relevant date is therefore the dates of the application for the mark in suit.

33. Earlier in this decision I found that the application in suit and the opponent's registrations were not confusable. Accordingly it is my view that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) therefore fails.

34. Finally, the Section 3(6) ground. Section 3(6) states:-

"A trade mark shall not be registered if or to the extent that the application is made in bad faith."

35. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* 1999 RPC 367, Lindsay J considered the meaning of "bad faith" in s3(6) of the Act and stated (a page 379):

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not

the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

36. Commenting on this passage from Gromax, Mr Geoffrey Hobbs QC, acting as the Appointed Person, stated in Demon Ale Trade Mark 2000 RPC 355,

"These observations recognise that the expression "bad faith" has moral overtones which appear to make it possible for an application for registration to be rendered invalid under Section 3(6) by behaviour which otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant. "

37. Thus bad faith can be exercised where there is no actual dishonesty as such. Have the applicants fallen short of the standards of acceptable commercial behaviour, however? The opponents submit that bad faith existed on the part of the applicants because they were aware of the opponent's trade marks and reputation at the date of application. However, in light of my earlier findings on the other grounds of opposition raised, this ground cannot succeed.

38. In a recent unreported decision of the Appointed Person. In the matter of application No. 2031741 by Eicher Limited - Royal Enfield Motor Units to register a mark in Class 12 and in the matter of opposition thereto under No. 45356 by David Matthew Scott Holder T/a Velocotte Motorcycle Co for a declaration of invalidity in respect of Trade Mark No. 1514064 in the name of Eicher Limited - Royal Enfield Motor Units, paragraph 31, Simon Thorley WC in relation to Section 3(6) stated that:

*"An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in Associated Leisure v. Associated Newspapers (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see Davy v Garrett (1878) 7 Ch. D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference."*

39. The opposition under Section 3(6) fails.

40. The applicant is entitled to a contribution towards his costs and I therefore order the opponents to pay him the sum of £600. 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 24 day of April 2002**

**JOHN MacGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**