

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2009184
IN THE NAME OF MAPLELEAF HOLDINGS LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45297 IN THE NAME OF
THE NATIONAL MAGAZINE COMPANY LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2009184
in the name of Mapleleaf Holdings Limited**

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and

**IN THE MATTER OF opposition thereto
under No. 45297 in the name of
The National Magazine Company Limited**

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Background

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On 28 January 1995, Mapleleaf Holdings Limited, of 413 Bury Old Road, Prestwich, Manchester, M25 5PS, applied to register the trade marks HE TO SHE in Classes 16 and 42 in respect of:

Class 16

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Printed publications; books, magazines and catalogues.

Class 42

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Medical, hygienic and beauty care services; cosmetic research; dress rental services; information services relating to fashion; agency services for arranging personal introductions; provision of information relating to transvestism and transsexualism.

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On 4 September 1996, The National Magazine Company Limited filed notice of opposition to this application. The grounds of opposition are in summary:-

1. **Under Section 3(1)(a)** Because the mark applied for is not capable of distinguishing the goods and services of the applicants from those of other undertakings
2. **Under Section 3(3)(b)** Because by virtue of the opponents' reputation in the trade mark SHE, the mark applied for is of such a nature as to deceive the public
3. **Under Section 3(4)** Because use of the applicants' mark is liable to be prevented by the law of passing off
4. **Under Section 3(6)** Because the mark was applied for in bad faith

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5. Under Section 5

Because the opponents are the proprietors of an earlier trade mark which is registered in respect of goods identical/similar to the goods/services covered by the application and there exists a likelihood of confusion on the part of the public which includes the likelihood of association.

Furthermore, the opponents earlier trade mark has a reputation in the United Kingdom and use of the mark applied for without due cause would take unfair advantage of or be detrimental to, the distinctive character or repute of the opponents earlier trade mark.

5. Under Section 5(4)(a)

By virtue of the law of passing off.

The opponents ask that the application be disallowed in the Registrar's discretion.

The opponents' registration referred to in the grounds of opposition is as follows:

| No. | Mark | Class | Journal/Page | Specification |
|--------|------|-------|--------------|----------------------|
| 721023 | SHE | 16 | 3939/1079 | Printed publications |

The applicants admit that the opponents are the proprietors of registration number 721023 and that the opponents have been using the trade mark SHE in relation to printed publications. They deny all other grounds asking that the application be allowed.

Both sides ask for an award of costs in their favour.

The matter came to be heard on 28 June 1999, when the opponents were represented by Mr Graham Shipley of Counsel instructed by Wildbore & Gibbons, their trade mark attorneys, the applicants were not represented.

Opponents' evidence

This consists of a Statutory Declaration dated 7 March 1997, executed by Stephen Rustat Hemsted, a Director of The National Magazine Company Limited, the opponents in these proceedings. Mr Hemsted says that he has been involved in the magazine publishing field for the previous 19 years although he does not say in what capacity, nor confirm the length of time that he has been with his present company.

He begins by saying that SHE is one of the magazines published by his company and is aimed at women in the 25 - 44 age group. He refers to exhibit SRH1 which consists of copies of the front cover of SHE magazine dating from October 1988 and January 1995, both of which clearly bear the title SHE. Mr Hemsted goes on to refer to the particulars of his company's trade mark registration, and to exhibit SRH2 which consists of a copy of the advertisement of the mark published in the Trade Marks Registry Journal.

Mr Hemsted continues saying that SHE magazine is well known throughout the United Kingdom and is widely published and advertised through trade magazines and other media, and sets out the “approximate” advertising expenditure for SHE magazine in the years 1988 to 1994, which is as follows:

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| | |
|------|----------|
| 1988 | £107,000 |
| 1989 | £33,000 |
| 1990 | £389,000 |
| 1991 | £102,000 |
| 1992 | £120,000 |
| 1993 | £127,000 |
| 1994 | £182,000 |

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He goes on to say that SHE magazine is one of the best selling magazines in the United Kingdom, and gives the monthly sales figures from 1990 to 1994 which are as follows:

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| | |
|------|---------|
| 1990 | 234,000 |
| 1991 | 269,000 |
| 1992 | 286,000 |
| 1993 | 255,000 |
| 1994 | 269,000 |

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Mr Hemsted next says that his company offers clothing and other fashion accessories for sale through its magazine, and that the trade mark SHE is applied to these goods. He says that from 1955 his company has continuously used the trade mark SHE on clothing, and goes on to set out the turnover figures for these goods, by year, from 1985 to 1994, and which ranges from £126,000 in 1985 to a peak of £551,000 in 1991.

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Mr Hemsted goes on to refer to the high quality of his company's magazine, and by inference, also its clothing. He makes reference to the application which he says includes his company's valuable trade mark SHE, and gives his views on the likely confusion should the application be registered, and the consequential damage that his company would suffer.

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Applicants' evidence

This consists of a Statutory Declaration dated 30 September 1996, by Stephanie Anne Lloyd, Managing Director of Mapleleaf Holdings Limited, a company she established in 1984.

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Ms Lloyd says that the trade mark HE TO SHE was first used by her company in 1989 in relation to the provision of goods and services to transsexuals and transvestites. She refers to exhibit SAL1 which she says consists of a copy of the first magazine published under the mark HE TO SHE. The magazine clearly bears this title HE TO SHE although preceded by the word FROM. The word HE is represented in blue and the word SHE in pink. No date of publication is given and consequently, the exhibit can be given little if any weight.

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Ms Lloyd continues saying that her company has extensively used the trade mark HE TO SHE

and TRANSFORMATION HE TO SHE since that date (1989?) through wholly owned subsidiaries, associated companies and distributors, and in respect of a range of goods and services which she lists and which are the same as set out in the application. She says that sales in the United Kingdom under the HE TO SHE trade mark have been approximately £2,000,000
5 per year, of which, 90% has been in respect of sales of goods, the remaining 10% in respect of services.

Ms Lloyd again confirms that the magazine HE TO SHE has been on sale at all of her company's shops throughout the United Kingdom since 1989, and in addition, for a period of five years her
10 company has sent out a free quarterly magazine under the name TRANSFORMATION HE TO SHE, a copy of which is shown at exhibit SAL2. The word TRANSFORMATION in the title is shown in a stylised italic script with HE TO SHE in a different script placed underneath. No date of publication is given and consequently this exhibit can be given little, if any weight.

Ms Lloyd continues saying that her company has spent about £250,000 per annum on advertising the mark HE TO SHE in the national press, and refers to exhibit SAL3 which consists of a number of advertisements relating to goods and services for transvestites, all of which are undated with some clearly relating to the United States, Germany and Ireland. In all but one instance the words HE TO SHE are preceded by the word FROM. Ms Lloyd says that in addition, her
20 company has sent out monthly promotions to mail order clients at a cost of approximately £400,000 per annum.

Ms Lloyd next refers to the apparent lack of confusion or serious damage to the opponents' trade mark, saying that as the companies have been operating concurrently for 10 years, this suggests that there has been no confusion. She refers to exhibit SAL4, which consists of a list of her
25 company's trade mark applications and registrations for the trade mark HE TO SHE, which apart from the application which is the subject of these proceedings, relates to other jurisdictions. Ms Lloyd goes on to say that in her opinion the public on seeing the trade mark HE TO SHE used in relation to magazines, printed matter or services will believe that they emanate from her
30 company, and that the mark is totally identified with her company.

Ms Lloyd continues by referring to the magazine produced by the opponents which she says is aimed at a totally different target audience. She concludes by repeating her opinion that the respective marks are not similar, and that in view of her company's long use of the mark HE TO
35 SHE and the apparent lack confusion to date, that the application should be registered.

Opponents' evidence in reply

This consists of a Statutory Declaration dated 21 October 1997, by Stephen Rustat Hemsted who
40 also completed the Declaration dated 7 March 1997 referred to earlier in this decision.

Mr Hemsted refers to the Statutory Declaration filed by Stephanie Ann Lloyd on behalf of the applicants. He makes particular reference to the fact that the magazine forming exhibit SAL1 to that Declaration is not dated, drawing the conclusions that it does not establish use at the date
45 claimed or that any use has been continuous from that date, which in his view may account for his company's lack of awareness of the applicants until the application was published in the Trade Marks Journal.

Mr Hemsted next refers to his Declaration dated 7 March 1997, giving his views on the facts he believes were established by that Declaration. He confirms his company's fears that confusion will arise between his company's and the applicants' magazines, saying that in view of the nature of HE TO SHE magazine his company may not be aware of it, particularly because it is a magazine which people would not admit to reading. He goes on to comment on the readership of applicants' magazine who he says are just as likely to read his company's magazine.

He says that his company prides itself on the quality of the magazines, and refers to the target audience and popularity of SHE magazine. He questions the consequences should the applicants' magazine be sold on open shelves in mainstream retail outlets and that if the applicants use their HE TO SHE mark in a normal and fair manner, in his view deception and confusion will arise.

Mr Hemsted continues saying that he is concerned by the content of the applicants' magazine which in his view could do damage to his company's SHE magazine. He refers to the prohibition on the registration of marks which would be contrary to public policy or accepted principles of morality, concluding that while the applicants' goods and services provided under the HE TO SHE mark could not be said to be contrary to public policy, they would be contrary to accepted principles of morality as far as the majority of people are concerned, and refers to exhibit SRH3 which consists of a copy of Section 3 taken from the Trade Marks Act 1994. He gives his views on the descriptiveness of the applicants' mark in relation to the goods and services for which registration is sought which he says are contrary to accepted principles of morality, concluding that the registration would damage his company's reputation and goodwill in its SHE trade mark.

Decision

I turn first to consider the ground under Section 3(1)(a). The opponents contend that the mark is not capable of distinguishing the goods and services of the applicants from those of other traders, although have not given any further details. Section 3(1)(a) of the Act reads as follows:

3(1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

Section 1(1) of the Act reads as follows:

1-(1) In this Act "trade mark" means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

There is no suggestion that the mark HE TO SHE is not represented graphically so the question, therefore, is whether the mark is capable of distinguishing the goods of the applicants from those of other traders. At the hearing Mr Shipley contended that the mark HE TO SHE may also be open to objection under Sections 3(1)(b), © & (d), but as the applicants had applied for a specification of goods wider than the particular area in which they trade the opponents were not

in a position to object under these sub-sections. If the goods covered by the application had been limited to a particular type, eg, “printed publications relating to transsexuals” and the application found to be contrary to Section 3(1)(b), © or (d), then it seems to me that if the goods were expressed in more general terms, eg, “printed publications”, the application must also be open to objection as the latter description of goods would include the former. The objection would be more obvious with the limitation but no less objectionable without. As was observed by Geoffrey W Tookey QC, in the Hold and Draw trade mark case (1964) RPC 6:

“..an applicant cannot obtain an advantage merely by a specification of goods so wide as to veil from the Registrar the precise character of the goods upon which he intends to use the mark.”

Turning to the matter of the objection under Section 3(1)(a), in the AD2000 trade mark case (1997) RPC 174, Geoffrey Hobbs sitting as the Appointed Person said:

“In order to be eligible for registration under the Act a sign must possess the qualities identified in section 1(1) and none of the defects identified in section 3.”

and

Section 3(1)(a) prohibits the registration of “signs” which do not satisfy the requirements of section 1(1) (because they are incapable of being represented graphically and/or incapable of distinguishing the goods or services of one undertaking from those of other undertakings) whereas the prohibitions of sections 3(1)(b), © and (d) are applicable to “trade marks”, ie signs which satisfy the requirements of section 1(1). From the proviso to section 3(1) it is apparent that sections 3(1)(b), 3(1)(c) and 3(1)(d) prohibit the registration of signs which satisfy the requirements of section 1(1), but nonetheless lack a distinctive character in the absence of appropriate use. This implies that the requirements of section 1(1) are satisfied even in cases where a sign represented graphically is only “capable to the limited extent of not being incapable of distinguishing..”.

In the Phillips Electronics NV v Remington Consumer Products Limited trade mark case, (1998) RPC 283, Jacob J stated:

‘Now it is of course the case that a mark (particularly a word mark) may be both distinctive of a particular manufacturer and yet also convey something by way of meaning of the goods....But you can take this argument too far. There are words which are so descriptive that they cannot be trade marks - “soap” for “soap”. The difference is one of degree, but important nonetheless. There are degrees of descriptiveness ranging from skilful but covert allusion to the common word for the goods. On the scale of distinctiveness you come to a point when a word is so descriptive that it is incapable of distinguishing properly, even if it does so partially. If that the position then it is “incapable of distinguishing” within the meaning of Article 2 of the Directive. And likewise the mark is then devoid of distinct character...’

There is no evidence that the term HE TO SHE is a term used by any other traders. At the hearing Mr Shipley took the view that the expression HE TO SHE is grammatically incorrect, which supports the position that the term is not the most likely way to describe the act of transvestism or transsexualism, or in other words, the subject matter of the goods and services of the application. I therefore come to the conclusion that the expression HE TO SHE is, as Geoffrey Hobbs put it, “capable to the limited extent of not being incapable of distinguishing....” and consequently, the opposition under Section 3(1)(a) fails.

Although not raised in the grounds of opposition, in view of my earlier comments I consider it appropriate to consider whether the mark HE TO SHE is open to objection under Section 3(1)(b), © & (d). There is no evidence that the mark HE TO SHE is generic or is a term which other traders would wish to use in the ordinary course of trade. I come to the view that the mark HE TO SHE is a covert, if not all that skilful allusion to a characteristic of the goods, and that the mark does not contravene sub-sections (b), © or (d).

Turning next to the objection under Section 3(3), which reads:

3(3) A trade mark shall not be registered if it is-

- (a) contrary to public policy or to the accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)

Although the notice of opposition refers to sub section (b) of Section 3, from the opponents' evidence and Mr Shipley's submissions at the hearing it would appear that their objection under this section relates to the subject matter of the goods and services provided under the mark which they claim to be contrary to the accepted principles of morality and which properly falls to be considered under sub-section (a). However, in my view it makes little difference under which sub-section the objection falls. There is no indication that the trade mark would be contrary to public policy or cause offence, or that there is anything inherent in the trade mark which would deceive the public, and no evidence has been submitted to substantiate these grounds. Consequently, I dismiss the objection under Section 3(3)(b) as specified in the grounds of opposition, and find the mark not be contrary to Section 3(3)(a).

The next ground is under Section 3(6) which reads as follows:

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The opponents' objection is based on the range of goods set out in the application. At the hearing Mr Shipley took the view that the evidence showed that the applicants had not traded in the full range of goods for which registration is sought, and that this constituted bad faith. Section 32(2) of the Act sets out the basic requirements for filing an application to register a trade mark, which must include a statement of the goods or services in relation to which it is sought to be registered. Section 32(3) requires an application to state that the trade mark is being used by the applicants (or with their consent) in relation to the goods and services specified in the application, or that

there is a bona fide intention to use the mark in relation to these goods and services. The use of the words “bona fide intention to use the mark” in the wording of Section 32(3) makes it clear that the applicants need not be trading in the full range, or indeed any of goods and services at the time the application is made.

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An application which seeks to register a mark in respect of goods or services for which there is no present or future intention to trade is an act of bad faith. In this case the applicants have signed the prescribed form of application which includes a statement in accordance with Section 32(3), and although previous trading patterns could be taken to suggest that the applicants may not move to trade in all areas covered by the application, I have no evidence that they will not. Accordingly, I dismiss the objection under Section 3(6)

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In the particulars of their objection under Section 3(4), the opponents have stated that “Use of the applicants' mark would be prohibited by the law of passing off”. The Act makes specific provision for oppositions based on the common law tort of “passing off” which properly falls to be considered under Section 5(4)(a), and to which I will come later in this decision. Section 3(4) is an absolute ground which in my view is intended to prevent the registration of trade marks which would contravene the law because of some intrinsic feature of the trade mark. The question of the other parties rights in the mark is a matter to be dealt with in considering relative grounds for refusal, and consequently, the ground of opposition under Section 3(4) is also dismissed.

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I next turn to consider the grounds of opposition under Section 5 of the Act. The opponents did not particularise the sub-sections of Section 5 under which they object, although the wording suggested that this would fall to Section 5(2)(b) and Section 5(3). I note the remarks of Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child case, (1998) RPC 455, when referring to the scope of the opposition said:

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“In the interests of justice and fairness it is plainly necessary for an objection to registration under Section 5(4) to be framed in terms which: (i) specify whether the objection is raised under sub-section 4(a) or sub-section 4(b); (ii) identify the matters which are said to justify the conclusion that use of the relevant trade mark in the United Kingdom is liable to be prevented by virtue of an “earlier right” entitled to recognition and protection under the relevant sub-section; and (iii) state whether the objection is raised in respect to all or only some (and if so, which) of the goods....”

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I see no reason why the interests of justice and fairness should not extend to Section 5(2) and Section 5(3). At the hearing Mr Shipley confirmed that the objections fell under Sections 5(2)(a), 5(2)(b) and Section 5(3), and I will turn first to Section 5(2) which reads:

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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,

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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.

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

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

The opponents rely on one trade mark in their name, numbered 721023 for the trade mark SHE which is registered in Class 16 and in respect of “Printed publications”. Having a date anterior to that of the application, this registration is an earlier trade mark within the meaning of Section 6(1)(a) of the Act.

The applicants' mark HE TO SHE is self evidently not an identical mark to the opponents' earlier trade mark, and it follows that the objection founded on Section 5(2)(a) must fail, which leaves the matter of sub-section (b). Looking first at the respective goods and services. The specification of goods for Class 16 of the application includes the description printed publications which would cover identical goods for which the opponent' earlier trade mark is protected. This leaves the services shown in Class 42 of the application, which are as follows:

Medical, hygienic and beauty care services; cosmetic research; dress rental services; information services relating to fashion; agency services for arranging personal introductions; provision of information relating to transvestism and transsexualism.

In a comparison of the services covered by the application and the goods set out in the opponents' registration, I look to the British Sugar Plc v James Robertson & Sons Ltd (TREAT) trade mark case (1996) RPC 9 in which Jacob J says:

“I think the sort of considerations the court must have in mind are similar to those arising under the old Act in relation to goods of the same description. I do not say this because I believe there is any intention to take over the conception directly. There plainly is not. But the purpose of the conception in the old Act was to prevent marks from conflicting not only for their respective actual goods but for a penumbra also. And the purpose of similar goods in the Directive and Act is to provide protection and separation for a similar sort of penumbra. Thus I think the following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

- © The physical nature of the goods or acts of service;
- (d) The respective 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 in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective good or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act of industry, put the good or services in the same or different sectors.

This is rather an elaboration on the old judicial test for goods of the same description. It seeks to take account of present day marketing methods. I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance). I do not pretend that this list can provide other than general guidance. The fact is that the Directive and hence our Act have introduced an area of uncertainty into the scope of registration which in many cases can only be resolved by litigation.”

Insofar as the provision of a service may involve use of printed matter, catalogues, etc, I can see no reason why the goods covered by the opponents' registration could not be used in the provision of the service, although as an adjunct rather than as part of a wider trade. It seems quite feasible that a user of the applicants' services could also be a reader of the opponents' magazine. The evidence shows that the applicants advertise their services in national newspapers which would be sold alongside, and will quite likely be seen by readers of the opponents' magazine. Magazines nowadays cover a wide and varied range of topics and it is not unreasonable to assume that a magazine aimed at a female readership would include advice and information relating to services contained within the application. That said, I do not consider that a magazine would be regarded an alternative or to be in competition with the applicants' services. While I can see the possibility of there being some similarity between the subject matter of opponents' magazine and the services provided by the applicants, it is not commonplace for the publisher of a magazine which may contain articles to provide the services referred to, and taking this and my previous comments into account, I come to the view that the applicants' services and the opponents' goods are not similar.

As the goods covered by Class 16 of the application are identical, the matter falls to be decided by a comparison of the marks themselves. For this purpose I have regard to *Sabel BV v Puma AG* (1998) RPC 199 in relation to Article 4(1)(b) of the First Council Directive of 21 December 1988, which corresponds directly with Section 5(2)(b), in which the European Court of Justice in dealing with the issue of comparison of marks said:

“..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign

and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

5 That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - 'there exists a likelihood of confusion on the part of the public ' - shows that the perception of marks in the mind of the average consumer of the type of goods or
10 services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

15 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public."

20 I also take into account the decision of the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117. In particular I take note of the following:

25 A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services
30 identified.

35 and

It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.

40 Finally the court gave the following judgement on the interpretation of Article 4(1)(b):

45 "On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

There may be a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 89/104 even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.”

In the view of Mr. Geoffrey Hobbs QC, acting as the Appointed Person, in the Balmoral case (Application No. 2003949):

“The tenth recital to the Directive and these observations of the Court of Justice indicate that an objection to registration under Section 5(2) of the Act should be taken to raise a single composite question: are these similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “*the earlier trade mark*” and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?”

Mr Shipley referred to the fact that the evidence showed that the applicants appeared to only sell their goods by mail order or in their own shops, On the face of it, this would seem to remove the likelihood of the respective goods coming into contact and serves to move the marks even further apart. However, under Section 5(2), it is the mark as applied for allowing for normal and fair use, and as Mr Shipley quite rightly pointed out, as the applicants have not limited the specification of goods to reflect the manner in which they trade I must consider the position with regard to the mark as applied for and assuming that the applicants' goods were on sale in the usual way.

While the consideration of the likelihood of confusion requires a composite approach, it is inevitable that in reaching a decision reference will be made to the similarity of individual elements of the marks. In a comparison of the applicants' mark HE TO SHE and the opponents' mark SHE, it is self evident that any similarity must rest in the word SHE as this is the only element common to both marks. Insofar as they share an element in common there must be at least some degree of visual and aural similarity, although the word SHE in the applicants' trade mark is no more the essential feature than the word HE, if anything it could be argued that being at the end of the mark (which is generally regarded as the least important part of a mark) it is of lesser importance.

The word SHE is an ordinary English word and would be recognised as such by the public and consequently has a low threshold of distinctiveness. In *The European Limited v The Economist Newspaper Limited* (1998) ETMR 251-336, Millett LJ said:

“Where descriptive words are included in a registered trade mark, the courts have always and rightly been exceedingly wary of granting a monopoly in their use.”

While I do not take this to the extreme and say that the proprietors cannot claim a monopoly in the word SHE, the fact that it is an ordinary and very well known word with some degree of descriptiveness for the goods means that a greater degree of similarity is required to establish a likelihood of confusion than would have been the case had the opponents' mark been an invented word.

The opponents' reputation is a material consideration in determining the question of similarity, and ultimately, the likelihood of confusion. The evidence gives various figures and includes the monthly copy sales of their magazine, although without further details relating to the size and their share of the market the extent of opponents' reputation cannot be fully established. However, the length of use, copy sales and the level of advertising expenditure is sufficient to suggest that they are likely to have established a reputation and goodwill in the United Kingdom in respect of a magazine for women. The opponents say that they have for some time also sold clothing under the SHE trade mark, and that they have a reputation in respect of these goods. However, beyond turnover figures there is no evidence to support this claim or to show how the mark was used, and given the size of the clothing market the total sales are, if not de minimis, are not far from it. I am therefore unable to conclude that they have any appreciable reputation in respect of anything other than a magazine for women, and conclude that this is essentially a 'one product' mark.

The circumstances of the trade are, I believe, also relevant and should be taken into account. Titles of magazines by their nature tend to make varying degrees of reference to their subject matter or target readership, and in what is a very crowded market this places constraints on the number of descriptive terms available. Consequently, it is not surprising that the titles of different magazines aimed at the same market sectors often have elements in common or are conceptually very similar, and a visit to almost any newsagent will show this to be the case, for example, Woman, Woman's Own, Woman's Weekly, New Woman are the titles of magazine. I take the view that the public is aware of this situation and is well used to differentiating between one magazine and another.

Taking account of all the above, I find that the mark HE TO SHE is not sufficiently similar to the opponents' mark SHE such as to create a likelihood of confusion. Consequently, the opposition under Section 5(2)(b) fails.

I turn next to consider the grounds under Section 5(3) which reads:

5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

The basic requirement for an objection under Section 5(3) is that the application for registration should be for the same or similar mark to the opponents' earlier trade mark, and that the application should be in respect of dissimilar goods or services for which this earlier right is protected. I have previously found the marks not to be similar, but in case I am found to be

wrong I will go on to consider the other aspects of an objection under Section 5(3).

5 It has already been established that the opponents trade mark registration number 721023 qualifies as an earlier trade mark within the meaning of section 6(1) above, and that they have a reputation and goodwill in respect of magazines for women. The opponents also claim a to have used the mark SHE in respect of clothing, but as they do not have a registered trade mark for these goods which constitutes an “earlier trade mark” within the meaning of Section 6(1), the opposition founded under Section 5(3) in relation to that trade must fail.

10 I have previously found the goods covered by Class 16 of the application to be identical, but the services covered by Class 42 not to be similar to the goods for which the opponents' earlier trade mark is protected. Consequently, the opposition must fail under Section 5(3) in respect of Class 16 of the application. This leaves the question of the services set out in Class 42 of the application. In *RBS Advanta v Barclays Bank plc* (1996) RPC P307, Laddie J. considered the meaning of the proviso to Section 10(6) of the Act which deals with comparative advertising. The second half of the proviso contains wording identical with the wording in Section 5(3) of the Act. Laddie J. expressed the following view on the meaning of the above words in that context:

20 “At the most these words emphasise that the use of the mark must take advantage of it or be detrimental to it. In other words the use must either give some advantage to the defendant or inflict some harm on the character or repute of the registered mark which is above the level of *de minimis*.”

25 I will deal first with the question of advantage to the applicants. In the Oasis Stores Ltd's (EVEREADY) trade mark application (1998) RPC 631, the registrar's Hearing Officer said:

30 “Where the applicants’ mark consists substantially of dictionary words which allude to (but do not directly describe) the nature of the goods in respect of which it is proposed to be registered, I think that the Registrar should be slow to infer that use of the mark will take unfair advantage of the distinctive character of an earlier mark consisting of the same dictionary words. The most that can be said here is that the applicants’ mark makes a vaguely similar allusion to the nature of the applicants’ goods as the opponents’ mark makes to theirs. The link is tenuous and unsurprising given that dictionary words are concerned. In these circumstances, the ‘bringing to mind’ of the opponents’ trade mark, insofar as it occurs, is likely to be no more than word association.”

40 I cannot disagree with this judgement which seems to be a reasonable statement of the position in this case. I have already said that the title of magazines tend to refer in some way to their subject matter or target readership, and it seems that the market is able to tolerate conceptually similar marks being used for different publications. Given this, I cannot see what, if any benefit the applicants would derive in respect of their services, and note that the opponents themselves do not say that the applicants have adopted the trade mark HE TO SHE to gain advantage from their reputation or goodwill in the SHE trade mark. I therefore conclude that the applicants' mark does not take unfair advantage of the opponents' trade mark.

45 In the EVEREADY case referred to above, the Registrar's Hearing Officer addressed the issue of detriment to the distinctive character of the opponents' mark, saying:

“Any use of the same or a similar mark for dis-similar goods or services is liable, to some

5 extent, to dilute the distinctiveness of the earlier mark. The provision is clearly not intended to have the sweeping effect of preventing the registration of any mark which is the same as, or similar to, a trade mark with a reputation. It therefore appears to be a matter of degree. In considering detriment under this heading it appears to me to be appropriate to consider:

1. The inherent distinctiveness of the earlier trade mark;
2. The extent of the reputation that the earlier mark enjoys;
- 10 3. The range of goods or services for which the earlier mark enjoys a reputation;
4. The uniqueness or otherwise of the mark in the market place;
- 15 5. Whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets;
- 20 6. Whether the earlier trade mark will be any less distinctive for the goods/services for which it has a reputation than it was before.”

25 I have already found the opponents' mark SHE to be semi-descriptive, or at least, to have a degree of association with the content and target readership of the magazine. I have also accepted that they have established a reputation and goodwill in respect of the mark in respect of magazine for women.

30 I have no evidence of the uniqueness or otherwise of the mark in the market place, and while the opponents' magazine may include articles which relate to the same services provided by the applicants, they are unlikely to come into contact in their usual channels of trade. I thus conclude that registration and use of the applicants' mark will not have a detrimental effect on the distinctive character of the opponents' mark for the goods in respect of which it enjoys a reputation.

35 This leaves the matter of whether use of the applicants' mark would be detrimental to the reputation of the opponents' trade mark. The opponents objection appears to be primarily directed at the subject matter of the applicants' magazine which they consider to be of a nature likely to cause offence to the public, and which if mistakenly linked with them would cause damage to their trade mark. I have already determined that the objection under Section 5(3) fails in respect of Class 16 of the application, and the question is whether the use of the mark HE TO SHE by the applicants in relation to the services covered by the application would have a detrimental effect on the goodwill and reputation of the opponents' magazine.

40 In the EVEREADY trade mark referred to earlier, the Registrar's Hearing Officer considered the question of detriment, saying:

45 “It appears to me that where an earlier trade mark enjoys a reputation, and another trader proposes to use the same or similar mark on dissimilar goods or services with the result that the reputation of the earlier mark is likely to be damaged or tarnished in some

significant way, the registration of the later mark is liable to be prohibited under Section 5(3) of the Act. By ‘damaged or tarnished’ I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to be, reduced on scale that is more than de minimis.”

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In the TREAT trade mark case (1996) RPC 281 at 295, Jacob J. gave the following dictum on the scope of Section 10(3) of the Act, which, contains the same wording as Section 5(3), stating:

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“I only note that it might cater for the case where the goods were vastly different but the marks the same or similar and the proprietor could show that the repute of his mark was likely to be affected. The sort of circumstances of the Dutch *Claeryn/Klarein* (mark for gin infringed by identical sounding mark for detergent, damage to the gin mark image), may fall within this kind of infringement, even though they do not fall within section 10(2) because there is no likelihood of confusion as to trade origin.”

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Here we have the publisher of a magazine claiming that they have a reputation such that, if the applicants were to use their trade mark in respect of a range of medical and personal services, that the use would be associated with them and that their good name would suffer. Although the publication may contain articles relating to the type of services provided for which the applicants seek to register their mark, it is not usual for a magazine to also provide the services referred to in a feature, and consequently, I see no reason why a reader would associate the applicants' services with the opponents. Under Section 5(3) the onus falls on the opponents to make out their case, and I come to the view that the opponent has failed to establish that use of the applicants' mark HE TO SHE in relation to the services covered in Class 42 of their application would take unfair advantage or be detrimental to the character or repute of their earlier mark. Given this and my previous findings the objection under Section 5(3) fails.

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I turn next to consider the grounds founded under Section 5(4)(a) which reads as follows:

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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-

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(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 use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

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No reference is made to any rule of law other than the law of passing off. Mr Hobbs QC set out a summary of the elements of an action for passing off in *WILD CHILD Trade Mark* 1998 RPC 455. The necessary elements are said to be as follows:

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- (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

- 5 (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.

10 The applicants are seeking to register their mark HE TO SHE in Class 16 for, inter alia, printed publications, which would include magazines, and in Class 42 for services which I have already found not to be similar. I will therefore restrict my considerations under Section 5(4)(a) to the position in relation to the goods set out in Class 16 of the application, for if the opponents fail in respect of identical goods, they will be in no better position for dissimilar services.

15 Magazines are generally inexpensive items although I note that the applicants' magazine shows a cover price of £15 which sets it apart from the mainstream magazines (such as the opponents' magazine) which sell for a few pounds. They are goods obtained by self selection, and are, I believe, chosen with a certain degree of care. Although displayed in one area they are usually grouped according to subject matter or intended readership. Publications with a more adult content (a description which I believe would include the applicants' magazine) tend to be placed on the top shelves of magazine displays to keep them out of the reach of children and avoid potential embarrassment by reducing the likelihood of them being selected in error.

20 I have previously accepted that the opponents have a reputation and goodwill in their mark SHE, albeit in relation to magazines for women. However, when considering the likelihood of confusion I came to the view that taking into account the practice in the trade for different publishers to use similar, semi-descriptive names for their magazines, that the marks were not similar. Given my earlier findings and my comments in the preceding paragraph, I cannot see how there can be misrepresentation, or consequently how the opponents will suffer damage. I therefore find that the opposition fails under Section 5(4)(a).

30 The opponents have asked that the registrar exercise his discretion in their favour and refuse the application. Under the Trade Marks act 1994 the registrar does not have the discretion to refuse marks which are otherwise acceptable for registration. Consequently, the opposition must also fail in this respect.

35 The opposition having failed on all grounds, I order that the opponent pay the applicant the sum of £435 as a contribution towards their costs.

Dated this 8 day of October 1999

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