

**TRADE MARKS ACT 1938 (as amended)**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1577952  
OF COLT STUDIO TO REGISTER A TRADE MARK IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION NO. 42567 THERETO  
BY NEW COLT HOLDING CORPORATION**

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OF COLT STUDIO TO REGISTER A TRADE MARK  
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10 OPPOSITION NO. 42567 THERETO BY  
NEW COLT HOLDING CORPORATION**

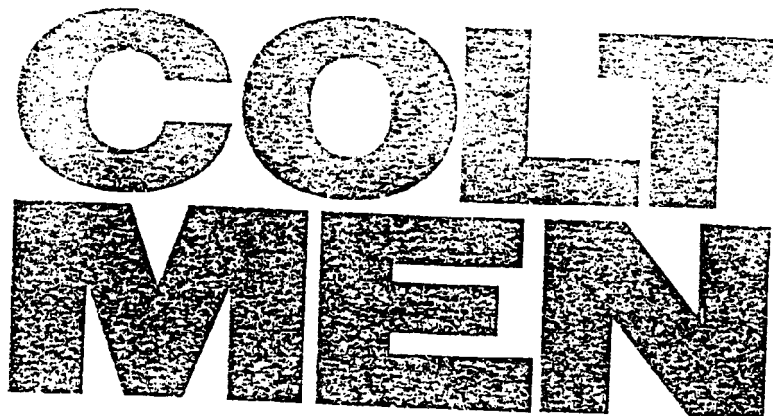
**BACKGROUND**

15 On 12 July 1994, Colt Studio of Studio City, California, United States of America, applied under application no. 1577952 to register the trade mark shown below.

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in respect of:-

Adult entertainment magazines; all included in Class 16.

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On 8 June 1995, New Colt Holding Corporation of New York, United States of America, filed a notice of opposition. The grounds of opposition can be summarised as follows:-

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1. Under Section 9 as the trade mark applied for is not adapted to distinguish goods connected in the course of trade with the applicant.

2. Under Section 10 of the Act in that the mark applied for is not capable of distinguishing goods connected in the course of trade with the applicant.

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3. Under Section 11 of the Act because of the use by the opponent of their trade mark, COLT, such that use of the applicants' trade mark is likely to deceive or cause confusion.

4. Under Section 68 of the Act on the grounds that the trade mark does not fall within the definitions set out in that section.

5 The opponents also asked the Registrar to refuse the application in the exercise of his discretion.

The applicants filed a counterstatement denying these grounds and each side seek an award of costs in their favour.

10 Both sides filed evidence in these proceedings and the matter came to be heard on 2 July 1998 when the opponents were represented by Ms Denise McFarland of Counsel, instructed by Keith W Nash & Co, their Trade Mark Agents, and the applicants by Mr Adrian Speck of Counsel instructed by Simons Muirhead & Burton, Solicitors.

15 By the time the matter came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however the relevant provisions of the old law must apply to these proceedings. Accordingly all references in this decision are references to the provisions of the old law.

## 20 **Opponents' evidence**

This consists of a Statutory Declaration dated 14 June 1996 by Heather Clare Matthews, of Keith W. Nash & Co.

25 Ms Matthews states that she is a partner of Keith W. Nash & Co, a position she has held since 1992; she represents the opponents in relation to these proceedings and that she receives instructions from and reports to the opponents' US Patent Attorneys, Perman & Green. All of the facts and matters set out in the Declaration come from her own personal knowledge or from consulting material supplied by Perman & Green.

30 Ms Matthews states that the opponents are the registered proprietors of registration no. 826457 for the trade mark "COLT" in respect of firearms and ammunition, which has been used in the United Kingdom by the opponents and their predecessors in business since 1852. A copy of a press advertisement dated 25 December 1852 is exhibited at HCM1 in support of this fact. She believes that the COLT trade mark is well-known to the general public in relation to firearms and that a section of the public spend their leisure time involved in related activities such as rifle and pistol shooting and gun collecting, and that there exists adult entertainment magazines to cater for such a market. In that connection she exhibits at HCM2 an article from the September 1995 edition of "Gun and Accessories Mart" which contains an article on the British Western & Shooting Society which refers, in turn, to COLT firearms. She goes on to state that adult entertainment magazines aimed at members of the public interested in firearms activities often contain articles relating to COLT firearms and she exhibits at HCM 3, 4 & 5 examples of such articles going back to April 1987. In addition she is advised by Perman and Green that there exists a Colt Collectors Association for collectors of firearms and COLT merchandise. This Association publishes a membership magazine called 'The Rampant Colt Magazine' which is supplied to all members, including those in the United Kingdom.

In view of the use made by the opponents of their trade mark COLT, and the references included in these magazines, Ms Matthews believes that the use of the applicants' trade mark COLT MEN in relation to adult entertainment magazines would be understood by members of the public to indicate a connection with the opponents' COLT trade mark. Ms Matthews goes on to exhibit  
5 copies of pages from the applicants' adult entertainment magazine. The front cover of this shows use of the word COLT alone as well as in combination with the word MEN. In addition, items such as firearms, t-shirts and belts bearing the word COLT are displayed by some of the models. Ms Matthews states that the opponents produce goods such as these items which also bear the opponent's COLT trade mark and as evidence of this she provides a copy of the 1986 Colt  
10 Firearms 150th Anniversary catalogue which shows use of the word COLT on a wide variety of goods such as belts, clothing, desk top accessories, glassware etc. In her opinion this suggests there was a clear intention by the applicants to indicate a connection with the opponents' trade mark and hence to take unlawful advantage of the substantial reputation associated with the opponents' trade mark.

15 **The applicant's evidence**

This consists of Statutory Declarations by Mr Razi Mireskandari, John Stonier and Mark Phillips.

20 Mr Mireskandari's Statutory Declaration is dated 18 April 1997. He states that he is a Solicitor with the firm of Simons, Muirhead & Burton and has the care and conduct of this matter on behalf of the applicant. The facts and matters referred to in his declaration are either known to him personally or have been ascertained from perusal of the files and documentation in his possession and are true to the best of his knowledge and belief.

25 Mr Mireskandari states that the applicants are the publisher of gay men's magazines. Based in California, the applicant has been in business for about 30 years and publishes about eight new titles each year which are distributed throughout Europe as well as the United States of America. These magazines were extensively and illicitly copied in the United Kingdom, and then sold  
30 commercially. It was in order to safeguard their rights that the applicants applied to register its trade mark COLT MEN in respect of adult entertainment magazines in Class 16.

35 Mr Mireskandari provides background to the examination by the Trade Marks Registry of this application which, following objection by the trade mark examiner and amendment of the specification of goods covered by the application, eventually proceeded to publication in the Trade Marks Journal for the specification of goods set out earlier in this decision. In relation to the opponents' grounds of opposition based upon Sections 9 and 10 of the Act, Mr Mireskandari provides a number of comments. First of all the trade mark COLT MEN has been used, he says, by the applicants as the title of their gay men's magazine for more than 20 years. First published  
40 in 1976, the magazine has since 1981 been distributed throughout Europe, and from 1991 has been available in the United Kingdom. He states that the applicants intend to use the trade mark in relation to adult entertainment magazines aimed at gay men. The term adult entertainment magazine in his view is understood to mean, and would mean in connection with the applicants' trade, one which contains erotic material not suitable for minors. He goes on to say that in his  
45 view the term COLT MEN is an appropriate title and well suited to the nature and contents of the applicants' magazine. In that connection he exhibits copies of extracts from an issue of the

magazine which show that the magazine is devoted to photograph pictures of the male nude.

5 Mr Mireskandari goes on to state that the principal meaning of the word COLT given by the second edition of the Oxford English dictionary is “the young of the horse; the young horse is a colt to the age of four, or in the case of a thoroughbred, five years”. It is in this sense of a young stallion that the title COLT MEN is, in his view, suggestive of the character of the applicants’ magazine and gives an indication of the nature of its contents. But in using this term the applicants never intended to refer either directly or indirectly to the opponents’ business as a manufacturer of firearms nor, in his view, can such be inferred from the contents of the applicants’ publications.

10 Insofar as the opponents suggest that the applicants’ use of the trade mark COLT MEN is likely to deceive or cause confusion, Mr Mireskandari makes a number of comments which are summarised as follows:

15 1. The opponents are not magazine publishers and rely primarily upon the appearance of the word COLT in sundry gun magazines. The applicants do not dispute that there are numerous magazines which cater for gun enthusiasts and that some of them contain references to COLT firearms (which they acknowledge is a well-known and well-established trade mark of a gun manufacturer). However, this does not support the opponents’ claim that the applicants’ use of the trade mark COLT MEN would give rise to confusion.

20 2. The titles and front covers of the “gun” magazines exhibited by the opponents make clear that these are aimed at a specific market i.e. that section of the public interested in firearms and activities involving the use of firearms. The front cover of the various issues of COLT MEN magazine exhibited are so obviously different and clearly not aimed at the firearms sector, that confusion would be impossible.

25 30 3. Confusion is unlikely to arise on the basis of the name alone because the COLT MEN magazine is only advertised in other gay publications, where both the advertising material and the context makes clear the nature of the magazine.

35 Insofar as the opponents’ ‘The Rampant Colt Magazine’ is concerned, Mr Mireskandari points out that this is a membership magazine available by subscription and to members of the Colt Collectors Association. It is most unlikely that any member of that Association would be deceived into thinking that the applicants’ magazine was in any way connected with the opponents’ goods. The applicants’ product is not widely advertised; it is only available through specialist booksellers and licensed sex shops; and, although available via mail order suppliers, the nature of such suppliers and their advertising material make it unlikely that anyone could buy a COLT MEN magazine without being fully aware of the kind of publication they are purchasing. When sold in specialist outlets it is not sold in a plain wrapper and thus its actual nature and contents are clearly to be seen and even if the magazine was more widely available its positioning in retail outlets would be such as to distinguish it from any magazine connected with guns or firearms.

Finally, Mr Mireskandari states that he is informed by the owner of Colt Studio that he does not know of any occasion during which COLT MEN has been published when the purchaser has claimed to have been confused into thinking that COLT MEN was in some way connected with COLT guns.

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In his Statutory Declaration dated 18 April 1997 Mr John Stonier states that he works as the Assistant Manager of a shop in London called the Clone Zone. Clone Zone is a company which, he says, specialises in the sale of designer clothes, fetish and rubber wear. The shop, in Old Compton St, also sells books, magazines and videos all aimed specifically at the gay market. He states that his company is one of the largest retailers of gay publications in the United Kingdom and he has worked for them for approximately 3 ½ years.

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In Mr Stonier's view Colt Studio is a well respected producer of gay men's magazines for many years; he personally has been aware of them for more than 15 years and COLT MEN is particularly popular within the gay community. He describes the location of the shop, which, he says, is in the heart of gay London, and which has between 2-3,000 customers visiting the shop each Saturday with more than 10,000 people per week in total visiting the shop. He has never encountered a customer who has been misled into thinking that there has been some connection between the COLT MEN magazine and COLT guns.

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Insofar as the exhibit to Ms Heather Matthew's Statutory Declaration which contains copies of photographs from the applicants' magazine is concerned, Mr Stonier states that models wearing police uniform or dressed as military men are common gay images which may incidentally include guns, such images appear in lots of gay literature.

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The Statutory Declaration by Mark Phillips, dated 18 April 1997 states that he works for Clone Zone as a buyer and that he is qualified to judge the popularity of the COLT MEN magazine within the United Kingdom.

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He states that there are more than 20 different titles in the COLT MEN range and each year he orders at least 1,000 copies for the Old Compton Street shop alone and that each of the other four retail outlets sells at least 400 copies per year. Finally, he states that COLT MEN magazines are widely known within the gay community and sell extremely well.

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### **Opponent's evidence in reply**

This consists of a further Statutory Declaration from Ms Heather Clare Matthews dated 10 November 1997.

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She states that she is advised by Perman & Green that an employee of New Colt Holding Corporation whilst searching for COLT merchandise was confused into accessing the Internet site of Colt Studio. She exhibits at HCM12 printed pages from the this Internet site. These, by and large, are advertisements for a number of films. Each title is accompanied by a synopsis of the film, which together with a warning on the first page of the Internet site, indicates that the content of the films is of a sexually explicit nature.

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That concludes my review of the evidence and I turn to consider the grounds of opposition which are founded upon Sections 9, 10, 11 & 68 of the Act.

## DECISION

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Ms McFarland, at the Hearing, indicated that Section 68 required a trade mark to be distinctive (presumably by the application of the definition of a trade mark set out in Section 68) and therefore if the trade mark was found not to be distinctive under Sections 9 & 10 it would fall foul of Section 68. Though it was not stated I assume the converse applies. I therefore consider this trade mark under Sections 9 & 10 of the Act, which state:

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9.- (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

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(a) the name of a company, individual, or firm, represented in a special or particular manner;

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(b) the signature of the applicant for registration or some predecessor in his business;

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(c) an intended word or invented words;

(d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

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(e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registerable under the provisions of this paragraph except upon evidence of its distinctiveness.

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(2) For the purposes of this Section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

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(3) In determining whether trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which-

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(a) the trade mark is inherently adapted to distinguish as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

10.- (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which-

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) a trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

The opponents submitted that the applicants' evidence indicated that the word COLT was chosen because publishers of the kind of material produced by the applicants used words such as colt, stallion and stud in order to allude to the models which appear in such magazines. Thus the term COLT MEN was both descriptive and non-distinctive for magazines featuring the male nude. The applicants admitted that the trade mark, in relation to the goods in question, did allude to a characteristic of the goods but submitted that this did not prevent registration.

As this application for registration was accepted by the Trade Marks Registry in Part A I am not able in these opposition proceedings, if I find that the trademark in suit is not one which can be accepted in Part A, to consider it as one for registration in Part B of the Register, (see *PARISON FABRICS* (1949) 66 RPC 217). Therefore, in respect of the grounds of opposition based upon Sections 9 & 10 of the Act, the application stands or falls on whether the trade mark COLT MEN is adapted to distinguish the applicants' goods as required by Section 9.

The trade mark COLT MEN clearly does not qualify for acceptance under the provisions of Section 9(1) (a), (b) or (c). I therefore have to determine whether it is a term which has no direct reference to the character of the goods, the applicants having accepted that the term alludes to the goods. In that respect, I take note of Kerly's Law of Trade Marks and Trade Names which at 8-29 states as follows:

(d) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname."

This paragraph is identical with the corresponding paragraph in Section 9 of the 1905 Act. It defines what is and for many years has been commercially by far the most important category of trade mark. Yet decisions by the courts on these words have not



5 been very numerous, at least until the last few years. The various decisions are listed  
below. Few of them are of value as laying down any definite principle; nor would they  
seem to imply any very consistent practice. One reason may lie in this, that almost every  
immediately attractive trade mark is, in some sense, descriptive or laudatory of the goods  
and so in some degree has reference to their character or quality. The difficulty is to  
decide whether that reference is a direct reference: one that seriously affects the word's  
capacity for distinguishing goods from a particular source, as distinct from the sort of  
reference that can be found only as an academic exercise. This is at best a somewhat  
metaphorical question and one depending ultimately upon the reaction of the public to  
the chosen word.

15 In this case the goods in question are adult entertainment magazines. And in relation to  
magazine titles the Registrar has always taken cognisance of the market-place for these goods  
in relation to the acceptance for registration of terms which might otherwise be descriptive. This  
is because, unlike in relation to books, the public (and the trade) expect titles of magazines to tell  
them what they can expect the magazine to contain. With these points in mind I have to  
determine whether the term COLT MEN directly describes the contents of the magazines sold  
under that trade mark.

20 I accept that the word COLT, along with the words Stud and Stallion, as suggested by Mr Speck,  
may be words which could be used to describe characteristics of the models used in magazines  
such as those produced by the applicants. But I do not believe that the words describe the  
product itself. The magazines may contain photographs of male nudes to which any of the above  
words might adjectively apply. But in my view that does not mean that the term COLT MEN  
is a direct reference to a characteristic of the magazines themselves. It may allude to the quality  
or characteristics of the merchandise, but no more. And in my view the relevant public on  
encountering the term in relation to adult entertainment magazines would no more than infer that  
they were magazines for those interested in homo-erotic material. Thus the term COLT MEN  
has the ability to act as a trade mark and is adapted to distinguish the applicants' magazines from  
those of others. The grounds of opposition based upon Sections 9 and 68 are therefore dismissed.  
For the reasons outlined above I do not consider I need to consider the trade mark against the  
provisions of Section 10.

35 I turn now to the grounds of opposition based upon Section 11 which state

11.- It shall not be lawful to register as a trade mark or part of a trade mark any matter  
the use of which would, be reason of its being likely to deceive or cause confusion or  
otherwise, be disentitled to protection in a court of justice, or would be contrary to law  
or morality, or any scandalous design.

40 The judicial test to be applied in respect of opposition under Section 11 is that set down in Smith  
Hayden & Co Ltd's application (Volume 1946 63 RPC 101) as adapted by Lord Upjohn in the  
BALI trade mark case [1969] RPC 496. Adapted to the matter in hand the test may be expressed  
as follows:

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Having regard to the user of the opponents' mark COLT, is the tribunal satisfied that the mark applied for COLT MEN, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

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The opponents submit that the applicants' trade mark is evocative of their trade mark and that a reasonable number of the public would consider that there was a connection in the course of trade and that by their nature the goods of the applicants may cause offence.

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There was, first of all, no dispute between the parties that the respective trade marks, COLT MEN and COLT, were similar. I have no hesitation therefore in holding that the trade marks are the same, the addition of the word MEN in the applicants' trade mark does not add, in my view, a significant feature. However, the applicants submitted that their trade mark was used on adult entertainment magazines (they had in fact offered to limit further to "Gay Men's Magazines) whilst the opponents' use was on guns, and thus the goods and the respective channels of trade were sufficiently at a distance for there to be no likelihood of confusion as to origin and therefore no offence caused to the opponents' customers and no damage to the opponents' reputation.

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The term adult entertainment magazines is, in my view, likely to mean to the public at large magazines of an erotic or sexually explicit nature. I do not think, as Ms McFarland submitted, that the term would be likely to be taken to cover also magazines about adult pursuits generally - such as hunting or to cover magazines which include violent material. Therefore in the context of the nature of magazines provided for adult entertainment I do not consider that the public at large, without some persuasion or suggestion, would consider the term to mean anything other than in the way I have construed it. Thus, I do not consider that the applicants and the opponents are operating in areas which overlap. In reaching this decision I take fully into account the publication entitled "The Rampant Colt Magazine" produced by the Colt Collectors Association and indeed the other 'gun' magazines exhibited by Ms Matthews. But in my view these magazines would be classified under the heading 'Hobbies' or 'Outdoor Activities' and would not be sold alongside adult entertainment magazines. Moreover, I accept (because it was not challenged) that magazines such as those sold under the COLT MEN trade mark are sold in a controlled way, through mail order or in licensed sex shops.

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The issue to be decided therefore is whether, the public will be given cause to wonder about the origin of goods sold under the respective trade marks and thus damage the opponents' reputation in their trade mark. A reputation which the applicants acknowledge and which extends beyond firearms (see exhibits HCM 9-11). I am not given any evidence of confusion as to origin and therefore I must reach a view as best I can based upon the material before me.

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It seems to me that adult entertainment magazines are only likely to be sold to customers who know what they want and what they are buying. Their sale and distribution seems to be arranged accordingly. Therefore the material sold under the COLT MEN trade mark will only be available to those who either know the magazine or are aware of its nature. In many respects the same applies to the firearms sold under the COLT trade mark and the range of other goods merchandised under that trade mark. Thus it is unlikely that these two sets of knowledgeable customers are going to be confused as to the origin of either parties goods.

I must not ignore however, the point made by Ms Matthews that the opponents' trade mark actually appears on goods, e.g. belts, worn by the male models which appear in the applicants' magazine. Also, that guns sold under the opponents' trade mark are shown being handled by these models. In this regard I take note of Mr Speck's submissions and Mr Stonier's statement that models in these magazines are sometimes portrayed as cowboys or policemen as part of the 'gay imagery', and therefore have about their person guns, belts etc. In the circumstances I do not consider that the use of the word COLT on some of the props worn by the models appearing in the magazine will have any impact on the minds of the magazine readers in relation to the opponents' trade mark or the goods sold under it.

There is also the matter of one of the opponents' employee who was confused into accessing the applicants' Internet site. I have to say from the pages of the applicants' Internet site exhibited by Ms Matthews I consider that the warnings given on the first page leave the reader in no doubt that they have accessed material of a sexually explicit nature and there is nothing there which is likely to confuse the reader as to origin.

Finally, Ms McFarland, referred me to an earlier case, HARD ROCK CAFE (IPD February 1997), in which it was held by the Assistant Registrar that the public on encountering the trade mark HARD ROCK in relation to condoms would assume a connection with the opponents' HARD ROCK CAFE trade mark. In that case the Assistant Registrar had the benefit of public survey evidence and evidence that the applicants' goods could be sold in the same establishment within which the opponents' services were provided. Thus it is not on all fours with the present case and does not assist matters.

In the circumstances and having full regard to the use of the opponents' COLT trade mark I consider that if used in a normal and fair manner, in relation to adult entertainment magazines, the applicants' trade mark COLT MEN is not likely to cause confusion and deception amongst a substantial number of persons, I therefore find that the opponents fail in their opposition under Section 11 of the Act.

There remains the matter of the Registrar's discretion but in view of my findings above in relation to the provisions of Section 11, which are mandatory, it is neither necessary nor appropriate for me to consider exercising it.

The opposition having failed, I order the opponents to pay the sum of £650 to the applicant as a contribution towards their costs.

Dated this 21 day of August 1998.

**M KNIGHT**  
For the Registrar  
The Comptroller General