

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2100084

BY PRIMEDIA LIMITED

TO REGISTER A TRADE MARK

PRIMEDIA

IN CLASSES 16, 38 & 41

AND IN THE MATTER OF OPPOSITION THERETO

UNDER No 46986

BY MR HARVEY TOOR

DECISION

BACKGROUND

1) On 13 May 1996, Primedia Limited of Primedia House, 135 Rivonia Road, Sandown, Republic of South Africa applied under the Trade Marks Act 1994 for registration of the trade mark **PRIMEDIA** in respect of the following goods:

In Class 16: “Books, magazines, periodicals and all other printed matter; bookbinding materials; photographs; stationery; instructional and teaching material.”

In Class 38: “Communications services; broadcasting services, including radio and television broadcasting.”

In Class 41: “Production of radio and television programmes; publication services; radio and television entertainment services; rental and hiring of videos, television films, educational products and related equipment, production of shows, cinematographic films and videos; organising of competitions, exhibitions and festivals.”

2) On the 10 June 1997 Mr Harvey Toor filed notice of opposition to the application. The grounds of opposition were amended on 10 June 1997 and are in summary:

a) The opponent has been using the trade mark **PRIMEDIA** in the UK in relation to the supply and rental of multimedia goods and services since at least 1994. As a result of this use the opponent has acquired a substantial goodwill and reputation in the mark in suit in the UK.

b) Given the goodwill and reputation enjoyed by the opponent in the mark in suit the application should be refused under Section 5(4) of the Trade Mark Act 1994.

3) The applicant subsequently filed a counterstatement denying all of the grounds of opposition. Both sides ask for an award of costs. Only the opponent filed evidence in these proceedings. The matter came to be heard on 30 April 2001 when the opponent was represented by Dr James of Messrs R G C Jenkins & Co. The applicant was not represented.

OPPONENT'S EVIDENCE

4) The opponent filed two statutory declarations. The first, dated 10 June 1997, is by Mr Harvey Toor who is a sole trader. He states that he has been trading in the UK under the names Primedia, Primedia Interactive and Primedia Interactive Multimedia Services since 1994.

5) Since its inception Mr Toor states his company has offered services such as: Multimedia programming, graphics creation, corporate presentations, multimedia training courses, computer animation, digital video production and the production of CD-Rom catalogues or brochures. These services, he claims, were aimed at business presentations, employee training applications and sales and marketing presentations.

6) Mr Toor also claims that his company has been involved in the creation of home pages on the world-wide web since 1994. Such a service involves programming, art direction, graphics creation, developing systems, and consultation and project development. In providing these and their other services the company supplies or rents computer hardware, software and instructional and teaching methods.

7) Mr Toor provides turnover and promotional expenditure figures for the mark in suit as follows:

Year	Turnover £	Promotion £
1995	6,500	1,010
1996	26,394	700
1997	119,000	650

8) Mr Toor states that due to the nature of his industry normal advertising is not productive. His company expends considerable amounts of time to building up personal relationships.

9) A number of exhibits were provided. The relevant items have been listed below:

- Exhibit HT1: comprises a set of accounts for the year ended 31 December 1994 which is headed "Mr R S Toor; Trading as Primedia; Media Content Production Services."
- Exhibit HT2: This is a brochure showing use of the Primedia mark and offering Interactive multimedia presentations. It is hand dated May 1995 .
- Exhibit HT3: Is a marketing postcard sent out to CBA and Associates and which has a post mark dated 27 March 1996. This is headed with the name Primedia.
- Exhibit HT4: This is a sample internet site which was developed for Barclays Bank Plc and is dated 1995.
- Exhibit HT7: A number of invoices for the period 4 February 1995 - 17 April 1996, all of which are on paper headed Primedia and refer to the provision of multimedia systems, training, programme alterations, rental of equipment, setting up websites and the provision of CD-Roms and addressed to various locations in the UK.

- Exhibit HT9: Various invoices sent to the opponent under the names, Primedia Ltd, Primedia and Primedia Presentations Ltd.
- Exhibit HT13: This consists of a large number of letters written on Primedia or Primedia Interactive headed paper to potential clients during the period Feb 1995 - 7 May 1996. Virtually all refer to previous conversations and / or meetings. The addresses are mostly in the South of England and are mostly to the headquarters of corporations.

9) The opponent's second declaration, dated 12 March 1998, is by Carey Budnik the Managing Director of Screen Multimedia, a position she has held for five years. Ms Budnik states that her company has "been using Primedia Interactive and / or Primedia Interactive Multimedia Services to create multimedia CD-Rom products since December 1994. I have therefore been aware of the name Primedia in relation to multimedia goods and services since that date. I have always associated the name Primedia in relation to multimedia goods and services, exclusively with Mr Harvey Toor and / or with companies controlled by Mr Harvey Toor."

10) That concludes my review of the evidence. I now turn to the decision.

DECISION

11) The only ground of opposition is under Section 5(4) 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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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."

12) In deciding whether the mark in question "PRIMEDIA" offends against this section, 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 Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 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 the 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.

"The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of "passing off", and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

13) With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision, and the arguments put forward at the hearing. I will consider these under the three main headings of Goodwill, Misrepresentation and Damage.

GOODWILL

14) The opponent has shown in its evidence that it was trading in the UK under the mark PRIMEDIA at the relevant date. Whilst the turnover figures for the period prior to May 1996 were modest the opponent also provided evidence that they had contacted a number of potential clients including various meetings. None of this has been challenged by the applicant. It is my opinion that a significant proportion of the relevant customer base knew about the company and their services through their advertising and promotional activities and this generated goodwill.

MISREPRESENTATION

15) To succeed under this heading the opponent only has to show that the relevant public will believe the services offered by the applicant are services of the opponent. The relevant public in this case are companies requiring assistance in a variety of areas concerned with customer interaction. The opponent is clearly a small scale company specialising in producing multi media products for marketing, presentation and educational purposes. The opponent also helps train customer employees in such skills. In providing these services the opponent also rents out various items of equipment such as computers.

16) The applicant's specification is for:

“Books, magazines, periodicals and all other printed matter; bookbinding materials; photographs; stationery; instructional and teaching material” in Class 16.

“Communications services; broadcasting services, including radio and television broadcasting” in Class 38.

And

“Production of radio and television programmes; publication services; radio and television entertainment services; rental and hiring of videos, television films, educational products and related equipment, production of shows, cinematographic films and videos; organising of competitions, exhibitions and festivals” in Class 41.

17) The services and products offered by the opponent are in many case identical to those covered by the applicant’s specification. Whilst some of the goods and services offered by the opponent are not identical to those of the applicant’s specification Dr James argued that the penumbra of protection that his clients should enjoy should extend to the natural extension of their business.

18) I reject this submission. Section 5(4)(a) prevents the registration of marks the use of which, at the relevant date, would be contrary to law; in this case the law of passing off. There is no separate legal basis for refusing registration in respect of further goods / services on the basis that these might be natural extensions of the opponent’s trade. On the contrary Article 13 of the Directive 104/89 requires the Registrar to register marks for any goods / services for which no ground of refusal existed at the relevant date.

18) Certain of the goods and services of the two parties although not identical are similar enough, given the identical nature of the marks involved to have led to confusion and deception amongst a substantial number of persons at the relevant date.

DAMAGE

18) It is accepted that, where the parties are in the same field of activity, if there is confusion between the products and services then there would be damage.

19) I am persuaded that at the relevant date, 13 May 1996, the opponent had acquired goodwill under the PRIMEDIA mark in relation to multi media products for marketing, presentational and educational purposes in Classes 16, 38 and 41. The opposition under Section 5(4) therefore partly succeeds.

20) As grounds for refusal exist only in respect of multi media products for marketing, presentational and educational purposes the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 restricting the specification as follows:

Class 16 “Books, magazines and periodicals; bookbinding materials; photographs; stationery; but not including instructional and teaching materials.”

Class 38: “ Radio and television broadcasting.”

Class 41: “ Production of radio and television programmes; radio and television entertainment services; production of shows; organising competitions, exhibitions and festivals.”

21) If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

22) The opposition having succeeded the opponent is entitled to a contribution towards their costs. I order the applicant to pay the sum of £1135. 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 8TH day of June 2001

George W Salthouse
For the Registrar
The Comptroller General