

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2177210
BY EMAP CONSUMER MEDIA LIMITED TO REGISTER
A TRADE MARK IN CLASSES 9, 16, 35, 38 & 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 50511
BY RCS PERIODICI S.p.A.**

TRADE MARKS ACT 1994

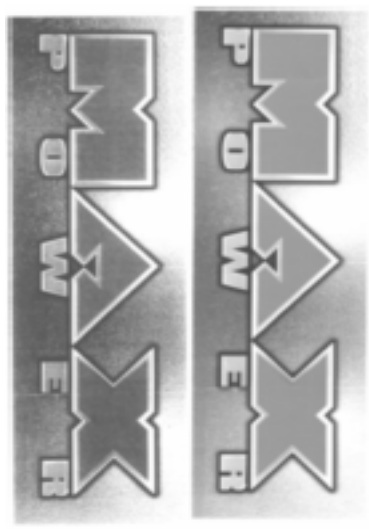
**IN THE MATTER OF Application No. 2177210
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**IN THE MATTER OF Opposition thereto under No. 50511
by RCS Periodici S.p.A.**

BACKGROUND

1. On 15 September 1998 EMAP Consumer Media Limited applied to register the following series of two trade marks in Classes 9, 16, 35, 38 and 41:



2. Registration was sought in respect of the following goods and services:

Class 09:

Computer software, computer programs, computer databases; data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; CD-ROMs; CDI's; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites).

Class 16:

Printed matter, printed publications, magazines, journals; periodical

publications; newspapers; books; newsletters; guides; printed programmes; stationery; writing implements; pens, pencils, car stickers.

Class 35:

Advertising, marketing and promotion services; provision of advertising, marketing and promotional services on-line from computer databases or the Internet (including web sites); organisation, arranging, implementation, conduction and presentation of exhibitions, shows, demonstrations, trade shows, business and commercial trade shows.

Class 38:

Telecommunication services; communication services; broadcasting services; television programming; radio broadcasting; radio programming broadcasting and production services; wireless transmission and broadcasting of television programmes; cable, television programmes; cable television and distribution of television programmes; cable television, video subscription television and radio broadcasting and transmission; computer network communications; transmission and reception of data and information; satellite transmission; teletext services; pay per view television transmission services; video on demand transmissions; rental, leasing or hire of apparatus, installations or components for use in the provision of the aforementioned services; advisory and consultancy services relating to the aforementioned services.

Class 41:

Publication of material which can be accessed from databases or from the Internet; interactive information provided on-line from computer databases or the Internet; information provided on-line from computer databases or the Internet; provision of information for accessing via communication and computer networks; electronic publishing.

3. The application was accepted by the Registrar and published in the Trade Marks Journal. On 15 December 1999 AA Thornton & Co on behalf of R.C.S. Periodici S.p.A. filed a Notice of Opposition against the application. In summary the grounds of opposition were:

(i) Under Section 5(2)(b) of the Act because the mark applied for is confusingly similar and covers the same and similar goods and services to the following UK registered trade mark in the opponent's ownership and there exists a likelihood of confusion on the part of the public –

REGISTRATION NUMBER	MARK	REGISTRATION EFFECTIVE	CLASS & SPECIFICATION OF GOODS
1346472	MAX	3 June 1988	Magazines included in Class 16

(ii) Under Section 5(3) of the Act because to the extent that the application in suit specifies goods and services which are not similar to the goods and services for which the earlier trade mark is protected, the registration of the applicant's mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

(iii) Under Section 5(4)(a) of the Act in that the trade mark applied for is liable to be presented by the law of passing off.

4. The applicant through its agent, Urquhart Dykes & Lord, filed a Counterstatement denying the grounds of opposition. Both sides filed evidence and have asked for an award of costs in their favour. Neither side requested a hearing and both parties were content for a decision to be taken on the basis of the written evidence filed.

Opponent's Evidence

5. This consists of a declaration by Crescenzo Pulitano dated 1 August 2001 and a witness statement by Vanessa Ann Broughton Lawrence of AA Thornton & Co (the opponent's professional representatives in this matter) dated 21 September 2001. Ms Lawrence's statement related only to the translation of Mr Pulitano's declaration.

6. Mr Pulitano is the General Counsel of R.C.S Group and Proxy Holder Representative of RCS Periodici S.p.A. (the opponent).

7. Mr Pulitano states that the opponent is a publisher of magazines sold under the trade mark MAX and that magazines sold under the trade mark MAX were first produced and sold in the UK in March 1985, and have been continuously available in the UK since that date. He adds that the magazines were originally produced by RCS Rizzoli Periodici S.p.A. which merged into RCS Editori S.p.A. at the end of 1994 which changed its name to RCS Periodici S.p.A. on 1 January 1996.

8. Mr Pulitano refers to Exhibit A to his declaration which, he states, comprises examples of the opponent's magazines which have been available in the UK and which show use of the trade mark MAX. The Exhibit comprises photocopies of the front cover and inside page taken from numerous magazines. The contents appear to be in the Italian language.

9. Mr Pulitano goes on to provide the following figures relating to the approximate annual value of sales of magazines under the trade mark MAX in the UK since 1996:

YEAR	SALES
1996	Lst. 14,130.00
1997	Lst. 14,733.50
1998	Lst. 15,700.50
1999	Lst. 9,450.00
2000	Lst. 7,850.00
2001	Lst. 3,600.00 (for the first half of the year)

10. Mr Pulitano adds that the opponent's magazines sold under the trade mark MAX are available throughout the UK including London, Bedford, Cambridge, Oxford, York and Edinburgh.

Applicant's Evidence

11. This consists of a witness statement by Robert Croxall dated 18 December 2001. Mr Croxall is a Publishing Director with EMAP Automotive Limited. He explains that his company publishes the magazine MAX POWER on behalf of the applicant, EMAP Consumer Media Limited.

12. Mr Croxall states that the applicant is the proprietor of a number of UK trade mark registrations which include MAX POWER and at Exhibit RC1 to his statement are details of these registrations. They include:

REGISTRATION NUMBER	MARK	CLASS OF GOODS AND SERVICES
2049709A	MAX POWER	9 & 42
2049709B	MAX POWER	16 – Magazines relating to cars
2234986	MAX POWER.COM	9, 16, 35, 38 & 41
2155875	MAX POWER	38 & 41

13. Mr Croxall goes on to say that the mark MAX POWER was first used in the UK on 1 April 1993 in relation to printed publications and that the mark has been in continuous use since that date. Attached as Exhibit RC2 to Mr Croxall's statement are copies of a selection of magazine covers bearing the mark MAX POWER dating back to June 1993.

14. Turning to the value of turnover generated by sales of printed matter bearing the mark, Mr Croxall provides the following approximate figures:

YEAR	TURNOVER - £
1994	2,386,379
1995	4,635,681
1996	6,622,821
1997	7,541,774
1998	7,867,046
1999	9,075,257
2000	9,475,836

15. On advertising and the promotion of the mark, Mr Croxall states that since 1994 approximately £4.26 million has been spent, including that spent on organising and promoting the event MAX POWER LIVE. Mr Croxall adds that the publication MAX POWER is widely available throughout the UK in all manner of retail outlets and he concludes that as a result of the use made of it the mark is very well known in the UK. He is not aware of any instances of confusion arising with respect to the opponent's mark.

16. Mr Croxall goes on to explain that the mark MAX POWER is also used as a domain name which provides access to an electronic magazine through the internet and that the version of the web site using `www.maxpower.co.uk` commenced in 1998. At Exhibit RC3 is a copy of a page downloaded from the web site. Mr Croxall is not aware of any instances of confusion with the opponents' mark that has arisen in respect of this use.

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

DECISION

18. I turn first to the ground of opposition based upon Section 5(2)(b) which reads as follows:

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

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

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

19. 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,”

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

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23,

who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

21. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection awarded to such a mark. The opponent has filed evidence relating to the reputation of its mark MAX which has been used in the UK in relation to magazines. However, it seems to me that there are obvious deficiencies in relation to this evidence. Sales figures are not provided in £ sterling, there is no indication of the number of magazines sold, no indication of market share, no information relating to the marketing and promotion of the magazine and no supporting evidence, from the trade or other independent sources, relating to the repute of the mark. Furthermore, it seems to me that as the magazine appears to be published in the Italian language, the scope for UK sales is somewhat limited. The onus is upon the opponent to provide that its earlier trade mark enjoys a reputation or public recognition and on the basis of the evidence filed in this case I do not believe

the usage shown has been on a sufficient scale to further enhance the inherent attributes of the mark. In DUONEBS (BL O/048/01) a decision of Simon Thorley QC sitting as the Appointed Person, it was said:

“In my judgement, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that marks would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

22. I do not believe the opponent can claim an enhanced distinctive character for its mark.

23. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Notwithstanding that both parties have used their marks in relation to magazines, I must assume normal and fair use of the marks across the full range of goods and services included within the respective specifications.

24. Turning to a comparison of the respective goods and/or services, I have to decide whether the goods and services covered by the application are the same or similar to the goods covered by the opponent’s reputation. The opponent’s strongest case clearly lies in relation to Class 16 of the mark in suit which includes “magazines” in general, goods identical to those of the application and also goods upon which both the opponent’s and applicant’s marks have been used.

25. On the basis that the opponent’s strongest case lies against Class 16 of the application, I go on to compare the mark in suit with the opponent’s earlier mark.

26. The opponent’s mark consists of the word MAX, a well known dictionary abbreviation for “Maximum”, whereas the mark in suit comprises the well known dictionary abbreviation and word MAX POWER (in a somewhat stylised but instantly recognisable format), which infers “maximum power”. In my view neither of these marks has a particularly strong distinctive character.

27. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

28. Firstly, I turn to a visual comparison of the respective marks. The similarities and differences are plain to see. Both the applicant's mark and the opponent's registration contain the dictionary abbreviation MAX, but the mark in suit also contains the dictionary word POWER. My decision must be based on overall impression and the addition of the word POWER, in my view, makes the marks look conspicuously different. I can think of no satisfactory explanation why the word POWER would be ignored or marginalised in use. In totality the marks look different.

29. In relation to aural considerations, the marks share the word MAX. However, the additional word POWER in the applicant's mark is a strong element which in totality makes the marks sound markedly different. I do not believe the word POWER would be slurred or ignored in oral use of the applicant's mark.

30. Next, I turn to a conceptual comparison of the marks. It seems to me that the word/abbreviation MAX would infer "Maximum" in general, or possibly a male forename, whereas MAX POWER would infer "Maximum Power" a term with its own direct meaning. I do not believe that, in totality, the marks share conceptual similarity.

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

32. On a global appreciation I have come to the conclusion that, while it is possible that some people encountering the applicant's mark may think it reminiscent of the opponent's mark it does not follow that a likelihood of confusion exists in that they would not presume the goods to emanate from the same origin or service. Given the visual, aural and conceptual differences between the marks and after taking into account all the relevant factors (including imperfect recollection, the category of goods, the customer for the goods and that neither of the marks possesses a particularly strong distinctive character), it seems to me that the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood.

33. As mentioned earlier in this decision (paragraphs 24 and 25 refer) I do not believe that the opponent has any stronger case in relation to Classes 9, 35, 38 and 41 of the application in suit. Indeed, the goods and services covered within these specifications are at best similar, as opposed to the identity of goods involved in Class 16, and it seems to me that the potential customer of these goods and services is, in general, likely to be more discerning and sophisticated than the customer for "magazines".

34. The opposition under Section 5(2)(b) fails.

35. Next I go to the Section 5(3) ground. Section 5(3) of the Act reads as follows:

"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.”

36. Section 5(3) requires consideration of:

- (i) whether the trade mark opposed is identical with or similar to the earlier trade mark;
- (ii) whether the trade mark opposed is sought to be registered for goods or services which are not similar to those for which the earlier trade mark is protected;
- (iii) whether, and to what extent, the earlier trade mark has a reputation in the United Kingdom;
- (iv) whether the use of the later trade mark is “without due cause”;
- (v) whether the use of the later trade mark;
 - (a) takes unfair advantage of; and/or
 - (b) is detrimental to

the distinctive character of the repute of the earlier mark.

37. Earlier in this decision I found that the application in suit and the opponent’s registration were not confusable. Accordingly, the Section 5(3) ground must fail at the first hurdle. Furthermore, guidance in relation to reputation under Section 5(3) have been set out in *General Motors Corporation v Yplon SA*, 2000 RPC 572, in paragraphs 23 to 27. Paragraph 26 indicates the standard that must be reached:

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

38. This test sets out a high threshold in my view and the onus is upon the opponent to prove that its trade mark enjoys a reputation and public recognition. In the present case there are obvious deficiencies in the opponent’s evidence on this point – paragraphs 21 and 22 of this decision refer. To sum up, in relation to their trade mark the opponent has not provided any specific details or examples of:- the volume of sales; the market share of

the mark; the promotion and marketing of goods or services under the mark; and no independent evidence from the public or trade.

39. In the light of the above I am unable to find or infer that the opponent had a reputation in the UK at the relevant date, especially taking into account the strict requirements which need to be satisfied under Section 5(3) to expand the parameters of “normal” trade mark protection. The opposition under Section 5(3) of the Act must also fail on this basis.

40. Next, the Section 5(4)(a) ground. Section 5(4)(a) 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.”

41. The law on the common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the ‘Appointed Person’, in *Wild Child* [1998] 14 RPC, 455:

“A helpful summary of the element of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. the guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

- (a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) 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
- (c) 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 referred 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 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.”

42. 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, the courts 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
- (d) the matter 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.”

43. Thus, to succeed in a passing of action, it is necessary for the opponents to establish that at the relevant date (15 September 1998) (i) they had acquired goodwill under their mark, (ii) that use of the applicant’s mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

44. Earlier in this decision I found that the application in suit and the opponent’s registration was not confusable. Accordingly it is my view that the necessary misrepresentation required by the tort of passing off will not occur and the Section 5(4)(a) ground must fail on this basis. I must also point out the shortcomings relating to the opponent’s evidence on the repute of its mark mentioned earlier in this decision.

45. The requirement upon an opponent to demonstrate goodwill in the context of passing off has been considered in two recent cases. In the case of *Radio Taxicabs (London Limited v Owner Drivers Radio Taxi Services Limited*, 12 October 2001, Mr Robert Englehart QC sitting as a Deputy Judge in the High Court pointed out that the court was

faced with “the total absence of evidence from the wider public” and went on to find that the burden of proving reputation with the general public lay on the claimant. At paragraph 89 the judge stated:

“I consider it possible that the claimant may have built up a sufficient reputation in the ways relied on but I cannot conscientiously put it any higher in the claimant’s favour than that thus one is left to speculate Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name “Radio Taxis” lies on the claimant and I find that the claimant has not discharged it.”

46. Furthermore, in the case of *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer* (a partnership) 16 May 2001, where in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a), Pumfrey J said:

*“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97. As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the matter in which the goods are traded or the services supplied; and so on.*

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

47. I have come to the conclusion that the opponent’s evidence does not establish sufficient reputation or goodwill at the relevant date under its trade mark to sustain a passing off action. Accordingly, the Section 5(4)(a) ground also falls at this hurdle.

COSTS

48. The applicant is entitled to a contribution towards costs and I therefore order the opponent to pay the applicant the sum of £600. This sum is 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 13th day of January 2003

JOHN MACGILLIVRAY
For the Registrar
The Comptroller-General