

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2134014

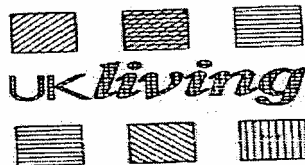
BY FLEXTech TELEVISION LIMITED TO REGISTER A SERIES OF TWO
TRADE MARKS IN CLASSES 9, 16, 25, 38 AND 41

AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 48658
BY I.P.C MAGAZINES LIMITED

DECISION

Introduction

1. This is an appeal from a decision of Mr. George Salthouse, the Hearing Officer acting for the Registrar, dated the 12th June 2002. The decision concerned an application by Flextech Television Limited (“the Applicant”) to register the following series of two marks:



The second mark in the series is limited to the colours purple, orange, blue, green, pink and black, as shown on the representation on the form of application.

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

In Class 9: “Computer hardware, computer software, apparatus for recording, transmission or reproduction of sound or images; video and audio tapes, compact discs, recording discs and tapes.”

In Class 16: “Printed matter, stationery, playing cards, books, newspapers, magazines, posters, stickers, transfers, pens, pencils, pencil sharpeners, erasers, pencil cases, note books, paper, envelopes, diaries.”

In Class 25: “Clothing, footwear, headgear.”

In Class 38: “Telecommunications; broadcasting services.”

In Class 41: “Publishing services, education and entertainment services utilising television, organisation of competitions, film and television programme production, film and television studio services, presentation of live performances.”

3. The application was opposed by I.P.C Magazines Limited (“the Opponent”) in relation to the specified goods and services in classes 9, 16 and 41. It was contended that registration of the trade mark would offend against the provisions of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) in the light of the earlier registration by the Opponent of the trade mark LIVING in respect of “Printed periodical publications” in Class 16.

4. At the hearing the Opponent withdrew its opposition in relation to certain goods and services, but maintained it in relation to the following:

Class 9: “Computer Software, video and audio tapes, compact discs, recording discs and tapes.”

Class 16: “Printed matter, books, newspapers, magazines, paper.”

Class 41: “Publishing services, education and entertainment services utilising television, film and television programme production.”

5. The Hearing Officer dismissed the opposition and it is against his decision that the Applicant appeals.

The Decision of the Hearing Officer

6. Section 5(2)(b) of the Act states:

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

(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 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.”

7. The Hearing Officer took into account aspects of the guidance provided by the European Court of Justice (“ECJ”) in *Sabel BV v. Puma AG* [1997] E.C.R. I-6191, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1998] E.C.R. I-5507; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [1999] E.C.R. I-3819 and *Marca Mode CV v. Adidas AG* [2000] E.C.R. I-4861. In assessing the similarity of the goods and services, the Hearing Officer also had in mind the guidance provided by Jacob J. in *British Sugar Plc v. James Robertson & Sons Limited* [1996] R.P.C. 281 at 296 and by the ECJ in the *Canon* case, at paragraph 23.
8. The Hearing Officer then proceeded to consider the question of the identity or similarity of goods and services. In relation to the goods the subject of the application in Class 16 he concluded that these were identical to those the subject of the Opponent’s specification, save for “paper” which he decided had little if any similarity to “printed periodical publications”. In relation to the goods and services in Class 9 and 41, the Hearing Officer found that these were all similar to “printed periodical publications”, save for “computer software”.

9. The Hearing Officer rejected a contention that the earlier trade mark had an enhanced level of distinctiveness as a result of use and therefore turned to consider the marks themselves. He found as follows:

“35 Clearly, the applicant’s mark contains the word “living”. However, as I have commented earlier, this is a common dictionary word, and is not very distinctive. I accept that the “UK” element also has a clear meaning and is also not particularly distinctive. However, when these two elements are combined they are different visually and aurally from the opponent’s mark. Neither mark has a strong conceptual meaning, they both allude to lifestyle, but this is a common concept amongst magazines.

36. Although I have no evidence on the matter, I believe that the relevant consumer for printed periodical publications is likely to be reasonably but not unduly careful in their purchase. The public is used to such items having very similar names, usually alluding or actually describing the subject of the publication. Whilst magazines have a more general interest may not be so carefully chosen and may be brought in a hurry, this is not a “bag of sweets” case. Although allowance must be made for the notion of imperfect recollection.

...

38. With all of this in mind I come to the conclusion, with some hesitation, that when all the factors are considered, even where the goods are identical, the differences in the marks are such that there was no likelihood of confusion at 28 May 1997. It follows that the opponent’s case also fails where respective goods and services are only similar. Consequently, the opposition under section 5(2)(b) fails.”

The Appeal

10. On the 10th July 2002 the Opponent gave notice of appeal to an Appointed Person. At the hearing the Opponent was represented by Mr. A. Bernard of F.J. Cleveland and the Applicant was represented by Mr. J. Pennant of D. Young & Co. Both parties agreed that I should follow the approach set out by the Court of Appeal in *REEF Trade Mark* [2003] RPC 5. I should show a real reluctance, but not the very highest degree of reluctance, to interfere with the

decision of the Hearing Officer in the absence of a distinct and material error of principle.

11. The Opponent has not pursued any appeal against the decision of the Hearing Officer in relation to “paper” or “computer software” and only appeals against the decision in relation to the following goods and services:

Class 9: “Video and audio tapes, compact discs, recording discs and tapes.”

Class 16: “Printed matter, books, newspapers, magazines.”

Class 41: “Publishing services, education and entertainment services utilising television, film and television programme production.”

12. The Opponent criticised the approach taken by the Hearing Officer to the comparison of the marks. It was said he failed properly to apply the legal principles which he had identified, had no sufficient regard to the fact that the earlier trade mark is included entirely within the Applicant’s mark, wrongly assessed the distinctive elements of the marks and failed to have regard to their conceptual similarity.

13. I have come to the conclusion that the Hearing Officer did fall into error in assessing the marks. It is clear that the similarities created by the marks must be assessed by reference of the overall impressions which they create and bearing in mind their distinctive and dominant components: *Sabel*, at paragraph 23. To my mind the distinctive and dominant component of the Applicant’s mark is the word “living”. Of course the other components, and in particular the “UK” component, of the mark must also be considered. But the “UK” component is not very distinctive and is not the dominant component of the mark. Accordingly, I believe the Hearing Officer fell into error in assessing both components as not being very distinctive. He ought to have approached the matter on the basis that the word “living” was sufficiently distinctive at least to satisfy the requirement of registration and to function as a trade mark.

14. I also believe the Hearing Officer did not have sufficient regard to the fact that the word “living” is not swamped by the other components of the Applicant’s mark and it conveys exactly the same conceptual meaning in the Applicant’s mark as it does in the earlier trade mark of the Opponent. This is not a case where it can be suggested that the two components “living and “UK” convey a different meaning together to that which they do separately. On the contrary it seems to me that, when used in relation to a periodical publication, the “UK” component is simply likely to convey that the publication is the UK version of “Living” magazine. I believe that this conclusion is reinforced by the fact that “UK” and “Living” appear in a different type script.
15. I am conscious that I should show a real reluctance to interfere with the decision of the Hearing Officer. But in the present case I have reached the conclusion that it is right to do so for the reasons which I have given. I must therefore proceed to make my own evaluation.
16. I turn then to consider the matter in relation to the particular goods and services the subject of the opposition. I will take first the goods in Class 16. The Hearing Officer found that “printed matter, books, newspapers and magazines” are identical to the Opponent’s specification of “printed publications”. The Applicant submitted that the Hearing Officer was wrong to conclude that books and printed periodical publications were identical. I accept that submission. Nevertheless they are, I believe, clearly similar, having regard to their end users, their nature and the trade channels through which they reach the market. I also agree with the Hearing Officer that the relevant consumers for printed periodical publications are likely to be reasonably but not unduly careful in their purchase.
17. The similarity between the marks is a matter to which I have already referred. I accept that there are differences between them. The Applicant’s mark has an array of squares around it and includes the component “UK”. These are apparent to the eye and, in the case of the prefix “UK”, to the ear. Nevertheless there is a substantial and significant similarity arising from the inclusion in the Applicant’s mark of the whole of the earlier trade mark.

When used, for example, in relation to periodical publications, I do not think that the presence of the “UK” component in the Applicant’s mark is a significant difference. Similarly, the array of squares around the Applicant’s mark seems to me to be a relatively simple background and very similar to much of the decoration that often appears in periodical publications. Furthermore, it would not dispel any aural confusion. For the reasons I have given, I believe the two marks do have a strong conceptual similarity through the common use of the word “Living”. Overall, and having regard to the identity or close similarity of the relevant goods and the degree of similarity between the marks, I have come to the conclusion that the use of the Applicant’s mark in relation to printed matter, books, newspapers and magazines would be likely to cause confusion.

18. I turn to consider the opposition in relation to the Applicant’s goods in Class 9. The Hearing Officer accepted the Opponent’s submission that magazines were available at the relevant date in other formats such as compact discs and audio tapes. For this reason the Hearing Officer regarded “video and audio tapes, compact discs, recording discs and tapes” as having some similarity to the Opponent’s goods. Again, it seems to me that the average consumers of such goods are likely to be reasonably careful in their purchase and I believe that much the same considerations apply to the Class 16 and Class 9 goods. Having regard to the similarity of the goods and the marks, I believe there is a real likelihood that the use of the Applicant’s mark in relation to, for example, video and audio tapes containing lifestyle material, would cause confusion. I think consumers would be likely to believe that such goods and a lifestyle magazine called “Living” do come from the same source.
19. I finally turn to consider the application in relation to services in Class 41. The Hearing Officer did not accept that the Opponent offers a publishing service to advertisers. In his view, the Opponent offers an advertising service to advertisers. Nevertheless, he was satisfied that there was a degree of similarity between publishing services and printed periodical publications. He apparently reached this conclusion on the basis of the evidence before him that a practice known as “masthead publishing” was becoming increasingly

common. This involves adopting the names of well known magazines as programme names and benefits both the programme makers and the magazine proprietors. There was also evidence before the Hearing Officer that it is becoming increasingly common for programmes to be described as “magazines”, and that this indicates a style of programming with different subjects and interests.

20. The Opponent challenged the conclusion of the Hearing Officer that the Opponent does not offer a publishing service to advertisers. In my view, the Opponent is correct. There is no suggestion that the Opponent plays any part in the creation or development of any advertisement. All it does is to publish advertisements placed with it by advertisers. However, I do not think this substantially affects this aspect of the decision of the Hearing Officer. He accepted that there is some similarity between publishing services and printed periodical publications.
21. I must therefore consider whether there exists a likelihood of confusion because of the similarity between the marks and between publishing services and periodical publications. I have come to the conclusion that there is no real risk of such confusion. I believe that advertisers and other consumers taking advantage of publishing services are likely to be well aware of the enterprise with which they are dealing and it seems to me that it is likely they would distinguish between the marks in issue. I do not believe there is a real likelihood of confusion in relation to publishing services.
22. As to the remaining services in Class 41, namely “education and entertainment services utilising television” and “film and television programme production”, I accept there is some similarity between these and “printed periodical publications”. But in my view that similarity is limited. I also have in mind that masthead publishing is something which was, until recently, the subject of stringent regulations and not a widespread practice. In relation to all these services, I have come to the conclusion that the similarities between the marks and the similarities between the goods and services are not such that there exists a likelihood of confusion on the part of the public.

Conclusion

23. In the result the appeal succeeds in relation to the following goods:

Class 9: “Video and audio tapes, compact discs, recording discs and tapes.”

Class 16: “Printed matter, books, newspapers, magazines”

The appeal against the decision in relation to the services in Class 41 is dismissed.

24. Both sides sought an order for their costs of the appeal. Mr. Salthouse ordered the Opponent to pay to the Applicant the sum of £1335. Before me I take the view that each side has achieved some success. I also have in mind that before the Hearing Officer and on appeal the Opponent withdrew its opposition to certain goods and services. Accordingly, I direct that the costs order of the Hearing Officer be set aside and that there be no order for the costs of the appeal or of the proceedings before the Hearing Officer.

David Kitchin QC

19th February, 2003