

IN THE MATTER OF APPLICATIONS NOS. 2292709, 2292720, 2292722, 2292723, 2292724, 2292726, 2292742, 2292746 AND 2292747 IN THE NAME OF IDEAL HOME LIMITED

AND IN THE MATTER OF OPPOSITIONS NOS. 90900, 90901, 90902, 90903, 90904, 90905, 90906, 90907 AND 90908 THERETO BY IPC MEDIA LIMITED

DECISION

Introduction

1. On 14 February 2002 Ideal Home Ltd applied to register the nine series of two trade marks shown in the appendix to this decision in respect of various goods and services in Classes 16, 35 and 41 (except for 2292747, which was only sought to be registered in Classes 35 and 41). Each of the series of trade marks consists of three elements, namely (1) a drawing of a girl or young woman, (2) a word which is apparently intended to be the name of the girl or woman depicted such as TECHNO, DIY or JETSET and (3) the phrase THE IDEAL HOME GIRL.
2. In due course the applications were opposed by IPC Media Ltd on grounds raised under sections 3(6), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. The objections on relative grounds were based upon the opponent's earlier registrations of a number of trade marks consisting of or including the words IDEAL HOME in Classes 9, 16, 35, 38 and 41 and upon the opponent's goodwill as the publisher of IDEAL HOME magazine.

3. After both parties had filed evidence and a hearing, George Salthouse acting for the Registrar upheld each of the oppositions in a written decision dated 14 February 2006 (O/050/06). The applicant now appeals.

Relevant provisions of the Trade Marks Act 1994

4. Section 3(6) of the 1994 Act provides:

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

5. Section 5 of the 1994 Act provided at the relevant times in relevant parts as follows:

- (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

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- (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.

- (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....

The hearing officer's decision

6. In his decision the hearing officer first held, following *FRANCO'S REVIERA CONE Trade Mark* (O/214/03), that the opponent was entitled to rely upon two registrations which had been revoked with effect from dates after the application date (and after the filing of the oppositions). This aspect of his decision was not challenged before me and I have therefore not considered its correctness. I doubt that it would make any difference to the outcome of the oppositions in any event.

7. So far as section 5(2)(b) is concerned, the hearing officer directed himself in accordance with the Registrar's standard summary of the jurisprudence of the Court of Justice of the European Communities in Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4881. The hearing officer held that the opponent's trade marks were inherently distinctive for all goods and services for which they were registered except books, magazines and radio and television programmes about the home and that its IDEAL HOME mark had an enhanced reputation in relation to magazines; that all of the goods and services specified in the applications were either identical or similar to goods and services covered by the opponent's registrations save for "paper, cardboard and goods made from these materials; stationery, plastic materials for packaging"; that the distinctive and dominant element of each of the applicant's trade marks was the phrase THE IDEAL HOME GIRL; that there were visual, aural and conceptual similarities between the applicant's trade marks and the opponent's trade marks, but also differences; and that, taking all these factors into account, there was a likelihood of confusion in relation to all goods and services covered by the applications except "paper,

cardboard and goods made from these materials; stationery, plastic materials for packaging”.

8. So far as section 5(3) is concerned, the hearing officer directed himself in accordance with *General Motors Corp v Yplon SA* [2000] RPC 572, *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, *DaimlerChrysler AG v Alavi* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines (O/455/00)*, *Mastercard International Inc v Hitachi Credit (UK) plc* [2004] EWHC 1623 (Ch), [2005] ETMR 10 and *Electrocoin Automatics Ltd and Coinworld Ltd* [2004] EWHC 1498 (Ch), [2005] FSR 7. The hearing officer held that the opponent had the necessary reputation in relation to its magazine to support a section 5(3) objection and that use of the applicant’s trade marks in relation to “paper, cardboard and goods made from these materials; stationery, plastic materials for packaging” would reduce the distinctiveness of the opponent’s trade marks.
9. With regard to section 3(6), the hearing officer directed himself in accordance with *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, *Harrison v Teton Valley Trading Co Ltd* [2004] EWCA Civ 1028, [2004] 1 WLR 2577 and *Barlow Clowes International Ltd v Eurotrust International Ltd* [2005] UKPC 37, [2006] 1 All ER (Comm) 478. The hearing officer held that the applicant had made each of the applications in bad faith since (1) it had registered numerous company and domain names, as well as making the applications, all centred around the words IDEAL HOME, (2) there was evidence that the applicant had sought to associate itself with the IDEAL HOME SHOW, (3) there was evidence that the applicant had sought to licence the trade marks and had made misleading claims in its advertising and (4) the applicant had failed to give any explanation for choosing the words IDEAL HOME as its main identifier or for seeking registration in classes closely shadowing those of the opponent despite a challenge from the opponent that the applicant was seeking to exploit any mis-association between itself and its activities and those of the opponent.

10. The hearing officer did not consider section 5(4)(a) in the light of his other conclusions.

Standard of review

11. This appeal is a review of the hearing officer's decision. In my judgment the hearing officer's decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

Further evidence

12. The applicant submitted certain items of further evidence in support of its appeal. In my judgment the applicant has not demonstrated that such further evidence should be admitted at this stage of the proceedings. Nevertheless I have considered the further evidence to see if it would make any difference to the result if it were to be admitted. In my judgment it would make no difference.

The appeal

13. Since the applicant was not professionally represented, its representative had understandable difficulty in identifying and articulating errors in the hearing officer's reasoning, let alone errors of principle, other than submitting that his conclusions were wrong. I have therefore scrutinised the hearing officer's reasoning with some care myself. Subject to one or two caveats which do not assist the applicant, I see no error of principle in his decision. I will deal briefly with each of the applicant's main criticisms of the hearing officer.

14. With regard to section 5(2)(b), the applicant's representative made five main points. The first was that the hearing officer had erred in his assessment of the applicant's trade marks. She argued that he had failed to differentiate between them and had failed to consider them as a whole, effectively ignoring the elements other than the phrase THE IDEAL HOME GIRL. In my judgment this criticism is unfounded. The hearing officer expressly recited the differences between the applicant's trade marks, but his conclusion was that the differences were immaterial to the comparison with the opponent's trade marks. Furthermore, he did consider the applicant's trade marks as a whole, but his conclusion was that the distinctive and dominant element in each was the phrase THE IDEAL HOME GIRL. I see no error of principle in his assessment. On the contrary, as the hearing officer stated, it is supported by the reasoned order of the European Court of Justice in Case C-3/03P *Matratzen Concord GmbH v OHIM* [2004] ECR I-3657
15. Secondly, the applicant's representative argued that the hearing officer had failed to take into account the applicant's intention to use each mark in relation to fields to which it was appropriate. Thus JETSET would be used in relation to travel goods and services, BEAUTY in relation to beauty products and services, IT in relation to information technology goods and services, DIY in relation to home improvement products and services and so on. Similarly, she also argued that the hearing officer had failed to take into account the way in which the applicant intended to use the marks, and in particular its intentions with regard to licensing. In my judgment these arguments are fallacious. The hearing officer proceeded, as he was obliged to do, on the basis that each of the trade marks applied for would be used in a normal and fair manner in relation to all the goods and services covered by the specifications. Furthermore, I consider that this argument supports the hearing officer's approach to the assessment of the trade marks, since it confirms that the "name" elements of the marks are non-distinctive.
16. Thirdly, the applicant's representative argued that the hearing officer had failed to take into account the differences between the applicant's intended fields of use and the opponent's field of use in relation to a magazine. Again,

however, I consider that the hearing officer was correct to compare the goods and services covered by the applications with those covered by the opponent's registrations. If the hearing officer erred, it was in treating the question of similarity of goods and services as a "yes/no" question rather than a question of degree. In my judgment this error favoured the applicant rather than the opponent, however, since, if the hearing officer had followed what I consider to be the correct approach, I believe that he would concluded that there was some degree of similarity, and hence a likelihood of confusion, with regard to all the goods and services covered by the applications.

17. Fourthly, the applicant's representative asserted that there had been no actual confusion between the applicant and the opponent. As to this, it is well-established that the absence of actual confusion is not conclusive even if there had been coexistence of the rival marks in the marketplace. In the present case, however, the hearing officer found that neither the applicant nor its associated companies had been trading. The applicant's representative asserted before me that this was wrong, but the evidence supports the hearing officer's finding.
18. Fifthly, the applicant's representative argued that other third parties had used IDEAL HOME marks without causing confusion. However the only third party whose use is established by evidence is Associated Newspapers Ltd, whose use of the trade mark IDEAL HOME EXHIBITION is acknowledged by the opponent. In this connection the applicant's representative relied upon the decision in earlier opposition proceedings brought by the opponent against an application by Associated Newspapers Ltd to register IDEAL HOME EXHIBITION (O/002/06). In my judgment this decision does not assist the applicant for a number of reasons. First, the opponent was actually partially successful in that case. Secondly, the facts were very different since there had been decades of parallel use of the respective trade marks. Thirdly and in any event, the hearing officer in the present case was obliged to make up his own mind based on the application of the law to the facts here regardless of what might have been decided in some other case.

19. In relation to section 5(3), the applicant's main criticisms were essentially repetitions of the fourth and fifth points dealt with above. I would add that, while the hearing officer's reasoning with regard to section 5(3) is rather "thin", he could have arrived at the same result under section 5(2)(b) for the reasons given in paragraph 16 above. In any event, the question is academic having regard to his conclusion under section 3(6).
20. In relation to section 3(6), the applicant again repeated the fourth point dealt with above. The applicant's representative also argued that there was no evidence to support the finding of bas faith. In particular, she criticised the hearing officer's conclusion that the applicant had failed to give an innocent explanation of its adoption of the expression IDEAL HOME as its main identifier. When I asked her what the explanation was, however, she twice failed to answer the question. In the absence of an innocent explanation the hearing officer was entitled to make the inference he did: see *Ferrero SpA's Trade Marks* [2004] RPC 29.

Conclusion

21. The appeal is dismissed.

Costs

22. The hearing officer ordered the applicant to pay the opponent the sum of £10,500 as a contribution to its costs of the proceedings below. I shall order the applicant to pay the opponent the additional sum of £1,000 as a contribution to its costs of the appeal.




8 January 2007



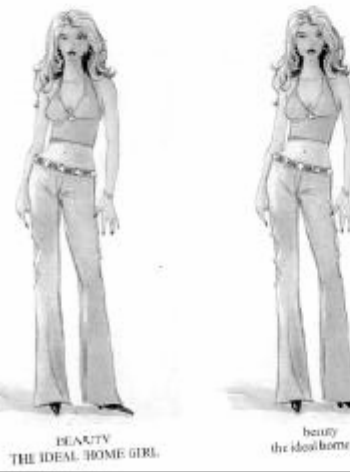
RICHARD ARNOLD QC




Maureen Ennison of the applicant appeared in person.

Simon Malynicz, instructed by fj cleveland, appeared for the opponent.

Appendix

Number	Trade Mark
2292709	 <p data-bbox="438 806 598 840">TECHNO THE IDEAL HOME GIRL</p> <p data-bbox="638 806 758 840">techno the ideal home girl</p>
2292720	 <p data-bbox="462 1265 614 1299">FITNESS THE IDEAL HOME GIRL</p> <p data-bbox="662 1265 774 1299">fitness The ideal home girl</p>
2292722	 <p data-bbox="422 1736 582 1769">MONEY THE IDEAL HOME GIRL</p> <p data-bbox="614 1736 734 1769">money the ideal home girl</p>

2292723	 <p>JOLIES THE IDEAL HOME GIRL</p> <p>jodies the ideal home girl</p>
2292724	 <p>GADGET THE IDEAL HOME GIRL</p> <p>gadgets the ideal home girl</p>
2292726	 <p>BEAUTY THE IDEAL HOME GIRL</p> <p>beauty the ideal home girl</p>

2292742	 <p data-bbox="443 577 574 607">JT THE IDEAL HOME GIRL</p> <p data-bbox="654 577 742 607">JL the ideal home girl</p>	
2292746	 <p data-bbox="454 1025 598 1055">DIY THE IDEAL HOME GIRL</p> <p data-bbox="654 1025 758 1055">dti the ideal home girl</p>	
2292747	 <p data-bbox="470 1478 614 1507">JETSET THE IDEAL HOME GIRL</p> <p data-bbox="710 1478 821 1507">jt set the ideal home girl</p>	