

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2143800
BY JAMES KIMBER MANAGEMENT LIMITED
TO REGISTER A TRADE MARK IN CLASS 16**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 48198
BY HAWKER CONSUMER PUBLICATIONS LIMITED**

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**IN THE MATTER OF Application No 2143800
by James Kimber Management Limited
to register a Trade Mark in Class 16**

and

**IN THE MATTER OF Opposition thereto under No 48198
by Hawker Consumer Publications Limited**

BACKGROUND

1. On 3 September 1997 James Kimber Management Limited applied to register the trade mark BLACKHAIR under application No. 2143800 in Class 16 for a specification consisting of:

‘Paper, printed matter, printed publications, books, newspapers, periodicals, magazines’.

2. The application was accepted and published for the specification as above. (The application was subsequently assigned in full, from 31 March 1999, and currently stands in the name of James Kimber Magazines Limited (the applicants in this case)).

3. On 11 February 1998 Hawker Consumer Publications Limited (the opponents) filed a notice of opposition. They say they are the proprietors of BLACK BEAUTY & HAIR magazine, which has been published in the UK for about 15 years. For the last five years they have also published an annual style book under the mark BLACK BEAUTY HAIRSTYLE BOOK, which has now been renamed BLACKHAIR STYLES. The opponents are also applicants in the UK for the two marks BLACK BEAUTY & HAIR and BLACKHAIR. They state that they have used the above marks as their trade marks extensively in the UK as denoting exclusively their goods. They say that the goods of the application in suite are the same as for the marks they applied for, and use and registration of the mark opposed should be refused under the provisions of s. 5(4) of the Act.

4. The opponents go on to say that for the goods at issue, the title BLACKHAIR - particularly for a magazine or periodical relating to hair care and styling - is clearly descriptive. As such, registration should be refused under the provisions of s. 3(1)(b) and (c) of the Trade Marks Act 1994. They also state that the application should be refused under the terms of s. 3(6) of the Act.

5. The applicants filed a counterstatement in which they admit the existence of the opponents, but make no admission as to the rights claimed by them or their relevance to the proceedings. They also state that it is clear from the opponents’ pleadings that they changed the name of an existing publication to BLACK HAIR STYLES only after the applicants adopted the mark at issue and therefore cannot claim to have an ‘earlier’ right. In effect, all other of the grounds of opposition are denied.

6. Both sides seek an award of costs in their favour and both filed evidence. The matter came to be heard on 8 December 2000. Mr I Bartlett of W H Beck Greener appeared on behalf of the applicants and Ms C Wolfe of Gill Jennings & Every appeared on behalf of the opponents.

OPPONENTS' EVIDENCE

7. The opponents filed a statutory declaration dated 29 October 1998 by Pat Petker, who has been one of their Directors since 1991. Mr Petker confirms that the opponents are the applicants for the mark BLACK BEAUTY & HAIR in respect of magazines in Class 16. The goods have been produced under the trade mark since the summer of 1982. Mr Petker states that the goods are distributed nationwide through stockists such as W H Smith and John Menzies, and at Exhibit 1 are two issues of the magazine dating from summer 1987 and August/September 1997. On page 32 of the latter, he points to further examples of previous front covers of the magazine dating back to the summer of 1982. He goes on to give sales figures under the mark in the UK:

	£
1993	272,400
1994	324,400
1995	344,600
1996	385,600
1997	399,000

Annual advertising and promotion figures are also provided:

	£
1993	8,700
1994	7,100
1995	11,900
1996	11,500
1997	13,800

8. At Exhibit 2, he gives examples of detailed analysis of the sales figures for February/March 1998 and April/May 1998 and states that sales of the magazine are highest around London. These facts are all, I note, outside the relevant date in these proceedings.

9. Mr Petker continues by stating that the opponents have sought to register the mark BLACK BEAUTY & HAIR, and for over five years have published an annual style book called BLACK BEAUTY HAIRSTYLE BOOK. This was renamed in 1997 to BLACKHAIR STYLES. The BLACK BEAUTY HAIRSTYLE BOOK derived its name from the magazine BLACK BEAUTY & HAIR and was presented in a similar font to underline this connection and to supplement the cross-publicity which each publication carries for the other. BLACKHAIR STYLES too had a similar presentation. Copies are provided at Exhibit 3.

10. Mr Petker finishes by saying that he believes the applicants deliberately copied his company's mark, both in presentation and in name and he offers his opinion that consequently confusion will be inevitable and that his company's goodwill and reputation will be tarnished and diverted to the applicants.

11. The opponents filed a further statutory declaration (dated 12 November 1998), from Ms Myrna Robinson, who is described by the opponents' agents in their covering letter of 24th November 1998 to the Registry as 'an independent party who is a reader of BLACK BEAUTY & HAIR and who suffered confusion'. In the declaration, Ms Robinson says she has read the BLACK BEAUTY & HAIR magazine for over a decade and describes an incident where 'recently' she picked up a copy of BLACKHAIR magazine in error, confusing it with the former publication. When she realised her mistake, and looked for the originator of the BLACKHAIR magazine, she still could not easily find evidence that it was from a different publisher. In view of this, and her long readership of the opponents' magazine, she concludes that less regular readers of BLACK BEAUTY & HAIR would be totally confused.

APPLICANTS' EVIDENCE

12. The applicants filed a statutory declaration dated 16th June 1999 by Mr James Kimber, the principal shareholder of James Kimber Publishing, formerly known as James Kimber Management Limited. Mr Kimber states that the applicants and their predecessors in title have been involved in publishing magazines and other printed publications, particularly relating to hair and fashion, for many years. One such magazine was HAIRFLAIR magazine which was first produced in 1982. Front covers of the February 1987 and May/June 1998 editions of this magazine are exhibited as JK1 and JK2.

13. Mr Kimber goes on to say that, as part of an on-going commitment to bringing out new titles, in 1997 it was decided to adopt the name BLACKHAIR for a new magazine. The application to register BLACKHAIR as a trade mark was made on 3 September 1997 after preliminary investigations had been carried out to show that there were no other registrations or any other title on the market similar to BLACKHAIR. The application was duly accepted and published by the Trade Marks Registry in November 1997. In preparation for the launch of the new magazine, the opponents produced various letter headings and associated stationery in July 1997 and, during July, August and September 1997, this paperwork was put into circulation, with an introductory leaflet (see Exhibit JK3).

14. The first edition of BLACKHAIR magazine was issued in December 1997, and is shown at Exhibit JK4. The magazine has been published bi-monthly since that time and examples of various of its covers are shown at Exhibit JK5. Mr Kimber refers specifically to the October/November 1998 edition (see Exhibit JK5) to illustrate other uses of the mark within the magazine. JK6 exhibits headed company paper utilizing the BLACKHAIR mark.

15. Mr Kimber states that the bi-monthly sales of the BLACKHAIR magazine currently average about 11,000 copies. He says that it has been extensively promoted by placing advertisements in various publications, at trade shows and by the production of various leaflets and posters. JK7 exhibits examples of leaflets and advertisements produced during 1998 (which is after the material date in these proceedings). Mr Kimber states that as a result of the use and promotion of the mark BLACKHAIR, the magazine has quickly established a strong reputation in the trade. He also says that to his knowledge there has never been an instance of confusion as to the name, nature or origin of BLACKHAIR magazine.

16. Mr Kimber states that he has read the opponents' evidence from Pat Petker and, while he knows of their magazine BLACK BEAUTY & HAIR, it is not the only magazine of its kind and does not entitle them to exclusive use of the word BLACK in relation to this field. He continues by saying that he feels that there has been and there is no likelihood of confusion between the marks BLACKHAIR and BLACK BEAUTY & HAIR because of the way the opponents' own evidence show it in use, i.e. with the words BLACK BEAUTY in much larger type than the '& HAIR' elements. As such he feels it would be principally known as BLACK BEAUTY rather than by its full name.

17. Mr Kimber takes issue with Mr Petker's statement in his evidence by saying that it was the applicants who first adopted the BLACKHAIR name in July 1997 before the opponents changed the name of their year book BLACK BEAUTY HAIRSTYLE BOOK to BLACKHAIR STYLES in November 1997. He says he believed this was deliberate in order to stop his company from launching its rival magazine in December of 1997 and suggests that far from the applicants copying the opponents' BLACKHAIR mark, it was in fact the other way round. He says this can be further seen from the nature of the logo used by the opponents in their November 1997 issue of the year book under the name BLACKHAIR STYLES, which adopted the exact same logo for the word BLACKHAIR as had been produced by the applicants on its promotional material since July 1997. To illustrate this he compares Pat Petker's Exhibit 3 and his Exhibit JK3. He says it can also be seen from Exhibit JK6 that the logo style adopted for BLACKHAIR is in keeping with other magazine titles his company produces and he points out that the opponents had never previously used two different typefaces nor this particular type-face for earlier editions of their year book.

18. In view of all this, Mr Kimber says that it is his belief that having seen the pre-launch publicity for the applicants' new BLACKHAIR magazine, in order to prevent its launch or create confusion over the launch, the opponents deliberately changed the name and logo style of their year book to that of the applicants' magazine. When that failed, they filed this opposition action.

19. Mr Kimber continues by noting that the opponents changed their logostyle again to a quite different typeface for their BLACK HAIRSTYLES year book, in November 1998, away from that closely resembling the applicants' BLACKHAIR logo. He exhibits at JK8 a copy of the front page of the opponents November 1998 BLACK HAIRSTYLES year book showing this changed logo.

20. Finally, Mr Kimber comments on the declaration of Ms Myrna Robinson. He questions her relationship with the opponents and says that this one instance of alleged confusion is hardly relevant in the circumstances - where two magazines of relatively large circulation had co-existed in the market place for a year before the alleged instance of confusion arose.

OPPONENTS' EVIDENCE IN REPLY

21. A second Statutory Declaration by Pat Petker is produced, dated 14 September 1999. He comments that the opponents only managed to obtain registration for their BLACK BEAUTY & HAIR mark on presentation of evidence of use, but the applicants secured registration of BLACKHAIR without the need for such evidence. In his view the word BLACKHAIR is so

descriptive that it should not have been allowed on the Register. Registration of the word prevents other traders from referring in the most natural way to describe the hair of black people. He claims that evidence as to the descriptive nature of the word BLACKHAIR may be adduced by the fact that whilst the opponents' magazine is entitled BLACK BEAUTY & HAIR, it is frequently accidentally referred to with the descriptive term 'BLACK HAIR & BEAUTY'. Mr Petker says that while his company are not attempting to obtain sole rights to use the words 'Black' or 'Black Hair', he believes that such rights should not be granted to anyone.

22. Mr Petker disagrees with the claim made in Mr Kimber's statutory declaration that he had seen the introductory leaflet put into circulation in July 1997 by the applicants, announcing their BLACKHAIR magazine launch. He says that while he was aware that such a magazine was to be produced by the applicants, he did not see the leaflet or the logo which they intended to use. He states that at no time until publication of the magazine in December 1997 was he made aware that the logo to be used for BLACKHAIR magazine was very similar to that used in his own company's publication of BLACK BEAUTY & HAIR magazine or in the re-designed BLACKHAIR STYLES year book. He says that the applicants used the same typeface, but in a different point size, to the opponents' magazine.

23. Mr Petker also takes issue with the contention that the opponents deliberately changed the name of their year book to attempt to stop the launch of the applicants' BLACKHAIR magazine. He adds that the logo style adapted for the year book was based on that used for their BLACK BEAUTY & HAIR publication and not copied from the applicants' proposed logo. He says that the reason for changing the design of the year book in 1998 was to avoid any further confusion between the magazines. This opposition action had been launched and he did not want the matter to be further muddled. In response to Mr Kimber's claim that there have been no instances of confusion between the marks in suit, Mr Petker refers to the instance of Myrna Robinson. He also points to the fact that in conjunction with the BLACK BEAUTY & HAIR title, his firm have used the phrase 'for the beauty conscious black woman' on the cover of that magazine. Mr Petker says that, when in July 1997, the applicants chose to refer to their magazine as being 'the image conscious black woman' in their publicity leaflet, this indicates that the phraseology had been copied from the opponents magazine, and that any copying was on their part and not *vice versa*. Finally, Mr Petker in response to a query from Mr Kimber as to the relationship between Myrna Robinson to the opponents, states she is a purchaser of the magazine, who is '[treated by]' the wife of another Director of the opponents'. This statement is unexplained, but does little to help me determine the extent to which Ms Robinson is representative of typical consumers.

24. This concludes my summary of the evidence in so far as I see it as relevant to these proceedings.

DECISION

25. At the hearing, Ms Wolfe representing the opponents, withdrew the s. 3(6) ground. That left ss. 3(1)(b) and (c), and s. 5(4)(a). I heard submissions from Ms Wolfe and Mr Bartlett on these grounds, and had read Mr Bartlett's skeleton arguments prior to the hearing. Paragraphs 3(1)(b) and (c) of the Act state:

3(1) *The following shall not be registered*

- (b) *trade marks which are devoid of any distinctive character,*
- (c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services.*

26. Ms Wolfe characterised the s. 3(1) pleading as the opponents' primary ground for opposition. She argued that the opponents own mark BLACK BEAUTY & HAIR was similar to the mark in suit yet, unlike the latter, when the opponents applied for its registration, they had met with official objections under s. 3(1). These objections had only been overcome on the presentation of evidence of use of the opponents' mark.

27. She saw the prima facie acceptance of the BLACKHAIR application as some sort of oversight because, in her view, BLACKHAIR was certainly less registrable than BLACK BEAUTY & HAIR. She submitted that it was 'completely and entirely descriptive, has no distinctive character whatsoever and obviously serves in trade to signify the type of goods, that is, magazines about the hair and hair styles of black people'. She contended that in every newsagent one could find health magazines, fashion magazines, hair magazines, black hair magazines. Ms Wolfe explained that hair naturally grows in basically five colours: blonde, brown, red, grey and black and that essentially there are three different types of hair: Caucasian hair, Oriental hair and Black hair. She submitted that it was not uncommon for a hairdresser to advertise themselves as a 'Black hair' specialist, or for consumers to request a hairdresser confident in dealing with 'Black hair'. As to Ms Wolfe's classification of hair types, there is no evidence to support it. And I think the appreciation of the average consumer might not be quite so well circumscribed - it is quite possible that they may refer to alternative ways of referring to head-colouring, e.g. red hair might be described as ginger hair, Caucasian hair as a white persons hair or black hair as Afro or Afro-Caribbean hair (Mr Bartlett essentially made the same point at the hearing).

28. However, on the issue of the descriptive nature of the mark in suite, I was referred to some specific evidence. Exhibit JK5 to James Kimber's statutory declaration of June 1999 shows a survey sheet and asks at Question 1 'Which magazines do you buy?' There are a number of options given, among them 'BLACKHAIR', 'BLACK BEAUTY & HAIR' and a publication called 'SOPHISTICATES BLACK HAIR'. Ms Wolfe used this as a concrete example of what she said is readily obvious in any case, i.e. that the word BLACKHAIR is required by others to describe the hair of black people.

29. To be succinct, I will not summarise Mr Bartlett's submissions on these points in detail, save to say he took the view that the mark is not as directly descriptive of black people's hair as the opponents would have me believe. The mark is BLACKHAIR not BLACK PEOPLE'S HAIR. Further, save for the one instance cited above, Mr Bartlett said there was no evidence to support Ms Wolfe's contention regarding the descriptiveness of the mark.

30. It was common ground that Registry practice relating to magazine titles/publications is somewhat more relaxed regarding descriptive content than in relation to most other products. Where the parties differed was in their views as to whether *prima facie* acceptance of the trade mark BLACKHAIR in Class 16 was possible. Ms Wolfe conceded that this was not a mark that could *never* be registered, just that it would require evidence of distinctiveness acquired through use made of the mark prior to application, even in the more relaxed environs of the Registry practices in this class of goods. Mr Bartlett differed, saying that the mark was merely allusive of the subject matter of the magazine and therefore the *prima facie* acceptance of the application was correct.

31. It of course falls to me to resolve this basic difference of opinion.

32. In balancing the arguments of both parties, I find myself persuaded by Ms Wolfe's submissions.

33. BLACKHAIR is not in itself a dictionary word. However, clearly its composition, without a need to resort to an unnatural dissection of the mark, is from two common dictionary words: BLACK and HAIR. When vocalised, the visual conjoining of those words is completely lost, and no great store should be placed on this in terms of bestowing the requisite statutory distinctive character upon the mark. It is well established in trade mark case law that such a trifling alteration is often not enough to disguise the descriptive content of the words. The questions here are: (a) Is there descriptive content in those words in relation to the goods and, (b) does that descriptive content fall foul of s. 3(1)(c) of the Act? The answer to both questions is, in my view, yes. The mark would relay to the average consumer the meaning that a magazine or publication bearing the title BLACKHAIR would contain material relating to the hair of black people.

34. I do not think that it is unrealistic to suggest that, in the same way as a consumer might seek advice as to whether a shop sells magazines on any given subject matter, a potential query relating to 'black hair' magazines would be quite likely, and readily understandable, particularly if the enquirer was a black person - not an unreasonable assumption given the target circulation of the magazines cited in this case.

35. The contention that there might be a number of alternative ways of describing a particular product was of course answered by Mr Hugh Laddie in *Profitmaker* (1994) 17 RPC, at page 616 lines 38-44, when he said:

'The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the marks. If it were, then all of these alternative ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the Register to ensure that common descriptions or laudatory words or not unusual combinations of them, have been monopolised by others'.

36. Further, in my study of the evidence submitted by both the opponents and the applicants I find support for my view that the words BLACK HAIR are readily understandable as meaning black people's hair and would be apt for use by others in this trade. Ms Wolfe drew my

attention to one example (Exhibit JK5 of Mr Kimber). There are others. In Exhibit 1 to Pat Petker's first Statutory Declaration, there is the August/September 1997 edition of the BLACK BEAUTY & HAIR magazine; in an editorial at page 4, the following quotes can be seen:

'Who would have thought that a magazine stated in 1982 covering **Black hair** and beauty issues...' (my emphasis), and

'Way back then, the **Black haircare** and beauty industry was in its infancy...' (my emphasis).

37. There are other instances in the same editorial of the word 'Black' being used as a genre of magazines:

'In that time we have seen other Black magazines...', and

'...making us the longest-running Black magazine in the UK...'

38. In the applicants' own evidence filed as Exhibit JK4, which accompanies the statutory declaration of James Kimber, there are in the editorial to the first edition to the magazine BLACKHAIR in Dec 97/Jan 98, other such references:

'We are proud to be the first **Black Brit hair** magazine to be published in over a decade...' (my emphasis), and

'We're here to celebrate the fact that **Black hairdressing** in Britain...' (My emphasis)

39. There are also classified advertisements in the magazines exhibited which show hairdressing specifically catering for black people. Though the stylists in those advertisements are often referred to as 'Afro' stylists, Ms Wolfe's contention that black hairdressing as a specialist genre would appear to be borne out. In these circumstances, the purpose of a BLACK HAIR magazine would be unequivocal.

40. There is an alternative descriptive connotation to the word BLACKHAIR, i.e. the hair of any person who has hair coloured black. I think it unlikely that a magazine on this subject would be produced, which adds substance to my view that the alternative meaning suggested by the opponents, and with which I agree, is clearly the most obvious. I think it is also important to consider the matter in the context of the likely purchasers or target circulation, which clearly would be largely black people. This is borne out at exhibit JK3 to Mr Kimber's statutory declaration where the mock-up of the first issue of BLACKHAIR magazine says: 'Target Audience: For the image conscious black woman'.

41. It is my view that the mark as a whole is one that is directly descriptive as shown above and further, is the sort of descriptive statement which other traders would want to, and should therefore be free to, use. It falls foul of s. 3(1)(c) for these reasons and, consequently, is *prima facie* devoid of any distinctive character under s. 3(1)(b).

42. In this regard, I am guided by the comments of Mr Justice Jacob in the *British Sugar Plc v James Robertson and Sons Ltd* (1996) RPC 281, which also go to s. 3(1)(c) of the Act, when he said:

‘Next, is “Treat” within s. 3(1)(b)? What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act “inherently” but the idea is much the same) devoid of distinctive character’.

43. Consequently, the opposition succeeds on the first ground under ss. 3(1)(b) and (c) of the Act.

44. In case I am wrong on the s. 3 issue, I go on to consider the second and final ground of the opposition under s. 5(4)(a) of the Act. Much of the evidence related to this ground and significant time at the hearing was spent on it, even though Ms Wolfe claimed it only to be the secondary ground of the proceedings. S. 5(4)(a) of the Act states:

A trade mark shall not be registered if, or to the extent that, its use in the UK is liable to be prevented-

(a) 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

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.

45. Mr Geoffrey Hobbs QC, in *Wild Child* (1998) RPC 455, set out the basis on which this tribunal should consider an action based upon this Section of the Act in relation to 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 Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 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 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.’

46. I find it helpful to comment on each of the stated three elements of the ‘classical trinity’:

(i) **Goodwill and reputation** - It seems to be common ground that the opponents have established a goodwill and reputation since 1982 for magazines under the mark BLACK BEAUTY & HAIR. The evidence summarised above shows this. The precise nature of this goodwill and reputation was the subject of some debate with regard to the presentation of the mark as actually used during the relevant period. That is a point I will comment on below, but it has no effect on my overall conclusion.

(ii) **Misrepresentation** - this, I feel, is the rub. For misrepresentation to have occurred several factors (as outlined in the cases above) are to be taken in to consideration. Two important elements are that there must have been confusion or deception leading to the misrepresentation. This essentially means that the public would mistake one mark for the other and thus mistakenly infer that the goods in suit are from the same source or are connected. The goods in question are identical and the marks are BLACK HAIR and BLACK BEAUTY & HAIR. I heard extensive submissions from both sides on the similarity or otherwise of these two marks. In my view while it can be argued that conceptually there is a certain similarity, overall I do not think the marks to be confuseable with each other. In the evidence and at the hearing there was much emphasis placed on the relative presentations of the two marks in terms of the fonts used, point size etc. To my mind many of these arguments were largely peripheral in that there was nothing unusual or distinctive enough in the particular script used in either case to make a significant contribution to the central issue of confusion or deception leading to misrepresentation. The kind of forensic dissection of the marks undertaken at the hearing was to my mind artificial and unnecessary, and to some degree smacked somewhat of desperate advocacy. Where the issue of presentation was significant, however, is in the way the BLACK BEAUTY & HAIR mark is presented in use, i.e. with the words BLACK BEAUTY far more prominent than the word HAIR and the ampersand. Although I do not consider the words in themselves to be similar in visual or aural terms, the presentation of BLACK BEAUTY & HAIR in use, which is of course completely pertinent in a s. 5(4)(a) action, further fortifies my belief that misrepresentation would not take place.

(iii) **Damage** - In view of my comments above, no damage could have occurred.

47. In terms of the one instance of alleged actual confusion, described in the evidence of Ms Myrna Robinson, I cannot place much weight on this. As the applicants point out, it consists of one instance of confusion in a marketplace where two magazines of relatively large circulation had co-existed for a year. Further, the nature of the relationship Ms Robinson has with the opponents has not been clearly explained.

48. There were substantial references in these proceedings to the opponents' use of the BLACK BEAUTY HAIRSTYLE BOOK. This publication, the evidence shows, subsequently changed its name in November 1997 to BLACKHAIR STYLES and then again in November 1998 to BLACK HAIRSTYLES. While it can readily be seen that the last two versions are very similar to the application in suit, as both were produced after the material date of 3rd September 1997, their existence has no bearing on this pleading. The first version of the yearbook attested to, BLACK BEAUTY HAIRSTYLE BOOK while within date, is not confuseable in line with my earlier view on BLACK BEAUTY & HAIR.

49. For these reasons the opposition fails under the s. 5(4)(a) ground.

50. However, the opposition is successful overall and the opponents are entitled to an award of costs. I order that the applicants pay the opponents the sum of £835 as a contribution towards their costs. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20TH day of February 2001.

Dr W J Trott
Principal Hearing Officer
For the Registrar, The Comptroller General