

O-141-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2041354
IN THE NAME OF LIBERTY MEDIA FOR WOMEN LLC
TO REGISTER A TRADE MARK IN CLASS 16**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 48858
BY IPC MEDIA LIMITED**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR M. FOLEY DATED 19 JUNE 2003**

DECISION

Introduction

1. This is an appeal against a decision of Mr. Mike Foley, the Hearing Officer acting on behalf of the registrar, dated 19 June 2003, in which he rejected an opposition against registration of UK Trade Mark No. 2041354 in the name of Liberty Media for Women LLC (“Liberty”) to whom the trade mark was assigned by the original applicant, McDonald Communications Corporation, with effect from 29 November 1999. UK Trade Mark No. 2041354, which was filed on 13 October 1995, concerns the following series in Class 16 for “periodical magazines for women”:

Ms.

MS

MS .

Ms

Ms .

2. The application was opposed by IPC Media Limited (“IPC”) on absolute and relative grounds under the Trade Marks Act 1994 (“the TMA”). The Hearing Officer dismissed IPC’s objections under section 3(1)(b) and (c) of the TMA. Ms. was allusive, possessed of distinctive character and prima facie deserving of registration in relation to periodical magazines for women (decision, paragraphs 42 – 46). The Hearing Officer added that on the evidence before him, Liberty had failed to establish that the mark had acquired distinctive character in the UK through the use made of it (decision, paragraphs 47 – 49). There is no appeal against any of these findings by the Hearing Officer.
3. The Hearing Officer also rejected IPC’s objection under section 5(4)(a) of the TMA that registration of the series should be refused because use of the trade mark in the UK was liable to be prevented by virtue of the law of passing off protecting IPC’s unregistered trade mark MIZZ used in conjunction with women’s magazines. The Hearing Officer arrived at the following conclusions, which are not challenged on appeal:
 - (a) The date for assessing the applicability of section 5(4)(a) of the TMA was the date of filing of UK Trade Mark No. 2041354 (13 October 1995).
 - (b) IPC had on the evidence established reputation and goodwill in the UK for MIZZ magazines at the relevant date.
 - (c) Although Liberty claimed to have first used Ms. for magazines in the UK in 1972 there was no conclusive evidence of that fact or of UK sales predating IPC’s introduction of MIZZ magazine in 1985. IPC had, therefore, on the evidence established earlier reputation and goodwill.
 - (d) Magazines are primarily obtained by self-selection.
 - (e) Magazine publishers habitually adopt titles that are allusive or semi-descriptive of the intended readership or content of the magazine.
4. I should mention that there is a “sister” appeal. IPC filed an application to register MIZZ in Classes 9, 16 and 35 on 20 June 1997. Liberty appeals against a further decision of Mr. Foley acting on behalf of the Registrar dismissing Liberty’s opposition to IPC’s application under section 5(2)(b) of the TMA based on the mark in suit. The oppositions were not consolidated but heard sequentially by the Hearing Officer. Unfortunately, evidence filed by the parties in support of/against the second opposition was referred to in the Hearing Officer’s decision on the first opposition (the subject of the present appeal) even though it clearly post dated the relevant date (13 October 1995). Whilst this caused some aggravation on my part, none of the rogue evidence appears to have influenced the Hearing Officer’s decision in the present case. In any event, neither party wished to take issue with the Hearing Officer’s account of the evidence. There are also typographical errors in the turnover figures the Hearing Officer listed for IPC in his decision. Again, no complaint was forthcoming from the parties.

The appeal

5. On 17 July 2003, IPC filed notice of appeal to an Appointed Person under section 76 of the TMA. IPC contends that the Hearing Officer erred in failing to take into account notional and fair use across the breadth of the specification applied for. Instead he based his decision upon the actual uses of the parties namely a niche market publication aimed at mature feminists (Liberty) and those aimed at young (*i.e.* 13 to 16 year old) teenage females (IPC) (Grounds of Appeal, para. 1). Had he properly considered the normal and fair uses to which the mark could be put, the Hearing Officer would have refused the application under section 5(4)(a) of the TMA or alternatively allowed the application to proceed but only in respect of the following specification: “Periodical magazines for women, all limited to feminist issues” (Grounds of Appeal, para. 2 and Further Notice of Appeal, para. 3).
6. At the hearing before me, IPC was represented by Mr. Michael Edenborough of Counsel. Mr. Malynicz of Counsel appeared for Liberty. I did not take up Counsels’ suggestion that I might wish to hear argument on the two appeals together. The appeals concern different relative grounds under the TMA, which I prefer to deal with separately and in independent decisions.
7. Counsel agreed that the appeal is by way of review. With a multi-factorial decision such as the present, I should be reluctant to interfere in the absence of a distinct and material error of principle (*REEF Trade Mark* [2003] RPC 101, per Robert Walker L.J. at para. 28).
8. I believe it undesirable to “cherry pick” passages from a Hearing Officer’s decision in order to support a case on appeal. The Hearing Officer’s conclusions under section 5(4)(a) were as follows (paras. 54 – 60):

“54. The extract from Willings Press Guide (exhibit SCF3) states that the opponent’s magazine under the title MIZZ was first published in 1985. A more precise date can be found in exhibit SCF2 which consists of a copy of a cover showing the magazine to have been available for purchase from at least as early as 12 April 1985. Although no figures relating to circulation have been provided, at a cover price of around 50p (extrapolated from the exhibits) turnover figures given for the years 1991 onward show significant copy sales, from which I consider it reasonable to infer that the opponents have established a reputation and goodwill in the name.

55. The applicants claim to have first used their trade mark in the United Kingdom in 1972, much earlier than that of the opponents. But as I have indicated in my consideration of the grounds under Section 3(1), there is nothing that I can see that conclusively establishes this to have been the case, nor that they were using their trade mark from a date earlier than that of the opponents, and I must therefore conclude

that based on the evidence before me, it is the opponents that have the earlier goodwill and reputation.

56. The opponents aim their publication at teenage females, whereas the applicant's target group appears to be feminists or those with an interest in feminism. I see no reason why teenagers, particularly those at the older end of this age range should not be interested in feminism, and accordingly there is some overlap in the customer base. But in any event, the specification of the application is limited to women in general, which must encompass both feminist and non-feminist consumers, including those in their teens.

57. Magazines are primarily obtained by self-selection which makes the visual appearance of the title (or trade mark) of primary importance, but I do not discount the potential for oral use, such as a consumer making an enquiry regarding the availability of a magazine. Although magazines are relatively inexpensive items, the consumer is, I believe, discerning in the selection, where able, often picking up the magazine to glance through its contents prior to the decision to purchase.

58. The words Ms. and MIZZ are visually different, but are indistinguishable when spoken. Ms. has a clear and well known meaning as a gender title, and although the same cannot be said of MIZZ, I take the view that where an invented word parallels a known word in some way, in this case, in its phonetic similarity, it is capable of creating the same idea in the minds of the consumer, and particularly so when used in relation to goods linked to the idea, as in a magazine for girls. Although the applicants had clearly begun using their mark in connection with their publication well before the opponents put theirs into use, they have not established that this was the case in this jurisdiction.

59. I have already stated that from my own knowledge (and as illustrated by the applicants) I believe that publishers of magazines adopt titles that are allusive or semi-descriptive of their intended readership or content. In such circumstances it is not surprising that other publications elect to use names that are visually, aurally or conceptually similar. Whilst the consumer appears well able to discern one title from another, in adopting names with a reference to a characteristic of the magazine or its intended readership, traders knowingly run the risk of others adopting similar titles and some limited confusion arising.

60. In my view the consumer desirous of obtaining MIZZ magazine who selects or is handed a copy of Ms. will not have been deceived into purchasing the goods of the applicants believing it to be the product of the opponents; I do not consider that there is much in the way of source motivation in the purchase of a magazine, the selection being primarily based on the content. They and/or the trader will have

been confused because of the similarity in the descriptive connotation of the title which I believe to be a circumstance of the trade. I do not see that in electing to use a title with some similarity to that of the opponents' magazine the applicants could be found guilty of misrepresentation, or to have trespassed onto the opponents' goodwill, or that the opponents will suffer damage in some material way. Accordingly I dismiss the ground under Section 5(4)(a)."

9. IPC's argument on appeal is dependent upon linking the Hearing Officer's observations on overlap in customers with those he made regarding content to give the alleged result that the Hearing Officer compared actual uses by the parties of their respective trade marks but did not additionally consider any normal and fair use Liberty might in future make of its mark within the specification applied for. That being the case, says IPC, Liberty's application should be restricted to "periodical magazines for women, all limited to feminist issues" to reflect the area where the Hearing Officer held that there was no operative misrepresentation. Alternatively, if such a limitation is considered unsuitable, Liberty's application should be refused in its entirety under section 5(4)(a) of the TMA. Liberty responds that paragraph 56 of the Hearing Officer's decision is fatal to IPC's claim. In that paragraph, the Hearing Officer (i) identifies the actual use made by each party (MIZZ aimed at teenagers, Ms. aimed at feminists), (ii) states that there is an overlap in those groups and, pertinently (iii) identifies that Liberty's specification is not in any event limited to the target group.
10. I believe that Liberty is correct and that the Hearing Officer did not fall into error by failing to consider notional and fair use of the applicant's mark. I believe this is clear not only from paragraph 56 of the decision but also from the Hearing Officer's discussion at paragraph 59 of the practice in magazine publishing of adopting allusive or semi-descriptive titles and the consequent ability of consumers to discern one title from another. That discussion is quite general in nature and obviously contemplates magazines containing articles covering the same subject area, be that homes, gardens, food or whatever. In other words, the Hearing Officer's use of the word "content" was not to signify different fields merely to describe the phenomenon that consumers choose magazines by leafing through the pages.
11. That is sufficient to dispose of the appeal but I should add something on the limitation put forward by IPC. It is my view that such a limitation would in any event be unworkable. First, as the Hearing Officer indicated, feminist issues might form suitable topics for any magazine. Second, there is the difficulty of defining "feminist issues" and its outer boundaries. The Court of Justice of the European Communities recently cautioned against the adoption of legally uncertain limitations albeit in the different context of the absolute grounds for refusal of registration (*Koninklijke KPN Nederland NV v. Benelux-Merkenbureau*, Case C-363/99, 12 February 2004, paras. 114 – 116).

Conclusion

12. In the result, the appeal fails. The Hearing Officer ordered that IPC should pay Liberty the sum of £635 in respect of the opposition and I direct that a further sum of £635 be paid to Liberty towards the costs of this appeal to be paid on the same basis as indicated by Mr. Foley.

Professor Ruth Annand, 10 May 2004

Mr. Michael Edenborough of Counsel instructed by fJ Cleveland appeared on behalf of IPC Media Limited

Mr. Simon Malynicz of Counsel instructed by R.G.C. Jenkins & Co. appeared on behalf of Liberty Media for Women LLC