

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2126328 BY
IPM LIMITED TO REGISTER A MARK
IN CLASS 16**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 48262
BY THE NATIONAL MAGAZINE COMPANY LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF application No: 2126328 by
IPM Limited

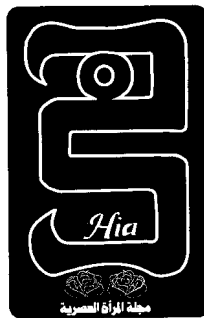
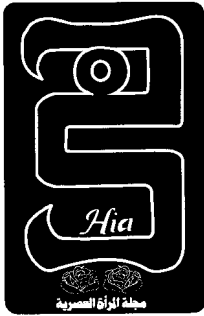
and

IN THE MATTER OF Opposition thereto under No: 48262 by
The National Magazine Company Limited

Background

1. On 10 March 1997 IPM Limited applied to register the mark shown below as a series of two marks for a specification of goods in Class 16 reading:

"Printed publications, newspapers, magazines and periodicals, photographs and printers' type."



2. The trade mark was advertised with the following information.

"The applicant claims the colours blue, brown and white as an element of the second mark in the series. The Arabic characters in the mark mean "She- The magazine for the modern woman".

3. The application was accepted and published and on 25 February 1998 The National Magazine Company Limited filed notice of opposition to this application. There were various grounds of opposition set out in the accompanying statement of case. However, on 23 February 2001 the opponents wrote to the Office stating that they were withdrawing all of their grounds of opposition with the exception of their objection under section 5(2) of the Trade Marks Act 1994. The ground of opposition under section 5(2) can be summarised as follows:

under section 5(2) in that the opponents are the registered proprietors of United Kingdom trade mark registration number 721023 for the trade mark SHE in Class 16 for “printed publications” and that the mark applied for is similar to the opponents’ trade mark and is in respect of similar or identical goods and there exists a likelihood of confusion on the part of the public.

4. The applicants filed a counterstatement denying the grounds of opposition, both sides seek an award of costs. The matter came to be heard on 6 March 2001. The applicants were represented by Mr Guy Tritton of Counsel instructed by Marks & Clerk, the opponents were represented by Ms Jessica Jones of Counsel, instructed by Wildbore & Gibbons.

Evidence

5. Both sides filed evidence in the proceedings. The opponents filed two statutory declarations. The first dated 17 November 1998 was by Ms Helen Ann Patricia Cullen a trade mark attorney with Wildbore & Gibbons, the opponents’ representatives in this matter. The second, dated 16 February 1999 was by Mr Stephen Rustat Hemsted, a Director of The National Magazine Company Limited, the opponents in this matter. Ms Cullen’s statutory declaration makes various statements concerning the examination procedure for the application in suit and makes various assumptions as to why the application was allowed to proceed to registration. These comments are not relevant to the opposition proceedings and I need not summarise them. Ms Cullen also provides information concerning the reputation of the opponents’ trade mark SHE. This information is provided in the evidence of Mr Hemsted and I will summarise the relevant parts of his evidence.

6. Mr Hemsted states that his company has used the trade mark SHE in respect of “printed publications” since at least the date of registration, that is 1953. His company publishes the magazine SHE which is a woman’s magazine aimed at the 25 to 44 age group, although he says that it is universally popular. At SRH 2 he exhibits copies of the front page of SHE magazine for October 1993, December 1993, December 1994, September 1995 and August 1996. Mr Hemsted gives approximate sales turnover figures for the years 1992 through to 1997. These are all in the region of 7 to 8.4 million pounds per annum. During this period the number of readers of SHE magazine is said to be in the region of one million. Approximate advertising expenditure for the period 1992 - 1997 is said to be 3.6 - 4.4 million pounds per annum.

7. Mr Hemsted states that SHE magazine is well known throughout the United Kingdom and is sold at many United Kingdom ports and airports and that the mark will have become well known in relation to “printed publications” to members of the international travel community

including UK residents who speak both Arabic and English. Mr Hemsted states that he believes that the trade mark SHE when used in respect of printed publications, especially magazines, is distinctive of goods emanating from his company and his company alone. He says that use of the trade mark the subject of the application will cause confusion in the minds of the public and the public will believe there is some connection between his company and the applicants.

8. The applicants filed a single statutory declaration dated 15 March 2000 by Mr Yasser Kamel El-Dabbagh, the Managing Director of H H Saudi Research & Marketing (UK) Limited.

9. Mr Yasser Kamel El-Dabbagh states that his company is the publisher and distributor of the magazine sold in the United Kingdom under the trade mark the subject of the application. He states that this use is under licence from IPM Limited and that his company has used the trade mark in relation to a bi-monthly magazine since 1993. Mr Yasser Kamel El-Dabbagh makes various comments concerning the evidence of Mr Hemsted and Mrs Cullen, the details of which I need not summarise. He also states that in his view, the opponents' trade mark, which he refers to as HIA and the applicants' trade mark are visually, phonetically and conceptually different. Examples of the magazine published by his company are attached at exhibit YKED5. Mr Yasser Kamel El-Dabbagh goes on to make various comparisons as to the layout of this magazine and the opponents' publication SHE. In addition, he states that HIA is an Arabic language magazine and that newsagents tend to group non-English magazines separately from English magazines. Mr Yasser Kamel El-Dabbagh states that the HIA magazine has been sold by subscription and through newsagents within the United Kingdom for the past six years and he states that there have been no instances of confusion. Accordingly, he denies that honest and fair use of the applicants' trade mark in relation to the goods applied for will cause confusion in the minds of the public or that the public may believe that there is any connection between the opponents and IPM.

10. That concludes my review of the evidence.

Preliminary Point

11. Shortly before the hearing, the applicants wrote to the Office, on 28 February 2000, seeking leave to file further evidence under the provisions of rule 13(11) of the Trade Mark Rules 2000. The evidence consists of a statutory declaration by Mr Benjamin George Willis, a trainee solicitor with Wedlake Bell.

12. The applicants sought leave to admit this evidence at the main hearing on 6 March 2001 and I heard submissions from both representatives on this matter as a preliminary point. Both parties appeared content for me to reserve my decision on the admissibility of the additional evidence. It was agreed that they should address me in the main proceedings on the basis that the evidence would not be admitted and in the alternative, make submissions on the basis that it would be admitted. Ms Jones did not have any instructions as to whether the opponents would wish to file evidence in reply to the applicants' additional evidence and I gave the opponents a period of one month from the date of my decision for them to consider whether they would wish to file any evidence in reply. In a letter dated 6 April 2001 they stated that

they did not intend to file any response to that evidence. Therefore, I will give my decision on the applicants' request to file further evidence.

13. The relevant provisions can be found in rule 13(11) of the Trade Mark Rules 2000. This reads:

“13(11) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.”

14. In addition, Ms Jones in her submissions made reference to the provisions of rule 68 which concerns alteration of time limits, the relevant provisions of which read:

“68-(1) The time or periods-

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2).....

(3).....

(4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.

(6).....

(7).....”

15. Mr Tritton's submissions were directed towards a discretion in rule 13(11) to admit further evidence. This in his view was a broad unfettered discretion and he noted that if leave was given, it could be on terms, for example leave could be given for the opponents to file evidence in reply. Mr Tritton took me to various factors which in his view I should take into account. These were taken from the judgment of Mr Justice Laddie in *Swiss Miss* [1996] RPC 233 at page 242. As noted by Mr Tritton, this approach was endorsed by the Vice Chancellor Sir Richard Scott in *Club Europe* [2000] RPC 329 at page 338.

16. Both these reported cases concerned the court's powers to admit further evidence on

appeal from a decision of the registrar. The issue before me is whether I should admit the further evidence in these proceedings. In Mr Tritton's view, discretion should be somewhat more in favour of permitting the admission in this scenario than on appeal; it could be said that a party seeking leave to file the further evidence on appeal has already had one opportunity to have their case determined. The factors set out in Mr Tritton's skeleton argument and listed by Mr Justice Laddie in *Swiss Miss* are as follows:

1. Whether the evidence could have been filed earlier and, if so, how much earlier.
2. If it could have been, what explanation for the late filing has been offered to explain the delay.
3. The nature of the mark.
4. The nature of the objections to it.
5. The potential significance of the new evidence.
6. Whether or not the other side will be significantly prejudiced by the admission of the evidence in a way which cannot be compensated eg by an order for costs.
7. The desirability of avoiding a multiplicity of proceedings.
8. The public interest in not admitting onto the register invalid marks.

17. Mr Tritton argued that all of the above were in his clients favour. Before considering his submissions, I should outline the content of the evidence and state that I read the evidence *de bene esse*. The statutory declaration of Mr Willis sets out certain facts concerning the existence on the market of a woman's magazine "Elle" and the fact that it is a registered trade mark in Class 16 and that the magazine has been on the market in the United Kingdom since 1985. Details of the average circulation are also provided along with an example of a March 2001 edition of the "Elle" magazine. A copy of a page from the Collins Robert French-English Dictionary is also exhibited showing that "elle" is the French word for "she".

18. In support of his argument that the evidence should be admitted, Mr Tritton submitted that the evidence could not have been filed earlier as it had only come to mind at a recent conference with Counsel. Thus, the information was clearly available at the time when the applicants' filed their evidence in chief but the connection between the opponents' magazine SHE and the magazine ELLE had only come to mind more recently. If any explanation was required for the delay then it was that the evidence had not been thought of before. The nature of the objections and the nature of the mark, the avoidance of a multiplicity of proceedings and the public interest were not relevant in this case as it was the applicants who were seeking to file the further evidence.

19. In Mr Tritton's view the potential significance of the evidence was obvious. He pointed out that the opponents appear to be seeking a monopoly in the word SHE in whatever language it appears and the evidence of Mr Willis showing that the magazine ELLE is on the

market was, in his view, plainly relevant. The evidence was axiomatic to his argument that magazines containing the same name in different languages can co-exist. As for prejudice to the other side, he noted that they had no real objection to it other than the fact that it was late. They could always be given an opportunity to file evidence in reply if they so wished and be compensated in costs.

20. Ms Jones' submissions took me to rule 68(5). In her view I should apply the test set out in rule 68(5) when considering a request to file further evidence. The time for the applicants to file their evidence in chief under rule 13(9) expired on 17 March 2000. Thus, as this request to file further evidence was made outside that time period, Ms Jones suggested that I could only extend the time period for the applicants to file evidence if I was satisfied with the explanation for the delay in requesting the extension and it appeared to me just and equitable to do so. In support of her submissions, Ms Jones referred me to the decision of the registrar's Hearing Officer, Mr Landau, in *Genius Trade Mark* [1999] RPC 741. In that case, the applicants' representatives sought an extension of time to file evidence in chief, the relevant period having expired on 4 December 1997. The application was made on 10 March 1999, one day before the main hearing in the proceedings. The registrar considered that rule 62(5) now rule 68(5) set out the two requirements identified by Ms Jones and refused the request.

21. I respectfully agree with the reasoning of the Hearing Officer in *Genius*. However, in my view the facts in this case are very different. In *Genius*, the applicants had failed to file any evidence in chief. Their request was not to file **further** evidence, they were requesting an extension of time to file their evidence in chief. In the instant proceedings, the applicants are seeking leave to file further evidence and there is, in my view, a fundamental difference. If I were to adopt Ms Jones' submissions when considering a request to file further evidence, then the provisions of rule 13(11) would be otiose. Any request to file further evidence, at any time in the proceedings, could be dealt with as a request to extend the time period for filing evidence in chief and as such, the test set out in rule 68(5) could be applied to all such requests.

22. The provisions of rule 13 set out the standard procedure for dealing with opposition proceedings before the registrar. It provides for three rounds of evidence. Rule 13(11) provides for further evidence to be filed at any time that the registrar thinks fit. I agree with Mr Tritton that the wording of rule 13(11) provides the registrar with a wide discretion to allow further evidence upon such terms as the registrar may think fit and I reject the test propounded by Ms Jones when considering the question of whether leave should be given to file evidence under rule 13(11). There is, in my view, some force in Mr Tritton's submissions that the test set out by Mr Laddie in *Swiss Miss* should be applied by the registrar. Indeed, it might appear captious if the registrar were to use a more stringent test than the court when determining whether evidence should be admitted in registry proceedings. That said, the fact that the registrar is a tribunal established by statute should not be overlooked. There are clear procedures set out by the rules that should be followed and sometimes the application of those rules will work in favour of one party or the other.

23. Having considered the submissions made to me on this point I accept that the test set out in the judgment of Mr Laddie in *Swiss Miss* provides a useful guide as to the exercise of the

registrar's discretion under rule 13(11) and I go on to apply it in determining whether in this case the evidence should be admitted.

24. Mr Tritton states that the evidence could not have been filed earlier because the existence of the Elle magazine and its relevance to these proceedings only came to mind during a case conference with Counsel. That may be so, and it may explain the delay, but the fact that the request was made only three working days before the main hearing must, in my view, be a factor that I should take into account when considering the applicants' request. It seems to me that this goes to the sixth point outlined by Mr Laddie, that of prejudice to the other side. Whilst it may be that the opponents could be compensated by an award of costs in order to deal with the issues raised by this evidence, there is a wider issue of prejudice to the opponents. These proceedings have been ongoing for over three years. The period for the applicants to file their evidence expired nearly twelve months ago. In my view, it is not unreasonable that the opponents should have prepared for the hearing set down for the 6 March 2001 on the basis of the evidence that was on file. There is a legitimate expectation that the arguments and issues would be focussed on the evidence that has been filed in the proceedings. Therefore, the fact that the applicants sought leave to admit the evidence just three working days before the main hearing is a factor that I should take into account when considering the question of leave to file further evidence.

25. I also consider the potential significance of the new evidence. Mr Tritton emphasised the importance of the evidence to his clients' case. I have to question his submissions. The evidence shows that there is a magazine on the market with the name ELLE, the word she in French. However, it does not give me any information as to how that magazine came to be on the market and how it came to co-exist with the opponents' trade mark. The mere fact that the magazine is on sale does not, of itself, assist me in reaching a decision. In my view, the evidence is therefore of little relevance to the question that is before me. As such, it could be argued that I should allow the evidence to be admitted as it will not affect my decision in this matter. However, in my view, if I were to allow the evidence to be admitted on that basis it could encourage bad practice and late applications to admit further evidence. The registrar is a tribunal that operates primarily on the basis of written evidence. It is not unreasonable that a party preparing for a hearing before the registrar should expect that the issue will be decided on the basis of the evidence filed in those proceedings. Whilst rule 13(11) provides for the admission of further evidence, there is in my view, an onus on a party seeking to bring forward such further evidence to do so at the earliest possible time. It may be that the evidence sought to be submitted by applicants had only just come to mind, however, if an application is made immediately before the date set for the main hearing then the timing of the request must, in my view, be a factor that the registrar takes into account when considering whether leave should be granted. That is not to say that a late request could never be granted, but it seems to me that it should be a factor that I should take into account.

26. Taking all the above factors into account I have decided to refuse leave for the applicants to file the statutory declaration of Mr Willis. I will deal with the issue of costs at the end of my decision.

Decision

27. As noted above, the opponents' sole ground of opposition was under section 5(2) of the Trade Marks Act 1994. This reads:

“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.”

28. The term ‘earlier trade mark’ is itself defined in section 6, this states

- “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,

29. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik 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:-

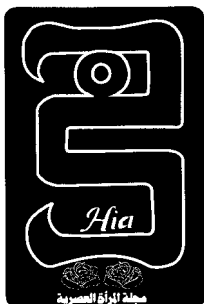
- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably 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 Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, 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* page 224;

- (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* page 224;
- (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* page 7, 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* page 8, 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* page 224;
- (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* page 732, 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* page 9 paragraph 29.

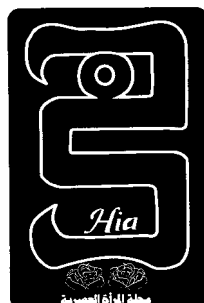
30. The opponents' statement of grounds refers to the trade mark SHE, registration number 721023. This is an earlier trade mark within the provisions of section 6. For ease of reference the opponents' and the applicants' trade marks are reproduced below.

Applicants' trade mark



Opponents' trade mark

SHE



Class 16

Printed publications, newspapers, magazines
and periodicals, photographs and printers' type

Class 16

Printed publications

31. It was common ground between the parties that the goods in questions are identical or very similar. Therefore, the matter falls to be determined on a comparison of the trade marks. As set out above, this is a global test. Where the earlier trade mark is highly distinctive either per se or because of the use that has been made of it, there is a greater likelihood of confusion. The opponents' evidence claims use from 1953. The turnover figures, advertising expenditure and readership figures all show that it has performed consistently in the market place over a prolonged period. It did not seem to me that Mr Tritton questioned the opponents' evidence of use, from which I find that the opponents' trade mark SHE does enjoy a reputation with the public. In reaching a view of the matter of confusion I also take into account the guidance that a lesser degree of similarity between the trade marks may be off set by a greater degree of similarity, or identicallity between the goods.

32. In considering the question of a likelihood of confusion I must judge the matter through the eyes of the average consumer of the products in question. The average consumer of the opponents' magazine, SHE, is said to be a woman aged 25-44. The average consumer of the applicants' product will be a woman who can speak Arabic. Mr Tritton suggested that the purchase of a magazine is primarily a visual act. Customers will look for their chosen publication on the shelves. My own experience tells me that this is often the case, although customers may also make an oral request for the magazine if they cannot find it on the shelf in the shop or if they wish to place a subscription with the newsagent.

33. Further, this case is unusual in that both parties agreed that there is no likelihood of confusion amongst anyone who cannot speak Arabic. Ms Jones was right to make that concession. To anyone who cannot speak Arabic, the applicants' trade mark is completely meaningless and abstract. Equally, there would be no possibility of confusion amongst those who can only understand Arabic. Therefore, both counsel agreed that the only possibility of confusion occurring would be amongst bilingual Arabic/English speakers. With that in mind, I consider the visual, aural and conceptual similarity of the two trade marks.

34. Clearly, the trade marks are visually very different, the applicants' mark consists of the word HIA, a device, a device of two roses and arabic script. The opponents' trade mark is the English word SHE, the subjective pronoun for the female third person singular. There was a disagreement during the hearing as to whether the large character shown in the applicants' trade mark is the arabic character for HIA. Ms Jones made submissions based on the fact that it was, Mr Tritton pointed out that there was nothing in the evidence to indicate that the character had any meaning. Mr Yasser Kamel El-Dabbagh in his statutory declaration at paragraph 13.1 states:

“It is clear from these representations [Exhibit YKED2 & 3] that the Hia and Device mark in fact consists of a prominent abstract Device in combination with the word Hia, two stylised rose Devices, some Arabic script and all of these are represented in a rectangular frame with rounded corners.”

35. Mr Tritton is correct in his submission, but I do not think that anything turns on this point. If “the prominent abstract device” is the arabic character for HIA then it would be seen as such by those who can read arabic, if it is not then it is an abstract element but the word HIA would still attract the attention of the purchaser as a reference point. It seemed to me that both parties also agree that advertising strap lines are common in the relevant trade. Thus, the phrase in the opponents’ trade mark which translates as “The magazine for the modern woman” would probably be seen by purchasers as such a strap line. The device of two roses is, in my view a small element of the mark when viewed against the trade mark as a whole. Thus whilst not discounting the various elements of the applicants’ trade mark which add to the visual differences between the two trade marks, even on a comparison of HIA and SHE, I find that there are clear visual differences between the two trade marks.

36. Aurally the two trade marks are also very different. The applicants’ trade mark would I believe be referred to as HIA, the opponents’ as SHE. Ms Jones submitted that confusion may occur if an Arabic speaker were to request the opponents’ trade mark orally. The shop keeper, may be confused if he too was an Arabic speaker. Ms Jones suggested that the purchaser might request the magazine SHE or HIA interchangeably. Such confusion might also occur if an Arabic speaker was recommending the magazine to a friend. I am uncertain as to the likelihood of Ms Jones’ scenario occurring. Further, I would have thought that an Arabic speaker would use the correct title of the magazine that they were looking to purchase, not a translation of that word. As Mr Tritton pointed out, the title of the applicants’ magazine is SHE and that in fulfilling that function the word SHE is fulfilling the function of a trade mark. It is not just an English pronoun. Equally, the applicants’ trade mark contains the word HIA, again fulfilling the function of a trade mark. If they are identified as such by the public then the public will, in general, use the correct name for the respective magazines. Thus, it seems to me that they would use HIA or SHE to specify the magazine that they wished to purchase or recommended.

37. Ms Jones referred me to the ECJ case *Deutsche Renault AG v. Audi AG* (Case C-317/91) [1995] FSR 738. However, I do not find this case to be of any assistance. It concerned the trade marks Quattro and Quadra. The relevant provisions in question were Articles 30 and 36 of the EC Treaty and also the German Trade Mark Law prior to the Trade Marks Directive. Further it would seem to me that the two trade marks in question have greater visual, aural and conceptual similarities than those before me.

38. Ms Jones’ strongest case fell under conceptual similarity. Both HIA and SHE are references to the subjective pronoun for the female third person singular. As such, there is conceptual similarity between the two trade marks. However, as noted above, for this conceptual similarity to arise, the members of the public must be able to speak both Arabic and English. Further, it seems to me that if an Arabic speaker was looking at the applicants’ magazine she would see the word HIA. She would not see the word SHE. It would require her to translate the word HIA into English before any conceptual link to the opponents’ trade mark could be made. This presupposes that a native Arabic speaker would translate words that he or she saw into English. I would have thought that those who speak a foreign language as a mother tongue do not routinely go around translating every word they see or hear into English. They think and speak in their native tongue. As an English speaker I see the word HIA and because I am informed of the fact that it means SHE, I make the connection between

the opponents' and applicants' trade mark that Ms Jones seeks to make. Someone who speaks English as their mother tongue and who understands Arabic may also make the connection that Ms Jones seeks to imply. However, in my view it would be unlikely that a native Arabic speaker would, as a matter of course, make the connection between HIA and SHE and then make a connection between the opponents' and the applicants' trade marks. This again, would ignore the fact that the two words are fulfilling a function of a trade mark and not as dictionary words.

39. In taking into account the visual, aural and conceptual similarities between the two trade marks I have taken into account the fact that the selection of the goods in question, magazines, is primarily a visual act but oral use may also be a factor. Mr Tritton also impressed on me the advice given by Wadlow in "The Law of Passing Off" concerning titles of newspapers and periodicals. At page 416, paragraph 6.42 it states:

"Two other factors deserve mention as helping to explain why so few cases are successful. One is that readers tend to show great loyalty to their preferred newspaper or magazine. In contrast to many other fields of business, they are likely to take whatever trouble is necessary to buy that in preference to others which might be very similar in name or get-up."

40. Mr Tritton referred to the fact that the ECJ in *Sabel* listed the factors as visual, aural and conceptual in that order and that conceptual similarity was very much the third and least telling of the factors. The factors are listed in that order but I note that the guidance given by the court shows that in certain cases conceptual similarity may of itself be sufficient to find the necessary likelihood of confusion; *Sabel* at page 224.

41. Conceptual similarity is the high point of Ms Jones argument. As I have stated above, I find that there is no visual or aural similarity between the two trade marks. No figures have been provided by the opponents as to the number of Arab speakers in the United Kingdom, or the number of such persons who are bilingual Arabic/English speakers. Ms Jones referred me to the guidance given in Chapter 6 of the Trade Mark Registry Work which reads as follows:

"4.13.7 Languages of ethnic minorities

Some of these languages are spoken by sizable minorities of UK residents. They include: Chinese, Greek, Urdu, Gujarati, Arabic."

The manual advises:

"4.13.8 Goods- in original script or transliteration

Consider whether the goods are likely to be destined for a particular ethnic market. This is likely to apply particularly to goods such as food and clothing. In such cases treat in the same way as the French, German etc. Object to words which, in English, would be open to objection under section 3(1)(c).

Where goods are unlikely to be aimed at the ethnic market, no objection."

42. This entry indicates that a sizable minority of UK residents may speak Arabic. However, this entry concerns objections under section 3 of the Act to the use of descriptive words in foreign languages as trade marks. This does not assist me in determining the number of Arabic/English speakers who might be able to make the necessary conceptual link between the applicants' and opponents' trade marks. As indicated earlier, Ms Jones conceded that for any confusion to occur the purchaser must be able to understand both languages, she further conceded that they must also be aware of the opponents' use of SHE for any conceptual link to be made. Mr Tritton suggested that this was even more fanciful and that there was no evidence to that effect. I agree that no evidence on this issue has been filed. Ms Jones also conceded that this was a case where the confusion would arise not from direct confusion but from an association that would lead the public to wrongly believe that the magazines came from the same or economically linked undertakings. In her view the applicants' product might be seen as the arabic language version of the opponents' magazine or that it was printed under licence.

43. This has not been an easy case to determine and there are a large number of factors that I have taken into account when reaching my decision. However, the onus in opposition proceedings is on the opponent to show that the necessary likelihood of confusion exists and in this case they have failed to discharge that onus. Whilst I do not discount altogether the chance that the conceptual similarity between the two trade marks may lead a very small number of persons to make a connection between the two trade marks such that they may believe that they come from the same or economically linked undertakings, the numbers would not be such that a finding that the necessary likelihood of confusion required by section 5(2)(b) of the Trade Mark Act 1994 exists. It follows that I find that the opponents' ground of objection under section 5(2)(b) of the Act is not made out and their opposition falls to be dismissed.

44. In the main proceedings the applicants have been successful and are entitled to a contribution towards their costs. On the preliminary point concerning the admission of the applicants' further evidence, the opponents were successful in resisting the applicants' request. On the preliminary point I award the opponents' £200 as a contribution towards their cost of the hearing. The applicants' award in the main proceedings will be reduced by £200. Therefore, I order that the opponents pay the applicants the sum of £835 as a contribution towards their costs. 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 19 day of June 2001

**S ROWAN
For the Registrar
the Comptroller General**