

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2147048
BY EMAP RADIO LIMITED TO REGISTER A MARK
IN CLASSES 35, 38 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50387
BY RADIO MALDWYN**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2147048

by EMAP Radio Limited to register a mark in Classes 35, 38 and 41

and

IN THE MATTER OF Opposition thereto under

No 50387 by RADIO MALDWYN

DECISION

1. On 3 October 1997 EMAP Radio Limited of London applied to register the mark MAGIC for goods and services in classes 9, 35, 38 and 41. Following the examination process Class 9 was deleted from the application and the service classes were amended. The application was published for the following services on the basis of distinctiveness acquired through use :

- | | |
|----------|---|
| Class 35 | Advertising, marketing and promotional services, none being for the arranging and conducting of trade show exhibitions in the field of clothing or accessories related to clothing. |
| Class 38 | Radio broadcasting services; radio programme broadcasting and production services. |
| Class 41 | Radio entertainment services; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; organisation of competitions and awards; arranging and conducting competitions; arranging and conducting award ceremonies; organisation of events for cultural , entertaining and sporting purposes; organisation of competitions. |

2. Following publication of the mark, an Amendment After Publication was published to include “; none relating to magic” at the end of the Class 41 specification.

3. On 11 November 1999 RADIO MALDWYN of Newtown Powys filed notice of opposition to this application in the following terms

- "1. The Opponents have since 1993 run a local radio station under the name of "Radio Maldwyn the Magic 756 AM", broadcasting to Mid Wales and the Borders.

2. Further, Radio Maldwyn Limited is part-owned by Murfin Music International Limited, who also run a radio station called Classic Gold Radio broadcasting in Herefordshire and Worcester and up to Birmingham. On the 13th March 1998 a company called Magic AM Limited was registered by Murfin Music International Limited with a view to running Classic Gold Radio under that name.
- 2.(sic) In so far as the Applicant intends to use the word "Magic" in connection with broadcasting services which may cross the areas already served by the Opponents' radio services, the Opponents' proposed mark is likely to deceive or cause confusion. Radio Maldwyn and Classic Gold Radio are commercial radio stations, and are advertised by a variety of advertising marketing and promotional means. Both radio stations provide music, news, talk shows and phone-ins, local "what's on" features and many other special features, all announced with the words "The Magic AM". The word "Magic" has become distinctive of the Opponents' services.
3. Further, the mark applied for consists exclusively of the laudatory word MAGIC, which is devoid of distinctive character and, put together with any other name to designate the services provided, would serve in trade to designate the nature of the services, for example, high quality radio broadcasting.
4. The mark applied for would not, if registration were granted, be distinctive of the Applicant's services."

4. The applicants filed a counterstatement denying the above grounds. Both parties have asked for an award of costs in their favour.

5. Both sides filed evidence in these proceedings and the matter came to be heard on 18 September 2001. The opponents were represented by Mr T Hinchliffe of Counsel instructed by Taylor Joynson Garrett and the applicants by Mr J Turner of Counsel instructed by Urquhart-Dykes & Lord.

Opponents' evidence

6. This consists of a statutory declaration dated 27 April 2000 from John Edwin Julius Murfin who is the Managing Director of Radio Maldwyn Limited.

7. Mr Murfin states that the opponents run a local radio station under the name of "Radio Maldwyn the Magic 756 AM", which has been broadcasting to mid Wales and the Borders since 1993. The opponents also run another station called "Classic Gold Radio The Magic AM" which broadcasts in Hereford and Worcester and up to Birmingham. This station has been operating for 16 months (Mr Murfin's declaration is dated 27 April 2000).

8. Exhibit JEJM1 consists of a copy of the Certificate of Incorporation of the company called Magic AM Limited dated 13th March 1998.

9. Mr Murfin claims that the word Magic has been incorporated in the phrase “the Magic 756 AM” in connection with Radio Maldwyn since 1991. Exhibit JEJM2 contains specimen advertisements, advertising rates as well as an extract from a 1995 edition of Radio Magazine.

10. The approximate advertising turnover of the opponents since 1992 is as follows :

1992	£120,000
1993	£110,000
1994	£110,000
1995	£108,000
1996	£110,000
1997	£108,000
1998	£110,000
1999	112,000

11. Exhibit JEJM3 provides a list of customers who have advertised through the opponent.

Applicants' evidence

12. This consists of two statutory declarations. The first is dated 22 November 2000 and comes from Christine Lund-Beck who is a trade mark attorney and partner with Urquhart-Dykes & Lord. She says that the facts given are taken from knowledge provided by the applicant or from her own personal knowledge. The second is dated 11 December 2000 and is by Timothy Ralph Schoonmaker, Chief Executive of EMAP Performance Limited.

13. Turning to Mr Schoonmaker’s declaration first, he states that the mark was first used in the UK in 1990 and has been used continuously since that date in relation to all activities associated with a radio station. Exhibit TS1 is a collection of material showing the trade mark in use.

14. The turnover figures for the mark are stated to be as follows :

1990	£200,000
1991	£250,000
1992	£297,000
1993	480,000
1994	£765,000
1995	£1,010,000
1996	£1,208,000
1997	£5,128,000

15. Advertising expenditure for the period 1990 - 1997 is said to have been in the region of £1.95 million.

16. Mr Schoonmaker claims that the mark is well known and has a reputation in the trade and is synonymous with the goods and services offered by the applicant. Further he states that the mark has become distinctive for the purposes of registration.

17. I now turn to Ms Lund-Beck's declaration. She makes similar claims to Mr Schoonmaker and adds that the applicants' reputation has been further enhanced by their activities in relation to organising presenting and promoting live events, together with printed matter.

18. Ms Lund-Beck then refers to Mr Murfin's declaration and exhibits. She states that it is unclear from the evidence the date on which the opponents allege that they started using the mark. In the Statement of Grounds the claim was 1993, whereas in the statutory declaration 1991 was claimed. In either event both dates are after the applicants first use.

19. Ms Lund-Beck refers to the Exhibit JEJM1 and the registration of the opponents company name. She states that the registration of a company name does not confer any trade mark rights, and further the registration took place some considerable time after the applicants' first use.

20. With regard to the turnover figures quoted in the opponents declaration Ms Lund-Beck suggests that these were generated after the first use by the applicants and are clearly insufficient to support any claim of the opponents that their mark is well known or distinctive. Converse to the opponents' assertion that confusion would arise with the applicants mark, Ms Lund-Beck claims that the reverse is the case, in that it is the opponents use of the mark which is likely to lead to confusion.

21. Finally Ms Lund-Beck refers to the registrability of the mark in question and states that the Registry accepted the mark on the basis of having become distinctive through use and it is accordingly registrable.

Opponents' evidence in reply

22. The opponents have filed a statutory declaration from John Edwin Julius Murfin dated 30 March 2001.

23. Mr Murfin disputes the applicants claim that they have used the mark for a longer period than he has and states that he has used the word in "idents" (jingles used to identify radio stations on air) since 1982. He exhibits at JM1 a copy of the information on a box of tapes of station "idents" and a list of the jingles on the tapes and at JM2 copies of two scores written in approximately 1982 incorporating various themes on the word MAGIC." Further he disputes the applicants'

claim that they had some sort of exclusive use of the word "Magic" since 1990 . He claims that the only station using the Magic name was the Leeds station, which the applicants purchased in 1994. Magic FM London only started in 1998.

24. Mr Murfin also supplies a complete list of radio stations in the UK which has been downloaded from the internet, which shows a number of stations using Magic (Exhibit JM3). The Manchester station referred to in Mr Schoonmaker's declaration is not listed as such, but rather as Piccadilly Radio 1152. He suggests that this means that the applicants have only recently started to use the word Magic in connection with the station.

25. Finally Mr Murfin states that none of his stations use Magic as their first name, but merely as a descriptive "hype" for the stations.

26. That completes my review of the evidence.

27. The opponents' statement of grounds made no reference to particular Sections of the Act. Their objections were clarified at the hearing as being under Section 3(1)(b) and (c) and Section 5(4)(a). It was conceded that the Section 3(1)(b) objection largely duplicated that under subparagraph (c). No material distinction need be drawn for the purposes of what follows. So far as is relevant Section 3(1) reads as follows:

3.-(1) The following shall not be registered -

- (a)
- (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 of rendering of services, or other characteristics of goods or services,
- (d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

28. The starting point for Mr Hinchliffe's submissions was the following practice set out in Chapter 6 of the Registry's Work Manual:-

" MAGIC

Colloquially, means "brilliant", "excellent", "super".

- MAGIC alone or plus goods - object prima facie under Section 3(1)(b) and (c)
- MAGIC plus distinctive element e.g. MAGIC DRAGON for bicycles - accept

Following another word, even a descriptive word, it may be acceptable because it then has less of a laudatory connotation. As a guide, the following have been accepted in Part B under the 1938 Act:

MIRROR MAGIC for mirrors, etc.
 ANIMAL MAGIC for printed matter
 BEDROOM MAGIC for bedroom furniture
 MILK MAGIC for milk feeding apparatus "

29. In his submission the Registry's examiner had correctly followed that guidance and taken an objection to MAGIC in the prima facie case with the result that the application only subsequently proceeded to publication on the basis of evidence of distinctiveness acquired through use. That is to say under the terms of the proviso to Section 3(1). The practice set out above, is, of course, intended as guidance to the Registry's examiners and is not necessarily determinative of the outcome of a particular application. In any case once a challenge has been raised in inter partes opposition or invalidity proceedings additional and/or different considerations may apply depending on what evidence or submissions are brought forward by an opponent or applicant for invalidity. I am not in these circumstances bound by the Registry guidance and must consider the matter afresh on the basis of whatever material is before me. I propose to start with a consideration of the merits of the word MAGIC in relation to the services concerned as if it were an unused mark. My attention has been drawn to *British Sugar plc v James Robertson & Sons Ltd*, 1996 RPC 281 (the TREAT case). Jacob J had this to say in relation to Section 3(1)(b) and the meaning of "devoid of distinctive character"

"Next, is "Treat" within section 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 inherently from the old Act but the idea is much the same) devoid of an distinctive character. I also think "Treat" falls within section 3(1)(c) because it is a trade mark which consists exclusively of a sign or indication which may serve in trade to perform a number of the purposes there specified, particularly, to designate the kind, quality and intended purpose of the product. The word probably also falls within section 3(1)(d): it is a sign which has become customary in the current language. Lots of

people use "Treat" in advertisements and on goods and I have some examples in evidence."

30. Mr Turner submitted that for most people MAGIC would bring to mind tricks or conjuring and that any laudatory signification was not the principal meaning conveyed by the word. Nevertheless it would not necessarily avail an applicant if one meaning of his mark made it unobjectionable in registrability terms if another meaning of the word was held to be descriptive/non-distinctive.

31. The Registry practice guidance suggests that MAGIC is a colloquialism for "brilliant", "excellent" or "super". That may be so (no dictionary or other material has been placed before me) but that does not mean that it must necessarily be treated as if it was a direct synonym for such words or substitutable for such words in any given context. In its laudatory sense it is at most informal usage. Whether it is current or accepted usage these days is more debatable. As with many such usages words drift into and out of fashion. I suggested at the hearing that a word such as 'wizard' might conceivably be said to have laudatory connotations but probably only for a certain age group of people. I doubt that it is used that way now any more than 'groovy', a word firmly locked in the 1960s. In approaching words of this kind one should also not lose sight of the goods or services. Colloquialisms may, for instance, find more ready usage in relation to consumer fashion items or childrens' toys say than heavy machinery or industrial chemicals.

32. Where does MAGIC stand in relation to the above considerations and particularly the services at issue here? I do not think it would be right to describe it as a completely outmoded or dated usage. It is not in the 'wizard' or 'groovy' category to take my above examples. Not surprisingly Mr Hinchliffe was inclined to the view that the objection to it was a fairly strong one. But I do not think that is the case either. That is the problem with comparing it to words such as 'excellent' and 'super'. It is by no means as straightforwardly laudatory as words of that kind. On my appraisal it is a word that is fairly close to the borderline of acceptability as an unused mark for services of the kind at issue here. Certainly it can be used in a laudatory context - 'the magic of FM radio' or 'an absolutely magic show'. But as a standalone word it is less easy to see MAGIC being seen as laudatory rather than trade mark usage in relation to the services at issue. On the other hand I cannot discount the possibility. In fact the opponents' own use provides some support for this and is illustrative of the type of use which might cast doubt on the ability of the word to function as a trade mark by nature as distinct from nurture to use Mr Hobbs' expression. Their use is 'Radio Maldwyn - the Magic 756 AM'. I am left in considerable doubt as to whether the average person encountering usage of that kind would understand that MAGIC is, or contributes to, a sign denoting trade origin as distinct from being purely laudatory use. The point is, of course, particularly true when other more obviously origin denoting material is present (in this case Radio Maldwyn). I have not found this an easy matter to decide but, bearing in mind particularly in the context of radio and other media/entertainment services that colloquialisms may well be used, I have come to the view that MAGIC is open to objection as an unused mark.

33. That is not the end of the story because the applicants say that they have used their mark and are entitled to benefit from the effect of the proviso to Section 3(1). Before coming on to the use that underpins their claim I should touch briefly on a point made by Mr Turner which is that there was a significant shift in emphasis in the opponents' case which only became evident at the hearing itself (or certainly after his skeleton argument was prepared). The opponents' statement of grounds appeared to make their own common law rights the centrepiece of the action with the Section 3 objection being largely restricted to an assertion as to the laudatory nature of the word MAGIC coupled with wording drawn from the provisions of the Act itself. That would perhaps have mattered rather less if the subsequent evidence rounds had drawn out the basis on which the bare claim was being made. In the event the opponents' evidence in chief concentrates overwhelmingly on their competing claim/rights and hardly at all on the Section 3 objection. In fact it is largely restricted to the comment in paragraph 9 of Mr Murfin's evidence in chief that "the applicants are seeking to register a word which is laudatory, and not distinctive of the applicants' services." There is little more to substantiate the claim in the reply evidence. In fairness to Mr Hinchliffe he was appointed at an extremely late stage in these proceedings (the day before the hearing I believe) and was entitled to present what he saw as the opponents' strongest case. However, whilst the applicants cannot say they were unaware of the ground of attack it is of some concern that a ground which had not been pursued with any vigour up to this point should become the main focus of attention at the hearing. It may also have conditioned the applicants' approach to the issues they considered needed to be addressed in their evidence.

34. I turn now to the applicants' position under the proviso to Section 3(1). Mr Hinchliffe drew my attention to two authorities. Firstly Jacob J's further comments in the TREAT case

"The proviso really means "has the mark acquired a sufficiently distinctive character that the mark has really become a trade mark." In the case of common or apt descriptive or laudatory words compelling evidence is needed to establish this. And in particular mere evidence of extensive use is unlikely to be enough on its own. Of course the power of advertising may be able to turn almost anything (save a pure description) into a trade mark, but it must be shown in a case of this sort that the mark has really become accepted by a substantial majority of persons as a trade mark - is or is almost a household word."

and secondly the following passage from *Windsurfing Chiemsee v Attenberger* 1999 ETMR 585

"49. In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.

50. In that connection, regard must be had in particular to the specific nature of the geographical name in question. Indeed, where a geographical name is very well known, it can acquire distinctive character under Article 3(3) of the Directive only

if there has been long-standing and intensive use of the mark by the undertaking applying for registration. *A fortiori*, where a name is already familiar as an indication of geographical origin in relation to a certain category of goods, an undertaking applying for registration of the name in respect of goods in that category must show that the use of the mark - both long-standing and intensive - is particularly well established.

51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations."

35. Mr Hinchliffe considered that the hurdle the applicants' mark had to overcome (as a laudatory word) was a high one and that their evidence did not get them over that hurdle. Mr Turner, for the applicants, submitted that, even if I was not with him on the prima facie case, MAGIC was the sort of mark that can relatively easily achieve the necessary distinctive character through use because the objection to it was not at all strong.

36. I take the view that in considering the application of the proviso to Section 3(1) I must have regard to the nature and strength of the objection to the mark. The evidential burden involved in satisfying the tribunal that a near irredeemably bad mark has nevertheless acquired a distinctive character through use must be proportionately greater than the burden faced in the case of a mark whose intrinsic qualities only narrowly fail to qualify it for prima facie acceptance. It will be apparent from my above analysis that I regard MAGIC as being towards the bottom of that scale.

37. The applicants' evidence in support of their case has been recorded above. They claim use since 1990 with significantly increased turnover over the intervening years. It seems that much if not all of the early use was in or around the Leeds area (depending on reception areas) but that various other MAGIC stations have been started since 1990. The applicants are actually none too specific on any of this but this much emerges from Mr Murfin's declaration on behalf of the opponents (not disputed by the applicants themselves). I find myself in agreement with some of Mr Hinchliffe's criticisms of the applicants' evidence including particularly the supporting exhibit to Mr Schoonmaker's declaration. A number of the examples of the trade mark in use are after the material date and others do not appear to be dated. I am, however, satisfied that the usage shown would be taken as an indication of origin rather than purely laudatory use. I also bear in mind Mr Turner's submission that the nature of broadcasting is that it is in itself a powerful self-promotional tool. Rather like the launch of a new newspaper it is likely to quickly generate awareness albeit that in the case of a local station that awareness is also likely to be local in nature. Even so the applicants' claims would have benefited from further substantiation. But I do not think the opponents seriously challenge the claim that the applicants' broadcast under the mark

MAGIC. Radio broadcasting is by its nature a very public activity which can easily be verified or challenged as the case may be. In all the circumstances I do not think the applicants have made out an irrefutably persuasive case but having regard to all the circumstances and the borderline nature of the objection I am satisfied that they are entitled to claim the benefit of the proviso to Section 3(1).

38. However the nature of that use requires some further consideration, Mr Hinchliffe noted that both Mr Schoonmaker and Ms Lund-Beck make quite extensive claims as to what merits protection covering all the activities associated with a radio station, radio broadcasting, radio entertainment services, advertising services, production and staging of competitions, live events, concerts etc. I am prepared to accept that the applicants have established their position in relation to their core activities. I regard these as being the Class 38 services and radio entertainment services in Class 41. Mr Hinchliffe, rightly in my view, suggested that there was no evidence to support a claim to the remainder of the services applied for, that is to say the whole of Class 35 and the whole of Class 41 save for radio entertainment services. I agree with that analysis and will deal with the consequences later in this decision.

39. Turning to Section 5(4)(a) the conventional test for determining whether the opponents have succeeded under this section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *WILD CHILD Trade Mark* 1998 RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' 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 applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents, and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

40. There are two strands to the opponents' case. The first is the activities of Mr Murfin's company's local radio station, Radio Maldwyn and the second the use of MAGIC in relation to "idents" or radio station jingles. I can deal fairly briefly with the latter because the opponents' position seems to me to be quite hopeless. Mr Murfin was a director of a company in Dallas Texas which produced jingles. An example of the cover of a box of tapes/jingles produced for a Belgian radio station is at JM1. Two musical scores written in approximately 1982 and sold to a Belfast radio station in 1984 are at JM2. The scores are said to have been sent to every radio station in the UK for marketing purposes. As Mr Turner pointed out it is most unlikely that they would all have wanted the same jingle. I take it, therefore, the scores were sent simply to demonstrate Mr Murfin's general capabilities. The supporting exhibit is unsatisfactory and

contains unexplained pencil overwrites. In addition to musical notations there are references to 'The Magic of Boston' (and other references suggesting that it is Boston USA that is being referred to), 'the Magic of Christmas' and 'the Magic of Autumn'. None of this suggests use of the word MAGIC as an indication of origin. Nor does it necessarily appear to relate to the UK. So far as Mr Murfin's involvement is concerned it shows that he was at that time composing jingles rather than supporting a claim that he was running a radio station.

41. Potentially of rather greater relevance is the fact that the opponents have been running a local radio station in Mid Wales and the Borders. The starting date is variously put at 1991 or 1992 (Mr Murfin's first declaration) or 1993 (the opponents' statement of grounds). Later still and after the relevant date a company was incorporated called Magic AM Limited (Exhibit JEJM1) but this is in itself not directly relevant to the trade mark proceedings. Mr Murfin gives turnover figures for the years since 1992 which consistently run at just in excess of £100,000 per annum. Exhibit JEJM2 shows use of the mark. I am not clear as to the date of the material though the first item has a manuscript annotation suggesting it may be from 1995. Two of the five photocopied pages appear to be advertisements for the station which either refer to RADIO MALDWYN or RADIO MALDWYN THE MAGIC 756 AM. The remaining three items are, I think, advice sheets on the benefits of advertising with the station and how to go about putting together an advertisement along with information on costs and areas of coverage. I take it that this material is directed towards potential advertisers. It might either be taken as an advertising service and/or a radio broadcasting service. The strong impression left by this material is that the distinguishing feature in each case is Radio Maldwyn. The words 'The Magic 756 AM' appear beneath the words 'Radio Maldwyn'. The latter words and '756 AM' are generally given greater prominence than the words 'The Magic'. There is no evidence before me to say what the public (listeners, advertisers and others) make of the reference to MAGIC. Where a strong primary indicator of origin such as Radio Maldwyn is present it is more likely that the public would consider the use of 'The Magic 756 AM' as being merely a laudatory strap line. Mr Murfin confirms what I would have expected to be the case when he says:

"None of my radio stations use the word "Magic" as their fist name - it is merely part of the descriptive "hype" of the stations, but that is the way such a word is generally used in promoting any product."

42. The opponents have, therefore, failed to establish that they have any goodwill in MAGIC or even a composite mark containing that word. Their case under Section 5(4)(a) is, therefore, bound to fail. It follows that I do not need to address Mr Hinchliffe's supplementary argument which dealt with the consequences in law if I were to find that each side had an independent and localised goodwill in their respective areas of operation at the material date.

43. The opposition has been partially successful in relation to Section 3. The application will be allowed to proceed to registration if, within 28 days of the end of the appeal period, the applicants file a form TM21 restricting their specification as follows:

Class 38 - radio broadcasting services; radio programme broadcasting and production services

Class 41 - radio entertainment services; none relating to magic

44. If they do not file a Form TM21 restricting their application in this manner the application will be refused in its entirety.

45. Both parties have achieved a measure of success. In all the circumstances I do not propose to make any award of costs.

Dated this 9th day of October 2001

**M REYNOLDS
For the Registrar
the Comptroller-General**