

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2198199  
BY ASIA TV LIMITED TO REGISTER A  
MARK IN CLASSES 16 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
No 50368 BY HACHETTE FILIPACCHI PRESSE**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2198199  
by Asia TV Limited to register a mark in  
Classes 16 and 41**

**and**

**IN THE MATTER OF Opposition thereto under  
No 50368 by Hachette Filipacchi Presse**

**DECISION**

1. On 22 May 1999 Asia TV Limited applied to register the following mark



for the following specification of goods and services

**Class 16**

Magazine and printed matter all relating to Asian lifestyle and fashion

**Class 41**

Publishing of magazines relating to Asian lifestyle and fashion.

2. The application is numbered 2198199.

3. On 3 November 1999 Hachette Filipacchi Presse filed notice of opposition to this application. They are the proprietors of the following earlier trade marks:

No	Mark	Class	Specification
1418364	PREMIERE	16	Magazines, all relating to cinema and film; all included in Class 16
2008672		41	Publishing of printed matter, including magazines and periodicals, relating to cinema and film

**PREMIERE**

4. The opponents say they have made substantial use of these earlier trade marks in the UK. Arising from this they raise objections based on Section 5(2)(b), 5(3) and 5(4)(a) of the Act.

5. The applicants filed a counterstatement making a number of observations on their own use (after the material date) and that of the opponents. They refer also to pending Court proceedings between the parties in what I take to be another jurisdiction. They deny the claims against them. The opponents have asked for an award of costs in their favour.

6. Only the opponents filed evidence. The parties initially requested a hearing but subsequently agreed that the hearing date could be vacated and a decision taken from the papers on the basis of the papers on file and written submissions. The latter have been filed on the applicants' behalf by Mr Sunil Rohra under cover of a letter dated 29 November 2001 and on the opponents' behalf by Mr M Bilewycz under cover of his letter of 30 November 2001. I bear these submissions in mind. At the further request of the parties the issuing of this decision has been delayed to allow settlement negotiations to continue. A number of extensions of time have been allowed for this purpose. By letter dated 22 March 2002, I allowed a short final period to conclude negotiations and at the same time indicated that the matter needed to be brought to a conclusion. The parties were advised that a decision would issue during the course of the week beginning 8 April 2002 in the absence of a concluded agreement by that time.

### **Opponents' evidence**

7. The opponents filed evidence in the form of a statutory declaration by Fabienne Sultan, their Industrial Property Vice Manager.

8. Ms Sultan says that her company commenced selling the French edition of the magazine PREMIERE in the United Kingdom in 1977. The American edition of her company's PREMIERE magazine has also been sold in the United Kingdom since October 1992, and the British edition of the magazine PREMIERE commenced sales in September of 1992.

9. Some of the subsequent evidence deals with worldwide sales or is otherwise not clearly identified as activity directed towards the UK market. Insofar as it is, the position is that sales of the French edition of the magazine have been:

<b>YEAR</b>	<b>VALUE - FFr</b>
1991	38,000 (approx)
1992	40,000 (approx)
1993	111,323 gross
1994	44,489 gross
1995	56,855 gross
1996	78,916 gross
1997	101,077 gross
1998	59,427 gross
1999	98,723 gross

10. The United States edition of the PREMIERE magazine has also been sold in the United Kingdom, with 11,162 copies sold in 1994, 11,108 sold in 1995, 10,714 in 1996, 9,377 in 1997, and 13,642 in 1998.

11. A selection of magazines (or copies of front covers) produced and sold in the UK for the years 1994 to 1998 along with certain other material relating to quizzes and entertainment services are at FS2 and FS3. Promotional expenditure is given in sterling but is not expressly said to relate to the UK. The figures are as follows:

<b>YEAR</b>	<b>EXPENDITURE</b>
1995	£ 600,000 (approx)
1996	£1,200,000 (approx)
1997	£1,300,000 (approx)
1998	£ 980,000 (approx)

12. Sales are said to have been made to towns and cities throughout the UK. A selected UK subscribers' list is exhibited at FS4.

13. That completes my review of the evidence to the extent I consider it necessary.

14. I regard Section 5(2)(b) as being central to the opposition and will, therefore, take that ground first. Section 5(2) reads as follows

"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."

15. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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*, 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*, 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*, paragraph 26;

- (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*, 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*, paragraph 29.

16. The goods and services at issue here are identical in broad terms. That is to say both parties have magazines/printed matter and publishing of magazines/printed matter. They differ, however, in their qualifying descriptions. The applicants' magazines and printed matter and publishing services are said to relate Asian lifestyle and fashion. The opponents' relate to cinema and film. The latter seem to me to be specific and readily understandable. I am less clear as to the scope and nature of a so-called lifestyle magazine. The applicants have not filed evidence but Mr Rohra, in his written submissions, gives some indication of the subject matter of his client's magazine as follows

"The magazine for which the Applicant's use the trademark name was one that was mainly used for a limited niche of subscribers to the Applicant's television channel Zee TV and other Zee channels broadcast in the United Kingdom. These subscribers are predominantly of Asian origin. The magazine contained programme schedules, a bit of programme related and Hindi film related gossip and interactive material as a Public relations exercise between the company and channel subscribers and was available free to Zee TV subscribers."

and

"If any of the Applicant's readers wished to read about western films and the latest in show biz they would still have to buy the Opponent's magazine or one covering the same subject matter, as the Applicant's magazine would not cover any of these topics. Similarly a reader of the Opponent's magazine would never be so confused as to pick up a copy of the Applicant's magazine presuming it to be that of the Opponents. This is because the cover itself is drastically different. Topics covered are totally linked only to the Bollywood (Hindi) Indian film and media industry and the cover itself always carries a photograph of an Indian film star."

17. It would seem, therefore, that film content is an important and possibly even central feature of the applicants' magazines notwithstanding that they are described more generally as relating to Asian lifestyle and fashion. That view is reinforced by the example of a ZEE PREMIERE magazine appended to the applicants' counterstatement. The opponents' specification of goods is not restricted to cinema or film of any particular nationality or culture and could notionally at least cover the Asian film industry. I, therefore, regard the respective goods and services as being at the least closely similar.

18. Turning to the marks I will first of all consider the distinctive character of the opponents' earlier trade marks bearing in mind that that character must be assessed by reference to both

the inherent and acquired qualities of the marks. Both earlier trade marks consist essentially of the word PREMIERE. No. 1418364 is in plain block capitals. No. 2008672 is not plain block capitals but it is not a particularly stylised typeface and for practical purposes would be seen simply as the word PREMIERE. The word PREMIERE has a specific meaning indicating the first showing of a film, play etc. In relation, therefore, to magazines relating to cinema and films the word is allusive or semi-descriptive. As such I regard it as of relatively low inherent distinctive capacity.

19. Use can change that position. Ms Sultan gives evidence relating to sales of French, US and British editions of the magazine PREMIERE. Curiously, although the British edition of the magazine has been on sale since 1992, no separate sales figures are given. Instead Ms Sultan gives sales values in French francs for sales in the UK of the French edition of the magazine and volume of sales for the US edition in the UK.

20. Promotion and advertising expenditure on the other hand is given in sterling. The figures seem rather large in relation to the number and value of magazine sales (I estimate typical UK retail prices to be in the £2 - £2.50 range having regard to the French franc, US dollar and pound sterling prices shown on the magazines). Extrapolating as best I can from the information available appears to suggest monthly sales of somewhere between 1500 and 2000 copies (plus whatever sales there are of the British edition). I find it difficult to draw meaningful conclusions from these figures. The sales figures appear to be relatively modest even allowing for the fact that it is a magazine with a specialist audience rather than a mass circulation publication. Without knowing more about the size of the potential audience and the magazine's position in the marketplace I am unable to conclude that the inherent characteristics of the mark have been enhanced through use.

21. With those observations in mind I turn to a comparison of the respective marks. I have already indicated that the opponents' mark is either a plain block capital version of the word PREMIERE or very close thereto in the case of No. 2008672. The applicants' mark might be said to consist of a number of features. There is the word PREMIERE written in a cursive script and presented vertically rather than horizontally. At the top of the mark and presented within the letter P is the word ZEE (written horizontally). At the bottom of the mark are the letters UK. The latter is, I would suggest, relatively insignificant in terms of size and importance and makes a negligible contribution to the character of the mark.

22. It is apparent therefore that the mark is more than simply the word PREMIERE. Nevertheless that word dominates the mark and forms the single most memorable feature of it. The vertical presentation of the word is not to be ignored and forms part of its overall character but as always words talk in trade marks. The word ZEE makes little visual impact but again must not be ignored (it seems that the applicants have since increased the size of the font of the word ZEE and indeed the examples given show it as the dominant element in what is, therefore, a somewhat different mark). On the whole, however, I find that the vertical presentation of the largest and dominant element distracts attention somewhat from the (horizontal) word ZEE.

23. Visually, therefore, the parties' marks are distinguishable only by reference to subsidiary elements in the applicants' mark. The main feature in each case is the word PREMIERE. The

presentational differences are insufficient in my view to displace the similarity that stems from the dominant common elements.

24. Both marks are likely to be referred to orally by their distinctive feature PREMIERE. Differences in presentation of the word will be of no significance in oral use. It is debatable whether the word ZEE would be referred to at all given its lack of prominence. The opposite is certainly true that ZEE is unlikely to be referred to without the word PREMIERE.

25. Conceptually the dominant element PREMIERE alludes to the subject matter of the magazines but is not outright descriptive. There is conceptual similarity as well.

26. I am required to take a global view of the matter having regard to similarities in the marks and goods/services (Balmoral Trade Mark [1999] RPC 297). On that basis I have little hesitation in concluding that there is a likelihood of confusion. Given the subject matter of the magazines and the distinctive and dominant components of the marks I consider that direct confusion is likely. Even if, contrary to my expectation, the word ZEE plays a more important role in actual use, it would be likely to be seen as a housemark that had not been previously noted. Someone familiar with the opponents' magazine who encountered the applicants' mark would be likely to consider that the opponents or an economically linked undertaking had produced a version of their magazine aimed at the Asian market. The opposition, therefore, succeeds under Section 5(2).

27. In the circumstances as I have found the respective goods and services to be similar the objection under Section 5(3) is bound to fail and I see no need to go and consider whether the opponents would also succeed under Section 5(4)(a).

28. The opponents having been successful are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £635. 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 12<sup>TH</sup> day of April 2002**

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