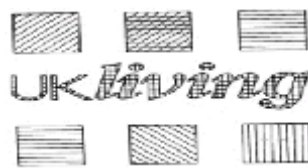


TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2134014  
BY FLEXTECH TELEVISION LIMITED  
TO REGISTER A SERIES OF TWO TRADE MARKS  
IN CLASSES 9,16, 25, 38 AND 41

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 48658  
BY I.P.C. MAGAZINES LIMITED

## BACKGROUND

1) On 28 May 1997, Flextech Television Limited of 160 Great Portland Street, London, W1N 5TB applied under the Trade Marks Act 1994 for registration of a series of two marks:



The second mark in the series is limited to the colours purple, orange, blue, green, pink and black, as shown on the representation on the form of application.

2) In respect of the following goods:

In Class 9: “Computer hardware, computer software, apparatus for recording, transmission or reproduction of sound or images; video and audio tapes, compact discs, recording discs and tapes.”

In Class 16: “Printed matter, stationery, playing cards, books, newspapers, magazines, posters, stickers, transfers, pens, pencils, pencil sharpeners, erasers, pencil cases, note books, paper, envelopes, diaries.”

In Class 25: “Clothing, footwear, headgear.”

In Class 38: “Telecommunications; broadcasting services.”

In Class 41: “Publishing services, education and entertainment services utilising television, organisation of competitions, film and television programme production, film and television studio services, presentation of live performances.”

3) On the 11 June 1998 I.P.C. Magazines Limited of King's Reach Tower, Stamford Street, London, SE1 9LS filed notice of opposition to the application, subsequently amended. The amended grounds of opposition, are in summary:

a) The opponent is the proprietor of Trade Mark 923021 for the word LIVING in respect of "Printed periodical publications" in Class 16.

b) The mark applied for is similar to the opponent's earlier mark and that the goods and services specified in classes 9,16 and 41 of the application are identical or similar to those protected under the opponent's registration. The mark in suit therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 3 April 2002 when the applicant was represented by Mr Pennant of Messrs D Young & Co., and the opponent by Mr Bernard of Messrs F J Cleveland.

#### OPPONENT'S EVIDENCE

6) The opponent filed two declarations. The first, dated 23 March 1999, is by Oswin Grady the Marketing Manager of the opponent company. He states that the name LIVING was first used in 1967 as the title of a magazine. At exhibit OG1 he provides a photocopy of a page from the Willings Press Guide, which mentions the title. At exhibit OG2 he provides copies of various front pages from magazines dated between February 1969 and January 1996. Mr Grady states that the title was used continuously until January 1996 when it was incorporated into the magazine published under the title "Woman & Home". However, despite the merger the mark LIVING was still used on the front cover of the magazine. At exhibit OG3 is a copy of the February 1996 issue front cover. This shows the title "Woman & Home" in large upper case print with above it in much smaller print the words "incorporating LIVING". The word "Living" being in lower case but in bold.

7) Mr Grady states that the association between the titles continued until July 1996. In March 1998 the magazine was relaunched under the title LIVING ETC. At exhibit OG4 he provides two copies of editions of this magazine, dated April 1998 and October 1998. The magazine costs £2.50 and is published eleven times per annum.

8) Mr Grady provides turnover figures under the mark as follows:

Magazine	Year	Turnover £
Living	4/90 - 3/91	1,355,000
Living	4/91 - 3/92	1,456,000
Living	4/92-12/92	1,046,000
Living	1/93-12/93	1,494,800

Living	1/94-12/94	1,310,000
Living	1/95-12/95	1,026,500
n/a	1/96-12/96	n/a
n/a	1/97-12/97	n/a
Living etc	1/98-12/98	919,100

9) Mr Grady also provides the number of magazines sold, the total adult readership number and also expenditure on promoting the magazine. Two sets of figures for magazines were provided, the opponent's own figures and those supplied by the Audit Bureau of Circulation (ABC). These figures differed and at the hearing Mr Bernard accepted that the figures provided by ABC should be the ones considered as they were independently compiled. Mr Grady states that the magazine was promoted by newspaper advertisements and retail site promotions. Examples of such are not available for the magazine prior to the relaunch in 1998. At exhibit OG6 he provides a copy of data sheets from his company's records. A number of items such as "calendar", "Hair ties", "eye pencil" and "health" are mentioned on these sheets. On the examples of the magazines provided at exhibit OG2 it is clear that each edition had a free gift such as chopsticks, cook cards, make-up etc.

Year	number sold	readership	promotion £
1990	201,749	746,471	n/a
1991	205,169	759,125	n/a
1992	189,502	701,157	n/a
1993	177,085	655,215	337,000
1994	150,010	555,037	297,300
1995	119,402	441,787	72,600
1996	n/a	n/a	n/a
1997	n/a	n/a	n/a
1998	174,699	n/a	1,266,520

10) Mr Grady claims that the mark LIVING has been used on products other than magazines such as cook cards, calendars, chop sticks etc. At exhibit OG7 he provides a CD, candle and style directory which all have the LIVING ETC brand on them. They all date from 1998-1999 and were free gifts with the magazine. He states that his company is negotiating licenses with companies interested in using the opponent's mark on their products. He claims that his company has produced CD-ROM versions of other titles and that changes in technology are making the use of electronic formats in publishing more common.

11) At exhibit OG8 Mr Grady provides an article from The Times, dated 11 September 1998.

He claims that the article shows that “there are also growing links between publications and television”. The article states that commercial channels were prevented by the Independent Television Commission from devising programmes from magazines. It states that the ban was “for fear that publishers would simply create extended advertisements for their titles”. The article states that the ban was lifted from cable and satellite channels “a year ago and from terrestrial channels two weeks ago”.

12) The second declaration, dated 22 March 1999, is by Jennifer Marian Noel an employee of the opponent’s trade mark agency. She provides a copy of the registration for trade mark number 923021.

#### APPLICANT’S EVIDENCE

13) The applicant has filed two declarations both by Ms Emma Tennant, the Head of Programming of the Living Channel for Flextech Television. She has been employed by the applicant since 1994. In her first declaration, dated 23 March 2001, Ms Tennant states that the mark in suit is used in connection with the UK Living Channel which first broadcast on 1 September 1993. She states:

“The table comprising exhibit ET1 which is now produced and shown to me sets out the percentage share (i.e. the figures shown represent the percentage of all adults watching television at the time) enjoyed by the UK Living Channel and the Living Channel. It can be seen that the percentage share from the commencement of broadcasting in 1993, when 0.5% of all adults watching television were watching the UK Living Channel has increased substantially to the current period, when 1.12% of all adults watching television were watching the Living Channel.”

14) Ms Tennant states that marketing and advertising expenditure in respect of the Living Channel is anticipated to exceed £3 million in the current [2001] year. She states that revenue has risen from approximately £500,000 in 1993 to over £23 million in 2000. The mark has been used in connection with broadcasting services and also with items of merchandising such as phones, umbrellas, pens, mousemats, handbags, aprons, slippers and toiletries. At exhibit ET2 she provides a number of press cuttings which mention the LIVING channel. She states that “At no time during the 7.5 year period in which the UK Living Channel and the Living Channel has been on air have there been any incidences of which my company is aware of confusion having arisen among any members of the public who had assumed that the LIVING channel originates from the same source as any printed periodical publications published under the name LIVING or that there is any commercial or other connection between my company and the opponent.”

15) In her second declaration, dated 19 April 2001, Ms Tennant states that her company used the mark in suit (UK LIVING and device) “in relation to a range of the goods and services as filed, between 1 September 1993 and 26 October 1997.” At exhibit ET3 she provides various items of printed matter from newspapers and TV listing magazines which include references to UK Living (the TV programme).

## OPPONENT'S EVIDENCE IN REPLY

16) The opponent filed a declaration, dated 24 September 2001, by Sarah Joanne Morrell a Publisher with the opponent company who has worked on titles such as IDEAL HOME, LIVING ETC and COUNTRY LIVING AND INTERIORS. She has worked for the opponent company since 1997. She states that:

“...it is now common for programmes to be described as magazines, i.e. indicating a style of programme with different subjects and interests. One such well-known magazine style television programme is THIS MORNING, a daily interest programme, with a broad subject matter. Indeed, it is interesting to note and of concern that the applicant's own evidence exhibits examples of their own use of the magazine style programming using the title LIVING MAGAZINE, LIVING MAGAZINE HIGHLIGHTS, JAYNE'S LIVING MAGAZINE.”

17) Ms Morrell states that a concept known as “masthead publishing” is becoming more common. This involves a tie-up between a magazine such as Slimming World and a series of TV programmes. She claims that this is a common practice and is the reason why people would assume a link between programmes and magazines. She states that there are restrictions on such links and only “sparing references” can be made. Ms Morrell claims that “It is also in the television broadcasters' interests that the link is strongly made, as this enables my company to drive its readers to the television content and as a result viewing figures for the programme increase.” Magazine titles can benefit from such exposure and she mentions BBC TOP GEAR and BBC GARDENERS WORLD as examples of magazines where sales have been uplifted by TV programmes. She states that the regulations are becoming more relaxed and that this will “enable us in the future to become more aggressive in linking the content of the programme with the magazine.”

18) Ms Morrell states that, based on her own experience, there is a strong and growing relationship between magazines and television programming. At exhibit SJM3 she provides a print out of BBC programmes for 24 September 2001. These include references to *Blue Peter* as a “Magazine programme” and to *Newsround* as a “Daily news magazine”. She states that “there is a real risk that if Flextech were to use the name LIVING, particularly on a magazine style, television programme, that this could be associated with my company's publication and viewers and readers could believe that the two were created and produced from the same source.”

19) That concludes my review of the evidence. I now turn to the decision.

## DECISION

20) At the hearing Mr Bernard withdrew the opposition in relation to the following goods and services:

In Class 9: “Computer hardware, apparatus for recording, transmission or reproduction of sound or images.”

In Class 16: “Stationary, playing cards, posters, stickers, transfers, pens, pencils, pencil sharpeners, erasers, pencil cases, note books, envelopes, diaries.”

In Class 41: “Organisation of competitions, film and television studio services, presentation of live performances.”

21) The only ground of opposition is under Section 5(2)(b) of the Act which states:

“5.- (2) A trade mark shall not be registered if because -

*(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 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.”*

22) An earlier right is defined in Section 6, the relevant parts of which state:

“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,*

*(b)...*

*(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”*

23) 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 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer 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* 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 Schuhfabrik 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-Meyer 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-Meyer Inc.* page 9, paragraph 29.

24) In order to assess the similarity of the goods and services, I note the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- (a) the uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) the physical nature of the goods or services;
- (d) the trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

25) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account.

Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

26) The opponent’s mark is registered for “Printed periodical publications” in Class 16. The applicant’s specification which is opposed is as follows:

In Class 9: “Computer software, Video and audio tapes, compact discs, recording discs and tapes.”

In Class 16: “Printed matter, books, newspapers, magazines, paper.”

In Class 41: “Publishing services, education and entertainment services utilising television, film and television programme production.”

27) I shall first consider the goods in Class 16. Clearly “Printed matter, books, newspapers and magazines” are identical to the opponent’s specification of “Printed periodical publications”. The remaining item in the applicant’s specification is “paper”. This term relates to stationery, which to my mind has little if any similarity to printed publications.

28) I turn now to consider the applicant’s goods in Class 9. Mr Bernard contended that magazines are available in mediums other than the printed version, such as CD and audio tape. I accept that printed periodical publications were available at the relevant date in other formats such as CD and audio tape. I therefore regard “Video and audio tapes, compact discs, recording discs and tapes” as having some similarity to the opponent’s goods. However, I regard “Computer software” as being dissimilar to the opponent’s goods.

29) I now turn to the applicant’s services under Class 41. Mr Bernard submitted that the opponent’s in their magazine offered a publishing service to advertisers. He also submitted that television companies want to use magazine titles as the titles of their television programmes in order to benefit from the existing readership who it is believed will watch a programme which has the same name as a favourite magazine. This is known as “masthead publishing” and as the evidence shows has been, until recently, subject to stringent regulations. I do not accept that the opponent offers a publishing service to advertisers. In my view they offer an advertising service to advertisers. Nevertheless, I accept that there is a degree of similarity between the services of the applicant and the goods of the opponent.

30) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors. I also look to the views expressed in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] FSR at paragraphs 23 & 24:

“23. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect,




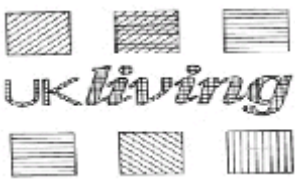
judgement of May 4,1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* {1999} E.T.M.R. 585, paragraph 49).

24. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 52).”

31) The word LIVING is a common dictionary word with a well known meaning. When used in relation to the goods for which it is registered, printed periodical publications, it alludes to the manner in which one conducts ones life, shortened in common parlance to lifestyle. The public is used to seeing magazines devoted to or containing articles regarding lifestyle. The mark therefore contains an element of descriptiveness when used on printed publications. In my view the mark has only a small degree of inherent distinctiveness. However, I must also consider the use that has been made of the mark to determine whether, due to the duration of use and sales and readership levels the opponent can claim an enhanced level of recognition. The magazine was published under the title LIVING between 1967 and December 1995. In January 1996 it was incorporated into the magazine “Woman & Home”. Whilst the mark LIVING was also shown on the front cover it was in a smaller font than the main title. The magazine “Woman & Home incorporating Living” was published until July 1996. In March 1998 the magazine LIVING was relaunched as “LIVING ETC”. Turnover and readership numbers are shown for the period 1990 - 1995. The magazine averaged a turnover of approximately £1,200,000 per annum, with readership averaging approximately 650,000, although these figures were reducing in the years before the magazines’ closure. I must also consider the fact that at the relevant date, 28 May 1997, the magazine had not been published under the mark LIVING solus for seventeen months, whilst the magazine incorporating the mark had also ceased publication ten months prior.

32) The cessation of use of a mark prior to the relevant date is not fatal to an opposition as some trade marks would retain their reputation for a considerable time after they ceased to be used. However, such marks enjoy significant inherent distinctiveness and/or considerable acquired reputation, and/or relate to goods which are in use for some considerable time after the last sale such as cars. In my opinion the opponent’s mark would, at the relevant date, not have enjoyed an enhanced level of recognition and magazines have, by their nature, a short shelf life. The public is also used to magazines being taken off the market. I must therefore compare the marks without assuming the earlier mark had an enhanced level of distinctiveness at the relevant date.

33) I now turn to consider the marks. For ease of reference I reproduce both parties marks below:

Applicant's Mark	Opponent's mark
 	<p data-bbox="790 392 981 470"><b>living</b></p>

34) The opponent contends that the array of squares around the applicant's mark is a simple and non-striking background and are not distinctive. They also claim that the element "UK" would be seen as a non-distinctive term denoting that the goods or services provided in or originating from the United Kingdom. The opponent contends that visually the most dominant and distinctive element of both marks is the word living, and that aurally the marks are similar.

35) I do not accept these contentions. Clearly, the applicant's mark contains the word "living". However, as I have commented earlier, this is a common dictionary word, and is not very distinctive. I accept that the "UK" element also has a clear meaning and is also not particularly distinctive. However, when these two elements are combined they are different visually and aurally from the opponent's mark. Neither mark has a strong conceptual meaning, they both allude to lifestyle, but this is a common concept amongst magazines.

36) Although I have no evidence on the matter I believe that the relevant consumer for printed periodical publications is likely to be reasonably but not unduly careful in their purchase. The public is used to such items having very similar names, usually alluding or actually describing the subject of the publication. Whilst magazines of a more general interest may not be so carefully chosen and may be bought in a hurry, this is not a "bag of sweets" case. Although allowance must be made for the notion of imperfect recollection.

37) When considering the above I take note of the view of Mr Hobbs Q.C. sitting as the Appointed Person in *Raleigh International* (SRIS 0-253-00) where he stated:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences."

38) With all of this in mind I come to the conclusion, with some hesitation, that when all factors are considered, even where the goods are identical the differences in the marks are such that there was no likelihood of confusion at 28 May 1997. It follows that the opponent's case also fails where respective goods and services are only similar. Consequently, the opposition under Section 5(2)(b) fails.

39) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1335. This sum 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 June 2002

George W Salthouse  
For the Registrar  
The Comptroller General