

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2255961  
BY JAMES KIMBER MAGAZINES LTD TO REGISTER THE TRADE MARK  
BLACKHAIR IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 52735  
BY HAWKER CONSUMER PUBLICATIONS LTD**

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**DECISION**

1. On 14 December 2000 James Kimber Magazines Ltd applied to register the mark BLACKHAIR for a specification of goods which reads “Printed matter and publications; magazines; instructional and teaching materials; stationery and office requisites; parts and fittings for all the aforesaid goods.”
2. The application is numbered 2255961.
3. On 20 June 2001 Hawker Consumer Publications Ltd filed notice of opposition to this application.
4. The opponents state that the term BLACKHAIR is clearly descriptive of printed matter, such as a magazine, relating to hair care and styling for black people and that, consequently, therefore, the trade mark is not capable of distinguishing the goods of the applicants from those of other undertakings within the meaning of section 1(1) of the Act. The opponents say that the application should, therefore, be refused in accordance with the provisions of section 3(1)(a) of the Act.
5. The opponents state that the applicants’ trade mark is clearly descriptive of printed matter, such as a magazines, relating to hair care and styling for black people. The trade mark is, therefore, devoid of distinctive character and should be refused in accordance with the provisions of section 3(1)(b) of the Act.
6. They further say that the applicants’ trade mark consists exclusively of a sign which may serve in trade to designate the intended purpose of the goods, such as a magazine intended for black people. Consequently, the trade mark should be refused in accordance with the provisions of section 3(1)(c) of the Act.
7. The opponents say that they successfully opposed a previous application of the applicants for the trade mark BLACKHAIR in respect of paper, printed matter, printed publications, books, newspapers, periodicals and magazines and the application was

refused in accordance with the provisions of sections 3(1)(b) and (c) of the Act. They say that the relevant decision is BL O/083/01.

8. The opponents request that the trade mark should be refused in its entirety and seek an award of costs.

9. The applicants filed a counterstatement denying the grounds of opposition.

10. The applicants also deny that decision BL O/083/01 is of any relevance because the opposition was decided on the basis that the trade mark had not been used. They say that in these proceedings they intend to submit evidence to show that the trade mark has acquired a distinctive character.

11. The applicants request that the opposition should be refused in its entirety and seek an award of costs.

12. The applicants and the opponents both filed evidence.

13. A hearing in respect of these proceedings took place on 23 October 2002. The applicants were represented by Mr Buehrlen of W H Beck Greener and the opponents by Mr Blum of Gill Jennings & Every.

### **Opponents' evidence**

#### **First witness statement of Robert Alan Blum**

14. Mr Blum is a partner and head of the trade marks department of Gill Jennings & Every.

15. Mr Blum for the most part reiterates the grounds of opposition. He submits that the trade mark BLACKHAIR cannot acquire a distinctive character as it is so inherently weak. He exhibits a copy of decision no BL O/083/01 and states that this decision is an exact precedent for the present case.

### **Applicants' evidence**

#### **Statutory declaration of David George Holliday**

16. Mr Holliday is a director of the applicants.

17. Mr Holliday states that the current application was filed to replace a previous United Kingdom trade mark application, No. 2143800 which was filed by the predecessors in title to the trade mark BLACKHAIR. That application is the subject of decision no BL O/083/01 which has already been referred to. Mr Holliday exhibits details of this application and a copy of the decision relating to it.

18. Mr Holliday states that the applicants were subsequently advised by their trade mark attorneys to file a fresh trade mark application on the basis that use of the trade mark since the filing of the previous application was likely to prove sufficient for the purposes of establishing an acquired distinctive character. He states that the previous application was filed on 3 September 1997 and the first edition of BLACKHAIR magazine was issued in December 1997 and, therefore, evidence of use could not support that application.

19. Mr Holliday exhibits at DGH2 a copy of statutory declaration made by Mr James Kimber which is dated 16 June 1999 and was filed in support of the earlier failed application.

20. Mr Kimber is identified in his declaration as being the principal shareholder of James Kimber Publishing Limited, formerly known as James Kimber Management Limited. Mr Kimber states that in 1997 his company decided to adopt the name BLACKHAIR for a new magazine. Mr Kimber says that his company produced various letter headings and associated stationery for the magazine in July 1997 and during July, August and September 1997 this stationery was put into use and an introductory leaflet was put into circulation. Mr Kimber refers to these leaflets being exhibited at JK3, however, in my copy of the evidence a copy of a leaflet is exhibited at JK7.

21. Mr Kimber exhibits at JK4 part of a copy of the first issue. This is dated December/January 1998. The first page of the magazine indicates that a large part of the magazine deals with hair. It indicates that the magazine is issued bi-monthly. Various photographs appear in the extract. They appear (the quality of the copy is not the best) to be photographs of persons of an African-Caribbean ethnic background. Mr Kimber states that since the first issue of the magazine was published in December 1997 it has appeared on a bi-monthly basis. He exhibits at JK5 examples of the front covers of various editions of BLACKHAIR magazine. He also includes in this exhibit various pages from the October/November 1998 edition of BLACKHAIR magazine. These pages show that the magazine relates to hair and is aimed at people with an African-Caribbean ethnic background.

22. Mr Kimber says that sales of the magazine average around 11,000 every two months. He says that the magazine has been promoted extensively in sister magazines such as "Hairflair", other magazines such as "Voice", "Nigeria Link" and "United Expo. 98", at trade shows such as "Hairworking", the Birmingham Hair & Beauty Show in August 1998 and through the production and distribution of various letters and posters. Mr Kimber exhibits at JK7 examples of advertisements and leaflets produced during 1998 to promote BLACKHAIR magazine. Included in these exhibits is a copy of an advertisement from "Voice" for 3 August 1998 referring to the Black Hair & Beauty Fair which was to be held in Birmingham in August 1998.

23. Mr Kimber says that BLACKHAIR magazine has quickly established a strong reputation in the trade and with the public as a leading hair and fashion magazine.

24. Mr Kimber then goes on to make various comments about the declaration of a Pat Petker. This declaration is not in these proceedings. Mr Kimber exhibits at JK8 the cover of the what he describes as “the opponents’ November 1998 BLACK HAIRSTYLES year book”. The originator of this publication would appear to be Black Beauty & Hair. From Mr Kimber’s declaration it appears that the opponents are responsible for Black Beauty & Hair magazine. Mr Kimber also comments on a declaration made by Myrna Robinson. This declaration is also not in these proceedings.

25. I now return to the contents of the declaration of Mr Holliday. Mr Holliday states that the wholesale turnover of BLACKHAIR has been as follows:

to 31 December 1999	£176,648
to 31 December 2000	£124,645

26. He also states that the following has been spent on advertising BLACKHAIR:

to 31 December 1999	£30,913
to 31 December 2000	£952

27. Mr Holliday also gives turnover and promotion figures for the year ending 31 December 2001. However, this application was filed on 14 December 2000 and so these figures cannot have a bearing upon my decision. I have to decide on the position at the date of the filing. I note that the part of the figures relating to 2000 cover a period of some 17 days after the date of the filing of the application. In the context of the sales of a bi-monthly magazine I consider that it would be overly fussy not to take these figures into consideration.

28. Mr Holliday says that the trade mark BLACKHAIR has been promoted on the front cover of the magazine and displayed at the point of sale. He exhibits at DGH3 two issues of BLACKHAIR magazine dated December/January 2000 and February/March 2000. Included in this exhibit is a copy of part of BLACKHAIR magazine for August/September 1999 which also refers to the Black Hair & Beauty Fair to be held in Birmingham on 21 and 22 August 1999.

29. Mr Holliday exhibits at DGH4 various other documents in relation to promotional activities for BLACKHAIR magazine. The “Whassup” exhibit is undated and so I cannot tell if it emanates from before the relevant date. Mr Holliday says that a souvenir programme of the African Caribbean Leukaemia Trust fundraising anniversary ball emanates from June 2000. However, it is clearly printed with the date of 2 June 2001, consequently it emanates from after the relevant date. The other evidence relates to the sponsorship of Ms Lorraine Gibson by the applicant in the Miss Big and Beautiful UK 2000 contest.

30. Mr Holliday goes on to give a list of places in the United Kingdom where the BLACKHAIR trade mark has been used. There is a wide spread of locations mainly in

England, including major conurbations such as London, Birmingham, Leeds and Newcastle.

31. Mr Holliday says that the relevant public have come to recognise the trade mark BLACKHAIR. He exhibits at DGH5 a letter from Intereactive Xtreme, Inc in support of this claim. Interactive Xtreme, Inc is a company based in the United States. The letter is trying to get the applicants to place business with the sender by using its web site. There is no indication that this letter is anything other than part of a general mail shot to magazines around the world. The sender is simply trying to sell a service. I do not consider that any great weight or significance can be attached to this letter. All it tells me is that the sender has identified the recipient as a producer of a magazine relating to hair.

### **Opponents' evidence in reply**

32. This consists of a further witness statement by Mr Blum.

33. Mr Blum's statement can be characterised as representing submissions rather than evidence of fact. I will briefly outline the main points of these submissions, as I see them:

- Mr Kimber states that the current sales of each issue of the magazine average around 11,000 copies. Mr Kimber does not give any other sales or advertising and expenditure figures;
- The figures given by Mr Holliday for turnover and promotional expenditure are only relevant where they relate to the period before the date of the filing of the application;
- Mr Blum believes that the trade mark is an "inherently unregistrable mark as was proved by the earlier opposition proceedings." He submits that "vast amounts of evidence use should be required in order to support such a weak mark." He states that he "would expect to see at least 5-7 years good use of the trade mark BLACKHAIR in respect of magazines";
- Mr Blum would expect to see independent evidence from people in the trade saying that they recognise the trade mark BLACKHAIR as belonging to and being distinctive of the applicants;
- The letter exhibited at DGH5 is only one example of a company recognising the existence of the applicants' BLACKHAIR magazine. Mr Blum does not consider that this evidence is convincing in showing that the trade mark has acquired a distinctive character through use.

34. That completes my review of the evidence.

35. Section 3(1) reads as follows:

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

- (a) signs which do not satisfy the requirements of section 1(1),

- (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) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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.”

36. As noted above this is the second action between the parties (or to be strictly correct the applicants’ predecessor in title). The previous opposition action (BLO/083/01) involved an application filed on 3 September 1997. The case was heard on 8 December 2000 and the decision issued on 20 February 2001. It turned on and was decided under Section 3(1)(b) and (c) of the Act. That decision was not appealed.

37. The application now before me was filed on 14 December 2000. The principal difference between this action and the previous one is that the applicants commenced use of their mark in 1997. The first edition of their magazine was put out in December 1997 but, as is the nature of such things, there were pre launch preparations and publicity from July 1997. It nevertheless appears to have been accepted for the purposes of the previous decision that such preparatory use as had taken place would not avail the applicants in terms of the proviso to Section 3(1) if they failed on the prima facie case (as they did).

38. The opponents have, on this occasion, also raised an objection under Section 3(1)(a) (and 1(1)). In AD 2000 Trade Mark, [1997] RPC 168, Mr Geoffrey Hobbs, sitting as the Appointed Person, indicated that “the requirements of Section 1(1) are satisfied even in cases where a sign represented graphically is only “capable” to the limited extent of being “not incapable” of distinguishing goods or services of one undertaking from those of other undertakings”. I do not think there can be any doubt that the mark applied for satisfies this test. I also note that an admission to this effect was made by the trade mark attorney who appeared on behalf of the opponents in the earlier case – see paragraph 30 of the Hearing Officer’s decision.

39. The main issue between the parties is the registrability of the mark having regard to Section 3(1)(b) and (c). The Hearing Officer’s decision in the previous case has been filed in evidence. His main findings in relation to this ground of opposition were that:

- BLACKHAIR is not a dictionary word but is formed from two common dictionary words;
- used in relation to magazines with the subject matter in question, the word BLACKHAIR would readily yield a meaning to the average consumer;
- certain references in the evidence gave support to the view that the term BLACKHAIR would be apt for use by other traders;
- there were other instances of use of BLACK to indicate a genre of magazines;
- the classified advertisements demonstrated that there were hairdressers specifically catering for black people;
- as regards an alternative descriptive connotation, it was unlikely that a magazine would be produced having as its subject matter the hair of any person who has hair coloured black.

40. For ease of reference I am reproducing in the Annex the full text of that part of the Hearing Officer's decision dealing with the substance of the Section 3(1)(b) and (c) objection. In doing so I should add that certain of the material that was before the Hearing Officer in the earlier case, notably Mr Petker's statutory declaration, has not been refiled. The evidence of Mr Kimber (for the applicants) has been adopted into the present proceedings as Exhibit DGH2 to Mr Holliday's evidence.

41. The Hearing Officer was guided by the following comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Next, is “Treat” within s. 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 from the old Act “inherently” but the idea is much the same) devoid of distinctive character.”

42. Mr Blum has also referred me to the following passage from the same case:

“A word or words to be really distinctive of a person's goods must generally be incapable of application to the goods of anyone else. [TREAT 1996 RPC 281].”

43. Mr Buehrlen, who appeared for the applicants, drew on the ECJ's guidance in *Procter & Gamble Company's* application (BABY-DRY) – Case C-383/99P. This



guidance was not available at the time of the previous BLACKHAIR case. The following extract from the judgment of the Court will suffice to indicate the approach that it was considered should be adopted:

“39. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

44. With the above facts, circumstances and guidance in mind I turn to the issues before me.

45. The most obvious basis on which the mark BLACKHAIR might be said to fall foul of Section 3(1)(b) and (c) is if it related to magazines about hair that is coloured black. The Hearing Officer considered this possibility in the previous opposition action and commented as follows:

“40. There is an alternative descriptive connotation to the word BLACKHAIR, i.e. the hair of any person who has hair coloured black. I think it unlikely that a magazine on this subject would be produced, which I agree, is clearly the most obvious.”

That is also my view of this particular approach to the mark.

46. The real issue on which the objection turns is how the mark BLACKHAIR will be seen in the context of a magazine or other publication relating to the hair of black people and in particular whether, if used in this context, the word serves to designate a characteristic of the goods or is in other respects devoid of distinctive character.

47. In paragraphs 36 and 38 of his decision, the Hearing Officer identified a small number of references to 'Black hair', 'Black haircare' and 'Black hairdressing' which reinforced his prima facie view of the mark based on the ordinary descriptive meanings of the words. I should say, parenthetically, that I do not consider the mere conjoining of the ordinary dictionary words into a composite word has a material affect on perception of the mark. The whole is little more than the sum of the parts.

48. I have given careful consideration to the evidence filed in this case and have not found, or been pointed to, other descriptive uses of black hair either in the magazine editorials and articles or in the advertising carried by the magazine. The latter in particular is likely to be indicative of how black people's hair is referred to in a trading context. As one might expect the applicants' magazines carry classified advertising for hair dressing salons, hair care products, hair and beauty retailers etc. A representative selection of advertisements contain references to:

"Specialists in Afro, European and mixed textured hair ...." (December/January 2000 Blackhair magazine)

"American Afro Caribbean Hair and Skin products ...." (December/January 2000 Blackhair magazine)

"We specialise in Afro Caribbean, Asian, European and Mixed Texture Hair"  
(December/January 2000 Blackhair magazine)

There are other references to:

"Afro Hair and Beauty Exhibition" (August/September 1999 Blackhair magazine)

"Afro Hair and Beauty Photostyling Competition" (February/March 2000 Blackhair magazine)

49. My own findings based on the evidence including the material that was not before the Hearing Officer in the earlier case is that there is little evidence to support the claim that 'Blackhair' is a term that finds ready usage in the trade. All the indications are that other terms are used. The few exceptions to this are the ones identified in the earlier decision.

50. The passage from BABY-DRY set out above notes that "any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers .... is apt to confer distinctive character ....". Notwithstanding the descriptive characteristics of the words making up the mark BABY-DRY, the combination was regarded as being a "syntactically unusual juxtaposition." On the face of it BLACKHAIR does not appear to be a syntactically unusual juxtaposition. It is a straightforward descriptive adjective and noun in the customary order in which one would expect to find those words. On the other hand once

it is accepted that the real objection is that it means black people's hair (rather than simply hair coloured black) the word represents a compression of meaning and language.

51. Mr Buehrlen submitted that applying the BABY-DRY criteria should now produce an answer favourable to his client. In particular he noted that in the previous decision the Hearing Officer had posed himself a question to do with the descriptive content of the mark whereas I should now approach the matter on the basis of whether the mark had an overall distinctive character rather than whether the parts had descriptive characteristics.

52. There is some attraction in the argument that BLACKHAIR represents a compression of language and meaning sufficient to say that it would not serve in normal usage from a consumer's point of view to designate certain characteristics of the goods. It is true too that Registry practice relating to magazine titles is somewhat more relaxed than in relation to most other products reflecting practice in the trade and the necessity for a magazine title to communicate its subject matter to actual or potential purchasers.

53. Despite the attraction of these arguments I am not persuaded that BLACKHAIR quite achieves registrability in the prima facie case. The reason for this lies, I believe, in a point identified in the previous action namely that 'Black' is used as a genre word in circumstances where it would clearly be understood to refer to black people rather than black in the sense of a colour. The examples given in paragraph 37 of the previous decision were drawn from editorials and referred to:

'In that time we have seen other Black magazines....', and  
'.... Making us the longest-running Black magazine in the UK....'

54. There are other examples of such usage. The opponents' magazine is called 'Black Beauty & Hair'. The December/January 2000 edition of Blackhair magazine refers to a competition finalist's interest in 'Black History and Culture'. The October/November 1999 edition of the magazine refers to October being 'Black History Month' and "It's not too late to enter the 'Black Trophy Competition'". Exhibit DGH4 shows the front page of 'Whassup' which is described as being a 'Black Arts & Entertainment Magazine'. These are, of course, examples that emerge in evidence that has been filed for other purposes but they do indicate natural usage. It is sufficient, I think, to persuade me that 'Black' is, often used to mean black people or the black community. More generally my own experience tells me that expressions such as the 'black vote' or 'black issues' would be readily understood. There is nothing inherently out of the ordinary in language being compressed in this way. The words 'headache tablet' do not cease to be descriptive simply because they represent a compressed way of saying 'headache relieving tablet'.

55. I therefore, conclude that consumers faced with a magazine called BLACKHAIR will, absent use as a trade mark, regard it as being a normal way of designating the essential characteristic of the goods, that is to say a publication dealing with black people's hair. It cannot properly be said to be a lexical invention within the meaning of the guidance in BABY-DRY. The mark is thus open to objection under Section 3(1)(c) and is also devoid of distinctive character within the meaning of Section 3(1)(b) in

relation to the first part of the applied for specification. I indicated at the hearing that I could see no objection to the mark in relation to ‘stationery and office requisites’. Article 13 of the Directive (89/104) comes into play in relation to these latter items. I now turn to the applicants’ use and the operation of the proviso to Section 3(1).

56. I have recorded above details of the applicants’ evidence of use. Mr Blum made a number of criticisms of this evidence. His main points were that there had been insufficient use for me to be satisfied that the mark had acquired a distinctive character; that the use was thinly spread (over 60 sales locations are referred to); that no demographic breakdown of sales has been provided; and that the scale of activity was modest for what he considered to be a non-specialist magazine.

57. Mr Buehrlen made a number of detailed submissions which were underpinned by the contrary claim that this was a specialist magazine. It followed in his view, that the scale of activity and method of promotion were consequences of, and dictated by, the nature of the target audience.

58. Guidance on the operation of the proviso to Section 3(1) of the Act can be gained from *Windsurfing Chiemsee Productions v Huber*, [1999] ETMR 585 which deals with the equivalent provision in the Directive (Article 3(3)):

“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.”

and

“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.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

59. The nature and size of the relevant consumer base is an important – and in this case, I believe, key consideration. Directly contradictory views have been taken as to how specialised the customer base is. In the previous action the Hearing Officer referred to the mock-up of the first issue of BLACKHAIR which identified the target audience as being “the image conscious black woman”. That entirely accords with my own reading of the evidence and in particular the content of the magazine. In fact the audience can probably be further defined as being aimed at a young or youthful audience. That suggests very strongly that the magazine is directed at a very specialist audience. It would have been of further assistance if the applicants had been able to give some indication of the size of that audience. Such information usually exists not least because advertisers require it in order to be satisfied that their expenditure is worthwhile. Against that the absence of such information is not in my view critical to the applicants’ case. There is after all actual evidence that advertisers have been attracted in the classified ads section of the magazines.

60. The applicants’ use falls to be assessed in the context of the consumer group identified above. BLACKHAIR magazine has a cover price of between £1.95 and £2.40 over the relevant period and sales averaging around 11,000 copies. It is a bi-monthly magazine. Turnover is given for 1999 (£176,648) and 2000 (£124,645) but not for the first full year of operation. The turnover figures are consistent with claims made as to the number of copies sold and the frequency of the magazine. Advertising and expenditure is put at £30,913 in 1999 falling to a mere £952 in 2000. That is not altogether surprising as magazine promotion is usually heavily front ended loaded to achieve quick consumer recognition. Once a market has been established the need for promotional advertising is much reduced. It is true that the information on sales is not put into context. However, the Windsurfing case cautions against over-reliance on abstract data such as predetermined percentages.

61. The opponents publish a rival magazine and are said to have done so for eighteen years. No doubt they would have commented if they felt the applicants’ claims were open to challenge as being either improbably exaggerated at one extreme or too small to make an impact at the other. Given the specialist nature of the magazine and the correspondingly limited audience I find the applicants’ basic claims to be entirely credible.

62. There are other reasons for according weight to the applicants’ evidence. The applicants and their predecessors are experienced in the publication of magazines. Their HAIRFLAIR magazine is said to have been first produced in 1982. They have a particular specialism in the niche area of hair and fashion publications (Mr Kimber’s statutory declaration, paragraph 2 at Exhibit DGH2). Mr Buehrlen’s skeleton argument conveniently draws together a number of the surrounding activities that the magazine has been involved with or sponsored as a means of keeping itself in the public eye:

“To further illustrate the nature in which the trade mark has been promoted and acquired a distinctive character, David George Holliday provides us with Exhibit **DGH.3** which features some of the magazines published under the trade mark

**BLACKHAIR** inside of which details of promotional activities are given. An example is the October/November issue which has various promotional activities, including the **BLACKHAIR** model search 1999 finals, the **BLACKHAIR** dream wedding competition, the **BLACKHAIR**/Ms London lifestyle show, the **BLACKHAIR** party on 2<sup>nd</sup> December 1999 at the Hippodrome and various advertisements in **BLACKHAIR** Classifieds. The same is shown in the February/March issue for the year 2000 including features on the **BLACKHAIR** anniversary party and advertisements for the **BLACKHAIR** calendar. The magazine itself promotes subscriptions as featured for example in the April/May 2000 issue of **BLACKHAIR** where annual subscribers to **BLACKHAIR** Magazine would be entitled to a free bottle of essence of i man. Again, the said publication further promotes the **BLACKHAIR** calendar as well as training services for hair salons.”

63. Mr Holliday’s evidence identifies over 60 locations on the UK (mainly England) where the magazine **BLACKHAIR** has been sold. Mr Blum submitted that this suggested sales were spread very thinly. The underlying suggestion is that scattered sales are likely to make less public impact than geographically concentrated sales. There is some force to that point. But I think it is reasonable to assume that sales will naturally be heaviest in towns or cities where there is a black community of significant size. It is highly unlikely that sales would be evenly spread throughout the country.

64. Taking the evidence as a whole it is, in my judgment, reasonable to draw the conclusion that **BLACKHAIR** has achieved recognition in its chosen specialist market place. In coming to a conclusion in relation to the proviso to Section 3(1) I bear in mind the nature and strength of the objection the applicants’ have to overcome; the nature of the goods (in particular the circumstances of the magazine trade); the specialist nature of this particular publication; the niche market it addresses; and the weight of the evidence. My conclusion is that the applicants are entitled to benefit from the proviso to Section 3(1). It is, however, clear that they only do so in relation to magazines. There is no, or insufficient, evidence to support a broader specification within the publications field.

65. Accordingly the application will be allowed to proceed if the applicants file a Form TM21 amending their specification to:

“Magazines; stationery and office requisites; parts and fittings for all the aforesaid goods.”

66. The applicants should file such a Form TM21 within one month of the expiry of the appeal period or, if the decision is appealed, within one month of the final determination of this case should the above-restricted specification be confirmed on appeal. If the applicants do not file a Form TM21 restricting the specification as before mentioned the application will be refused in its entirety.

67. The applicants have been largely successful in terms of the basis on which this case has been fought and are entitled to an award of costs. The opponents have achieved some

minor adjustment to the specification. Taking all these factors into account I order the opponents to pay the applicants the sum of £1250. 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 13<sup>th</sup> day of November 2002**

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

**Annex in paper copy only.**