

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2471077  
BY NICE FASHION & MUSIC S.L.  
TO REGISTER A SERIES OF TWO TRADE MARKS**



**IN CLASSES 9 & 41**

**AND**

**OPPOSITION THERETO  
UNDER No. 96858 BY  
IPC MEDIA LIMITED**

**AND CONSOLIDATED CASE**

**IN THE MATTER OF APPLICATION No. 2482051  
BY IPC MEDIA LIMITED  
TO REGISTER THE TRADE MARK  
MELODY MAKER  
IN CLASSES 9, 16, 35 & 41**

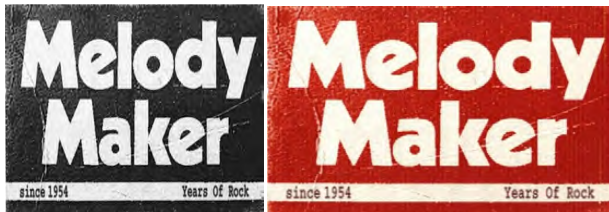
**AND**

**OPPOSITION THERETO  
UNDER No. 97977 BY  
NICE FASHION & MUSIC S.L.**

## **BACKGROUND**

### **APPLICATION 2471077**

1) On 31 October 2007 Nice Fashion & Music S.L. (hereinafter NICE) applied to register the following series of two trade marks:



2) After examination, the trade mark was accepted and subsequently published for opposition purposes on 11 January 2008 in Trade Marks Journal No.6718 for the following goods and services:

Class 9: Sound media.

Class 41: Musical productions; production of recorded music.

3) On 11 April 2008 IPC Media Limited (hereinafter IPC) filed a notice of opposition. In summary the opposition is based upon the following:

a) IPC states that it has used the mark “Melody Maker” on publications in the UK since 1960 and also on electronic publications including a website. The mark has also been used throughout the UK in relation to cover mounted recordings, vinyl records and cassette tapes. The mark in suit therefore offends against Section 5(4)(a) of the Act.

b) The logo was created by an employee of the opponent and was used on the front of printed publications, as well as other goods and services including electronic publications, cover mounted recordings, vinyl records and cassette tapes. The mark in suit therefore offends against Section 5(4)(b) of the Act.

4) NICE filed a counterstatement, dated 12 Aug 2008, denying all the claims and putting IPC to strict proof of use.

### **APPLICATION 2482051**

5) On 11 March 2008, IPC applied to register the trade mark MELODY MAKER. After examination, the trade mark was accepted and subsequently published for opposition purposes on 11 July 2008 in Trade Marks Journal No.6743 for the following goods and services:

Class 9: Information stored in or on electronic and/or optical means; printed publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other networks; electronic files; electronic databases; electronic directories; pre-recorded

digital media; downloadable digital media; webcasts; podcasts; vodcasts, podscrolls; computer software and computer programs; video and audio tapes, cassettes, discs and records; read only memory; magnetic data carriers; CDRoms; inter-active CDs; video CDs; DVDs; computer peripherals.


Class 16: Printed matter; printed publications; books, manuals, magazines, periodicals, journals; atlases; bookbinding materials; stationery; instructional and teaching materials; calendars and posters; artists' materials; paper and goods made of paper; cardboard and goods made of cardboard.



Class 35: Advertising and promotion services and information services relating thereto; arranging and placing advertisements for others; electronic shopping retail services connected with furniture, home furnishings, home appliances, household equipment and containers, garden equipment and appliances; provision of information and advice relating to the retailing of goods; compilation of information into computer databases and systemisation of computer databases; compilation of directories.

Class 41: Entertainment and education services; cultural and sporting activities; live events; booking agency services; organisation of conferences, conventions, exhibitions, competitions and award ceremonies; presentation, distribution, syndication, networking and rental of television and radio programmes and of films and video recordings; provision of radio and television entertainment services; publishing services; publication of directories; electronic publishing services; information and advisory services relating to all the aforesaid services.

6) On 26 September 2008 NICE filed a notice of opposition. In summary the opposition is based upon the following:

a) NICE is the proprietor and applicant of the following earlier trade marks:

Mark	Number	Dates	Class	Specification
	M839772	UK designation date 18.10.2004  Priority claim 08.07.2004  Registered date 03.03.2006	25	Clothing, footwear, headgear.

	2471077	Application date 31.10.07 Pending	9	Sound media.
				41

b) The opponent states that the goods and services are identical and/or similar and that the marks are similar. The mark in suit is said to offend Section 5(2)(b) of the Trade Marks Act 1994.

7) On 19 December 2008 IPC filed a counterstatement denying NICE’s contentions. IPC points out that whilst both are earlier trade marks, the UK mark is opposed. The International mark is registered for goods in Class 25 and IPC denies that these goods are similar to its goods and services in Classes 9, 16, 35 and 41. There is, they say, no likelihood of confusion and the 5(2)(b) ground should be dismissed.

8) Only IPC filed evidence in these proceedings which to the extent that I consider it necessary I have summarised below. The matter came to be heard on 12 November 2009 when IPC was represented by Mr Malynicz of Counsel instructed by F J Cleveland. NICE was not represented but their agent provided written submissions which I shall refer to as and when relevant.

**IPC’S EVIDENCE**

9) IPC filed eleven witness statements. The first, dated 30 January 2009, is by Allan Jones. He states that he has worked for IPC for 34 years. He began as a writer on Melody Maker magazine in 1974, becoming the editor in 1984 until 1997. He provides a personal history and also a history of IPC and details of its publishing empire, neither of which assists my decision. With regard to the Melody Maker magazine he states that it was first published in 1926 as a monthly magazine, changing to a weekly magazine in 1933. Regarding the logo he comments:

“10.10 It was Jack [Hutton] that initiated the redesign of Melody Maker. In 1962 the classic Melody Maker logo was created (“the 1962 logo”). The logo was first used by at least July of that year. Now produced and shown to me marked exhibit AJ13 is a representation of the famous logo with its distinctive red colour and cut out white lettering.

In 1963, this was followed by the paper itself which was redesigned by Jack in collaboration with his new Assistant Editor and talented designer Bob Houston.”

10) He states that in 1996 “IPC purchased the domain name [www.melodymaker.co.uk](http://www.melodymaker.co.uk) and slowly launched the website until it became fully functional in 2000”. He states that in 1999 the magazine was re-launched as a glossy magazine and the 1960’s logo was re-invented. He provides examples of the front covers from the 1990s at exhibit AJ22. The last edition of Melody Maker was published in December 2000 and the magazine was merged with New Musical Express (NME). A copy of the front cover of the last edition is at exhibit AJ23. He states that the British Library has every edition of the magazine for readers to peruse and that second hand editions of the magazine are still being offered for sale. Further, an internet search reveals that since 2001 over one hundred articles have used the phrase “Melody Maker”. He states that the magazine was sold throughout the UK via newsagents, high street retailers, petrol stations and convenience stores. He provides circulation figures for six monthly periods from 1946-2000. I have distilled these figures to reflect each decade.

Period	Average weekly circulation
1940s	47,066
1950s	91,145
1960s	85,904
1970s	166,032
1980s	73,725
1990s incl (2000)	55,092

11) To put these figures into context Mr Jones provides circulation figures for the NME which was the main rival to Melody Maker. During the 1990s the NME had an average circulation of approximately 106,000. He states that the magazine also sponsored music festivals such as Reading and Leeds throughout the 1990s. Starting in 1983 and continuing until its demise in 2000 the magazine regularly produced flexidiscs, LPs, cassettes and CDs under the Melody Maker name, these were given away with the magazine. He states that the magazine was also promoted at trade fairs until the mid 1980s. Mr Jones states that the mark has been licensed for others to use. He points out that Lee Cooper were licensed to produce Jeans, T-Shirts, vest and dresses in very limited numbers, approximately 6,000 garments only which are on sale as he writes his statement. He also provides details of other such agreements between 2004-2008 where companies such as the BBC, Oxford University Press, Endemol and the Guardian have paid to use the mark “Melody Maker” on TV programmes, newspaper supplements and educational goods. He states:

“Melody Maker is a seminal part of the music industry’s history and future. Melody Maker is constantly referred to in music documentaries today. The fact that it is still referred to today is evidence of its importance and the fact that it is still known and recognised as a reliable source by the industry and public.”

12) Mr Jones also provides turnover figures for Melody Maker as follows:

Year	Turnover £ million
1995	3.3
1996	3.5
1997	3.3
1998	2
1999	2.1
2000	2.25

13) Mr Jones provides a copy of a book written about the magazine and published in 1999; he also provides evidence of another book about the magazine published in 2001. At exhibits AJ46 & 47 he provides examples of articles on the internet and in the press which refer to the magazine. The internet examples are mostly undated, whilst the press articles range between 2001 and 2008. The Melody Maker internet site has, since early 2001, redirected viewers to the NME site as the two magazines were merged. However, the domain name has been kept in existence with all fees being paid. Mr Jones points out that IPC are still considering the use of the mark on a variety of products such as DVDs, CDs etc. He looks to other publications such as *Smash Hits*, *Bunty* and *Jackie* which although no longer appearing in printed form are still used on products. He points out that IPC have produced and sold books and annuals in the past which contain classic Melody Maker features and photographs from their archives.

14) The second witness statement, dated 3 February 2009, is by Eric Fuller the Managing Director of IPC Ignite, a division of IPC, a position he has held since September 2006. Prior to this he was the Publishing Director as of September 2000. He states:

“6. Although Melody Maker magazine had closed, IPC never abandoned the Melody Maker brand. Soon after the magazine’s closure, work started on the digitalisation of the Melody Maker archive. Essentially, IPC employed a company to electronically scan every page of every issue of Melody Maker magazine. IPC intend to make the complete, searchable digital archive available on-line. This will be provided under the Melody Maker brand and will carry historic Melody Maker artwork, including some of the Melody Maker logos. It is envisaged that the archive will be of interest to the general public at large as well as to the enthusiasts and academics. It is possible that access to the archive would be provided free of charge and that it would derive its income from advertising revenue. Although the technical aspects of the archive are virtually complete, we still need to address some legal issues before making the archive available. The archives of a number of other publications are already available on-line including The Times and The Guardian newspapers as shown in Exhibit EF4.”

15) The third witness statement, dated 3 February 2009, is by Bob Harris a well known presenter on radio and television. He states that as a presenter and journalist he has been involved in the music industry since 1970. He states that the magazine was very well known and that if he saw a magazine, newspaper, website, clothing or music related goods with the mark “Melody Maker” he would assume that it was connected to the original magazine. He refers to a magazine called “No Depression” in the USA which ceased publication and went solely on-line. Another US magazine gives away a CD with every edition. He believes that Melody Maker could evolve in a similar manner.

16) The fourth witness statement, dated 30 January 2009, is by Dave Robinson a co-founder of Stiff Records which was a major label in the years 1976-1986. He has been in the music industry since 1967. He states that he would assume any magazine, clothing or music related goods and services branded “Melody Maker” would be associated with the original magazine and were part of a re-launch. He states that Melody Maker was “the font of all music knowledge”.

17) The fifth witness statement, dated 30 January 2009, is by Johnny Hopkins who has worked in the music industry since 1991 dealing with the press in various capacities. He is now a director of an independent PR agency and lectures on Pop Music and Media. He confirms that the Melody Maker magazine was well known and that if he saw a publication with the mark he would assume that it was connected with the old magazine. He confirms that CDs, cassettes and records were regularly attached to the cover of the magazine.

18) The sixth witness statement, dated 30 January 2009, is by Ruth Mitchell a writer involved in the music industry since 1997. She worked for the Melody Maker for a while prior to its cessation in 2000. She has subsequently worked as a publicist for a company involved in music and film and as a freelance in similar fields as well as working in radio. She states that if she saw a publication or musical recording with the mark Melody Maker she would assume a connection with the original magazine or an associated company. She states:

“Another reason I decided to make my documentary was because if you watch any music documentary today, Melody Maker is the magazine that is continuously mentioned. It carved its own place in history. People remember reading it, they remember advertising in its classified ads, and they remember forming new bands from it. It is one of the most historical brands because it was publicised for such a long time, and because bands that went on to be world famous, such as Led Zeppelin, recruited new members through it.”

19) The seventh witness statement, dated 29 January 2009, is by Chris Charlesworth. He states that he has worked in the music industry as a writer, PR manager and editor which has left him fully acquainted with all aspects of the music business and more specifically the magazine and book publishing industry as it relates to rock music. He states that he would associate a magazine, musical recording, clothing or sponsorship using the mark Melody Maker with the magazine published by IPC. He would assume that it was being resurrected. He states that the mark applied for by NICE is identical to the masthead used for many years by the magazine.

20) The eighth witness statement, dated 30 January 2009, is by Deborah Morris of Carratu International plc an investigation agency. The only use of the mark by NICE that the company could find was on two websites, one of which stated “Melody Maker, the legendary music magazine, blossoms into a roaring fashion brand, from the news-stands to the shop window”.

21) Lastly, Anna Blackburn IPC’s Trade Mark Attorney filed three witness statements, dated 2 February 2009, 6 February 2009 and 19 May 2009. She states that she carried out a search of English language publications using Nexis UK for the term “Melody Maker”. For the period 1984 – 2009 more than 3,000 hits were returned. She also provides a copy of a book “In their

Own Write” which is a history of rock journalism. It begins in 1952 with Melody Maker and ends in 2000 with the closure of the magazine.

22) She provides a copy of a letter from Mark Radcliffe who has worked for the BBC as a radio presenter for nineteen years. Although this is strictly hearsay evidence, it has not been challenged. He states that if he saw a magazine, musical recording or concert with the words “Melody Maker” he would assume an association with the old magazine. He states:

“I believe that the words Melody Maker still carry today the reputation and power that they did in the past in respect of music-related goods and services, such that if a music product, and especially a magazine, was re-launched today under the brand, those words would have the power to influence the public to buy it.”

23) She states that, between 14 and 19 May 2009, she carried out a number of internet searches in relation to:

- a) the goods clothing, footwear and headgear;
- b) the goods and services sought to be registered by the IPC;
- c) the websites of some of the major operators in the fashion industry offering clothing, footwear and headgear;
- d) the websites of numerous undertakings providing the goods and services covered by the application of IPC.

24) The results are at exhibit AB1-4 respectively. These consist of:

- AB1: Pages from internet sites selling clothes, footwear and headgear. None also offer goods or services similar to those of IPC..
- AB2: Pages from internet sites offering goods and services identical/similar to those of IPC. None of which offer clothing, footwear or headgear.
- AB3: Pages from internet sites for major clothing retailers. They offer clothing, footwear, headgear and accessories such as belts, bags, purses, umbrellas, sunglasses, jewellery and watches.
- AB4: Pages from internet sites from, inter alia, You Tube, Yell, Sky, John Lewis, Amazon, Waterstones and Ryman. These offer goods and services identical to those of IPC, and some offer clothing, footwear and headgear. However, as IPC points out to the extent that some of the undertakings offer clothing, footwear and headgear for sale they do so in different and separate sections of the site and not in close proximity to the goods and services of IPC.

25) That concludes my summary of the evidence filed.



## DECISION

26) Subsequent to the hearing IPC withdrew the ground of opposition under Section 5(4)(b) with regard to opposition 96858 against application number 2471077.

27) I shall first consider the opposition against application 2471077 which is now based solely upon section 5(4)(a) which reads:

“5. - (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

28) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s 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 defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

29) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the Court of First Instance in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07*. In that judgment the CFI stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 18 March 2008.”

30) Applying this reasoning to these proceedings, the material date is the date of the application for registration. However, if there had been use of the trade mark by the applicant prior to the date of application this would have to be taken into account. It could establish that it was the senior user, that there had been common law acquiescence or that the existing position should not be disturbed and so NICE’s use would not be liable to be prevented by the law of passing-off (*Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.) As NICE filed no evidence it cannot be regarded as the senior user and the date of their application, 31 October 2007, is the relevant date.

31) With these considerations in mind I turn to assess the evidence. IPC published the *Melody Maker* magazine from 1926 until December 2000. Initially issued monthly, from 1933 it was published weekly. The magazine reported on the music scene covering most genres, it also contained advertisements for instruments, sheet music, electrical equipment connected to producing music, recorded music on vinyl, tape, CDs etc, as well as items such as clothing and also employment opportunities connected with music. The magazine enjoyed substantial success throughout its 67 years, with a circulation figure averaging over 86,000 copies per week. The magazine also recorded unknown artists and provided examples of their work free to readers by way of records/tapes and CDs attached to the magazine. Many of those featured went onto be highly successful and their initial recordings for the magazine are sought after. The magazine was purchased and read by members of the general public interested in music as well as those in the music profession or associated businesses. This evidence is unchallenged. IPC also claimed goodwill in relation to musical events such as festivals. The evidence provided showed that the

magazine sponsored certain events and that it had a marquee advertising its magazine at these events.

32) I first turn to consider the issue of goodwill. I was referred to two cases, *Ad-Lib Club Limited v Granville* [1971] FSR 1 and *Sutherland v. V2 Music Ltd* [2002] EMLR 28. In the latter case, Laddie J. held:

“H6. 1. If a party abandoned a business and the goodwill associated with it, he could not subsequently bring proceedings for passing off to protect that goodwill. He had relinquished any interest in the goodwill, and it was likely that he would be unable to show any damage because there was nothing left to damage. The temporary cessation of a business, however, did not necessarily destroy the goodwill in that business, although over time the goodwill would shrink and eventually disappear. As long as the owner of the goodwill had not abandoned it, it remained an asset protectable from damage by passing-off proceedings. Destroying the goodwill so that it was no longer an attractive force which would help the owner's business was but one form of damage of which the court could take notice.

[Star Industrial Co. Ltd v. Yap Kwee Kor \[1976\] F.S.R. 256 applied](#) . [Ad-Lib Ltd v. Granville \[1972\] R.P.C. 673](#) and [Thermawear Ltd v. Vedonis \[1982\] R.P.C. 44 followed](#) .

H7. 2. The law of passing off protected the goodwill of a small business as much as the large, but the court would not intervene to protect a goodwill which any reasonable person would consider as trivial.

H8. 3. It was likely that during the period 1993 to 1995 Liberty 1 was known to some tens of thousands of members of the public and admired by a significant number of them. Although memories of Liberty 1 must have faded for very many of them by 2001, the impact which Liberty 1 had made on the public had not disappeared. Although the case was very close to the borderline, Liberty 1 had retained a residual reputation among members of the public. In addition, Liberty 1 had a continuing, if small, reputation in the music industry.”

33) NICE contend that IPC had abandoned the business, however the evidence shows that IPC had invested a considerable sum in having every issue of the magazine ever produced scanned into a digital archive with a view to commercially exploiting the content. There is no evidence of any announcement that the magazine was closing forever. Indeed examples were given in evidence of other magazines ceasing publication in paper form and re-emerging some time later in a different format or as an annual rather than a weekly publication. In the instant case, less than seven years had elapsed between the last magazine being published (December 2000) and the relevant date (October 2007). Given the scale of the circulation over its 76 year life, which even at the final publication date was substantial (over 32,000), it is clear to me that IPC would have, at the relevant date, retained substantial goodwill in the mark MELODY MAKER with regard to printed publications.

34) Moving onto the question of the various vinyl records, tapes and CDs that were given away free with the magazine, NICE contends that these would not be viewed as being use of the mark in suit by IPC, but as ancillary use designed as a marketing gimmick. They contend that the

average reader would be aware that the publisher had obtained a job lot of goods and attached them to the magazine as an inducement to purchase. However, this ignores the evidence that these recordings were specifically made for the magazine by up and coming artists. It is clear from the evidence that a number of artists who made these recordings when they were unknown became world famous and the early recordings were then much prized. Because of this such “freebies” were not, I believe, regarded as being “a job lot” but were seen as being an extension of the magazine and its ethos of covering the latest artists as well as established figures. In my view IPC has shown that it had goodwill in records, tapes and CDs during the last four decades of its existence, which would have also lasted during the seven years from its final publication to the relevant date.

35) I must determine the average consumer for the goods and services of the parties. NICE contend that IPC’s magazine was aimed at 16-20 year olds interested in the “pop market”. They contrast this with the fact that their goods are used for all types of music as well as audio books, plays as well as historical programmes. They contend therefore that the average consumer should be the general public including businesses, a view which I agree with. However, I do not agree with their analysis of the average consumer of IPC’s product. IPC’s magazine may have been aimed mainly at a younger audience and had a content slant towards pop or rock music, but it is clear that it did comment on other musical genres and was purchased by others as set out in paragraph 31 above. Further, given its longevity those who read it in their teens and/or early twenties would still remember the magazine when considerably older, and they would form a substantial number of the general public.

36) Having established that IPC had goodwill in the mark “Melody Maker” for printed publications, records, tapes and CDs at the relevant date, I now turn to consider the issue of misrepresentation. In considering this issue I take into account the findings in *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] F.S.R. 155 where Mr. Justice Falconer held:

“(1) That the plaintiffs had established high reputation in the mark LEGO which extended beyond the field of toys and construction Kits; the mark LEGO was wholly distinctive of them and had in fact become a household work;

(2) The reputation of the plaintiffs mark and their goodwill was wide enough to extend to goods such as garden sprinklers and other irrigation equipment;

(3) That the use of the trade mark LEGO in relation to products of the defendants would mislead persons into thinking that those products were the goods of or connected with the plaintiffs;

(4) That expert evidence based on the results of a properly conducted survey of public opinion was admissible as evidence proving an external fact, namely public opinion:

[G.E. Trade Mark \[1969\] R.P.C. 418, Ch.D.](#) ; [\[1970\] R.P.C. 339, C.A.](#) and [\[1973\] R.P.C. 297, H.L.](#) ; [Customglass Boats Ltd. v. Salthouse Brothers Ltd. \[1976\] R.P.C. 589, considered](#) ;

(5) In the law of passing off as it has recently developed, there was no limitation in respect to the parties' fields of activity. Nonetheless, the proximity of the defendants' field of activity to that of the plaintiffs would be relevant as to whether the acts complained of in a particular case amounted to a misrepresentation;

Erven Warnink BV v. J. Townend & Sons (Hull) Ltd. [1980] R.P.C. 31 H.L., applied ;

(6) In relation to misrepresentation, the plaintiffs had established that there was a real risk that a substantial number of persons among the relevant section of the public would in fact believe that there was a business connection between the plaintiffs and the defendants;

(7) The effect of the defendants continuing to use LEGO in relation to their products would destroy that part of the plaintiffs' reputation in their mark LEGO and the goodwill attached to it. In view of the nature and extent of the plaintiffs' reputation in the mark LEGO, such use was calculated to injure the plaintiffs' goodwill in the sense that it was a reasonably foreseeable consequence that it would do so;

(8) As a substantial number of persons would think that the use of LEGO on or in relation to the defendants' products would indicate \*157 that they were the plaintiffs' goods, the inability of the plaintiffs to control such use involved a real risk of injury to their reputation in the mark and hence to their goodwill:

Draper v. Trist (1936) 56 R.P.C. 429 ; Henderson v. Radio Corporation Pty. Ltd. [1969] R.P.C. 218, considered ;

(9) The defendants' criticism of the market survey was not justified to any substantial extent.”

37) IPC have not established a reputation as strong as that shown by LEGO, but it is very considerable and has been built up over decades of use. Clearly, NICE's marks are dominated by the words “Melody Maker”. The words “since 1954” and “Years Of Rock” are considerably smaller than the first two words and are relatively non-distinctive. I take into account the comments in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, although I must still compare the marks as wholes. There is a clear visual, aural and conceptual similarity between the marks, with only minor differences which do not affect the way that the average consumer would view the marks. Clearly, “records tapes and CDs” are identical to “Sound Media” and also similar to “production of recorded music”. To my mind the reputation of IPC with regard to music, in printed form or recorded form is such that use of the almost identical mark by NICE with regard to “Musical productions” would also cause misrepresentation. In reaching my decision I take into account the comments of Morritt L J in the Court of Appeal in *Neutrogena Corporation and Another. v Golden Limited and Another* [1996] RPC 473, when he said, in effect, that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of members of the public would be misled into purchasing the applicant's products in the belief that they were the opponent's.

38) I must now go on to consider if IPC has suffered, or is likely to suffer, damage as a result of this misrepresentation. Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that “he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill”.

39) In the current case, both IPC's and NICE's marks contain, as the dominant and distinctive element, the words “Melody Maker”. Registration of NICE's mark would be in respect of goods and services that include, inter alia, “sound media” and “production of recorded music”, the same goods and services in respect of which IPC uses its mark. This being the case, people and businesses

familiar with IPC's magazine and recorded music would expect musical goods and services under the same name to be from the same undertaking that had used that name in the past. I have already found that, as such, there is a real likelihood of deception amongst a substantial number of the relevant public. Taking all this into account and considering the close similarity between the marks, I conclude that IPC's goodwill will be damaged in that, IPC may, for example, lose business to NICE because of the existence of a mistaken belief that NICE's musical goods and services are in fact those of IPC. It would therefore be deprived of its benefits.

40) The consequence of my findings is that IPC's opposition in respect of the grounds under Section 5(4) (a) of the Act is successful, and that application 2471077 should be refused in its entirety.

### **Application 2482051**

41) I now turn to consider the application by IPC to register the mark MELODY MAKER in Classes 9, 16, 35 & 41.

42) The opposition is based solely upon section 5(2)(b) which reads:

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

(a) ....

(b) it is similar to an earlier 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.”

43) An earlier trade mark is defined in section 6 of the Act, 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), Community trade mark or international trade mark (EC) 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,”

44) In these proceedings NICE was relying upon its two earlier marks. One, its International mark 839772, which was registered on 3 March 2006 and is therefore not subject to The Trade Marks (Proof of Use, etc) Regulations 2004. The other mark is application 2471077 which has been rejected for registration as a result of the successful opposition, and which will not feature as a consideration under this heading.

45) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd*

*Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM) C-334/05 P (LIMONCELLO)*. 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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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*,

(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.*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

46) In essence the test under Section 5(2) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the mark applied for and NICE's mark on the basis of their inherent characteristics, assuming normal and fair use of the mark on NICE's specification and IPC's specification as applied for.

47) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use

then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

48) The opponent has shown no use of its mark as outlined earlier in this decision. To my mind the opponent’s mark is inherently distinctive. The average consumer for the opponent’s products must be the average citizen of the UK including businesses.

49) I shall first consider the specifications of both parties.

Applicant’s specification (IPC)	Opponent’s specification (NICE)
<p>Class 9: Information stored in or on electronic and/or optical means; printed publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other networks; electronic files; electronic databases; electronic directories; pre-recorded digital media; downloadable digital media; webcasts; podcasts; vodcasts, podscrolls; computer software and computer programs; video and audio tapes, cassettes, discs and records; read only memory; magnetic data carriers; CDRoms; inter-active CDs; video CDs; DVDs; computer peripherals.</p>	<p>M839772 Class 25: Clothing, footwear, headgear.</p>
<p>Class 16: Printed matter; printed publications; books, manuals, magazines, periodicals, journals; atlases; bookbinding materials; stationery; instructional and teaching materials; calendars and posters; artists' materials; paper and goods made of paper; cardboard and goods made of cardboard.</p>	
<p>Class 35: Advertising and promotion services and information services relating thereto; arranging and placing advertisements for others; electronic shopping retail services connected with furniture, home furnishings, home appliances, household equipment and containers, garden equipment and appliances; provision of information and advice relating to the retailing of goods; compilation of information into computer databases and systemisation of computer databases; compilation of directories.</p>	
<p>Class 41: Entertainment and education services; cultural and sporting activities; live events; booking agency services; organisation of conferences, conventions, exhibitions, competitions and award ceremonies; presentation, distribution, syndication, networking and rental of television and radio programmes and of films and video recordings; provision of radio and television entertainment services; publishing services; publication of directories; electronic publishing services; information and advisory services relating to all the aforesaid services.</p>	

50) In carrying out the comparison I will take into account the authorities set out in paragraphs 45-47 inclusive above.

51) In its written submissions NICE relied upon the goods and services of its mark 2471077 to oppose the Class 9, 16 & 35 goods and services of IPC. As this mark has been successfully opposed I will not comment upon the submissions made by NICE.

52) Considering the specification of its International mark to that of the IPC's application, NICE contends

“With regard to NFM's class 25 goods, it is simply noted that IPC's own witnesses have stated that they would be confused by use of the mark in question on clothing.”

53) Firstly, I put little stock in these comments from the witnesses in relation to this opposition as they were considering the matter from the other angle. They would associate any mention of Melody Maker on clothing with IPC because of the reputation of the magazine. They are not stating that clothing is similar to other goods and services. This is a dog that will not hunt.

54) Taking account of all of the above when considering the marks globally, I believe that the goods and services applied for by IPC are so far removed from the goods of NICE in class 25 that there is no likelihood of consumers being confused into believing that the goods and services provided by IPC are those of NICE or provided by some undertaking linked to them.

## **FINDINGS**

55) For the sake of clarity I will set out here the decisions in both cases.

i) Application 2471077 by NICE. The opposition was completely successful under Section 5(4)(a).

ii) Application 2482051 by IPC. The opposition was unsuccessful under section 5(2)(b), NICE's application to be refused, IPC's application to be registered.

## **COSTS**

56) IPC has been completely successful in both actions. I also note that the opposition by NICE was particularly unfocussed. The fact that only one hearing was held in relation to the two cases reduces the overall costs. I order NICE to pay IPC the sum of £6,400 (see breakdown below). 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 14 day of January 2010**

**G W Salthouse  
For the Registrar  
The Comptroller-General**

Preparing a statement and considering the other side's statement	1200
Preparing evidence and considering and commenting on the other side's evidence	2000
Preparing for and attending a hearing	3000
Expenses	200
TOTAL	6400