

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE  
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

**THE BRITISH BROADCASTING CORPORATION**

**Applicant**

**and**

**ZAHRA PUBLISHING LIMITED**

**Opponent**

CONCERNING

**Trade Mark Application No. 2004/01082 (229932)**

**EASY COOK (series of two)**

**Background**

1. On 19 May, 2004, The British Broadcasting Corporation, a British company of Broadcasting house, Portland Place, London W1A 1AA, United Kingdom, made application (No. 2004/01082) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the series of marks shown below as a trade mark in respect of the following specification of goods and services in Classes 9, 16 and 41:

**EASY COOK**



**Class 9:** *Downloadable electronic publications and printed publications in electronically readable form.*

**Class 16:** *Paper, cardboard and goods made from these materials; printed publications; magazines; books; pamphlets; printed guides;*

*catalogues; programmes; photographs; stationery; artists' materials; paint brushes; instructional and teaching material; plastic material for packaging; printing blocks; posters; cards; postcards; greeting cards; trading cards; invitations; diaries; calendars; photograph albums; prints; paper and plastic bags; gift boxes; notepads; writing instruments and crayons; coasters; gift and luggage tags; ornaments of paper, card and papier mache; stickers; transfers; stamps; personal organisers; address books; note books; pen and pencil holders; desk mats; embroidery, sewing and knitting patterns; postage stamps, giftwrap.*

**Class 41:** *Provision of entertainment, education, recreation, instruction, tuition and training both interactive and non-interactive; production, presentation, distribution, syndication, networking and rental of audio, video, still and moving images and data whether in compressed or uncompressed form and whether downloadable or non downloadable; game services; production and rental of educational and instructional materials; publishing services (including electronic publishing services); exhibition services; organisation, production and presentation of shows, competitions, contests, games, concerts and events; language teaching; provision of language schools and language courses; provision of information and advisory services relating to any of the aforesaid services.*

2. The application was accepted for registration and advertised accordingly under No. 229932 in Journal No. 2002 on 8 September, 2004.
3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 7 December, 2004 by Zahra Publishing Limited, an Irish company of 19 Railway Road, Dalkey, Co. Dublin. The Applicant filed a counter-statement on 11 March, 2005 and evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. The opposition became the subject of a hearing before me, acting for the Controller, on 26 March, 2008. The parties were notified on 25 April, 2008 that I had decided to uphold the opposition and refuse registration of the series of trade marks in respect of certain of the goods and services, namely,

Class 9 – *all goods*

Class 16 - *Paper, cardboard and goods made from these materials; printed publications; magazines; books; pamphlets; printed guides;*

*catalogues; programmes; photographs; stationery; artists' materials; instructional and teaching material; printing blocks; posters; cards; postcards; greeting cards; trading cards; invitations; diaries; calendars; photograph albums; prints; notepads; stickers; transfers; stamps; personal organisers; address books; note books.*

Class 41 – *all services*

and to dismiss the opposition and allow the series of trade marks to proceed to registration in respect of the remaining goods, namely,

Class 16 - *Paint brushes; plastic material for packaging; paper and plastic bags; gift boxes; writing instruments and crayons; coasters; gift and luggage tags; ornaments of paper, card and papier mache; pen and pencil holders; desk mats; embroidery, sewing and knitting patterns; postage stamps, giftwrap.*

5. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) filed on 23 may, 2008.

### **Scope of the opposition**

6. The opposition is based on the series of marks shown below, which is registered in the Opponent's name under No. 229287 as of 3 November, 2003 in respect of the following goods and services in Classes 16 and 41:

**EASY FOOD**

**EASYFOOD**



**Class 16:** *Publications, periodicals, journals, magazines, books and catalogues; book markers, calendars and diaries*

**Class 41:** *Entertainment, education, training and instructional services; exhibitions, seminars and conferences, workshops; production presentation and rental of television and radio programmes and of films and sound and video recordings; publication; production and rental of educational and instructional materials; organisation of competitions and cultural events*

7. On the basis of its proprietorship of that registration and its claimed use of the trade mark EASYFOOD, the Opponent raises objection against the present application under Section 10(2)(b) and Section 10(3) of the Act. It also alleges that the application for registration was made in bad faith by the Applicant and that it is, therefore, contrary to Section 8(4)(b) of the Act. Finally, it asserts that the Applicant does not have a *bona fide* intention of using the series of marks applied for in relation to all of the goods and services of the application and that registration would therefore be contrary to Sections 37(2) and 42(3) of the Act. Further grounds of objection were raised in the notice of opposition but these were neither substantiated by evidence nor supported by any argument at the hearing and I am satisfied that they may simply be ignored.

#### **The evidence filed and facts claimed**

8. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits JM1-JM148) dated 14 September, 2005 of John Mullins, its Commercial Director. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits SLP1-SLP4) dated 20 July, 2006 of Susan Lydia Payne, Brand Protection Manager of BBC Worldwide Limited, a wholly-owned subsidiary of the Applicant. Evidence in reply submitted by the Opponent under Rule 22 consisted of a second Statutory Declaration (and Exhibit JM15) dated 18 June, 2007 of John Mullins.
9. I would summarise the relevant facts averred to in the evidence as follows. The Opponent launched a bi-monthly recipe magazine under the name EasyFood in the Republic of Ireland and Northern Ireland on 24 November, 2003. The magazine contains information and tips on food, preparation and cooking of food, diet, nutrition and food safety. By the time of the filing of the present application (the “relevant date” for these proceedings), the Opponent had published three issues of EasyFood magazine, with sales in Ireland and the United Kingdom of

20,754, 18,790 and 19,141 copies respectively. Turnover (sales and advertising revenue) for the same period amounted to approximately €3,000. The magazine is available throughout the State in Dunnes Stores, Tesco Ireland, Spar, SuperQuinn, SuperValu, Centra and Easons as well as in a number of newsagents. It is also sold in London and elsewhere in the United Kingdom. Since 10 May, 2004, a 30-minute radio show entitled The Easy Food Show has been broadcast in the Dublin area on Anna Livia 103.2 FM.

10. The Applicant became aware of the Opponent's EasyFood magazine in February, 2004. At that time, the Applicant had plans to launch a magazine under the name EASY FOOD in the United Kingdom and, having undertaken trade mark searches and enquiries as to the use of the name EASY FOOD, it decided to proceed with those plans. In May, 2004, following the announcement by the Applicant of the launch of an EASY FOOD magazine, Mr. Mullins of the Opponent contacted the Applicant and informed it that the Opponent had plans to sell its magazine of that name in the United Kingdom. The Applicant decided to change the title of its proposed magazine to EASY COOK and informed Mr. Mullins accordingly by telephone on 17 May, 2004. Some correspondence ensued between the Opponent's legal representatives and the Applicant but it appears to have come to nothing. The Applicant subsequently commenced use of the name EASY COOK in the United Kingdom but has not yet sold magazines under that title in this jurisdiction although the name has been promoted since as early as July, 2004 in other publications of the Applicant, which circulate here.

#### **The hearing and arguments of the parties**

11. At the hearing the Opponent was represented by Simon Gray, Trade Mark Agent of Tomkins & Co. and the Applicant by Shane Smyth and Carol Gormley, Trade Mark Agents of F.R. Kelly & Co.
12. Mr. Gray argued the Opponent's case on the basis of the strong visual, aural and conceptual similarities between the trade marks EASY FOOD and EASY COOK combined with the fact, as he claimed, that the average consumer could not be expected to exercise such care in the selection of a low-cost item such as a magazine as to negate the likelihood of confusion arising from the simultaneous

use of two such similar names. He asserted that the evidence showed that the Opponent's magazine had very rapidly achieved a high degree of success and he argued that the use by the Applicant of a very similar name in respect of an identical product would clearly take unfair advantage of that success. The application for registration was characterised by a lack of *bona fides* on the Applicant's part as the Applicant clearly knew of the Opponent's trade mark and its use in the jurisdiction but proceeded with the application nevertheless. It was also questionable as to why the Applicant, a U.K. company, had filed for registration first within this jurisdiction and used that filing to claim priority for its subsequent application for registration in the United Kingdom, its home market.

13. Mr. Smyth replied to the effect that, although there are undeniable similarities between the respective trade marks EASY FOOD and EASY COOK, those similarities are not such as to lead to a likelihood of confusion on the part of the average consumer. The Opponent's trade mark is descriptive of the subject matter of the magazine published under that name and must, therefore, be seen as displaying a very low level of inherent distinctiveness such that the scope of protection afforded to it must be narrowly defined. A likelihood of confusion should not be inferred from the inclusion in the Applicant's trade mark of elements that are also descriptive of the goods in question as such a finding would serve to bestow on the Opponent an unjustified monopoly in relation to such descriptive terms. Contrary to the Opponent's assertion, the average magazine reader must be assumed to exercise a degree of discernment in the selection of those goods as his purpose is not simply to acquire a magazine, *per se*, but to purchase the specific magazine that interests him and to which he may be expected to have developed a certain loyalty by habitual use. Magazines are normally displayed on open shelves and grouped according to subject matter and, although different magazines relating to the same subject matter may have similar names, nevertheless, consumers are used to distinguishing between them without confusion.

14. Ms. Gormley denied that the Opponent's mark enjoyed the high reputation claimed by Mr. Gray. The evidence showed that the Opponent's mark had been in use for only a very short period of time prior to the relevant date and the claims

with regard to the level of sales of the Opponent's EASY FOOD magazine relative to other popular publications had not been properly substantiated. The onus was on the Opponent to show that its trade mark had the requisite reputation to ground an objection under Section 10(3) of the Act and it had failed to do so.

15. Finally, Mr. Smyth asserted that the objection to registration under Section 10(2) of the Act was not available to the Opponent in respect of certain goods included in the application for registration as those goods are not identical with or similar to any in respect of which the Opponent's mark is protected. The goods he named in this regard are in Class 16, namely, *paint brushes, plastic material for packaging, paper and plastic bags, gift boxes, writing instruments and crayons, coasters, gift and luggage tags, ornaments of paper, card and papier mache, pen and pencil holders, desk mats, embroidery, sewing and knitting patterns, postage stamps and giftwrap.*

## **Grounds of decision**

### ***Relative grounds objections***

#### *Section 10(2) – likelihood of confusion*

16. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

*(2) A trade mark shall not be registered if because –*

*(a).....*

*(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.*

#### *The respective goods and services*

17. I consider, first of all, the Applicant's assertion that the objection under Section 10(2) cannot apply in respect of the goods listed in paragraph 15. It is clear from the wording of the provision that a certain similarity as between the respective goods/services must be established for the question of likelihood of confusion to

arise and I agree with the Applicant that no such similarity exists between the goods in question and the goods and services for which the Opponent's trade mark is protected. None of the goods mentioned in paragraph 15 has a similar purpose to any of the goods or services covered by the Opponent's earlier registration. Nor does any of them constitute an alternative or complementary product to any of those for which the Opponent's mark is protected. Certainly, some of the goods in question share some of the physical properties of the goods covered by the Opponent's earlier registration but they cannot be regarded as similar goods for present purposes on that account alone. So, for example, *calendars* and *diaries* (in the Opponent's earlier registration) and *gift and luggage tags* and *postage stamps* (in the application for registration) are normally made of paper, and thus fall within Class 16, but they would not be regarded, on an objective assessment, as in any way linked or related goods. The average consumer would not make a connection between the respective goods or expect them to emanate from the same or economically related undertakings. So, notwithstanding that the goods in question fall within Class 16 and that the Opponent's mark is protected for goods in that Class, nevertheless, there is no real similarity between the respective goods and the application therefore escapes the objection under Section 10(2) insofar as it concerns the goods referred to in paragraph 15.

18. As regards the other goods and services covered by the application for registration, I note, firstly, that the Applicant did not advance the same argument at the hearing in respect of those goods and services to the effect that they are not similar to the goods and services covered by the Opponent's earlier registration. I take that as tacit acceptance on the part of the Applicant that the goods and services in question are similar to those of the earlier mark. In my opinion, they clearly are. The Class 9 goods of the application are essentially the same goods, albeit in electronic form, as *publications* in Class 16 for which the Opponent's earlier trade mark is protected. The Class 16 goods of the application in respect of which I have decided to refuse registration include several items that fall within the general description of "printed matter" (*printed publications, magazines, books, pamphlets, printed guides, catalogues, programmes, instructional and teaching material, cards, postcards, greeting cards, trading cards, invitations, calendars*) which are identical with or similar to the like goods covered by the



earlier registration (*publications, periodicals, journals, magazines, books and catalogues, calendars*). They also include a number of stationery items (*stationery, artists' materials, printing blocks, photograph albums, notepads, stickers, transfers, stamps, personal organisers, address books, note books*) which are similar to the stationery items (*book markers and diaries*) for which the earlier mark is protected. The items, *photographs, posters and prints*, of the application for registration may be regarded as similar to *publications* of the earlier registration as the latter goods would include items containing the former goods. Finally, the designation, *paper, cardboard and goods made from these materials* included in the application for registration embraces all of the items included in Class 16 in the earlier registration. As regards Class 41, I consider that all of the services specified in the application for registration may be seen as falling within the designation, *entertainment, education, training and instructional services* for which the Opponent's earlier mark stands protected.

19. The identity/similarity of the respective goods and services having been accepted, the question turns, essentially, to a comparison of the respective trade marks, an assessment of the distinctiveness of the earlier mark and, ultimately, an assessment of the extent to which there may be said to be a likelihood of confusion between the marks in the ordinary course of trade in the goods and services. Not surprisingly, these were the questions on which the parties' representatives were sharply divided at the hearing.

*The comparison of the trade marks*

20. While both the Opponent's earlier trade mark and the trade mark propounded for registration by the Applicant are in the nature of series of marks, displaying some figurative elements, I think it sufficient to undertake the comparison of the marks by reference simply to the names EASY FOOD and EASY COOK. That was the approach taken by the parties' representatives at the hearing and, in my view, it is the sensible approach as the overall identity of each of the respective marks is determined by its verbal content and the visual impact of the respective figurative elements is so small as to be not worthy of serious consideration in the comparison of the marks. As in all cases of this kind, it is necessary to compare the marks on visual, aural and conceptual criteria, having regard both to the

overall impression formed by the marks and to the relative importance of those criteria in informing the average consumer's perception of trade marks used in relation to the categories of goods and services in question.

21. Visually, the trade marks are highly similar because they each consist of two words of equal length and they share 6 of their 8 letters in common, which letters are identically arranged in the respective marks. Furthermore, the double O in the second word of each mark is visually striking relative to the remainder and the presence of this feature heightens the visual similarity between the marks. The marks also display a high degree of aural similarity, the first two of their three syllables being identical and the third highly similar. While the words "food" and "cook" are not apt to be mistaken for each other through mishearing given ordinary pronunciation, nevertheless the difference in sound between those words is not sufficient to dislodge the overall phonetic similarity between EASY FOOD and EASY COOK.
  
22. As regards conceptual similarity, I take the view that EASY FOOD and EASY COOK each conveys the concept of easiness in relation to the preparation of food. Because food, *per se*, cannot properly be described as "easy", the immediate message given by EASY FOOD is, in my view, "easily *prepared* food". In the context of the name of a magazine, which is the Applicant's primary intended use of its trade mark, the name EASY FOOD would be taken by the average person to suggest content relating to foodstuffs that are easy to prepare and cook as well as recipes for meals that may be prepared relatively quickly and by persons who do not have great culinary skills. That is exactly the message given by the name EASY COOK so that, in my opinion, the marks may be regarded as conceptually identical.
  
23. In this regard, I reject the argument advanced on behalf of the Applicant to the effect that the term EASY FOOD constitutes an unusual juxtaposing of the adjective "easy" with the noun "food" whereas the term EASY COOK is syntactically correct. There is no appreciable difference between the marks in terms of syntactic peculiarity and the reasoning informing my earlier decision in

relation to EASYJET and EASYMOVES<sup>1</sup> is not applicable here. In this case, the concept evoked by both trade marks EASY FOOD and EASY COOK is the same and that concept is not hidden or clouded by any particularly unusual arrangement of the words forming the marks.

24. I turn now to consider whether greater importance should be attached to one of the grounds of comparison – visual, aural or conceptual – over and above the others. That question must be decided by reference to the category of goods or services under consideration and it is apparent that the present application covers a range of different goods and services. However, the matter was argued before me at the hearing entirely by reference to the goods of primary interest to both the Applicant and the Opponent, namely, food-related magazines and I think it appropriate that I should also focus on those goods first and foremost.

25. There seemed no dispute between the parties at the hearing that the visual comparison is more important than the aural in the context of trade marks relating to magazines because those goods are normally displayed for sale on open shelves so that the consumer's selection is usually based on a visual inspection rather than by asking a sales assistant for the goods by name. As I have noted above, there is a high degree of visual similarity between the marks in this case. It is usual also for magazines to be displayed for sale grouped or arranged by reference to their subject matter so that all the magazines relating to a particular topic are displayed together. The Applicant argues that this reduces the significance of any conceptual similarity that may exist between the marks because, in the context of magazines relating to food and cooking, one must expect that the trade marks used will make reference to that subject matter so that consumers will not be surprised to find similar-meaning marks on the goods of different undertakings. There is certainly merit in that argument and it would clearly be wrong to overstate the importance of conceptual similarity in the context of magazine names, the purpose of which is, at one level, to inform the consumer of the type of content they address. However, I do not agree that it follows that the conceptual similarity as between EASY FOOD and EASY COOK should be disregarded entirely in the

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<sup>1</sup> Decision dated 12 July, 2007 in the matter of Trade Mark No. 226996 in the name of Colin Jarrett and opposition thereto by Easygroup IP Licensing Limited

context of the assessment of the likelihood of confusion between those trade marks, even as applied to food and cooking related magazines. After all, the conceptual message given by both EASY FOOD and EASY COOK is not simply generic, as in, “*this is a food/cooking magazine*”, it is specifically to the effect that the content of the magazine is focussed on ease and convenience in food preparation and each mark conveys that message using the same grammatical device, i.e., the word EASY as prefix. So, while conceptual similarity may not normally be a relevant factor in the context of these specific goods, the fact that these marks evoke the same, specific concept and do so using an almost identical arrangement of words is, in my opinion, a relevant factor in the assessment of likelihood of confusion in this case.

*The distinctiveness of the earlier mark*

26. In the assessment of the likelihood of confusion between trade marks, it is established that the more distinctive the earlier trade mark is, whether inherently or by virtue of the use that has been made of it, the greater will be the likelihood of confusion arising from the use by a competitor of a similar trade mark<sup>2</sup>. The Opponent claims that its trade mark EASY FOOD is inherently distinctive and that it had acquired an additional factual distinctiveness through the use made of it prior to the filing of the opposed application. The Applicant argues that EASY FOOD displays only a very low degree of distinctiveness, because it makes an obvious allusion to an essential characteristic of the goods to which it relates, i.e., the subject matter of the magazine of that name. It asserts also that the limited use made of the mark prior to the relevant date does not entitle it to any higher degree of protection based on claimed factual distinctiveness. On both on these questions, I agree with the Applicant.

27. As regards the inherent distinctiveness of the trade mark EASY FOOD in relation to a food-related magazine, I would say that the mark possesses the distinctive character required for registration but no more than that. In other words, it is not devoid of any distinctive character so that the average person, on encountering it once used as a trade mark for the relevant goods, would, on a subsequent

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<sup>2</sup> paragraph 24 of European Court of Justice decision of 11 November, 1997 in Case No. C-251/95, Sabel BV v Puma AG and Rudolf Dassler Sport

occasion, recall the mark and make the requisite connection between the goods bearing it and those that he had previously seen marketed under that name. The mark does not, however, display any particular inventiveness or novelty that might serve to imbue it with a high degree of distinctive character. In fact, it is a rather obvious and banal name.

28. As to the claim of factual distinctiveness acquired through use, it is for the Opponent to prove that the mark had become known and identified with its goods by a substantial section of the relevant consumers as of the relevant date, the date of filing of the present application. In my opinion, it has failed to do so. Its evidence is to the effect that it had published three editions of the EASY FOOD magazine, totalling approximately 60,000 copies, prior to the relevant date. The publication was, therefore, still relatively new to the market at that time and the reasonable assumption must be that it was still in the early stages of the process of building its brand identity and customer loyalty. There is nothing in the Opponent's evidence on which one could rely to dislodge that assumption or to support the claim that its trade mark had acquired a particular factual distinctiveness by virtue of the use made of it prior to the relevant date. For these reasons, I find that the Opponent's trade mark is not to be treated as highly distinctive for the purposes of the assessment of the likelihood of confusion.

29. Before proceeding to make that assessment, I think it appropriate to address the consequences of the latter finding, particularly in the light of the argument presented at the hearing on behalf of the Applicant to the effect that the level of protection to be afforded to the Opponent's earlier trade mark should be commensurate with its distinctiveness (or lack of it), lest an unjustified monopoly in ordinary descriptive words be bestowed on the Opponent. It would be wrong, in my opinion, to take the logic of that argument so far as to effectively deny the Opponent's earlier trade mark the protection given to registered marks by the Act. In other words, while the Opponent's mark may not be entitled to the enhanced level of protection accorded to marks having a high distinctive character, it is, nevertheless, a registered trade mark and must be treated as having ordinary distinctiveness for the purposes of the assessment of likelihood of confusion. In making that assessment, I am required only to consider the likely effect on the

perception of the average consumer arising from the simultaneous use of both the Opponent's and the Applicant's marks in relation to the relevant goods and services. I am not permitted to import into the assessment of likelihood of confusion considerations of the monopoly effect of the Opponent's earlier trade mark registration or of the need to keep descriptive words free for use by all traders in circumstances where the validity of the Opponent's registration has not been challenged by the Applicant.

*Likelihood of confusion*

30. In deciding this case, I have been guided, as always, by the principle that the likelihood of confusion must be appreciated globally, having regard to all of the relevant factors and that it must be judged from the perspective of the average consumer of the goods or services in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely instead on the imperfect picture of them that he keeps in his mind. As I have already noted, the present application relates to a range of goods and services, for which the typical purchasing scenario may differ from one to the next but the parties have focussed their arguments on the likelihood of confusion between the respective marks used in relation to a food magazine and I have mainly considered that scenario also.

31. In doing so, I have not looked at matters from the point of view of the person who has a particular familiarity with and loyalty to the Opponent's magazine and takes great care to ensure that he purchases it and no other. Nor have I considered the person who has a rather vague recollection of the name of the Opponent's magazine and is apt to choose, without particular attention, any publication whose title suggests content of a similar nature. Those were the extremes suggested on behalf of the Applicant and the Opponent, respectively, in support of their competing arguments on the question of the likelihood of confusion but, in my opinion, neither fits the description of the average consumer for present purposes. I think it correct to consider the matter from the perspective of the person who has encountered the Opponent's EASY FOOD magazine on, perhaps, one or two occasions and who subsequently finds a magazine entitled EASY COOK while browsing the relevant section of a newsagent's or other retail outlet. Given the

periodical nature of these publications, one must assume a certain lapse of time between the average consumer's exposure to each new edition of a particular title; indeed, the appearance on the newsstands of the latest edition is often his cue to purchase.

32. So, what is the likelihood that the average person noticing an edition of EASY COOK magazine for sale bearing a recent date might wrongly take it to be the latest edition of the EASY FOOD magazine that he had previously purchased? In my opinion, there is a real and definite likelihood of confusion in that scenario. The overall visual and conceptual impressions of the two names are so similar that a person exercising ordinary care could easily mistake one for the other in the context of their use on magazines, which are purchased periodically and by reference to their subject matter. That is not to say that a person directly comparing the two titles side by side would confuse them or even assume a connection between the two. He might well not. He might simply deduce that two competitors had chosen very similar, but fairly obvious names for their respective publications in the convenience cooking/recipe market. But side by side comparison of marks is not the context in which the likelihood of confusion is to be assessed. Regard must be had, rather, to the person who knows the earlier trade mark and then discovers the like goods for sale under the later mark. In the present case, I take the view that confusion is likely between two rather uninspiring trade marks because they mirror each other almost identically in their look, sound, meaning, make-up and, indeed, in their banality. It was argued on behalf of the Applicant at the hearing that, in view of the very low degree of distinctiveness of the Opponent's mark, a finding of likelihood of confusion could only be justified if the marks were virtually identical. In my opinion, they are virtually identical! It would be very easy to mistake one for the other and the simultaneous use of them by different undertakings would inevitably lead to confusion.

33. As I have indicated, the parties' representatives did not see fit to address the question of likelihood of confusion in relation to any of the goods or services covered by the application for registration other than food-related magazines. I do not propose to do so in any detail either. I find it sufficient to say that, although

the profile of the average consumer and the typical purchasing scenario may differ as between each of the goods and services in question, I find no reason to believe that the likelihood of confusion that I have identified in relation to the use of the respective trade marks on magazines would be affected to any significant degree by those differences. At the end of the day, the high degree of similarity between the marks, coupled with the assumption of less than perfect memory on the part of the average consumer, leads to a likelihood of confusion and there is no special circumstance of trade in any of the goods or services of the application for registration that are similar to those covered by the earlier mark which would operate to reduce or eliminate that likelihood. For these reasons, I have decided that the application for registration should be refused in respect of all of the goods and services other than the goods mentioned in paragraph 15.

*Section 10(3) – unfair advantage or detriment*

34. Section 10(3) of the Act provides that a trade mark shall not be registered if it is identical with or similar to an earlier trade mark if the earlier trade mark has a reputation in the State and the use of the later trade mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark. The Opponent claims the benefit of this Section of the Act, which, if applicable, would extend the grounds for refusal to cover also the goods mentioned in paragraph 15 which are not similar to those for which its earlier trade mark stands protected. As I have indicated above, however, I am not satisfied that the Opponent's evidence proves that its trade mark had acquired any significant additional factual distinctiveness by virtue of the use that had been made of it as of the relevant date. It follows that I do not accept that the trade mark had a reputation in the State as of that date and I find, therefore, that the opposition should be dismissed insofar as it is grounded on Section 10(3) of the Act.

***Absolute grounds objection***

*Bad faith*

35. Section 8(4)(b) of the Act prohibits the registration of a trade mark if, or to the extent that, the application for registration is made in bad faith by the applicant. Although the Opponent included a ground of opposition based on the allegation of



bad faith in the notice of opposition, it did not particularise the charge in any way but sought, though argument and innuendo, to characterise the Applicant's filing of the application in this jurisdiction as somehow improper or underhand. I find, therefore, that the charge of bad faith has not been properly made and that it does not fall to the Applicant to rebut it.

***Objection that requirements for registration not met***

*No intention to use*

36. Section 37(2) of the Act requires an applicant for registration of a trade mark to include in the application a statement that the trade mark is being used, by or with the consent of the applicant, in relation to the goods or services specified in the application, or that the applicant has a *bona fide* intention that it should be so used. Section 42(3) provides that the Controller shall refuse an application if the applicant fails to satisfy him that the requirements for registration have been met. The Opponent has raised objection under these provisions, claiming that the Applicant did not have a *bona fide* intention to use the series of trade marks applied for in relation to all of the goods and services of the application. It has not, however, given any evidence in support of that claim. As with its allegation of bad faith, it has, rather, engaged in speculation as to the Applicant's intentions and sought to put a spin on statements made in the Applicant's evidence and in the previous correspondence between the parties relating to the proposed launch by the Applicant of a magazine entitled EASY FOOD in early 2004. That is simply not a credible basis on which to advance what is, in essence, a claim that the Applicant lied in making its statement of intended use of its trade mark when it filed the present application for registration. The fact is that the application contained the statement required by Section 37(2) and no objection can lie against it based on that provision. The Opponent can challenge the veracity of that statement but, if it does so, it is effectively alleging bad faith against the Applicant and it falls under the strict requirements to particularise and prove that charge. It has not done so and, accordingly, I dismiss the opposition on this ground also.

Tim Cleary  
Acting for the Controller  
6 June, 2008