

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO: 1488881  
BY PORTLAND PUBLISHING LIMITED TO REGISTER THE  
TRADE MARK

**FORWOMEN**

AND

IN THE MATTER OF OPPOSITION BY  
IPC MAGAZINES LIMITED  
THERE TO UNDER OPPOSITION NO: 44843

## DECISION

On 25 January 1992, Portland Publishing Limited applied under Section 17(1) of the 1938 Trade Marks Act to register the following trade mark in Class 16:

### FORWOMEN

5 The original specification for which the mark was filed, was as follows:

‘Printed matter, books, magazines, monographs, photographs, instructional and teaching material (except apparatus); playing cards, paper, cardboard and goods made from these materials’.

10 Following examination of the application under the 1938 Act, the application was subsequently converted to an application under the 1994 Act, and was accorded a new filing date of 31 October 1994. Following re-examination of the application under the 1994 Act, evidence of acquired distinctiveness was submitted, and the application was accepted and published for the following goods:

‘Erotic magazines’.

15 The application is opposed by IPC Magazines Limited on the following grounds:

Ž under Section 3(1)(b), as the mark is devoid of any distinctive character,

Ž under Section 3(1)(c), as the mark consists exclusively of signs or indications which may serve in the trade to designate the kind, intended purpose, or other characteristics of the goods specified in the application,

20 Ž under Section 3(1)(d), as the mark consists exclusively of signs or indications which have become customary in the current language or in the bona fide or established practices of the trade,

25 Ž under Section 3(1)(b), as the mark is of such a nature as to deceive the public as to the nature of the goods. Given the manner in which this ground of opposition is worded, I have assumed that this ground goes to Section 3(3)(b) of the Act, and not Section 3(1)(b) as indicated.

30 A counterstatement was provided by the Applicants denying the grounds of opposition. Both sides ask for an award of costs in their favour, with the Applicants pointing out that they were not warned of the possibility of opposition, nor were they requested to withdraw the application.

Both sides filed evidence in these proceedings, and the matter came to be heard on 11 November 1999. The Applicants for registration were represented by Mr G Fernando of Counsel, the Opponents were represented by Mr A Bernard of F J Cleveland.

### **OPPONENTS EVIDENCE**

5 This consists of a Statutory Declaration by Elizabeth Watkinson. Ms Watkinson, currently employed as a publisher in the Womens Weeklies department of the Opponents, explains that she has been employed by them since August 1994. Since that time, she has held various positions in the company which have included Sales Executive, Account Manager, Client Account Manager and Marketing Manager. In her opinion this background makes her well  
10 placed to give an informed view of the products and buying processes which take place in the publishing field.

Having given some background to the size and scope of the Opponents trading activities, Ms Watkinson then explains that the Opponents publish seven weekly and sixteen monthly magazines aimed exclusively at women. Examples of the titles published are provided.  
15 Apparently, the Opponents and other publishers attempt to closely target a specific area of the market, and identification with a particular magazine is of paramount importance to a magazine's success. Ms Watkinson goes on to say that the words FOR WOMEN are widely used by the Opponents and other publishers on their magazines, and on advertising and promotional material relating to them. In Ms Watkinson's view, the words FOR WOMEN are  
20 generic, as they appear on marketing literature produced by numerous different publishers.

To support her contentions, Ms Watkinson refers to a range of magazines at Exhibit EW1, in which the words FOR WOMEN appear in what she believes to be a descriptive sense. I note the words appearing in the following forms:

25 PRIDE magazine: 'For Women of Colour', WOMAN & HOME magazine: 'For women who know what they're about', WOMANS JOURNAL: 'super food for women'. Other examples are provided, but in my view, these are the most relevant. In Exhibit EW2, Ms Watkinson points to use of the word FOR WOMEN (by the Opponents) in connection with the launch of their EVA publication in 1994, and in Exhibit EW3, Ms Watkinson refers to further use of the words FOR WOMEN in a brochure entitled 'Advantage', produced by the Opponents in the  
30 summer of 1995.

Having reviewed all of these Exhibits, I note that the vast majority of the references provided by the Opponents, are after the material date in these proceedings. That said, I am conscious of the comments of Mr Bernard at the hearing, where he drew a distinction between the material date on which the Applicants must rely, i.e. the application date of 31 October 1994,  
35 and the acceptability of the Opponents evidence which (in the main) post dates the application. Mr Bernard pointed out that the Opponents evidence ought to be considered acceptable where it assists the Tribunal in answering the following question: 'Would it be likely that other traders would want to use this?', i.e. the words FOR WOMEN. I agree.

## APPLICANTS EVIDENCE

5 The Applicants filed two Statutory Declarations in support of the application. The first is by Gillian Smaggasgale, a partner in the firm of Mathys & Squire, who are the Applicants' trade mark agents. I do not need to summarise Ms Smaggasgale's declaration in detail, but will bear its contents in mind when reaching my decision. In short, the declaration points out that the documents provided at exhibits EW1-EW3 of the Opponents' evidence post date the application and, as such, are not relevant. Secondly, the declaration points out that where the words FOR WOMEN do appear, they only do so in the context of a phrase or sentence, or where other words appear between them.

10 The second declaration is from Jonathan Richards who is the Group Managing Editor of Fantasy Publications Limited, the Applicants' company. The Applicants are part of the Northern & Shell Plc, and Mr Richards explains that he has been with the company since May 1986, and has held his current position since June 1993. Mr Richards comments that this application has now been assigned to his company from the original owners Portland  
15 Publishing Limited.

Mr Richards explains that in order to fulfill a perceived need in the market place for an erotic publication catering to the female population, the Applicants launched the magazine FOR WOMEN in April 1992. This 'spring special' had to be reprinted three times to meet the demand, and ultimately sold some 400,000 copies in three weeks. He adds that the magazine  
20 was published monthly from July 1992.

At JR1 Mr Richards exhibits copies of front covers of the magazines. Having reviewed these covers I note that some are after the material date in these proceedings. The others are of little assistance, as they are such poor photocopies the dates (if any) are unreadable. However, what is clear is that in each case the mark is used as two separate words i.e., FOR  
25 WOMEN and, as such, is not the mark as applied for i.e. FORWOMEN (as one word).

Mr Richards adds that the mark has featured extensively in the press, and at Exhibit JR2 he exhibits examples of such references. Whilst I note that these references are from a wide range of publications and pre-date the material date, once again, all the references are to the words FOR WOMEN as two words.

30 Mr Richards continues that in August 1992, the Applicants launched a further publication entitled WOMEN ON TOP, followed by WOMEN ONLY in September 1992. However, towards the end of 1992, it was decided to merge these titles with FOR WOMEN, and the magazines were relaunched (as one publication) in January 1993, under the title FOR  
WOMEN. Exhibit JR3 is a list of press cuttings concerning the re-launch.

35 Mr Richards adds that the publication has been sold throughout the UK. He continues that following the early interest in the magazine circulation has settled to approximately 35,000 copies per month. He then provides turnover figures from the date of first use to August 1997. However, I can of course only take account of sales up to 31 October 1994, and from the figures provided, I would estimate turnover in the relevant period to be in the order of £2  
40 million.

In so far as promotion of the mark is concerned, Mr Richards explains that given the high level of media attention the magazine has attracted, it has not been necessary to spend much effort in promotional activities or in advertisements. However, from July 1992 to the date of application, approximately £350,000 has been spent on promoting the magazine. Mr Richards further explains that the magazine's Editor is regularly interviewed by other magazines, and also on radio and television programmes. In addition, in 1993, the Applicants presented a live show known as the Xposure tour 1993.

This show took place in a range of locations in the UK, and promotional and merchandising material associated with the show are shown at Exhibits JR4 and JR5. Once again, I note that where the mark does appear, it is always shown as two words i.e., FOR WOMEN.

That concludes my review of the evidence in so far as it is necessary.

### **THE DECISION**

At the beginning of the hearing a preliminary point arose. Mr Fernando for the Applicants, sought to have all of the Opponents' evidence filed in these proceedings disregarded as irrelevant. He argued that all of the Opponents' evidence referred to the words FOR WOMEN (presented as two words), whereas the mark which is the subject of this application was for FORWOMEN (one word). Mr Bernard for the Opponents said that the evidence filed was clearly relevant, as the use of the words FOR WOMEN presented as two words had a clear impact on the registrability or otherwise of the word FORWOMEN presented as one word.

Having considered both sides submissions on this point, I took the view that the acceptability or otherwise of the evidence filed by the Opponents could only be fully determined when both sides had made their substantive submissions. I also said that I would consider Mr Fernando's verbal and written submissions further. Having done this, I have come to the conclusion that I cannot regard the Opponents' evidence as irrelevant. Mr Fernando argued that FORWOMEN was a portmanteau word and an invented word. I think it is neither. First, a portmanteau word blends the meaning of two words - as in WHISQUEUR ('whisky' and 'liqueur') - into one; FORWOMEN is two words put together. Elision of two such words will make little difference to their meaning (see COFFEEMIX [1998] RPC 20 717, at 725). Further, as was pointed out by Mr Bernard, the Applicants' evidence does not make the distinction made by Mr Fernando anymore than the Opponents' evidence. FOR WOMEN is used repeatedly, and the Applicants obviously did not consider the elided form of the mark to be significantly different from the un-elided form at the evidence gather stage.

Mr Fernando also argued that, following examination, there was a presumption of validity on the mark proposed to be registered. This is not the case. Such a presumption only applies to registered marks (see s 72). I make this point because it was returned to at the end of the Hearing by Mr Fernando where it seemed to form an important part of his case.

Having consider this preliminary issue, I now turn to consider the main grounds of opposition. These are based on Sections 3(1)(b)(c) and (d) of the Act.

Section 3(1) of the Act reads as follows:

(1) The following shall not be registered-

(a) .....

(b) trade marks which are devoid of any distinctive character,

5 (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 of 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;

10 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.

In their notice of opposition, the Opponents claim that the mark is of such a nature as to deceive the public as to the nature of the goods. Section 3(3) of the Act reads as follows:

15 (3) A trade mark shall not be registered if it is-

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

20 No evidence was filed to support this ground of opposition, nor were any oral arguments provided. This ground is therefore dismissed.

Turning now to the main grounds of opposition under Sections 3(1)(b)(c) and (d) of the Act, at the Hearing Mr Fernando accepted that, in so far as the words FOR WOMEN (two words) were concerned, the comments of Ms Watkinson in her Declaration (see paragraphs 3 and 4) were correct, and were not contested. Indeed Mr Fernando went further and conceded that:

25 ‘..for the purposes of these proceedings, I am prepared to accept that FOR WOMEN, as is stated in PHILIPS v REMINGTON is probably unregistrable’,

and continued:

‘In so far as the evidence says “for” and “women” are common words and describe “for women” they do not need any evidence for that. That is common knowledge’.

30 With that in mind, it is clear that the acceptability or otherwise of this application turns on whether the words FORWOMEN (presented as one word) qualify for acceptance either *prima facie* or on the basis of acquired distinctiveness.

Both parties drew my attention to a number of decided cases which they felt would assist in reaching a conclusion. Mr Fernando referred to the comments of Aldous L J in the Court of Appeal in the *PHILIPS v REMINGTON* case [1999] RPC 809 and the comments of Neuberger J in *BACH FLOWER REMEDIES* [1999] 1 RPC 1. Mr Bernard referred to  
5 *BRITISH SUGAR V JAMES ROBERTSON* (the TREAT case) [1996] RPC 281, *AD2000* [1997] RPC 168 and *PROFITMAKER* [1994] RPC 613. Mr Bernard also referred me to Chapter 6 of the Registrar’s Work Manual, and in particular the guidance provided to examiners on how to examine cases where evidence of user is filed.

On the issue of registerability of the mark *prima facie*, I found Mr Fernando’s position  
10 confusing. Dismissing Mr Bernard’s reliance on TREAT by reference to Aldous L.J. in *PHILIPS V REMINGTON*, he stated: ‘This idea about these are words which traders might legitimately want to monopolise has all been swept away...’. He then referred me to Neuberger J in *BACH FLOWER REMEDIES*, and said:

‘...when you have trade marks which consist solely of a combination of elements which, on  
15 their own, are devoid of distinctive character, the combination as a whole may have distinctive character. That is the new approach under the Directive and under the 1994 Act. We are not looking at monopolising in legitimate terms. We are just looking at whether, when you stick the two together, you have done enough to just take it marginally outside their overall descriptiveness. That is exactly what Aldous LJ said in *PHILIPS v*  
20 *REMINGTON*. He said let us look at a case under the old Act, *WELDMESH*. If you have them separately, as two words, you cannot get it registered, but when you put them together you have made sufficient capricious alteration to enable you to get it registered. That is it. All this stuff about monopolising terms does not matter.’

Later, Mr Fernando stated:

‘By parity of reasoning, it is absolutely right that “for women” follows from “welded  
25 mesh”...here we have the composite mark. This is of sufficient capricious alteration..’

However, referring to comments made by Mr Barnard, at the end of the Hearing:

‘He was saying that we were saying that it is *prima facie* registrable. I am not saying that. What I am saying is that we have satisfied the Registrar already.’

Mr Fernando appears to maintain that his client’s mark in the ‘one word’ form contains  
30 ‘sufficient capricious alteration’ to be registerable, but he does not have to satisfy me on this, as the Registrar has already accepted the application and the onus is thus on the Opponents to show that she was wrong. (In passing, I note Mr Fernando’s references to the comments of Aldous LJ to the effect that the 1994 Act was passed to implement the Directive and which  
35 swept way old law. However, I also note that Aldous LJ says that while cases decided under the old law are no longer authoritative, knowledge of the reasoning in such cases can provide awareness of the type of problems that arise during use of trade marks.)

I have already dealt with presumption of validity after acceptance and decided that there is no  
40 such thing. Certainly in the case where an applicant relies on evidence of use to qualify for registration the onus and burden of proof is upon the applicant (see *DUALIT LTD v*

*ROWLETT CATERING APPLIANCES LTD* [1999] RPC, page 898, at paragraphs 29 and 30). The Applicants in this case do provide evidence of use, which I will consider shortly. First I want to refer to the example furnished by Aldous LJ in *PHILIPS v REMINGTON*, cited by Mr Fernando above. The Judge stated:

5       ‘An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating it is capable of distinguishing’

Later, he adds:

10       ‘The scheme of the Directive and the Act appears to require that signs which are not capable of distinguishing are excluded for registration at the initial stage. Those which are capable of distinguishing will be excluded unless they have or have acquired some distinctive character. An example is the trademark WELDMESH to which I have referred. It is capable of distinguishing, but without use would retain its primary meaning of welded  
15       mesh. It would therefore be devoid of any character that was distinctive. However, use could provide a secondary meaning, namely that the welded mesh to which the trade mark was applied came from a particular trader. Upon that being established it would become registerable as it would pass the dual test laid down by section (Article) 3(1)(a) and (b).’

The Judge says that the ‘capricious alteration’ in the mark WELDMESH is enough to provide  
20       the spark which could be fanned into a secondary meaning as a trade mark. In other words, WELDMESH was not regarded by the Judge as registerable *prima facie*, but required evidence of user to perform the role of a trade mark. There is an arguable difference between FORWOMEN, which simply amounts to the joining together of two well known English  
25       words, and the sign WELDMESH, which does not. The question could be asked as to whether such a mark is capable of distinguishing at all. At the Hearing, as stated above, Mr Bernard referred me to Registry guidance on examination of cases where evidence of user is filed. This guidance follows from statements in the *TREAT* case, where Jacob J stated:

30       ‘Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin’.

The guidance states<sup>1</sup> that, as a rule of thumb, signs which appear to be incapable of distinguishing can be identified as the sort of signs that would not have been accepted under the old law, because they have no inherent distinctiveness. It goes on to say that such signs should not be accepted on mere evidence of use alone, and refers to the type of signs  
35       envisaged. Examples provided are, *inter alia*, purely descriptive or laudatory words, purely laudatory slogans, devices which appear to be a type common to the trade, geographical locations that have a reputation for the goods or services, and totally non-distinctive words or signs. In relation to this final category of mark, the example provided of a sign which should not be accepted on mere evidence of use alone, is the sign ‘FOR HIM’.

---

<sup>1</sup>Registry Work Manual August 1998, Chapter 6, pages 64-65.



Under the grounds pleaded I do not have to consider this point, but I do I think I have to conclude that this mark, like WELDMESH, is devoid of distinctive character. It, at least, falls below the line drawn by Jacob J in the TREAT case:

5           ‘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  
10           inherently but the idea is much the same) devoid of distinctive character. I also think  
“Treat” falls within Section 3(1)(c) because it is a trade mark which consists exclusively of a  
sign or indication which may serve in trade to perform a number of the purposes there  
specified, particularly to designate the kind, quality and intended purpose of the product’.

I thus now need to consider the use the Applicants have made of their mark.

15           The Applicants only had two and a half years use on which to rely at the material date.  
Following the initial launch of the publication, circulation figures have reduced to some 35,000  
magazines per month, which in the context of the magazine market aimed at women is modest.  
Turnover and promotional figures in the relevant period have been similarly moderate. This is  
not enough, in my view, for the public to take the mark as a badge of trade origin and would  
20           require much more evidence than that provided to argue for acquired distinctiveness. While I  
accept that this use had been on a specialist magazine, and the Applicants’ specification is  
limited, that does not, I believe, assist them greatly. The content of magazines enclosed with  
the Opponents’ evidence contains a significant number of articles about sex, and the distinction  
between one type of magazine labelled ‘erotic’, and others which are not, is becoming  
25           increasingly blurred.

Regardless of this, what is fatal to the Applicants’ case is that the mark used has not been the  
mark as applied for i.e. the word FORWOMEN (as one word). Indeed, all the use that has  
been shown is of the words FOR WOMEN as two words. Given Mr Fernando’s comments in  
this respect mentioned above, I have little hesitation in finding that the Applicants have not  
30           established that the mark as applied for has acquired a distinctive character through use.

Following from this, I find the Opponents successful in their opposition under Sections 3(1)(b)  
and (c) of the Act and the opposition succeeds. The Opponents are entitled to a contribution  
towards their costs. I therefore order the Applicants to pay to them the sum of £835.

**Dated this 16<sup>th</sup> Day of February 2000.**

35           **Dr W J Trott**  
**Principal Hearing Officer**  
**For the Registrar, the Comptroller General**