

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2290533
BY**

FUTURE SM TM

**TO
REGISTER THE TRADE MARK:**

FUTURE

IN CLASSES

**1, 2, 3, 4, 5, 6, 7, 8,
10, 11, 12, 13, 14, 15, 16, 17, 18, 19,
20, 21, 22, 23, 24, 25, 26, 27, 28, 29,
30, 31, 32, 33, 34,
39 & 40**

AND

**THE OPPOSITION THERETO
UNDER NO 92761
BY
FUTURE PUBLISHING LIMITED**

Trade Marks Act 1994

IN THE MATTER OF Application No 2290533

by Future SM TM

to register the trade mark:

FUTURE

in Classes 1-8, 10-34, 39 & 40

and the opposition thereto

under no 92761

by Future Publishing Limited

BACKGROUND

1. On 30 November 2001, Future SM TM, Future Visionaries, USA, hereafter FST, applied to register the word FUTURE as a trade mark for a wide range of goods and services in classes 1-8, 10-34, 39 and 40 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. I do not propose to list the full specification of goods in this decision. However, I do note that the registration sought appears to be for all of the goods listed in each of the above mentioned classes. Of particular interest for the purposes of this hearing was the specification sought in the following classes:

Class 16 *Paper, cardboard and goods made from these materials, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites, furniture, instructional and teaching material, playing card, printers, printing blocks.*

Class 25 *Clothing, footwear, headgear*

3. The trademark was published for opposition purposes in the Trade Mark Journal on 28 May 2004.

4. On 27 August 2004, Future Publishing Limited, Beauford Court, 30 Monmouth Street, Bath, BA1 2BW, UK, hereafter referred to as FPL, filed notice of their opposition to the registered mark on the following grounds:

Section 3(6) The opponent states that the basis for their objection under this ground is that:

"The said specification merely recites the class headings of all goods and services in international classes 1-42. The Application was therefore filed in bad faith for the purposes of section 3(6) of the Act in that a person adopting proper standards, with knowledge of all the relevant circumstances, would


have concluded that the Applicant in fact had no bona fide intention to use the mark in relation to all the goods and services identified in the specification.”

Section 5(2)(b) The mark as applied for is similar or identical to a number of the opponents marks (see below)

Section 5(3) The opponent has significant reputation in the Community Trade Marks (CTMs) ‘THE FUTURE NETWORK [CTM 001150614]’ and ‘FUTURE PUBLISHING [CTM 001089374]’ in relation to “printed matter, printed publications, periodicals, magazines, publication services and the provision of information and entertainment over the internet in a wide variety of fields”

Section 5(4)(a) Registration is prevented by the law of passing-off in relation to the unregistered mark FUTURE which has been in use by the opponent since 1985 “...in relation to its publication services and on a wide range of printed matter, printed publications, periodicals, including in particular magazines, and on associated websites”. It has also been used on “...promotional items such as clothing and headgear.”

5. The Opponent is the registered proprietor of the following trade marks for the goods and services listed:

Mark	Number	Effective Date	Class	Specification
	UK 2220616	28.01.2000	9	Publications in electronic format; providing on-line electronic publications downloadable from the Internet; CDs, CD-ROMs; computer software relating to leisure; computer games software; computer software relating to business; computer software relating to the Internet.
			16	Printed matter, printed publications, periodicals, magazines, newspapers, books.
			41	Publishing services; arrangement of exhibitions; provision of information relating to entertainment, sport, education, computers.
FUTURE MUSIC	UK 2015230	23.03.1995	16	Printed matter, printed publications, periodicals, magazines, newspapers, books, paper and goods made from paper,

				photographs, instructional and teaching material, stationery, posters, cardboard and articles made from cardboard, greeting cards, playing cards, wrapping paper, calendars, writing and drawing instruments.
THE FUTURE NETWORK	CTM 001150614	23.04.1999	9	Computer software and publications in electronic format supplied on-line from databases or from facilities provided on the internet (including web-sites); computer software, computer games, software information storage apparatus; disks, tapes, magnetic tapes, cartridges, cassettes; computer programmes; videos, cassettes (including cassettes pre-recorded with sound, images and/or graphics; containers therefore), tapes, CDs, CD-ROMs; apparatus for games adapted for use with TV receivers, electric and electronic apparatus for video games; pre-recorded machine-readable data carriers; apparatus and instruments for reproducing data from machine readable data carriers; all relating to entertainment and in particular to audio and video apparatus and instruments, musical instruments and services associated therewith.
			16	Printed matter, printed publications, periodicals, magazines, newspapers, books, paper and goods made from paper, photographs, instructional and teaching materials, stationery, posters, cardboard and articles made from cardboard, greeting cards, playing cards, wrapping paper, calendars, writing and drawing instruments.

FUTURE PUBLISHING	CTM 001089374	26.02.1999	9	Computer software and publications in electronic format supplied on-line from databases or from facilities provided on the internet (including web-sites); computer software, computer games, software information storage apparatus; disks, tapes, magnetic tapes, cartridges, cassettes; computer programmes; videos, cassettes (including cassettes pre-recorded with sound, images and/or graphics; containers therefore), tapes, CDs, CD-ROMs; apparatus for games adapted for use with TV receivers; electric and electronic apparatus for video games; pre-recorded machine-readable data carriers; apparatus and instruments for reproducing data from machine readable data carriers; all relating to entertainment and in particular to audio and video apparatus and instruments, musical instruments and services associated therewith.
			16	Printed matter, printed publications, periodicals, magazines, newspapers, books, photographs, posters, greeting cards, playing cards, calendars.
			41	Provision of information relating to entertainment, sport and education.
			42	Provision of information relating to computers; computer programming, design of hardware/software, leasing access time to databases, consultancy information and advisory services relating to all the aforesaid; consultancy and advisory services relating to entertainment, sport and education; providing facilities for exhibitions.

CASA EDITRICE FUTURE	CTM 001089515	26.02.1999	9	Computer software and publications in electronic format supplied on-line from databases or from facilities provided on the internet (including web-sites); computer software, computer games, software information storage apparatus; disks, tapes, magnetic tapes, cartridges, cassettes; computer programmes; videos, cassettes (including cassettes pre-recorded with sound, images and/or graphics; containers therefore), tapes, CDs, CD-ROMs; apparatus for games adapted for use with TV receivers; electric and electronic apparatus for video games; pre-recorded machine-readable data carriers; apparatus and instruments for reproducing data from machine readable data carriers; all relating to entertainment and in particular to audio and video apparatus and instruments, musical instruments and services associated therewith.
			16	Printed matter, printed publications, periodicals, magazines, newspapers, books, paper and goods made from paper, photographs, instructional and teaching materials, stationery, posters, cardboard and articles made from cardboard, greeting cards, playing cards, wrapping paper, calendars, writing and drawing instruments.
			41	Provision of information relating to entertainment, sport and education.

			42	Provision of information relating to computers; computer programming, design of hardware/software, leasing access time to databases, consultancy information and advisory services relating to all the aforesaid; consultancy and advisory services relating to entertainment, sport and education; providing facilities for exhibitions.
FUTURE VERLAG	CTM 001089572	26.02.1999	9	Computer software and publications in electronic format supplied on-line from databases or from facilities provided on the internet (including web-sites); computer software, computer games, software information storage apparatus; disks, tapes, magnetic tapes, cartridges, cassettes; computer programmes; videos, cassettes (including cassettes pre-recorded with sound, images and/or graphics; containers therefore), tapes, CDs, CD-ROMs; apparatus for games adapted for use with TV receivers; electric and electronic apparatus for video games; pre-recorded machine-readable data carriers; apparatus and instruments for reproducing data from machine readable data carriers; all relating to entertainment and in particular to audio and video apparatus and instruments, musical instruments and services associated therewith.
			16	Printed matter, printed publications, periodicals, magazines, newspapers, books, photographs, posters, greeting cards, playing cards, calendars.
			42	Provision of information relating to computers; computer programming, design of hardware/software, leasing access time to databases, consultancy information and advisory services

				relating to all the aforesaid; providing facilities for exhibitions.
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6. Both sides filed evidence

7. The opponent FPL requested a hearing which was held before me on 15 February 2007. FPL was represented by Mr Paul Walsh of Bristows. The applicant FST was not represented but the agent for the applicant, Mr Jonathan Linn of Jonathan Linn provided written submissions on his behalf. Mr Walsh also provided a written submission in advance of the hearing.

EVIDENCE

Evidence in Chief of the Opponent - First Witness Statement of Brent Manchester

8. Mr Manchester is the Legal and Business Affairs Manager of FPL where he has worked since 1996. In this capacity he has access to the files and records of FPL and he is authorised to make statements on behalf of FPL in support of this opposition. The information comes from his own knowledge or belief and/or the records of FPL relating to its use of the mark FUTURE and related trade marks

9. FPL was founded in 1985 and incorporated as a limited liability company in 1986. FPL is a wholly owned subsidiary of Future Plc. From May 1999 until January 2005 the company, now known as Future plc, was called The Future Network plc. Future plc, formerly The Future Network plc, has been listed on the London Stock Exchange since 1999, it has a market capitalisation value of £1 billion; it publishes over 127 magazine titles and licences 50 of these in 30 other countries. It has offices in Europe, USA and Japan and the company employs over 1700 people worldwide. FPL is the UK subsidiary of Future Plc. According to Mr Manchester, FPL is the fourth largest magazine publisher in the UK. Exhibit BM4 provides a print-out from the Companies House on-line register which confirms the previous name of the company as The Future Network plc.

10. Exhibit BM1 comprises copies of the front pages of a number of magazine titles published by FPL. These all show use of the registered mark FUTURE PUBLISHING, CTM Registration No. 1089374, on the front cover in a number of different representations. These are summarised in the Annex to this decision, different fonts are used and the text is shown as white text against a black background.

11. Circulation figures for the magazine titles shown in Exhibit BM1 in the period 1996 to 2001 are shown in Table 1. These figures show the average monthly circulation of each title, over two six-month periods (January-June and July-December) of the relevant year. For example, between January and June 1996 an average of 77,635 copies of PC FORMAT were sold each month. When only one figure is shown, for example, figure of 85,111 copies for PC PLUS in 2001, this represents the average monthly circulation for the relevant title over the whole 12 months of the year. Mr Manchester states that his purpose in providing these figures is to confirm 'the significant amount of goodwill and reputation owned by Future in CTM Registration No. 1089374 FUTURE PUBLISHING and the mark FUTURE generally'.

TABLE 1: (a) Circulation figures for various magazine titles published by FPL for the period 1996-1998

Magazine Title	Circulation Figures					
	1996		1997		1998	
	Jan-Jun	Jul-Dec	Jan-Jun	Jul-Dec	Jan-Jun	Jul-Dec
PC FORMAT	77,635	82,080	91,540	106,314	110,227	95,339
PC PLUS	80,457	81,360	88,308	106,421	117,149	120,265
TOTAL FILM	FIGURES UNAVAILABLE (first year of launch)		50,487	52,904	61,497	66,474
PC GAMER	45,190	53,131	60,178	70,848	65,378	68,242
TOTAL GUITAR	32,456	42,647	44,436	45,007	46,073	48,150

TABLE 1: (b) Circulation figures for various magazine titles published by FPL for the period 1999-2001.

Magazine Title	Circulation Figures					
	1999		2000		2001	
	Jan-Jun	Jul-Dec	Jan-Jun	Jul-Dec	Jan-Jun	Jul-Dec
PC FORMAT	97,627	102,810	101,095	80,121	72,089	76,337
PC PLUS	126,815	111,054	117,645	95,606		85,111
TOTAL FILM	67,609	72,225	75,197	77,291	78,118	83,100
PC GAMER	77,220	83,669	84,060	73,549	73,695	78,553
TOTAL GUITAR	40,705	36,062	31,516	30,192		33,303

12. Mr Manchester states that FPL have taken these figures from the website of the Audit Bureau of Circulations ('the ABC') which is an independent source of circulation, distribution and attendance data for ABC certified magazines, newspapers, directories and exhibitions within the UK and Ireland (see paragraph 7 of his witness statement). I accept that this is an authoritative source of such data.

13. Exhibit BM2 comprises a copy of a promotional publication entitled 'The Business, Internet & Creative Computing Group', published by FPL in 2000 to promote its publishing

and internet activities. Page 27 of this exhibit shows a number of the trade marks used by Future plc and its subsidiaries.

14. Exhibit BM3 shows print-outs of various websites owned by FPL that provide information on a wide variety of fields such as computing, gaming, technology, music, sports and entertainment. However, although the associated information from the WHOIS or NetNames databases shows that these sites were in existence at the relevant date, the date of application, 30 November 2001, these printouts were obtained in 2006 and it is not possible to establish what information they were providing, if any, prior to the relevant date, the date of application 30 November 2001. Despite the assertion from Mr Manchester that the FUTURE PUBLISHING mark has been continuously used on each site, other than the copyright statement at the bottom of the page, I can find no other reference to or use of the registered trade marks on these web-site extracts.

15. Exhibits BM5 and BM6 show materials produced by FPL under its former name The Future Network plc. Both exhibits show use of CTM Registration No. 1150614, THE FUTURE NETWORK (see, for example, page 1 of Exhibit BM5 and see pages 1 & 2 of Exhibit BM6). Exhibit BM5 provides a copy of certain pages from the 1999 Annual Report of The Future Network plc which show that the company sold 5.5 million magazines worldwide per month in 1999 for 122 magazine titles. The company's internet sites had 4.6 million unique visitors per month. Exhibit BM6 is a copy of the portfolio of publications for Spring 2001 issued by The Future Network plc. This shows the number of publications coming under the umbrella of The Future Network plc as published in 2001 within the UK, across various European countries and the US. Pages 10-33 show the cover page from various examples of these publications and it is possible to make out the FUTURE NETWORK trademark on many of these pages. On page 40, all the magazine titles, websites, web-networks and on-line magazines provided by Future Publishing in the UK are listed. This list is dated 28 February 2001. The total number of magazines sold each month in 2001 within the UK alone was more than 2.1 million, with subject matter covering computer and video games; business, internet & creative; sports & entertainment; handcrafts and hobbies. This exhibit also gives details of the Internet sites and publications produced by the Future Network plc and it notes that in January 2001 the UK websites provided by the Future Network had 2.5 million unique visitors.

16. The opponent's marks have been used on a range of goods and promotional items ancillary to the field of publishing, magazines, printed matter and publications. Exhibit BM7 shows use of the marks FUTURE MUSIC and FUTURE PUBLISHING in relation to beer mats, mouse mats, CD holders, pens and advertising banners. They have also been used on clothing items. Exhibit BM8 shows photographs of T-shirts bearing the marks FUTURE PUBLISHING (two examples of logo) and FUTURE MUSIC. T-shirts bearing the FUTURE MUSIC mark have been printed and issued since 1999, and a small number have been available for sale through the FUTURE MUSIC magazine since this date. T-shirts bearing the FUTURE PUBLISHING marks have been printed and distributed since 1999, primarily for promotional purposes. Mr Manchester explains that T-shirts bearing the FUTURE PUBLISHING and FUTURE MUSIC marks are given away at trade shows and exhibitions and distributed for wearing at charity and other corporate events. This activity has taken place on a regular annual basis since T-shirts bearing these Future trade marks were first printed in 1999.

17. Exhibit BM9 is provided by Mr Manchester as an illustration that consumers, such as users of the internet, will associate the word Future with the opponent's business activities. It is a print-out from the Google search engine for an Internet search, dated 10 February 2006, on the word 'Future' on a worldwide basis (i.e., not simply limited to the UK). FPL's website at <http://www.futurenet.com> was the first hit found, while the company's music website at <http://www.futuremusic.co.uk> being the tenth hit in the list. However, this search also shows that there are many, many other uses of the word 'Future' in addition to that referred to by the opponent.

Evidence in Chief of the Applicant – Mr Kent G Anderson

18. Mr Anderson, is the founder and president of Future Enterprises, which is also known as Future SM TM and Future Visionaries (SM is an abbreviation for 'Service mark' and TM is an abbreviation for 'Trade mark', SM is more commonly used in the US than in the UK). Mr Andersen refers to these names as his 'various business trading styles'. The facts, information and evidence in his witness statement are taken from Mr Andersen's personal knowledge or from his personal and business records related to the mentioned trading styles.

19. Mr Andersen founded what he refers to as the trading styles "Future SM TM", "Future Visionaries" and "Future Enterprises" in the late-1990s, and he has been operating with them since approximately 1998. In the absence of any challenge to this date from the opponent, I am happy to accept 1998 as the starting point for Mr Anderson's activities.

20. In setting up under these titles or trading styles, which he uses interchangeably, Mr Andersen states at para.2 that it was his "idea to create and develop a business model capable of exploitation in all manner of fields of commerce which would encapsulate and promote my ideas and principles for a futuristic world". His first internet website dedicated to this idea was www.geocities.com/visionaryman2000, which was set up in 1998 and is still in operation (2004). Exhibit KGAI is a printout of the current pages from this original website which provide a detailed explanation of Mr Andersen's ideas for the FUTURE brand. I have taken note of the following statements from this Exhibit from the section entitled 'Who we are' (paragraphs 1-3):

"I am Kent Anderson, founder and president of FutureSM Enterprises. I am dedicated to our future. I see a more highly advanced world. I am very creative, hold many patents, enjoy inventing, and am a prolific thinker. Leadership value qualities, integrity and my love and fascination is with ideas in inventing, and thinking of a futuristic world.

I find fascination with our past and the future, and how inventors, entrepreneurs changed the world. I care for our world and all people in all countries. I wonder about what future generations will say about us, and ask what they have done for us. What will our answer be? There needs to be forth [*sic*] entity a place that people can market, test their ideas in any marketing sector focused towards our future. I am in the process of building this corporation, and have spent many years on it. Hopes are to find the leaders; people who have the same interest and goals I have. In the end, we will be able to offer what no other company in the world canSM.

This will be a large undertaking, and will provide a huge marketing arena, with many opportunities available. To test and to market, invest in properties to

launch new industries, new products, and new services under the name FutureSM. Future related products in any marketing sector and focus on not the old, but the new corporation. Could include on Future IslandSM, Research centers, retail, health, communications, etc. "

[emphasis in bold added by me]

21. Mr Anderson began, in around 2000, the process of seeking to register the "FUTURE" brand name as a trade mark or, as also referred to in the USA as a service mark, in the USA and then abroad. The application to register this mark in the UK is the subject of these proceedings. Since around 2000, Mr Anderson has also developed a further internet website, "www.futnrevisionaries.com", which he states "expands on my original website". Pages from this new website are provided as Exhibit KGA2. I note that much of the material on this website is the same as that on the original website, e.g. sections entitled 'Who We Are' and 'Goals'. I have taken note of the following statements from Exhibit KGA2:

"* As one of many, we are strong. Our goal is to secure rights globally to the brand FUTURE, to create global opportunities from the brand so that all people can benefit from the brand FUTURE with their ideas and dreams. Global organizations and companies affiliated with brand FUTURE will create global resources and infrastructures that will allow development of new ideas and a means for new industries to be developed. Global benefits will be created for all people.

*** My vision and belief is that the brand FUTURE has the ability to create opportunities for all people and build new jobs and industries globally. Opportunities will be available to all people, especially the people who have ideas for products and services but do not have the resources. The opportunity would include using their trademarks, copyrights and patents with the brand FUTURE which would help inventors, etc. to be heard and to realize their potential. For example, individual's designs for automobiles etc. would be used and associated with the brand FUTURE. The global infrastructure built with the brand FUTURE would be able to support their efforts with knowledge and resources. By working together with the brand FUTURE and sharing by licensing ideas and products to each other, each individual will benefit from the brand FUTURE. Companies and individual will be allowed separately to benefit from the FUTURE brand globally."**

[Page 2, Exhibit KGA2];

and

"We have spent years of building the brand FUTURETM with our pending rights in USA/UK.

We want to create an open global infrastructures [sic] to allow all people and all countries the ability to share the brand FUTURETM and to created [sic] and build new industries around it.

We would like to have and to create an open door policy to allow new products to be discovered to benefit our world. At this time we do not solicit new ideas because we

don't have the resources to do so. We hope soon to have pending partners and others who want to join us so we can build the projects and open infrastructure."

[Page 3, Exhibit KGA2, emphasis in bold added by me];

and

"Licensing opportunities are currently available under the name FutureSM.

To identify and hold harmless Future Visionaries.com and Futurelicensingworld.com.. Its owner, subsidiaries, etc. for any liability or claims related to any property loss or damage caused by your actions or any of the information. We do not accept under any confidentiality of any kind. If you use this site, you agree to these terms. We do not solicit ideas. **We are marketing and licensing our own intellectual property right, our futureSM brands, to entities, who, has what it takes to be associated with our future imageTM. Our products, goods, and services represent our future familyTM and affiliated with the newTM.** We do not accept under any confidentiality of any kind. If you use this site, you agree to these terms.

WE ARE LOOKING FOR COMPANIES, INVENTORS, MARKETING COMPANIES, LICENSING COMPANIES, ULTREPRENURES [sic, entrepreneurs(?)], MANUFACTURERS, ETC. WHO WANT TO USE OUR BRAND FUTURE WITH YOUR BRANDS AND FOR YOUR IDEAS, GOODS AND SERVICES. FOR THE FOLLOWING THIS CREATS [sic] THE GLOBAL OPORTUNITIES [sic] FOR ALL TO BENEFIT THIS IS NON-EXCLUSIVE SO WE ALL CAN BENEFIT .

TRADEMARKS IN INTERNATIONAL CLASSES HAS BEEN ALLOWED AT THE USPTO UNDER THE BRAND FUTURE....."

(Page 6, Exhibit KGA2, emphasis in bold added by me)

22. I also note that Mr Kent provides a list of various patents that are available to build new markets using his business model. In Exhibit KGA1 a number of US patents are illustrated on page 3. In Exhibit KGA2, in addition to these same patents illustrated on pages 5 and 6 (see section entitled 'USA Patents for License'), there is also a large number of trademarks listed on pages 6-9 and three franchise ideas are listed on page 9.

23. In paragraph 3 of his witness statement, Mr Andersen summarises the development of his business plan and the motivation behind his trade mark applications. There appears to be six elements to this:

- (a) Establishing a brand name;
- (b) Establish the brand 'right from the inception of this idea';
- (c) The name "FUTURE" is the key element of this "brand", chosen in good faith because it was a good concept and would be ideal for capturing the spirit of his ideas;
- (d) Obtain appropriate protection for this brand name over as wide a range of goods and services as possible in order to provide maximum opportunities for control and licensing of the brand as the business would develop in all sorts of technical, cultural and commercial fields;
- (e) Following (d), many, if not most, of Mr Andersen's trade mark applications sought appropriately broad and widely defined lists of goods and services; and

- (f) Develop a global scale business in virtually any type of goods or services in the technical, cultural and commercial fields.

24. Mr Andersen cites this website and his earlier website as an illustration of the 'very diverse nature of the potential business activity fields which I have always believed could be susceptible of developing under my business model and associated intellectual property, particularly under the "FUTURE" brand name' (see para. 4). He also states that "Not only have I continued to consolidate the "FUTURE" name in the development of my business model via my websites, but since about 2000, I have also actively promoted it by writing letters directly to people and organisations in a whole host of commercial fields who I believe might be suitable for and interested in investing in my business ideas and thus being potential licensees of my intellectual property, especially that in the "FUTURE" mark. Such letters have generally always borne my characteristic "FUTURE SM TM" name and address identifying stamp, a sample of which on blank letterhead paper is attached hereto as Exhibit KGA3." (see para. 6) This exhibit shows a blank page with the letterhead that Mr Anderson uses for this correspondence. The applied for mark is shown on the top line of the address as indicated by use of the superscripts TM and SM; these are used to indicate that the word FUTURE is a trade mark (TM) and, as is more commonly used in USA, a service mark (SM), indicating its use to denote services rather than goods.

25. Mr Andersen estimates that he has spent \$180 per annum to maintain his Internet websites. He also estimates that he has spent \$50,000 to date in filing, prosecuting and defending his various trade mark and other IP registration applications in the USA, UK and elsewhere. However, no further details are provided regarding the portion of such estimated costs that apply in the UK or the actual dates when any such payments were made.

Evidence in Reply of the Opponent - Second Witness Statement of Brent Manchester

26. This included a second witness statement from Mr Manchester and a further five exhibits BM10-BM14. All this material appears to be directed towards showing the use that FPL had made within the relevant 5-year period ending on 28 May 2004 of the trade mark FUTURE MUSIC, UK Trade Mark Registration no. 2015230. This mark was registered in the name of Future in relation to "printed matter, printed publications, periodicals, magazines". FUTURE MUSIC is the title of a magazine that has been published monthly by FPL since November 1992. Exhibit BM 10 shows copies of front covers of a sample of issues of this magazine from November 1992 to January 2002 which each use of the Mark.

27. Circulation figures for FUTURE MUSIC magazine for the years 1996 to 2001 were as follows:

Year	Circulation figure	
	JAN-JUNE	JULY-DEC
1996	23,320	26,020
1997	28,501	28,753
1998	27,071	26,523
1999	23,011	
2000	18,653	
2001	20,645	

These figures are obtained from the same source and on the same basis as the circulation figures for the other magazine titles published by Future and as discussed in paragraph 8 of the First Witness Statement given by Mr Manchester. Thus, between January and June 1996 an average of 23,320 copies of the title FUTURE MUSIC were sold each month whereas in 1999 an average of 23,011 copies were sold every month.

28. The FUTURE MUSIC Mark has been used on booklets and other printed publications that are often given away as promotional materials with the FUTURE MUSIC magazine. Exhibit BM11 shows some examples of these ancillary publications entitled "FUTURE MUSIC The Black Book", "The FUTURE MUSIC Guide to Mixing", "FUTURE MUSIC The Little Red Book 2004" and "FUTURE MUSIC The Essentials Book 2005". On average 4 or 5 such booklets covering different areas of interest within the music industry are published annually and given away with issues of FUTURE MUSIC magazine throughout the year. Other examples of material bearing the FUTURE MUSIC mark that was given away in the past with issues of FUTURE MUSIC magazine include calendars and CDs. In particular music CDs are given away on a regular basis with this magazine, as can be seen from the copies of front covers in Exhibit BM 10.

29. The domain name www.futuremusic.co.uk was registered in the name of FPL in 1998, and since this date the website at <http://www.futuremusic.co.uk> has featured a summary of the content of the current issue of the printed version of the magazine and other promotional information in relation to the title. Exhibit BM12 is a copy of the relevant WHOIS information showing FPL as the Registrant of the Website's domain name. Exhibit BM13 is a sample print-out taken from the Website on 9 February 2006. Mr Manchester refers to the fact that at the bottom of the Website's home page is a link whereby visitors can access a FUTURE MUSIC Technology Forum (run in conjunction with 'Computer Music', another magazine title published by Future) ("the Forum") and participate in on-line discussions and debates with other visitors. Exhibit BM14 is a copy of the Forum's homepage detailing the various discussion groups active as at 9 February 2006. As at this date there were 16,805 registered users of the Forum.

30. This concludes my summary of the evidence

PLEADINGS

30. FPL does not dispute any of the evidence filed by FSM.

31. FPL is opposing the entire registration on the basis of section 3(6) and is opposing registration in classes 16 and 25 to varying degrees on the basis of sections 5(2)(b), 5(3) and 5(4)(a). FPL is objecting to the registration of goods in class 16 under Section 5(2)(b), 5(3) and 5(4)(a). If FPL succeeds under Section 5(2)(b), then there is no point in going on to consider the grounds under Section 5(3) and Section 5(4) as these do not add anything. FPL is objecting to the registration of goods in class 25 under sections 5(3) and 5(4)(a).

32. I will consider the Section 3(6) objection against the entire registration first and then turn to the objections under Section 5 to the specific registrations in classes 16 and 25.

DECISION

SECTION 3(6) & SECTION 32 – BAD FAITH & A BONA FIDE INTENTION TO USE

Section 3(6) – Bad Faith

33. Section 3(6) of the Act is as follows:

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith

34. This provision originates from Article 3(2)(d) of European Directive 104/89. The correct approach to bad faith was set out by Lindsay J. in *Gromax Plastics Ltd v Don & Low Norwovens Ltd* [1999] RPC 367 (at 379) in which the judge stated that:

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall short in order to amount to bad faith is a matter best left to be judged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

35. In *China White* [2005] FSR 10, the Court of Appeal decided that the 'combined test' they understood to have been laid down by the House of Lords in *Twinsectra v Yardley* [2002] 2 AC 164, should be applied in deciding cases under section 3(6) of the Trade Marks Act. The 'combined test' was said to be that, not only must the applicant's behaviour be unacceptable by the standards of reasonable and honest people, but that the applicant must have realised that by those standards his conduct was unacceptable.

36. The Privy Council's judgment in *Barlow Clowes International Ltd v Eurotrust International Ltd* (10 October 2005,) indicated that the House of Lords' judgment in *Twinsectra* had been misunderstood. It concluded that it was not necessary to enquire into a defendant's views as to what were acceptable standards of reasonable behaviour. It was sufficient to show that a defendant's knowledge of a transaction was such as to render his participation contrary to normally acceptable standards of honest conduct.

37. Following this decision, the House of Lords judgment in *Twinsectra* is considered to have the meaning given to it by the Privy Council in *Barlow Clowes*. Consequently, in applying the so-called 'combined test' to a claim under section 3(6) of the Trade Marks Act, as I am required to do by the judgement of the Court of Appeal in *China White*, I should give the test the meaning described by the Privy Council in *Barlow Clowes*.

38. The test to be applied under section 3(6) of the Act is therefore whether the applicant had sufficient knowledge of relevant matters so as to make its application for registration dishonest or below the standards of acceptable commercial behaviour observed by reasonable and experienced men in the relevant field.

Section 32 - bona fide intention to use

39. Section 32 (3) of the act reads as follows:

(3) The application shall state that the trademark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

Guiding Principles

40. In *Demon Ale* [2000] RPC 345, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated (at page 356) that

"In the present case the objection under section 3(6) related to the applicant's breach of a statutory requirement. Section 32(3) of the Act required him to be a person who could truthfully claim to have a bona fide intention that DEMON ALE should be used (by him or with his consent) as a trade mark for beer. His application for registration included a claim to that effect. However he had no such intention and could not truthfully claim that he did. That was enough, in my view, to justify rejection of his application under section 3(6)..

Mr Hobbs upheld a bad faith objection on the ground that the applicant for registration of a trade mark had no intention of using the mark in respect of the goods listed in the application, contrary to the statement on the form of application required by section 32(3) of the Act. The applicant for the registration had admitted that he had no intention of using the applied for mark in the course of the proceedings.

41. Although section 3(6) is based upon Article 3(2)(d) of the Directive, section 32(3) does not come from the Directive. It is an home-grown requirement. Nevertheless, Mr Hobbs saw no reason to doubt that section 32(3) was compatible with the Trade Mark Directive. He noted that the 8th recital to the Directive specifically confirms that "in order to reduce the number of trade marks registered and protected in the Community... it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation."

42. In *Reckitt Benckiser (UK) Ltd v Robert McBride Ltd*, BL 0/355/04, Mr Arnold, sitting as the Appointed Person, similarly saw no incompatibility between section 32(3) and the Directive.

43. However, in *Knoll AG's Trade Mark* [2003] RPC 10, Mr Justice Neuberger (as he then was) appeared to believe that there may be some tension between the requirement of section 32(3) of the Act and the provisions of the Directive. Although he appears to have envisaged some results that would be incompatible with the Directive, the judge did not find the requirement for a statement under section 32(3) to be so. The fifth recital to the Directive states that the member states remain free to set the procedures for obtaining registration. The judge's concern was that section 32(3) (or any other provision introduced by a member state) should not be viewed as introducing a further **substantive** ground for refusal for which there is no basis in the Directive (emphasis added by me).

44. In order to address this concern, it is necessary, when considering the interaction between sections 3(6) and 32(3), to focus on the question of whether the applicant made the statement required by section 32(3) in bad faith, rather than on simply the factual accuracy of the statement. This was the conclusion reached by Mr Allan James in Trade Mark Registry

decision BE O/026/06, *New Covent Garden Market* and I will approach the matter in the same way.

ANALYSIS

45. In order to determine if the application was made in bad faith or without a bona-fide intention to use, I must consider the situation at the date of application and what was in the mind of the applicant at this date.

46. The applicant FSM is seeking registration for a wide range of goods and services. FPL were in error in their statement of grounds when they stated that FST were seeking registration for all goods and services in all 42 classes. FST is not seeking registration for all goods and services in classes 9, 35-38, 41 and 42. Mr Anderson appears to be the only employee of FST and as such the decision by FST to seek registration in 35 classes and so pay the resultant substantial fees would appear to be an active and deliberate decision by Mr Anderson. I do not accept that just because an applicant for a trade mark is seeking a broad specification of goods e.g. all goods and services in 35 classes, that this will mean that they fall foul of Section 32(2) and that the applicant cannot have a *bona fide* intention to use, or consent to use, the trade mark.

47. Mr Anderson states quite clearly in paragraph 7 of his witness statement that:

"Given the above facts, I strongly and honestly believe that I have demonstrated the good faith nature of the making of my various trade mark applications based on the "FUTURE" mark, including my UK application which is the subject of these proceedings. In particular, it always was and still is a matter of good faith on my part that I sought and am still seeking registered trade mark rights on this UK application which extend over as wide as possible goods and services coverage, in order to maximize the business potential and licensability [*sic*] of my "FUTURE" brand in accordance with my beliefs, principles and intentions as explained above and in my various websites Exhibited hereto."

Thus, Mr Anderson is quite explicit in stating that it is his true (i.e., *bona fide*) intention that the applied for mark will be used for all the goods specified. Given Mr Anderson's vision for the trade mark as discussed above, it is not surprising that he is seeking registration for a wide range of goods and services.

48. As I have indicated in my summary of the evidence above, the business ideas of Mr Andersen have been described in more detail in the extracts from both his websites. It is clear from these exhibits and the relevant statements that I have noted above, that at the time of application, FST was not using the trade mark in relation to all of the goods or services applied for. The mark was being used to identify the business concept of Mr Anderson, the managing director of FSM, the creation of a large marketing entity where other companies could test and market their products. In so doing the companies involved would then be able to use the trade mark FUTURE as an additional trade mark to indicate that they have developed a product that is fit for future use, is looking forward, and has all the qualities that Mr Anderson and FST consider to be important.

49. As the above extracts from the website also show, it is clear that Mr Anderson does not have the money or facilities to develop such products himself. He has the overall idea of how

his business concept will work and he is seeking investment from others. He is seeking investment and partnership with other companies that will provide funding and/or products which can be sold or marketed under the FUTURE trade mark. He is providing the intellectual property and ideas and is seeking further ideas and products but, especially funding, to develop this business concept. From Exhibit KGA1 and KGA2, it is clear that Mr Anderson considers that his marketing concept can be applied to almost any area of business and that the FUTURE trade mark, if registered, could be used to promote goods and services from shops, universities, sporting activities, research facilities. I consider that evidence provided by the applicant clearly shows a bona fide intention to use the FUTURE mark in relation to goods and services that would fall into class 35, i.e., "advertising, business management". However I note that FST has not sought registration of the applied for mark in this class. Instead, FST is seeking to register the mark for the wide range of goods and services that Mr Andersen wants to use the mark to promote directly or through a licensing arrangement.

50. Thus in terms of use of the mark applied for, I conclude that Mr Andersen has shown a bona fide intention to use this applied for mark for the purpose of advertising, promoting and marketing goods and services. In the absence of details of specific goods to be advertised and promoted, this would be advertising in general which is covered by services in class 35. However, Mr Andersen is not seeking registration in class 35, he is seeking registration in relation to a wide range of goods and services that he intends to use the mark for. He has not yet been able to do so mostly because of lack of funds (see comments to that effect in Exhibit KAG2 and KAG3).

51. In his skeleton argument, Mr Walsh for the opponent states that the FPL "allegation is not one of dishonesty, but one relating to an overly wide specification and lack of *bona fide* intention to use" and goes on to argue that the applicant "has no present and settled intention to use the mark across the whole range of the specification, or in relation to class 16 and 25, or at all". He states that "a hope to licence in due course and a program of obtaining maximum registered protection to do so fall's short of a present and settled intention". In support of this argument, he refers to paragraphs 8-250 to 8-272 of Kerly's Law of Trade Marks and Trade Names, 14th edition.

52. While I have some sympathy with this argument, I do not think that it is as clear-cut as presented by Mr Walsh. Much of the discussion in Kerly's revolves around how Section 32(3), which is a national UK provision, should be interpreted in light of the trade mark directive and accepts that there is some uncertainty at how best to interpret this provision and whether or not it is compatible with community trade mark law. It is clear that many more issues have been claimed as bad faith in the UK because of s32(3) (see paras. 8-265 to 8-267) than in other European jurisdictions. However, I am satisfied that it's purpose must not be to place an additional and separate substantive requirement that has to be met, as referred to in *Knoll AGs Trade Mark* (see discussion below). As mentioned above, account has to be taken of whether the applicant made the statement required by section 32(3) in bad faith when they applied for the trade mark rather than on the factual accuracy of the statement. There is no guarantee that Mr Andersen will realise his objective but I am satisfied that when he applied for the mark he had a bona fide intention to do so and that he was making efforts to realise this intention even if these had had little success to date.

53. The requirement under s32(3) is met if there is a *bona fide* intention to use the trade mark or to have it used with the consent of the applicant. It is clear from the evidence that Mr

Andersen is seeking to involve others in his business in order to attract investment, and, to a lesser extent ideas and products. In my view this indicates that Mr Andersen and FST will consent to the applied for mark being used by third parties if the opportunity arises. However, this behaviour is dependent or conditional on the involvement of others, their money and their ideas. Thus use of the trade mark is not certain or guaranteed.

54. It is not uncommon for small businesses in the early stage of their development to seek to register intellectual property rights such as a patent or a trademark. This provides them with a legally enforceable right to prevent other companies from taking advantage of their business, while they seek to develop the business themselves. One such development is to license the use of the intellectual property right to another business in return for investment. In such a situation the registered proprietor of the IP right may not have a clear idea about how his business will develop. The process of seeking investment and licensing partners often provides new directions for the business. I consider that this is such a situation. The applicant FST and its founder/president Mr Anderson, are a small enterprise, with a business idea that they believe has enormous potential and they want to register the trade mark as a means to identify the goods and services that this business idea could provide. The applicant is entitled to seek registration of the trade mark even if they do not have a clear idea which of these applied for goods and services will be marketed under the trade mark FUTURE just so long as the applicant has a clear intention to make use of this mark or to consent to use of the mark for all the goods and services specified.

55. The situation in this case is not the same as occurred in the *Demon Ale* case cited above where the applicant admitted himself that he did not intend to use the applied for mark if he succeeded in the registration. In *Ferrero SpAs Trade Marks* [2004] RPC 29, the number of trade mark applications and the period over which they had been made were sufficient to establish a prima facie case that the registered proprietor did not have a genuine intention to use the trade marks at the dates they were applied for. The registered proprietor did not answer this case and so the claim that there was not a genuine intention to use the trade marks was successfully made out. In the *New Covent Garden Market* decision, Case BL O/026/06, the Hearing Officer, Mr Allan James, found that the decision in relation to section 32(3) depended more on whether the mark applied for could serve as a trade mark in the circumstances of the case and that, although there may have been a bona fide intention to use the sign applied for, the sign applied for was not able to function as a trade mark.

56. The concern about whether an overly wide specification is made in bad faith has been discussed in two cases where summary judgement was being sought. Although discussed, the issue was not decided given the summary nature of proceedings. In *Knoll AGs Trade Mark* [2003] RPC 10, Neuberger J commented that:

"35 As Mr Campbell points out, it is not as if the 1994 Act or the Directive contain no provision so far as unduly wide specifications are concerned. Section 46 of the 1994 Act and Article 10 of the Directive provide for revocation of a registration to the extent that there has been a lack of genuine use of the mark for the specified uses for a period of five years. In addition, s.46 of the 1994 Act can be invoked to effect a partial revocation: see *DaimlerChrysler AG v Aluvi (t/a Merc)* [2001] R.P.C. 42. Thus, it would seem that, if the mark in issue was used only for obesity products by the defendant for the five years following registration, it could be revoked save in relation to obesity products. There is thus a powerful argument, at any rate on the face of it, for [the claimant] that by merely failing to identify its specification sufficiently precisely, or by

framing its specification too widely, an applicant for registration cannot be guilty of bad faith.

36 However, there are, plainly, powerful arguments the other way. Under the previous legislation, the Trade Marks Act 1938, framing a specification too widely could amount to bad faith--see the discussion in *Road Tech* at [1996] F.S.R. 814 to 816. Such a proposition is also supported by the potentially unfair monopolistic consequences of a trade mark registration, the risk and disadvantages of cluttering up the register, and the need to discourage greed or "covetousness" in the field of intellectual property rights. In light of those types of consideration, which can be further justified by reference to s.32(3) of the 1994 Act, there are decisions of Laddie, Robert Walker, and Jacob JJ. (which I discuss below) which support the proposition on which the claimant's case rests. The first two decisions technically only decide the proposition is arguable, and in the third decision, the observations are obiter. However, it seems clear that I should not depart from those decisions, at least for summary judgment purposes. "

57. In *Road Tech* [1996] F.S.R. 805, Robert Walker J commented (at 814) that:

"Even if a trademark can be registered which is not in actual use it ought to be restricted to those goods in connection with which it is going to be used. In my opinion it is not the intention of the Act that a man registering a trademark for the entire class and yet only using it for one article in that class, can claim for himself the exclusive right to use it for every article in the class.

This passage and other similar passages cited to me show the tension, which is a recurring theme in intellectual property cases, between the public interest in protecting legitimate rights against piracy, and the public interest in preventing a trader acquiring a monopoly wider than is needed for his legitimate protection. The court has no difficulty in recognising both of these as objectives underlying the trademarks legislation, and Laddie J. (in the *Mercery* case) expressed at least a tentative view that the 1994 Act was intended to curb excessively wide registrations."

If a wide specification is granted for a trade mark, it will be at least five years before a third party can seek to revoke the application on the basis of non use under Section 46 of the Act. However, a registered proprietor is entitled to a period of time within which to make use of their trademark to develop their business. The applicant is in effect seeking a minimum five year period from the date of application within which to put their business and marketing concept to work in relation to all possible goods and services. It is this latter factor which is key to this decision, does the applicant have a bona fide intention to use the applied for mark in relation to sufficient goods and services to justify registration in all classes for which registration is sought. The answer in my opinion is that FST, which for all intensive purposes is Mr Anderson, believes that the idea can work for all goods and services but that they have not been able to put any arrangements in place that show how the partnership approach they propose will work at the date of application. In Exhibit KGA2, it is stated (at page 6) that the situation as at 15 May 2006 was:

"We are looking for companies, inventors, marketing companies, licensing companies, ~~entrepreneurs~~ [i.e. entrepreneurs], manufacturers, etc. Who want to use our brand

future with your brands and for your ideas, goods and services . For the following this creates [*sic*, creates] the global oportunities [*sic*, opportunities] for all to benefit”.

At paragraph 5 of his witness statement, Mr Andersen states that has been writing to people and organisations to invite them to invest in his business ideas and to license use of the FUTURE trade mark since 2000 and his websites have been in existence since 1998 and 2000 with their clear invitation to interested parties to join him. Thus at the time of the application some steps, all be they limited ones, had been taken. The opponent does not dispute these facts. While I would have been happier to see an example of such a letter and some evidence to show that some third party was interested in working with Mr Andersen, I do not think that their absence is sufficient to say that Mr Andersen did not have a bona fide intention to use the trade mark.

58. The opponent does not allege that the opponent, FST was acting dishonestly but rather question whether the applicant had “in applying for a mark over 40 classes specified by class heading genuinely intended to use the mark”. As I have indicated above, FST is seeking registration in 37 classes (not 40 or 42 classes).

59. Taking all of the above into account, I consider that there is not enough evidence for me to conclude that that the applicant does not have a bona fide intention to use or arrange to have the trade mark used with his consent in relation to the goods and services applied for. I am unable to conclude that the applicant did not, at the date of application, have a bona fide intention to use the mark for goods and services in the classes applied for. A balance has to be struck between the right of the applicant to obtain a registration and the public interest to prevent unduly wide specifications, in this instance, I consider that the applicant is entitled to a period of registration within which to develop his business idea further. The applicant is not being given an opened ended opportunity or an unduly wide specification that cannot be challenged, because under Section 6A of the Act, he has a period of five years within which to demonstrate use of the mark or face a challenge on the grounds of non-use.

SECTION 5(2)(b) – LIKELIHOOD OF CONFUSION

60. According to Section 5(2)(b) of the Act a trade mark shall not be registered if because:

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier 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.”

61. Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

Guiding Authorities

62. In determining the question under section 5(2)(b) of the Act, I take into account the guidance provided by the European Court of Justice (ECJ) in:

- (i) *Sabel BV v Puma AG* [1998] RPC 199;
 - (ii) *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117;
 - (iii) *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77;
 - (iv) *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723;
- and
- (v) *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM) (case C-106/03 P)* [2005] ETMR 23.

63. It is not required that actual confusion results between the marks in order for an opposition under Section 5(2)(b) to succeed. The test is the likelihood of confusion.

64. In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion in the mind of a consumer. 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, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

65. 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 more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case."

31. On the basis of the six earlier trade mark registrations indicated above, the opponent is opposing registration of the sign FUTURE under Section 5(2) for the following goods in class 16.

Paper, cardboard and goods made from these materials, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites, furniture, instructional and teaching material, playing card, printers, printing blocks.

The Earlier Marks

66. The registered trademarks all comprise the word FUTURE in conjunction with some additional words. The words CASA EDITRICE and VERLAG have the same meaning in Spanish and German respectively that PUBLISHING has in English. These three marks are registered for the same goods and services (in classes 9, 16, 41 and 42). UK consumers might recognise the word VERLAG as being an equivalent to PUBLISHING but I do not think they would recognise CASA EDITRICE as meaning the same. The term PUBLISHING is descriptive in relation to goods for which these marks are registered in class 16 (printed publications, see above). Thus the distinctive element of these marks is the word FUTURE. Similarly, UK registration 2015230, registered since 1995, for FUTURE MUSIC comprises the word FUTURE in conjunction with a descriptive word (MUSIC) for the goods for which this mark has been used, printed publications on music in class 16. Thus the distinctive element for this mark is also the word FUTURE.

67. CTM 1150614 is registered for the word mark THE FUTURE NETWORK whereas UK 2220616 is registered for THE FUTURE NETWORK, a word + device mark. CTM 01150614) is registered for a wider range of goods in class 16 than UK 2220616. The device element in UK 2220616 emphasises the word FUTURE using a different font and a distinctive form of the letter 'T' when compared to the font used for the other words 'The' and 'Network'. The use of white text on black background is not considered significant. Both of these marks have been registered for a period of more than five years. Use of this mark was used in the 1999 Annual Report of The Future Network plc, the former name of the opponent company, entitled 'fnet' (see Exhibit BM5) and in the 'Portfolio Spring 2001' summary of publications produced by all the companies in The Future Network in 2001 (see Exhibit BM6). Together both of these confirm that THE FUTURE NETWORK trade mark has been used in relation to printed matter. However, the use made of this mark has been much less than the use made of the FUTURE PUBLISHING and FUTURE MUSIC trade mark. Although this mark contains the word FUTURE, I do not think that it can be taken on its own as the dominant distinctive element of the mark. The word NETWORK in this mark is not descriptive for the goods for which it has been used and I do not consider that it can be ignored in the way that Mr Walsh proposes in his skeleton argument so that it also can be considered as, in effect, a FUTURE MARK.

68. Thus I consider that the opponent has the best case under Section 5(2)(b) in relation to CTM 001089374 (FUTURE PUBLISHING) and CTM 001150614 (THE FUTURE NETWORK) which I shall refer to as the Opponents FUTURE marks

69. Exhibits BM1 and BM10 show use by the opponent of the mark FUTURE PUBLISHING on printed publications in a number of forms. These are summarised in the Annex to this decision. All of these are word marks with some additional device elements - white text on black background, presence or absence of a strap-line ('Medin with passion' or 'Your Guarantee of Value') and the word 'future' in a distinctive font where the F and T share the same horizontal bar. However, in each of these the distinctive element of the mark is still the word FUTURE. I consider that use of this mark in the forms shown (see Annex) meets the requirement of Section 6A(4) of the Act, i.e., "use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered".

70. In addition to use of the FUTURE PUBLISHING Trade mark, Exhibits BM10 and BM11 also show use of the trade mark FUTURE MUSIC in relation to goods in class 16 as the title of a monthly music magazine produced by the opponent. Again although words FUTURE MUSIC are presented in a number of different fonts, this does not alter the distinctive character of the mark, the word FUTURE.

Reputation

71. The evidence provided by the opponent shows that they have been involved in the production and sale of printed publications since 1993. The circulation figures provided for six magazine titles, i.e., PC PLUS, PC GAMER, TOTAL GUITAR, TOTAL FILM, PC FORMAT and FUTURE MUSIC published by the opponent shown that significant numbers of people are purchasing the opponents products. All of these magazines have the trade mark FUTURE PUBLISHING printed on the front cover. In 2002, this amounted to an average of just under 400,000 copies of these magazines being sold each month. The opponent has used a number of activities to promote the FUTURE PUBLISHING and FUTURE MUSIC marks, for example, promotional offers using the FUTURE MUSIC trade mark on computer mouse mats, CD-covers and pens (see Exhibit BM7); on t-shirts (see Exhibit BM8) and on books (see Exhibit BM11); and using the FUTURE PUBLISHING trade mark on t-shirts (see Exhibit BM8) and mouse mats (see Exhibit BM7). I am satisfied that this will have firmly fixed in the minds of a large number of consumers in the UK that publications and printed matter which are identified by the word FUTURE are likely to be produced by the company known as FUTURE PUBLISHING that also produces FUTURE MUSIC magazine.

72. I do not consider that there is sufficient evidence to show that the trade mark THE FUTURE NETWORK is well known and has a reputation in its own right. Exhibits BM2, BM4 and BM5 merely provide an explanation that the Future Network is the parent company of Future Publishing, Future Verlag and other subsidiary companies and it provides examples of the magazines that these companies publish. However, I do think that the words Network will bring to mind the word Publishing and that as both marks contain the same distinctive element, the word FUTURE, then a consumer will recognise that the mark FUTURE NETWORK is probably from the same source as FUTURE PUBLISHING.

Comparison of the Marks

73. The applied for mark FUTURE is identical to the dominant and distinctive element of the opponents FUTURE marks.

Comparison of the Goods

74. The opponent has shown use of their FUTURE marks in relation to printed matter and publications. The opponent has also shown that they have a reputation in relation to their FUTURE marks. Thus I consider that given the identical or similar nature of the goods and the identical nature of the marks, there is a likelihood that a consumer seeing the word FUTURE on any printed materials or other such goods in class 16, will bring to mind the opponents mark. It is likely that they will consider that the goods bearing the applicants applied for FUTURE mark will come from the same source as those of the opponent.

75. FPL has been successful in opposing registration of the trade mark FUTURE in relation to all goods in class 16 on the grounds of Section 5(2)(b).

SECTION 5(3) – UNFAIR ADVANTAGE OR DETRIMENT

The Law

76. Section 5(3), by virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, has been amended from its original form to read:

“5-(3) A trade mark which – (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Guiding Principles

77. The scope of this Section of the Act has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572; *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767; *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42; *C.A. Sheimer (M) Sdn Bhd's TM Application (Visu)* [2000] RPC 484; *Valueci Designs Ltd v IPC Magazines (Loaded)* BL/455/00 and, more recently *Mastercard International Inc v Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited v Coinworld Limited and others* [2004] EWHC 1498 (Ch).

78. In order to establish if an earlier trade mark has a reputation, I take account of the guidance laid down in the second *Chevy* case (i.e. [2000], RPC, 5572:

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

76. This case also provides guidance on the nature of the test to be applied in determining whether there is unfair advantage or detriment and the standard of proof that is called for. The Advocate General said (see [(1999), ETMR, 122]):

"43. It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: "takes unfair advantage of, or is detrimental to" (emphasis added). Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court: the national court must be satisfied by evidence of actual detriment, or of unfair advantage. The precise method of adducing such proof should in my view be a matter for national rules of evidence and procedure, as in the case of establishing likelihood of confusion see the tenth recital of the preamble."

77. More recently in *Mastercard International Incorporated v Hitachi Credit (UK) Plc* Mr Justice Smith dealt with a submission by Counsel for the Appellant (on appeal from a Registry opposition decision) that Section 5(3) was concerned with possibilities rather than actualities. Commencing with the above passage from *Chevy*, the judge reviewed the leading cases dealing with the point including observations by Pumfrey J in the *Merc* case and Paton J in *Sihra*. He concluded that the Registry Hearing Officer had been right to conclude that there must be "real, as opposed to theoretical, evidence" that detriment will occur and that the Registry Hearing Officer was "right to conclude that there must be real possibilities as opposed to theoretical possibilities".

78. I should just add that, whilst the above extract refers to real evidence of the claimed form of damage, this cannot mean that there must be actual evidence of damage having occurred. In many cases that come before Registry Hearing Officers the mark under attack is either unused or there has been only small scale and recent use. No evidence of actual damage is possible in such circumstances. I, therefore, interpret the above reference to mean that the tribunal must be possessed of sufficient evidence about the use of the earlier trade mark, the qualities and values associated with it and the characteristics of the trade etc that it is a reasonably foreseeable consequence that use of the other side's mark will have the claimed adverse consequence(s).

79. If it is accepted that there will be damage, it must be more than simply of trivial extent as is evident from the following passage from *Oasis Stores Ltd's Trade Mark Application* [1998] RPC 631:

"It appears to me that where an earlier trade mark enjoys a reputation, and another trader proposes to use the same or similar mark on dissimilar goods or services with the result that the reputation of the earlier mark is likely to be damaged or tarnished in some significant way, the registration of the later mark is liable to be prohibited under Section 5(3) of the Act. By 'damaged or tarnished' I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to be, reduced on a scale that is more than *de minimis*".

80. I note too the following from Mr Geoffrey Hobbs QC (sitting as a Deputy Judge) in *Electrocoin Automatics v Coinworld*:

"102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, 'the link' established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose." (footnotes omitted).

Due Cause by Applicant

81. In considering the issue under Section 5(3), I have also to consider whether the applicant had due cause to use the mark it seeks to register. FST is as to why they are justified in choosing this particular mark, and they are seeking to register it for the goods and services specified. The applicant cannot therefore gain relief under this provision of the Section.

82. As discussed in relation to the Section 5(2)(b) ground, FPL has established that they have a reputation in their FUTURE marks in relation to goods in class 16. FPL is also claiming that they have a reputation in relation to goods in class 25. The evidence provided by FPL does not support this claim to a reputation for goods in class 25. The only examples of use of the opponents FUTURE marks in relation to goods in class 25 has been the reference by Mr Manchester to use of t-shirts in paragraph 18 of his first witness statement. He clearly states that these were being used principally as promotional tools and were given away at trade shows and exhibitions. Mr Manchester states that a small number of t-shirts bearing the FUTURE MUSIC trade mark were sold through the magazine but provides no further information, for example, regarding the number of such t-shirts produced, how many were sold or given away in promotions. Exhibit BM8 shows a T-shirt with the FUTURE MUSIC trade mark printed on the front of it, and a T-shirt with the FUTURE PUBLISHING trade mark printed on the front of it. It is not possible to read the neck labels of these t-shirts.

83. In *Daimler Chrysler AG v. Javid Alavi (T/A Merc)* [2001] R.P.C. 42, Pumfrey J considered whether the use of the MERCEDES-BENZ and MERCEDES trade marks in respect of clothing was mostly "T-shirt use" of these marks as decorative embellishment or as a bill-board to advertise the trade marks. Although he found that the "T-shirt use" in this case was use which indicated trade origin, the learned judge concluded that because of the very close association between the clothing and the cars sold by the claimant under these marks, there was no substantial goodwill in clothing distinct from vehicles. The clothing was sold through showrooms selling Mercedes cars and as part of the gifts and accessories sold by the car company.

84. The use by the opponent of a T-shirt bearing the FUTURE MUSIC mark cannot be considered use that is distinct from use in relation to the magazine for the purposes of generating a separate goodwill. Similarly use of a T-shirt bearing the FUTURE PUBLISHING mark cannot be considered use in relation to clothing that is distinct from use in relation to the opponents publishing business for the purposes of generating a separate goodwill. I am satisfied that the use of the opponent's FUTURE marks on T-shirts is not sufficient to establish a separate and protectable goodwill for clothing in relation to class 25.

85. As the opponent FPL has failed to establish that the earlier mark has the necessary reputation to sustain an objection under Section 5(3), this ground of the opposition fails.

SECTION 5(4)(a) – PASSING OFF

86. Section 5(4)(a) of the Act states:

“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.”

In determining whether the sign in question offends against this section of the Act, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child* case [1998] RPC 455.

Goodwill and Reputation

87. Pumfrey J in *REEF Trade Mark* [2002] RPC 19 stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* [1946] 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.....”

88. Professor Annand, sitting as the appointed person, in the *Loaded* decision BL O/191/02, accepted that proof of goodwill could be accomplished by other means. The judgment of the Court of Appeal in *Phones4U Ltd and another v Phone4u.co.uk Internet Ltd and others* [2006] EWCA Civ 244, reported as [2007] RPC 5, is a warning against basing a decision on a formula and ignoring the actual evidence.

89. As the applicant has already established the likelihood of confusion between the earlier mark and the sign in relation to goods in class 16, I do not need to consider the grounds under Section 5(4)(a) in relation to these goods and will do so only in relation to class 25

90. In order to succeed in a claim for passing off, the opponent will have to show that a person seeing the word FUTURE on goods being sold by the applicant would consider that these goods were being sold by the opponent. The word FUTURE is inherently not very

distinctive as a trade mark because it is a common and well known dictionary word. The reputation and goodwill that FPL have established in relation to goods in class 16 does not in my opinion extend to goods in class 25. I do not consider it likely that a person seeing the word FUTURE on clothing, headgear or footwear in class 25 would consider that these goods were from the same source as goods in class 16 sold under the opponent's FUTURE marks. Thus there is no likelihood that a misrepresentation will occur that is likely to cause damage to goodwill in the opponents business.

91. FPL has not made out the ground under Section 5(4)(a) to oppose registration of the goods in class 25.

Conclusion

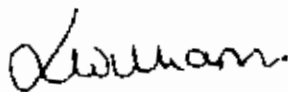
92. FPL has failed in its opposition under Section 3(6) to registration of all the goods and services applied for in trade mark application no. 2290533 for the word mark FUTURE.

93. FPL has succeeded in its opposition under Section 5(2)(b) to the registration of trade mark application no. 2290533 for all goods in class 16 but has failed in its opposition to registration of this mark in relation to goods in class 25 under Section 5(3) and 5(4)(a).

COSTS

94. FPL has succeeded only in part in its opposition to registration by FST of trade mark application no. 2290533 for the word mark FUTURE. As a consequence, I consider that FST is entitled to a contribution towards their costs. I order FPL to pay FST the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of September 2007



AP Dr Lawrence Cullen
For the Registrar,
the Comptroller-General

ANNEX

Trade Mark registration 2290533 for the mark FUTURE
Opposition 93671

The forms of the trade mark FUTURE PUBLISHING used by the Opponent (FPL) on printed publications in the period 1997 to 2001



Media with passion



Date	Magazine
August 2001	PC Format
February 2001	PC Format
March 2001	PC Gamer
August 2001	PC Plus

Date	Mugazine
January 1997	Total Guitar
January 1995	Total Guitar
January 1998	Total Film
January 1998	Future Music

Date	Magazine
January 2001	Total Guitar
February 2001	PC Format
December 2000	PC Gamer
January 2001	Future Music

Date	Mugazine
November 1999	PC Format
June 1998	PC Format
January 2000	Total Guitar
April 1997	Total Film
January 2000	Future Music