

O-084-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2564210
BY STAFANO ZICCHI TO REGISTER THE TRADE MARK**

AEROVOGUE

IN CLASS 25

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 101633
BY THE CONDE NAST PUBLICATIONS LTD**

BACKGROUND AND PLEADINGS

1) On 15 November 2010, Stefano Zicchi applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark AEROVOGUE in respect of *clothing, footwear, headgear* in Class 25.

2) The application was published in the Trade Marks Journal on 26 November 2010 and on 25 February 2011, The Conde Nast Publications Ltd (“Conde”) filed notice of opposition to the application. The grounds of opposition are in summary:

- a) the application offends under Section 5(2)(b) of the Act because the mark is closely similar to two earlier marks in the name of Conde and it is in respect of goods that are identical to Conde’s Class 25 goods and similar to its Class 16 goods and use of Mr Zicchi’s mark would be likely to cause confusion. The relevant details of Conde’s two earlier marks are reproduced below:

Mark details	List of goods
696667 VOGUE Filing date: 9 March 1951	Class 16: <i>Printed publications, catalogues, and paper patterns for use in making clothes.</i>
2342861 VOGUE Filing date: 8 September 2003 Registration date: 9 May 2008	Class 25: <i>Clothing, footwear and headgear.</i>

- b) The mark offends under Section 5(3) of the Act because Conde claims that its earlier mark 696667 enjoys a substantial reputation in relation to its famous fashion and clothing magazine and its related activities. It claims that use or registration of Mr Zicchi’s mark, without due cause, would take unfair advantage and/or would diminish the distinctive character and/or repute of Conde’s mark.
- c) The mark also offends under Section 5(4)(a) because Conde has developed a substantial goodwill under the sign VOGUE as a result of the long standing and continuous trade under the sign in respect of its

magazine that is well known for its articles, features and endorsements on fashion and clothing.

3) By virtue of having a registration date that predates, by more than five years, the publication of Mr Zicchi's mark, Conde's earlier mark 696667 is subject to the proof of use provisions set out in Section 6A of the Act. Conde's other earlier mark relied upon is not subject to these provisions. Consequently, Conde is entitled to rely upon the all the goods listed in its earlier mark 2342861.

4) Mr Zicchi subsequently filed a counterstatement denying Conde's claims and put it to proof of use.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 12 February 2013 when Conde was represented by Ian Bartlett for Beck Greener and Mr Zicchi represented himself.

Opponent's Evidence

6) This takes the form of a witness statement by Pamela Rose Raynor, Finance Director of Conde. Ms Raynor provides a range of information regarding the use of Conde's VOGUE mark in respect to the well know magazine.

7) Ms Raynor states that the New York Times, in December 2006, described VOGUE magazine as "the world's most influential fashion magazine". Ms Raynor also states that the British edition of VOGUE has been published continuously since 1916. It addresses topics such as fashion, beauty, lifestyle and design. Example covers are provided at Exhibit PR2 from the period January 2008 to May 2009. These all clearly show the magazine title VOGUE.

8) Ms Raynor provides UK revenue, mainly obtained from sales and advertising, for the period 2005 to 2011 and are in the region of £20 million or more. Corresponding figures of copies sold in the UK during the same period are approaching 2 million for each year. Ms Raynor also states that, according to the National Readership Survey, average issue readership figures are in excess of a million.

9) At Exhibit PR3, Ms Raynor provides extracts from the VOGUE online magazine at www.vogue.co.uk. These extracts were obtained from waybackmachine at www.web.archive.org and comprise pages dated in 2006, 2007 and 2010. Marks shown in at least one of these pages are VOGUE.COM, VOGUE and "the VOGUE blog" and VOGUETV. Unique user numbers to this website are disclosed as being over 3.8 million in 2007, rising to nearly 12 million in 2011. Advertising of the VOGUE magazine has cost Conde in excess of £600-700 thousand a year since 2005.

10) At Exhibit PR5, Ms Raynor provides printouts from Mr Zicchi's website and she claims that the clothes sold are associated with the aeronautical business. The website promotes shirts, casual [clothing] and footwear. A letter from the, then, advisors to Mr Zacchi (provided at Exhibit PR6), to Conde's representative in these proceedings, states "Our client is an aeronautical goods brand".

Applicant's Evidence

11) This is in the form of two witness statements. The first of these is by Andrew James Clemson, Registered Trade Mark attorney with FJ Cleveland LLP, Mr Zicchi's representatives at the time.

12) Mr Clemson conducted an Internet search to ascertain third party uses of word "vogue". He states that a search for the word "vogue" on [yell.com](http://www.yell.com) revealed of 800 hits and he provides a sample of these at Exhibit AJC1 showing a variety of businesses using the word "vogue" to identify themselves.

13) At Exhibit AJC2, Mr Clemson provides the first page of 100 hits on www.yell.com where the company name is "Vogue" alone. The exhibit shows these hits are in respect of numerous ladies clothes shops, a couple of hairdressers and a selection of other types of businesses.

14) Exhibit AJC3 is a further printout from www.yell.com showing 15 hits for VOGUE found in respect of "ladies fashion". The first ten of these are ladies' clothes shops called "Vogue", all situated in Northern Ireland. One other, also in Northern Ireland relates to an address a trader called "Gerard Vogue". Four are in respect of ladies clothes shops in Scotland and the final entry relates to a ladies clothes shop identified as "Vogue Wise" in Norfolk. Ten further entries are also provided, two of which are "Vogue Fashions & Shoes", again in Northern Ireland and "En Vogue" ladies clothes shop in Nottinghamshire. All others listed do not have VOGUE in their title. Exhibit AJC4 is similar but is in respect of jewellery (14 hits).

15) At Exhibit AJC5, Mr Clemson also provides a full list of companies beginning with the word "Vogue" obtained from the website of Companies House. Fifty are listed.

16) At Exhibit AJC6 and Exhibit AJC7, Mr Clemson provides screen shots from the website of a jewellery shop in Windsor called Vogue and a furniture shop in Glasgow called Vogue Furniture.

17) Finally, Mr Clemson exhibits printouts of registered marks obtained from the IPO's website. These are in respect of the marks BRAVOGUE (Exhibit AJC8), PROVOGUE (Exhibit AJC9) and INVOGUE (Exhibit AJC10). Screenshots are also provided in the first two of these exhibits showing the marks in use on the respective proprietors' websites. In the former, use is in respect of ladies

underwear. In the latter, use is in respect of a “fashion and lifestyle retail business” and states that “the Provogue fashion collections are available [...] across 73 cities pan-India.”

18) The second witness statement is by Mr Zicchi. He explains that he is a private pilot and owner of AV Eight Limited and Institute of Aviators. He explains that the fashion brand AV Eight was developed as part of a strategy to improve and raise the image of the aviation industry in the same way that Ralph Lauren’s Polo brand as done for the sport of polo. He explains that AEROVOGUE is a sub-brand of the AV Eight line of products.

19) The mark AEROVOGUE has been used since February 2008 in respect of bespoke menswear and ladies wear and it has been used continuously in the UK since then. Where use has been through the company AV Eight Limited, it has been with Mr Zicchi’s full consent. Sales to date have been made from the web site www.aveight.aero and screen shots are provided at Exhibit SZ2 showing prices in pound sterling.

20) Mr Zicchi states that there “have not been sales of any significance” because the operation has been in product development. At Exhibit SZ3 is a spreadsheet showing purchase order activity from 25 May 2010 showing forty orders totalling just over £24,000. Many of these relate to fabric, lining, buttons, cottons, labels etc. and not to the sale of the finished clothing. Mr Zicchi provides details of advertising and marketing expenditure in the UK totalling nearly £18,000.

21) Mr Zicchi is not aware of any instances of confusion.

22) At Exhibit SZ4, Mr Zicchi provides screen shots from eight websites showing use by third parties of the element VOGUE alone and marks incorporating the word VOGUE. These are shown, in use, in respect of furniture (one website), beds (one website), skincare and beauty care (one website), use of GERARD VOGUE, COUNTRY VOGUE and VOGUE LIMAVADY for the retail of clothing and other goods.

Opponent’s Evidence in reply

23) This is a witness statement by Susan Caroline Davey, trade mark attorney with Beck Greener, Mr Zicchi’s representative at the time. At Exhibit SCD2, Ms Davey provides photographs of a top purchased from www.gerardfashions.com, one of the retailers represented in Mr Zicchi’s Exhibit SZ4. No mention of VOGUE is made on the label or swing tag. Exhibit SCD3 is a screen shot from Mr Zicchi’s website showing his mark AEROVOGUE appearing on a clothing label.

DECISION

Section 5(2)(b)

24) At the hearing, Mr Bartlett stated that the ground based upon Section 5(2)(b) of the Act was its primary claim. Section 5(2)(b) reads:

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

(a) ...

(b) 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.”

25) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

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

26) Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

27) Conde relies upon two earlier marks, both are registered and therefore qualify as earlier marks as defined by Section 6 of the Act. Earlier mark 696667 is also subject to the proof of use provisions because its registration procedure was completed more than five years before the publication of Mr Zicchi's mark. However, as recognised by Mr Bartlett at the hearing, Conde's best case lies with its other mark, 2342861, as it is in respect of identical goods. If Conde is not successful when relying upon this mark, it will be no more so when relying on 696667 in respect of non-identical goods. Consequently, I limit my consideration under this ground of opposition to a comparison of Mr Zicchi's mark with Conde's 2342861 mark. In light of this, it is not necessary for me to consider the issue of proof of use in respect to Conde's other earlier mark.

28) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

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

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

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

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

Comparison of goods

29) It is self evident that as both the respective specifications include the terms *clothing*, *footwear* and *headgear* that the respective goods are identical.

The average consumer and nature of purchasing act

30) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

31) I am mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [2000] R.P.C. 285 when he said the following, in respect of the purchasing process for clothing:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

32) The General Court (“GC”) has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). There is no evidence in the current case suggesting that I should take a different view to that expressed by Mr Thorley and I apply his comments here. The purchasing act will involve a reasonable degree of care and attention but not the highest degree of attention. As Mr Thorley noted, the purchasing process is primarily a visual one but I do not ignore the aural considerations that may be involved. The average consumer of the respective goods is likely to be ordinary members of the public.

Comparison of marks

33) For ease of reference, the respective marks are:

Conde’s mark	Mr Zicchi’s mark
VOGUE	AEROVOGUE

34) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). Conde's mark consists of the single word VOGUE and it follows that this is the dominant and distinctive element. Mr Zicchi's mark consists of the prefix AERO conjoined with the word VOGUE. There is a natural break between these two words, resulting in them both retaining their own distinctive character and remaining identifiable as independent elements within the mark, being equally dominant.

35) Having identified the dominant and distinctive elements of the respective marks, I now turn to compare the marks. From a visual perspective, they share some similarity in that the word VOGUE appears in both marks. Mr Zicchi's mark also has the additional four letters AERO appearing at the beginning of his mark. This gives the appearance of a noticeably longer mark. Taking account of these points, I conclude that the respective marks share a moderately high level of visual similarity.

36) Aurally, Conde's mark consists of a single syllable, whereas Mr Zicchi's mark consists of three syllables, the first two being absent in Conde's mark. These similarities and differences combine to give the marks a moderate level of aural similarity.

37) Conceptually, Mr Bartlett submitted that the word AERO is descriptive, but that VOGUE is distinctive. The word AERO is defined as an informal adjective for *aeronautical* or *aerodynamic*¹. The word VOGUE is defined as a noun meaning "the prevailing fashion or style at a particular time"². With these meanings in mind, Mr Zicchi's mark may be said to allude to the prevailing aeronautical fashion. However, it is not obvious to me that the average consumer will perceive such a meaning. This is because the word VOGUE is somewhat nebulous in nature, and whilst the consumer may vaguely know it has something to do with fashion, they are likely not to know its precise meaning. Consequently, in the absence of evidence to the contrary, I consider that the average consumer will not attach any direct descriptive meaning to the word VOGUE. Taking all of this into account, the consumer is unlikely to see the descriptive possibilities in the respective marks. However, insofar as the consumer may understand the conceptual meaning of the word VOGUE, the marks will share a moderate level of conceptual similarity.

38) I have found that the respective marks share a moderately high level of visual similarity, a moderate level of aural similarity and, insofar as any meaning may be attributed to the marks by the consumer, a moderate level of conceptual

¹ "aero". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 20 February 2013 <<http://oxforddictionaries.com/definition/english/aero?q=aero>>.

² "vogue". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 20 February 2013 <<http://oxforddictionaries.com/definition/english/vogue?q=vogue>>.

similarity. Overall, this combines to give the marks a moderate to moderately high level of similarity.

Distinctive character of the earlier mark

39) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

40) Whilst Conde has provided extensive evidence regarding the use of its mark in respect of its well known fashion magazine, there is no evidence that it has used its mark in respect of any *clothing, footwear or headgear*. Consequently, I need only the inherent qualities of its mark. In this respect, I have already noted that its possible allusive quality, in respect of *clothing, footwear and headgear*, is not likely to be perceived by the average consumer. Consequently, its inherent distinctive character is likely to be moderate rather than low.

Likelihood of confusion

41) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

42) Mr Zicchi submitted at the hearing that because the business areas of the parties are different, with VOGUE being a media vehicle and AEROVOGUE being a fashion brand, there cannot be confusion. This is not the issue that I have to consider. I am required to consider the notional position when considering the marks and goods, as set out in Conde's earlier mark and as set out in Mr Zicchi's application, and not what the actual position is in the market place. Conde has a registration that covers *clothing, footwear and headgear*. It is this specification of goods that defines the scope of Conde's claim and not its activities in the market place. Consequently, for the purposes of my considerations, the business area of the two parties is identical, namely *clothing, footwear and headgear*. Therefore, I dismiss Mr Zicchi's argument.

43) In reaching this conclusion, I have kept in mind the guidance of the court in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 where Laddie J stated:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

44) Mr Zicchi's other main submission (and focus of his evidence) is that there are numerous other businesses operating in the fashion industry in the UK that identify themselves either by the word VOGUE or a name that incorporates the word VOGUE. In making such a submission, Mr Zicchi gave a broad interpretation to the meaning of “fashion industry” and expressed the view that it includes the furniture industry as well as jewellery and clothing. His evidence also included information about a skincare and beauty care business using the word VOGUE. Consequently, his evidence of businesses using the word VOGUE covers this broad spectrum of businesses. It is my firm view that the existence of a business called “Vogue Furniture” or a skincare and beauty care business using the word VOGUE does not assist his case. Conde does not rely on a mark that covers such goods. The goods at issue here, as I have already stated, are *clothing, footwear and headgear*.

45) Mr Zicchi also provides evidence of numerous other businesses using the word VOGUE and at the hearing, Mr Bartlett provided detailed submissions as to why this evidence should be considered as not being persuasive in supporting the contention that the word VOGUE is commonly used in the fashion industry to identify traders and that, as a result, it has a lessened capacity to identify Conde's VOGUE goods. It is not necessary that I discuss all of Mr Bartlett's criticisms in detail. It is sufficient that I record that he pointed out that some relate a furniture trader, others to jewellery traders and where the evidence relates to clothing, it is in respect of a company based in India and where there is no evidence of actual use in the UK, or it is in respect of a name for clothing

retailers. Mr Bartlett points out that with regard to this latter group of traders, there is no information regarding the scale of use, nor if the use of the various VOGUE signs extends to use on clothing rather than identifying a retail shop.

46) I concur with Mr Bartlett that this evidence does not demonstrate what Mr Zicchi purports that it does. There is nothing to illustrate that the word VOGUE is commonly used as a mark to identify clothing, footwear or headgear, and whilst there is some evidence of it being used to identify some traders in the wider fashion industry, the scale of this is unknown for the reasons put forward by Mr Bartlett. I conclude that the ability of Conde's VOGUE mark to identify its goods is not diminished by the use, by third parties, identified in Mr Zicchi's evidence.

47) Further, the list of company names provided at Mr Clemson's Exhibit AJC5 does not advance Mr Zicchi's case as it is not known whether such company names are used as trade marks to identify those companies' goods or services. Consequently, this evidence cannot be interpreted as demonstrating the situation in the market place.

48) Mr Bartlett referred me to *Bulova Accutron* [1969] RPC 102 which was decided under the old Trade Marks Act. The court held that a word that is confusingly similar with an earlier mark is not "rendered innocuous" by the addition of another word appearing before the word. As Mr Bartlett also pointed out, this approach has been expressed, albeit in slightly different terms, more recently by the CJEU in *Medion*. The relevant comments are:

"30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established."

49) I must also take account of the level of distinctive character of Conde's mark. In doing so I am mindful of the following guidance of the GC in Case T-189/05, *Usinor SA, v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM):

70. Nevertheless, although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (*Canon*, paragraph 24), it is only one factor among others involved in that

assessment. Thus, even in a case involving an earlier mark of weak distinctive character, on the one hand, and a trade mark sought to be registered which is not a complete reproduction of it, on the other, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (Case T-112/03 *L'Oréal v OHIM – Revlon (FLEXI AIR)* [2005] ECR II-949, paragraph 61), particularly where the mark sought to be registered includes elements which are even less distinctive than the element that is common to the marks at issue (see, to that effect, order of 27 April 2006 in Case C-235/05 P *L'Oréal v OHIM*, not published in the ECR, paragraph 45). Since likelihood of confusion is the specific prerequisite for protection of the earlier mark, that protection applies irrespective of whether the earlier mark has only weak distinctiveness (Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraph 110). The fact that the earlier mark has weak distinctive character does not therefore mean that the similarity of the marks at issue may be disregarded; otherwise there would be a failure to comply with the obligation under Article 8(1)(b) of Regulation No 40/94 to make a global assessment of the likelihood of confusion (see, to that effect, Case C-171/06 P *TIME ART v Devinlec and OHIM* [2007] ECR I-0000, paragraph 41).

50) It is my view that the word VOGUE does indeed have a distinctive role in Mr Zicchi's mark. Further, as Mr Zicchi's own evidence illustrates, AERO may be used and perceived as indicating a link to aeronautics. Consequently, this element of his mark is no more than a weak level of distinctive character. The result is that the VOGUE element of his mark will have a greater prominence in the mind of the average consumer.

51) I conclude that there is no likelihood of direct confusion because the addition of the word AERO in Mr Zicchi's mark will not go unnoticed. However, taking account of all of the above guidance, I find that there is indirect confusion in the sense that the average consumer will assume that the respective marks identify goods that originate from the same or linked undertaking.

52) It has been recognised by the GC in Case T-400/06, *Zero Industry Srl, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, paragraph 81) that "it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates, and second, it is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another". With this in mind, it is my view that the consumer is likely to see goods provided under the mark AEROVOGUE as being a sub-brand of VOGUE clothing, possibly designating a sub-brand with some link to aeronautics.

53) Consequently, I find there is a likelihood of confusion in respect of all of the goods subject to these proceedings and the opposition under Section 5(2)(b) succeeds in its entirety.

Section 5(3) and Section 5(4)(a)

54) At the hearing, Mr Bartlett stated that these grounds were “very much secondary” to the ground based upon Section 5(2)(b) and that they were only raised in case the opposition based upon Section 5(2)(b) failed. It has not. The opposition based upon Section 5(2)(b) has been successful in its entirety. Consequently, it is not necessary to consider these additional grounds of opposition.

COSTS

55) The opposition having been successful, Conde is entitled to a contribution towards its costs. I take account of the fact that a hearing has taken place and that both sides filed evidence. I award costs on the following basis:

Preparing Notice of Opposition (including official fee) and considering statement of case in reply	£500
Preparing evidence and considering other side’s evidence	£700
Preparing and attending hearing	£600
TOTAL	£1800

56) I order Stefano Zicchi to pay The Conde Nast Publications Ltd the sum of £1800. 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 25th day of February 2013

**Mark Bryant
For the Registrar,
the Comptroller-General**