

O-314-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3022188
BY VOQUE LIMITED
TO REGISTER THE TRADE MARK:**



**IN CLASSES 18 & 25
AND**

**IN THE MATTER OF JOINT OPPOSITION
THERE TO UNDER No. 401308 BY
THE CONDE NAST PUBLICATIONS LIMITED AND
ADVANCE MAGAZINE PUBLISHERS INC.**

BACKGROUND

1) On 16 September 2013, Voque Limited (hereinafter the applicant) applied to register the trade mark shown on the above page in respect of the following goods:

In Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.

In Class 25: Clothing, footwear, headgear.

2) The application was examined and accepted, and subsequently published for opposition purposes on 18 October 2013 in Trade Marks Journal No.2013/042.

3) On 6 December 2013 The Conde Nast Publications Limited and Advance Publishers Inc. (hereinafter the opponents) jointly filed a notice of opposition. The grounds of opposition are in summary:

a) The opponents are the proprietors of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification
VOGUE	2625601	22.06.12 19.04.13	25	Clothing; footwear; headgear.
TEEN VOGUE	2654639	01.03.13 09.08.13	18	Goods of leather and/or imitation leather; clothing, belts, collars and leads for animals; whips; harness and saddlery; walking sticks; animal skins; hides; luggage; bags; brief cases; document cases; shopping bags; trunks; travelling bags; handbags, shoulder bags, tote bags, backpacks and ruck sacks; bicycle bags; purses; wallets; key cases; parts, fittings and accessories for all the aforesaid goods.
VOGUE	696667	09.03.51 09.03.51	16	Printed publications, catalogues, and paper patterns for use in making clothes.

b) The opponents contend that the mark in suit is confusingly similar to their registered trade marks shown above. They state that the goods applied for in the mark in suit are similar or identical to those for which their marks are registered. The mark in suit would be confused with the opponents' marks and would, without due cause, take unfair advantage of or be detrimental to the distinctive character of the opponents' marks, in that it would cause tarnishing and/or loss of distinctiveness. The mark in suit therefore offends against sections 5(2)(b) and 5(3) of the Act. The opponents accept that their strongest case under section 5(2)(b) rests with their trade marks 2625601 and 2654639; whereas their strongest case under section 5(3) rests with their trade mark 696667.

c) The opponents contend that they (or their predecessors in business) have published the world famous magazine VOGUE since 1916. They contend that the magazine is the world's best known and most prominent fashion and beauty magazine. It has provided information, advice, articles, recommendations, events, competitions offers and retail and advertising services relating to fashion clothing beauty and style. The opponents contend that they have goodwill and reputation in the mark Vogue and that use of the mark in suit would cause misrepresentation and damage to their goodwill. The mark in suit therefore offends against section 5(4)(a) of the Act.

4) On 21 October 2014, the applicant filed a counterstatement. Basically, it denied all the grounds and commented that it is involved in the retail of clothing and so its activities are significantly different to the "fashion bible" printed by the opponents. It claims that the marks are different visually and in meaning as it contends that its mark VoQue (e'voque) in free translation means evokes or awakes which directly reflects the circumstances in which the applicant company was established. It also contends that there are other marks registered in the UK which contain the word "vogue" but none containing the word "VoQue". It does not put the opponents to proof of use.

5) Only the opponents filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard; only the opponents provided written submissions.

OPPONENTS' EVIDENCE

6) The opponents filed a witness statement, dated 14 January 2015, by Pamela Rose Raynor the Finance Director of The Conde Nast Publications Ltd, a wholly owned subsidiary of Advance Magazine Publishers Inc. She states that she has full access to the records of both companies and is authorised by both to make her statement. From her statement I take the following:

- A fashion and beauty magazine has been published under the name VOGUE in the UK since 1916.
- It is a monthly magazine which has, during the period 2008-2013, generated average annual sales of over 1,200,000, with advertising revenues for the same period averaging £21million per annum.
- The estimated number of readers during this period has averaged over 1.2million per annum.
- In the same period an average of over £600,000 per annum was spent promoting the magazine. Since 2009 the on-line magazine has attracted a substantial number of readers.
- The magazine has won a large number of awards.
- The magazine has hosted a number of fashion events, and produced T-shirts with the Vogue name upon them.
- The Conde Nast College of Fashion and Design offer a twelve month VOGUE fashion foundation diploma, a VOGUE Intensive Summer course and the VOGUE Fashion Certificate.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The first ground of opposition is based on section 5(2)(b) which reads:

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

(a)

(b) it is similar to an earlier 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.”

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

(a) 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.”

10) The opponents are relying upon their trade marks listed in paragraph 3 above which are clearly earlier trade marks. Given the interplay between the dates that the opponents' marks (2625601 & 2654639) were registered (19 April 2013 & 9 August 2013 respectively) and the date that the applicant's mark was published (18 October 2013), section 6A of the Trade Marks Act does not come into play. Trade mark 696667 was registered on 9 March 1951 and so would have required proof of use but the applicant did not request this of the opponents in its counterstatement. The opponents are therefore entitled to rely on each of the earlier marks and for each of the goods as registered.

11) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) 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;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

13) The applicant's specification is for, broadly, clothing, footwear, bags and leather goods in classes 18 & 25. The opponent's specifications also cover the same items. The goods of both specifications can vary somewhat in their prices but neither would be considered to be complex. The items would be

purchased by the average member of the public and businesses. Such items tend, for the most part, to be purchased in shops or online. In shops and online they will be self selected and the visual aspect will be the most important element. When purchasing in a shop or if ordering by telephone aural considerations must be considered but the initial choice will still be made visually. Retailers will also be customers but I believe that they will make their choices in a similar way, be it from the internet, a brochure or the shelves in a cash and carry. They may also order via the telephone or in person. Effectively they have the same issues as the general public and I regard them to be the same. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

14) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

15) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average consumer is likely to pay a reasonable degree of attention to the selection of items of clothing, footwear, bags and leather goods.

Comparison of goods

16) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18) For ease of reference the goods of the two parties are as follows:

Opponent's goods and services	Applicant's goods
2654639: In Class 18: Goods of leather and/or imitation leather; clothing, belts, collars and leads for animals; whips; harness and saddlery; animal skins; hides; trunks; travelling bags; handbags, backpacks and rucksacks; purses; wallets; key cases; walking sticks; luggage; bags; brief cases; shoulder bags, tote bags, document cases; shopping bags; bicycle bags; parts, fittings and accessories for all the aforesaid goods.	In Class 18: Leather and imitations of leather; clothing for animals. whips, harness and saddlery; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks.
2625601: in class 25: Clothing; footwear; headgear.	In Class 25: Clothing, footwear, headgear.

19) The respective specifications in each class are clearly identical, with the exception of umbrellas and parasols in Class 18 which are not similar to any of the opponents' goods in classes 18 or 25.

Comparison of trade marks

20) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Case C-591/12P, Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

21) It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponents' trade marks	Applicant's trade mark
2654639: TEEN VOGUE	
2625601: VOGUE	

22) The applicant contended in its counterstatement that the marks of the two parties have different fonts and completely different typography. It also points out that the graphic element is in the middle of the word element of its mark. It also claims that the respective meanings of the words in the marks of the two parties are different. It claims that its mark “VoQue (e´voque) in free translation means evokes, or awakes” whereas it states that the opponents’ mark Vogue “is usually associated with the word “fashion”, it indicates the general character of the trademark i.e. a broad scope that could be interpreted in various ways”.

23) I shall first compare the applicant’s mark to the opponents’ trade mark 2625601. The word VOGUE is a well known English word which means fashionable or popular. Clearly, when used in relation to class 18 and 25 goods it alludes to the goods being “of the moment” or fashionable. To my mind, the font used by the applicant is not unusual and the opponents would be within their rights to use its mark in the same font. Clearly, the applicant’s mark has a large device element in the middle of the word and the middle letter “Q” is significantly larger than the other letters in the mark. The applicant has not claimed that the device element would convey anything to the average consumer,

and given that it consists of a circle and a crown I would agree that the average consumer would see these elements but they would not convey any meaning and do not affect the fact that the mark consists of and would be seen by the average consumer as “VOQUE”. The applicant contends that the word would be seen as a shortened version of “evoque” but does not say why the average consumer would make this adjustment. I do not accept this contention; to my mind the average

consumer will view the mark as a VOQUE mark. There are obvious visual similarities in that the first two and last two letters of each mark are identical and both are five letter marks. The marks differ in their middle letters, and the fact that the applicant's mark has two device elements and the middle letter is much larger than the other letters of the mark. Overall the marks have a moderate degree of visual similarity. Aurally the marks are quite similar in their initial sound, as both would be pronounced "Vo", but differ in that the second syllables are "g" and "q" respectively. To my mind each mark would sound "VOK" (short "o") and Vohg (long "o"). Overall they are aurally similar to a low degree. Conceptually the opponent's mark has a well known meaning whilst the applicant's mark would be seen as an invented word.

24) Moving onto the opponents' trade mark 2654639 for TEEN VOGUE. The goods for which this mark is registered are, broadly, bags and leather goods. Here the word TEEN has a clear meaning as such items are routinely designed specifically to appeal to teenagers, much as clothing and other fashion accessories are also designed for particular age groups. To my mind, the average consumer will view the word as describing the clientele at which the goods are aimed. The second word in the mark has already been discussed in the preceding paragraph. There is a low degree of visual similarity, and also a low degree of aural similarity. Conceptually the opponents' mark has meaning the applicant's does not.

Distinctive character of the earlier trade mark

25) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

26) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of

confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

27) However the independent and distinctive element does not need to be identical. In *Bimbo SA v OHIM*, Case T-569/10, the General Court held that:

"96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60)."

28) In *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), Arnold J. stated that:

"47. In my view the principle which I have attempted to articulate in [45] above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *Bulova Accutron* the earlier trade mark was ACCURIST and the composite sign was BULOVA ACCUTRON. Stamp J. held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.

48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion."

29) The opponents' 2625601 mark is a well known English word whose distinctive character lies within its whole and which is not directly descriptive of the goods and so has a moderate level of inherent distinctiveness. The opponents' 2654639 consists of two words, one of which is descriptive of the consumer that the goods are aimed at, and so the initial word "Teen" has a very low level of distinctiveness, and the second word whilst being well known is clearly the dominant and distinctive

element. Overall the mark has a moderate level of inherent distinctiveness. Whilst the opponents have filed evidence of use of its mark VOGUE in the UK it is related to use on a fashion and beauty magazine. The very limited use on clothing (and none on class 18 goods) is not enough for the opponents to benefit from enhanced distinctiveness.

Likelihood of confusion

30) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' trade marks as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public, who will select the goods and services by predominantly visual means and who will pay only a reasonable degree of care when doing so;
- The respective specifications in each class (18 & 25) are clearly identical, with the exception of umbrellas and parasols in Class 18 which are not similar to any of the opponents' goods in classes 18 or 25.
- In comparing the mark in suit to the opponents' mark 2625601 the competing trade marks have a moderate degree of visual similarity. Aurally the marks are similar to a low degree. Conceptually the marks are different.
- In comparing the mark in suit to the opponents' mark 2654639 the competing trade marks have a low degree of visual and aural similarity. Conceptually the marks are different.
- the opponents' earlier trade mark 2625601 has a moderate level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness as no evidence of use in relation to clothing in the United Kingdom was filed. The opponents' earlier trade mark 2654639 overall has a moderate level of inherent distinctiveness. As no use on goods in class 18 was shown in the evidence the mark cannot benefit from enhanced distinctiveness.

31) In view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponents or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds with the exception of umbrellas and parasols in class 18.**

32) I next turn to the ground of opposition under section 5(3) which reads:

“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.”

33) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Addidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark’s image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or

similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

34) Under this ground the opponents rely upon their trade mark 696667 which is registered for goods in Class 16. The onus is upon the opponents to prove that their earlier trade mark enjoys a reputation or public recognition and it needs to furnish the evidence to support this claim. To my mind the opponents have provided the evidence, see paragraph 6 above, that its mark does enjoy such a reputation in respect of a fashion and beauty magazine and so it clears the first hurdle.

35) Once the matter of reputation is settled an opponent must then show that the relevant customers would make a link between the two trade marks and how its trade mark would be affected by the registration of the later trade mark. In Case C-408/01, *Addidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

36) There is some debate as to whether the judgment of the CJEU in *L'Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L'Oreal v Bellure* [2010] RPC 23 when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood* [2010] RPC 2: see paragraph 136. Thirdly, in *Specsavers v Asda Stores Limited*¹ [2012] EWCA Civ 24: see paragraph 127. On each occasion the court appears to have interpreted *L'Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. However, the absence of due cause appears to be closely linked to the existence of unfair advantage. See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*.

37) In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (CH) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair

advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

38) In *Aktieselskabet af 21. November 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded *prima facie* that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude *prima facie* that there was a risk, which was not hypothetical, of unfair advantage in the future.”

39) I must consider the similarity of the opponents’ fashion and beauty magazine to the goods applied for. Whilst the magazine carries photographs and articles about clothing and leather goods such as bags etc which are found in class 18 there are clearly fundamental differences between the goods of the two parties.

40) I accept that similarity of goods is not required under section 5(3) but it is one of the factors which I have to take into account in determining whether the average consumer will make a link between the marks of the two parties. The term VOGUE means fashionable or popular and so it has only a low degree of inherent distinctiveness when used on a magazine dealing with fashion in all its forms. I also found earlier that the opponents’ mark has an enhanced reputation through use in respect of magazines. The competing trade marks are visually similar to a moderate degree, are aurally similar to a low degree and are conceptually different. The applicant has provided no reason for adopting the mark in suit. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that the average consumer will make the link between the marks in respect of the applicant’s goods, and that there is an advantage for the applicant to derive, from both the reputation of the opponents and the promotional activity they carry out. **The opposition under Section 5(3) therefore succeeds.**

41) In light of this finding I decline to go onto consider the position under section 5(4), although given my other findings I believe that the result would also have been in favour of the opponents.

CONCLUSION

42) The opposition under Sections 5(2)(b) and 5(3) have been successful.

COSTS

43) As the opponents have been successful they are entitled to a contribution towards their costs.

Expenses	£200
Preparing a statement and considering the other side’s statement	£300
Preparing evidence	£500

Preparing submissions	£200
TOTAL	£1200

44) I order Voque Limited to pay The Conde Nast Publications Limited and Advance Publishers Inc. jointly the sum of £1200. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of July 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**