

O/014/21

TRADEMARKS ACT 1994

IN THE MATTER OF THE TRADEMARK APPLICATION UK00003411509

BY

ROZ O'BRIEN

TO REGISTER THE FOLLOWING TRADEMARK IN CLASS 44

Vanity Fur Surrey

AND THE OPPOSITION UNDER NO. 418368 THERETO

BY

RICHARD PARKER

## **Background and pleadings**

1. Roz O'Brien (the applicant) applied to register the trade mark 'Vanity Fur Surrey' in the UK on 4 July 2019. It was accepted and published in the Trade Marks Journal on 13 September 2019 in respect of class 44 for Dog Grooming Services.
2. Richard Parker (the opponent) opposes the trade mark on the basis of Section 5 (1) and 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK trade mark 3405766, for the mark 'Vanity Fur' which is also registered in respect of Dog Grooming Services. The earlier mark was applied for on 10 June 2019 and registered on 8 November 2019.
3. The opponent argues that the marks are identical or similar and the respective services are identical or similar also. It claims that there is a likelihood of confusion as the only difference between the marks is the addition of a geographical place name – Surrey. The opponent argues this is further likely to cause confusion given both parties are currently trading within the area of Surrey.
4. Neither party was represented during the proceedings. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
5. Both sides filed written submissions which I will not summarise here but will refer to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## DECISION

6. Section 5(1) of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

7. Section 5(2)(b) is also being relied upon and is as follows:

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

(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”.

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts 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 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and

which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2, above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

### **Comparison of the services**

10. The services of both the Applicant and Opponent are ‘Dog Grooming Services’ and are therefore identical.

### **Identity of the marks**

11. Section 5(1) requires the marks to be identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

12. The marks at hand differ only in the additional word ‘Surrey’ in the Applicant’s mark. However, I must consider whether that additional element is purely descriptive in nature. In this regard I remind myself of the decision reached in *Reed Executive plc v Reed Business Information Ltd*, Court of Appeal [2004] RPC 767. Jacob L.J. found that ‘Reed’ was not identical to ‘Reed Business Information’ even for information services. He stated that:

“40. It was over “Reed Business Information” that battle was joined. The composite is not the same as, for example, use of the word “Reed” in the sentence: “Get business information from Reed”. In the latter case the only “trade-marky” bit would be “Reed”. In the former, the name as a whole is “Reed Business Information”. The use of capital letters is of some visual significance – it conveys to the average user that “Business Information” is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg “Palmolive Soap” compared to “Palmolive”) the position might have been different. But “Business Information” is not so descriptive – it is too general for that.”

13. Taking this into account I must consider whether “Surrey” is solely descriptive in nature. In this instance it is referring to a geographical location that is likely to be perceived simply as the origin of the services on offer. It does not add anything else and is not general enough to make a difference to the marks. The marks may therefore be considered as identical.
14. As I have found the marks and the services at issue to be identical, the opposition, insofar as it is based on Section 5(1), has been successful.
15. The Opponent has also opposed the application under Section 5(2)(b) which requires the marks to be similar. In the event that I am found to be wrong in my conclusion under Section 5(1), that the marks are identical, I will now determine whether the marks would be considered similar.
16. The following principles 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*.

The principles:

(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 greater 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 to mind the earlier mark, 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.

### **Comparison of marks**

17. 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 the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

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

19. The respective trade marks are shown below:

<b>Vanity Fur</b>	<b>Vanity Fur Surrey</b>
Earlier trade mark	Contested trade mark

20. The earlier mark comprises two words, VANITY and FUR. The word FUR may be said to have a suggestive quality within the context of the services at issue, being the grooming of dogs. The word VANITY may also have an allusive quality. The sign, when considered as a whole, will likely be perceived as a play on the expression ‘VANITY FAIR’ and as such will likely be considered as a unitary sign that hangs together. Neither element can be said to be more dominant than the other, and while the word VANITY may be said to be more distinctive than the word FUR, neither element can be said to play a greater role in the mark. The overall impression in the earlier mark lies in its totality.

21. The contested mark also contains the words VANITY and FUR, but also includes the word SURREY, which will be perceived simply as the geographical origin of the services at issue, being a large county in England. As such the word SURREY can be said to play a lesser role in the mark and, as has been found in the assessment of the earlier mark, it will be the combination VANITY



FUR that plays the greater role in the contested mark. The overall impression in the contested mark lies in the words VANITY FUR.

22. Comparing the marks visually, both contain the words 'Vanity Fur' presented identically, with the Opponent's mark wholly contained within, and forming the beginning of the Applicant's mark. The applicant's mark also contains the word 'Surrey' which is placed at the end of the mark and even though this addition represents approximately one third of the Applicant's mark, I find that the marks are visually similar to at least a medium degree.
23. The competing marks are aurally similar to the extent that the first two words of the applicant's mark will be pronounced identically to the opponent's earlier mark. It is possible that the further verbal element 'Surrey' in the Applicant's mark may not be articulated by the average consumer as to them it is likely to be perceived as describing the origin of the services. For the consumer that will not articulate the element 'Surrey' the marks are aurally identical. Where it is the case that the element 'Surrey' is articulated then the marks can be said to be similar to at least a medium degree.
24. Conceptually both marks are likely to be perceived by the average consumer as a play on the term 'Vanity Fair'<sup>1</sup> and therefore share an identical concept. The word 'Fur' in both marks conveys a message that is likely to be perceived as a link to the kind of animals to which the services at issue are aimed. The word 'Vanity' conveys the message of taking care of appearance and looks and may possibly be considered suggestive of the types of services that are provided.
25. The additional element 'Surrey' in the Applicant's mark will be readily understood as an English county<sup>2</sup> and therefore will convey a message regarding the likely geographical origin of the services. The marks can be said to be conceptually similar to a high degree.

---

<sup>1</sup> <https://www.collinsdictionary.com/dictionary/english/vanity-fair>

<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/surrey>

## Average consumer and the purchasing act

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

27. 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.”

28. The parties have differing views on their average consumers. The Applicant claims that their average consumer is limited to a very local range (of around 5 miles). The Opponent claims to have customers that travel to use their services from much further afield. My assessment of the average consumer, however, does not hang on the question of where that consumer may come from or how far they may be prepared to travel in order to take up the services of either party.

29. I consider that the average consumer of dog grooming services will be members of the general public that own dogs. The selection of such services will largely be a visual process in traditional outlets or from websites online, however I do not ignore the potential for the marks to be spoken, for example,

by sales assistants in a retail establishment or through word of mouth recommendations.

30. I also consider that the average consumer will be paying at least an average degree of attention in their purchase. The purchase will require more attention than casual inexpensive purchases (*e.g. daily consumables*) as it involves the treatment of their dog. Most dog owners would see their dog as part of their family and would therefore pay a reasonable degree of attention to how their dog is treated and looked after by others. However, it does not require the highest level of attention as the services are still not overly expensive and likely to be procured on a regular basis.

### **Distinctive character of the earlier trade mark**

31. 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).”

32. 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.”

33. The Opponent filed a small amount of evidence of their mark in use however has not claimed that the use has enhanced its distinctiveness. I will therefore consider the position based on the inherent distinctiveness of the mark.

34. The earlier mark consists of two words both of which can be said to be ordinary dictionary terms that will be readily understood individually. The words allude to the services being provided- ‘Vanity’ in reference to the grooming services element and ‘fur’ being a nod to the fact the services are for dogs. The mark does not however directly describe the services being provided. I consider the totality ‘Vanity Fur’ to be a play on the well-known expression ‘Vanity Fair’ and this fanciful concept raises the level of the distinctiveness of the mark.

Therefore, 'Vanity Fur' can be said to be inherently distinctive to at least a medium degree.

### **Likelihood of Confusion.**

35. The Applicant has submitted that the businesses have been trading using their respective names and at this point, no customers have confused the two. I must consider the guidance from Millett L.J. in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 where it was stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

36. Whilst the consumers may not have mistakenly travelled to the incorrect premises, this does not mean that they could not confuse the two marks as being the same.

37. There are two types of confusion that I must consider here. Firstly, direct confusion i.e. one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

38. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on

the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

39. To determine whether there is a likelihood of confusion, I must bear in mind a number of factors. I have found the marks to be visually similar to at least a medium degree, aurally similar to at least a medium degree or potentially identical, and conceptually similar to a high degree. The services are identical. I have found the average consumer to be using at least a medium degree of attention in selecting these services. I have also found the earlier mark to be inherently distinctive to at least a medium degree.

40. The only distinguishing feature between the marks is the addition of the word 'Surrey' in the Applicant's mark. I have already found this additional word to be solely geographically descriptive and therefore it does not have an impact on the distinctiveness of the mark. Further, both parties are situated in the area of Surrey and so there is nothing to distinguish between the companies. I would therefore consider that the closeness of the two parties in location could lead to a higher likelihood of confusion for the average consumer. This leads me to find that there would be direct confusion between the marks.

41. The opposition under Section 5(2)(b) has been successful.

## **Outcome**

42. The Opposition succeeds under Section 5(1) and 5(2)(b).

## Costs

43. The opponent has been successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs is calculated as follows:

Official fee	£100
Preparing a Notice of Opposition and reviewing Counter Statement	£200
Preparing Evidence and written submissions And considering the Applicant's written submissions in lieu	£500
<b>Total</b>	<b>£800</b>

44. I therefore order Roz O'Brien to pay Richard Parker the sum of £800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 8th day of January 2021**

**Laura Nicholas  
For the Registrar**