

O/0243/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3923193

BY EVER IN VOGUE LTD

TO REGISTER:



AS A TRADE MARK IN CLASSES 35 & 41

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 443774 BY

ADVANCE MAGAZINE PUBLISHERS INC

BACKGROUND AND PLEADINGS

1. On 15 June 2023, Ever in Vogue Ltd (“the applicant”) applied to register the mark shown on the front cover of this decision as a trade mark in the United Kingdom in respect of services in Class 35 and 41. These are listed in Annex A to this decision.
2. On 23 October 2023, the application was opposed by Advance Magazine Publishers Inc (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns all the services in respect of which registration is sought.
3. The opponent relies on the following two marks:

UKTM No. 3734858 (“the 858 mark”)

VOGUE

Filing date: 20 December 2021

Registration date: 29 April 2022

Relying on goods and services in Classes 9, 35 and 41. These are listed in Annex B to this decision and are relied on under both grounds.

UKTM No. 904023041 (“the 041 mark”)

VOGUE

Filing date: 2 September 2004

Registration date: 12 November 2017

Relying on services in Class 35 under section 5(2)(b) and goods in Class 16 under section 5(3). These are listed in Annex B to this decision.

4. Both marks qualify as earlier marks under section 6(1)(a) of the Act by virtue of their earlier filing dates. The 858 mark was registered less than five years before the filing date of the contested application, and so this mark is not subject to the use provisions of section 6A of the Act. The 041 mark is subject to those provisions and the opponent has stated that it has used this mark for all the goods and services relied on.

5. Under section 5(2)(b), the opponent claims that the marks are similar and that the goods and services covered by the marks are either identical or similar. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

6. Under section 5(3), the opponent claims that it has developed a “*massive*” reputation in its marks in relation to what it describes as “*its core business of publishing its world-famous fashion magazine both in print and online*” and that this reputation extends to the goods and services relied upon. It submits that use of the contested mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier marks, and that therefore the application should be refused. It further submits that a link would be created in the mind of the relevant public so that they would believe that the applicant’s use of the contested mark is use by the opponent or by a party economically linked with or endorsed by the opponent. The link would also constitute free-riding on the reputation of the opponent and be an unfair advantage for the applicant. In addition, the opponent submits that the use of the contested mark would be detrimental to the reputation of the earlier marks as the opponent would have no quality control over the applicant’s goods and services. Finally, the opponent submits that use of the contested mark would be detrimental to the distinctive character of the earlier marks by weakening their ability to identify the goods and services as coming from the opponent. The economic behaviour of the relevant public would be altered, as they would no longer rely on the exclusivity of the opponent’s rights to identify its goods and services.

7. The applicant filed a defence and counterstatement. It denied that the marks were similar, that the parties’ goods and services were similar or identical, and that there would be a likelihood of confusion. It also denied that there would be a link between the marks in the mind of the relevant public and that use of the contested mark would

be detrimental to the opponent's earlier marks. It did not put the opponent to proof of use of the 041 mark.

8. Only the opponent filed evidence. It comes in the form of a witness statement dated 14 March 2024 from Eric Gisolfi, Vice President and Associate General Counsel at Advance Publications Inc., which owns and controls the opponent. It goes to the reputation of the earlier marks and is accompanied by 17 exhibits.

HEARING AND REPRESENTATION

9. The matter came to be heard on 28 January 2025. Only the opponent attended the hearing and it was represented by Julius Stobbs, of its legal representatives Stobbs. The applicant did not attend the hearing and has represented itself throughout these proceedings. It filed written submissions in lieu (which it described as a "skeleton argument") on 26 January 2025.

RELEVANCE OF EU LAW

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

FACTUAL BACKGROUND

11. The opponent is the owner of Condé Nast, which is the publisher of the magazine *Vogue* in the UK. The magazine was first published in the US in 1892 and, as of 22 August 2021, it had 26 different international editions. The UK edition was first published in 1916.¹ The 041 mark appears prominently on the cover of the magazine, although some later issues include the word "BRITISH" inside the letter O of that mark.² These covers show that the focus of the magazines is fashion, although celebrities such as film stars and pop singers are also featured.

¹ Witness statement, paragraphs 2-3; Exhibit EG1.

² Exhibit EG2.

12. The British Vogue website was launched in 1996 and received one million monthly unique users in March 2011.³ Screenshots in Exhibit EG11 show that the website featured articles and videos.⁴ Mr Gisolfi also refers to video series “In the Bag” and “Life in Looks”. Exhibit EG15 contains screenshots from YouTube, but they have been reproduced two to a page, and so I am unable to see when the videos were published and how many times they have been viewed.

13. Mr Gisolfi has provided a table showing circulation figures of the print and digital editions of the magazine. The latter has been available since 2011.⁵ These are taken from the Audit Bureau of Circulations. I have not reproduced the table exactly as it appears in the witness statement. This is because Exhibit EG5 shows that separate figures for the UK and Republic of Ireland are available. I have used these in the table below. It may be that this understates the use in the EU, but the total figures in the witness statement are likely to overstate it. All figures given are average per monthly issue.

Date range	Print Circulation	Digital Circulation	Gross Circulation
01/01/2016- 30/06/2016	153,924	4,414	158,338
01/07/2016- 31/12/2016	155,779	3,818	159,597
01/01/2017- 30/06/2017	151,841	2,917	154,758
01/07/2017- 31/12/2017	155,355	1,722	157,077
01/01/2018- 30/06/2018	164,723	2,937	167,660
01/07/2018- 31/12/2018	160,205	3,643	163,848
01/01/2019- 30/06/2019	160,806	2,906	163,712

³ Exhibit EG1, page 6.

⁴ Video screenshots can be seen on page 7.

⁵ Witness statement, paragraph 11; Exhibit EG7.

Date range	Print Circulation	Digital Circulation	Gross Circulation
01/07/2019- 31/12/2019	159,637	3,324	162,961
01/01/2020- 31/12/2020	159,900	4,331	164,231

14. The 2022 UK media kit gives later figures. Mr Gisolfi explains that these are given to the magazine’s advertisers to inform them of the circulation and reach of the printed and digital editions and are published in the preceding autumn. Consequently, the figures in the 2022 kit relate to autumn 2021. These state that the magazine has a total reach of 20.4 million and a readership of 796k, with 14.3 million social followers and 5.3 million “*digital uniques*”.⁶ It is not clear how those figures are calculated, but I consider that it is likely that they represent global readership.

15. The opponent’s trade marks have been licensed for use on books. Exhibit EG6 contains screenshots from Amazon’s UK website showing the listings of the following books (I have put the publication date in brackets): *Vogue On: Coco Chanel* (2012); *Vogue On: Vivienne Westwood* (2013); *Vogue On: Giorgio Armani* (2015); *Vogue On: Manolo Blahnik* (2017); *Vogue on Location: People, Places, Portraits* (2019); *Vogue Essentials: Little Black Dress* (2018); *Vogue Essentials: Lingerie* (2019); *Vogue Essentials: Heels* (2019). The books are shown to have been available in print and electronic form. Mr Gisolfi does not give any sales figures or examples of advertising for these goods.

16. Exhibit EG8 contains screenshots from the vogue.co.uk website, obtained via the Wayback Machine Internet Archive, that contain brief details of newsletters to which users could subscribe. These are Vogue Daily and Vogue Weekly, both running since November 2012, Vogue Beauty, running since November 2020, and Vogue Royals, shown since 23 November 2021 as “*launching soon*”. From 23 November 2021, there is also Introducing: Vogue’s The Get, which is said to be a weekly newsletter containing details of selected products to buy. The earliest screenshot is dated

⁶ Exhibit EG3. The figures quoted in paragraph 8 of the witness statement differ from the figures in the exhibit. I have used the latter.

1 October 2016 and the latest 14 March 2023. There is no information on the numbers of people receiving the newsletters.

17. Mr Gisolfi also draws my attention to a software application “Vogue Runway Fashion shows”, which allows users to watch runway shows from around the world.⁷ I am not told when this app was launched, although the description in the exhibit has a copyright date of 2020. Neither is there any information on the number of downloads.

18. On 14 September 2023, the second Vogue World event was held in London and livestreamed across various platforms including the Vogue website and the Runway app. This followed the first Vogue World event in New York in 2022. Income generated from ticket sales was to go towards arts organisations such as the National Theatre, Royal Opera House and Rambert dance company. The event, which featured theatrical, dance and musical performances, as well as fashion, was covered in *The Guardian* and *The Independent*.⁸ Although the event took place after the relevant date, the article from *The Independent* is dated 31 May 2023 and reports on the announcement of the event.

19. Exhibit EG10 contains screenshots from vogue.co.uk/shopping dating from 2 August 2022, 28 December 2022, 4 January 2023 and 9 March 2023. These show highlighted products, such as clothing, footwear and accessories, and provide a link to enable the consumer to purchase the goods. The word “VOGUE” appears in the stylised form used in the 041 mark and as a plain word. Mr Gisolfi states that this evidence shows use of the marks for advertising and retail services.

20. An article from 2013 states that for over 60 years Vogue has run a talent contest to identify promising young writers. The competition was extended to cover photographers in 2018 and illustrators in 2021.⁹ In 2008, British Vogue and the British Fashion Council established the BFC/Vogue Designer Fashion Fund to support design businesses. Exhibit EG16 contains information on past winners up to 2023.

21. The final exhibit contains three articles. The first is from the *Telegraph* website, dated 29 July 2019, and is entitled “From Meghan to Diana, how royal women have

⁷ Exhibit EG9.

⁸ Exhibit EG14.

⁹ Exhibit EG12.

weaponised the power of Vogue”. The second is from the *Daily Mail* website, dated 4 May 2020, and is entitled “Dame Judi Dench, 85, looks radiant in British Vogue as she becomes fashion bible’s oldest cover star in HISTORY and vows to never retire”. The third article is from *The Guardian* website, dated 15 September 2022, and is entitled “Timothée Chalamet makes history as British Vogue’s first solo male cover star”. These are three publications that are widely read in the UK.

DECISION

Section 5(2)(b)

22. Section 5(2) of the Act is as follows:

“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.”

23. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25:

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 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; and
- k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of marks



24. It is clear from *SABEL BV v Puma AG*, Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: see, in particular, paragraph 23 of that judgment. 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 (“CJEU”) stated in *Bimbo SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-519/12 P, that:

“34. ... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”

25. The applicant submits that the marks are not similar and that the contested trade mark should be considered as a whole. Artificial dissection of the marks would indeed be wrong, although it is necessary for me 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 the marks.

26. The respective marks are shown below:

Contested mark	Earlier marks
	<p data-bbox="805 1317 1013 1350">The 858 mark:</p> <p data-bbox="805 1400 925 1433">VOGUE</p> <p data-bbox="805 1579 1013 1612">The 041 mark:</p> 

The overall impressions of the marks

27. The 858 mark is a single word, “VOGUE”. In *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, the General Court (“GC”) said that such plain word marks protected the word or words contained in the mark which may be used in any form, colour or typeface: see paragraph 39. There are no other elements that could contribute to the overall impression of the 858 mark.

28. The 041 mark also consists of the single word “VOGUE”. It is presented in capital letters in a very slightly stylised typeface. In my view, it is the word “VOGUE” that makes the greatest contribution to the overall impression of the mark, with only a small role played by the stylisation.

29. The contested mark contains a number of elements. The largest of these is the string of letters “EIV”, presented in stylised gold capitals. I agree with Mr Stobbs that the average consumer, viewing the mark as a whole, will perceive these letters as initials, not least because immediately below them, in smaller gold capital letters, are the words “EVER IN VOGUE”. They will believe that the letters stand for those words. The two words “FASHION SHOW” appear in yet smaller gold capital letters below them. At the bottom of the verbal part of the mark are the words “... creating A Platform For Fashion Talents” in white title case.

30. In my view, “EIV” is the dominant element of the contested mark by virtue of its size and the stylisation. However, as I have already noted, I agree that it would be perceived as representing “Ever in Vogue”, which is large enough to be read comfortably. I also agree that “Fashion Show” is descriptive for a large number of the services for which the mark has been applied. It is not descriptive for services such as *Production of sporting events for radio*. Even so, the presentation of “Ever in Vogue” above “Fashion Show” would lead the average consumer to view the former as making the greatest contribution to the distinctive character of the mark. In my view, the phrase in white would be seen as a strapline. I find that “Ever in Vogue” makes the greatest contribution to the overall impression of the mark, with a slightly smaller role played by the initials, and with lesser roles played by the stylisation, remaining verbal elements and colour.

The mark comparison

31. The only difference between the opponent's two marks is a very slight stylisation. I do not consider that this would have anything but a very small impact on the respective levels of similarity with the contested mark. I shall therefore compare both earlier marks with the contested mark at the same time.

32. The word "VOGUE" is the only word in each of the earlier marks and it is entirely contained in the contested mark. However, I must consider the contested mark as a whole, bearing in mind its dominant and distinctive elements, which I have described above. The large initials, additional words and stylisation are all points of difference between the parties' marks. I have not included colour in the list of differences, because the earlier marks could fairly be used in the same gold colour as in the contested mark and on a black background too. I find that the contested mark is visually similar to the earlier marks to a low degree, with the similarity being very slightly lower for the 041 mark, although, as I have already noted, the impact of the stylisation on the comparison is very small.

33. The earlier marks would be pronounced in the usual way with a single syllable. The applicant makes no submissions on how the marks would be spoken. The opponent submits that the mark would be spoken as "Ever in Vogue Fashion Show" with the words pronounced in their usual way or with the abbreviation at "EIV" at the start. It considers that the average consumer would not verbalise the strapline "Creating a Platform for Fashion Talents". I agree. The contested mark is considerably longer than each of the earlier marks and the common word is found in the middle of it. I find that the marks are aurally similar to a low degree.

34. The opponent submits in its skeleton argument that it has educated the average consumer to understand that use of the word "VOGUE" in the context of fashion is use by the opponent and so the concept of the contested mark is "*always appearing in the pages of Vogue Magazine*". This is the type of argument that Mr Philip Harris, sitting as the Appointed Person, dismissed in *Retail Royalty Company v Harringtons Clothing Limited*, BL O/593/20:

"74. The Opponent is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean

different things, and in trade mark law the term is sometimes used loosely, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public *as a trade mark*.

75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trade mark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken. Whilst a trade mark's reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.

76. It is true that there are cases where an extensive reputation has been parlayed into conceptual meaning (for example C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*) but these are the exception rather than the rule and depend on their own facts. Furthermore, the 'reputation' element in those cases related to the fame attached to the names of the individuals for their roles in society, rather than specifically to a trade mark function. In other words, it was a different sort of reputation."

35. In my view, the word "VOGUE" will bring to the mind of the average consumer the idea of the prevailing fashion, while the contested mark would be perceived as referring to a fashion show featuring clothing and accessories that would always be fashionable. I consider that the level of conceptual similarity of the marks is between medium and high.

Distinctive character of the earlier mark

36. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-342/97:

"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).”

37. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it.

38. To the extent that any of the goods and services relied on relate to fashion, the earlier marks have a low inherent distinctive character, as they allude to the content or purpose of the goods or services. Where the goods and services do not relate to fashion, the marks have a medium degree of inherent distinctive character.

39. Mr Stobbs submitted that the opponent’s marks had achieved a significant level of reputation and therefore enhanced distinctive character in relation to fashion. He referred me to the decision of Professor Phillip Johnson, sitting as the Appointed Person, in *O2 Worldwide Limited v CX02.com (UK) Ltd*, BL O/393/19, who said:

“39. ... I agree with the Hearing Officer that reputation in itself does not make a mark highly distinctive. However, while distinctiveness and reputation are different, the nature, factors, and evidence used to prove enhanced distinctiveness are the same as for reputation. Furthermore, reputation for the purposes of section 5(3) is a higher threshold than for acquired distinctiveness. In other words, if there is a reputation then distinctiveness should be enhanced. Where it fits on the distinctiveness scale after this enhancement is a question of fact in each individual case.”

40. I have not yet made any findings on whether the earlier marks have a reputation for any of the goods and services relied upon. What I take from the Appointed Person’s

comments for the present purposes is that I must bear in mind where the mark starts on the distinctiveness scale.

41. The evidence that I have already summarised shows significant use in relation to publications. For the purposes of this ground, it is only electronic publications that are relevant. The digital edition of the magazine has been available since 2011. The table in paragraph 13 contains the digital circulation figures for the period 2016-2020. Average monthly circulation figures in the UK and Republic of Ireland range from 1,722 to 4,414. The UK figures are likely to be lower than this, but there is nothing to tell me by how much. Exhibit EG7 shows that the British Vogue app was available on the Apple App Store. The information appears to have been printed on 23 August 2021, and there are reviews from 2019 and 2020 and information showing updates in 2011-2014. Subscriber information from the Vogue website is undated, but was printed on 11 March 2024. I can accept that the distinctive character has been enhanced for *Downloadable magazines* and *Downloadable digital content in the form of electronic publications of magazines* in so far as they relate to fashion. The inherent distinctive character of the 858 mark for these goods is low. On the basis of the use made of the mark, I find that it has been enhanced to a medium level.

42. The evidence Mr Stobbs referred me to in connection with the Class 35 services was the use of the vogue.co.uk website as an online shop for clothing and accessories from a range of brands.¹⁰ I have no sales figures to show the extent of use of the mark for such services or data on website visits. In my view, the evidence falls short of what would be required to show that the distinctive character of the earlier marks had been enhanced in relation to these services.

43. Turning now to the Class 41 services, Mr Stobbs draws my attention to the Vogue Talent Contest, Vogue World Event, the YouTube series “Life in Looks” and “In The Bag”, and the establishment of the British Fashion Council/Vogue Designer Fashion Fund.¹¹ At the relevant date, the Vogue World Event had only taken place once, and this was in New York. While I acknowledge that it was streamed globally, I have been given no information on how many people in the UK viewed it. The second event was held in London after the relevant date, although preparations and publicity had begun

¹⁰ Skeleton argument, paragraph 8d.

¹¹ Ibid, paragraph 8e.

before it. Turning to the YouTube series, I have already said that the quality of the relevant exhibit is such that I cannot tell how many views each video has had. However, even if this information were legible, the figures are likely to be global, rather than focused on the UK, which is the relevant market for these purposes. I do not consider that the Designer Fashion Fund is an entertainment service. It appears to me from the evidence that this is a service that awards grants and so is more of a monetary service. Finally, I am not persuaded that the Vogue Talent Contest, although it has been long-running, is properly an entertainment service. It is a competition for writers and, later, photographers and illustrators. Taking the evidence as a whole, I am of the view that it does not show that the distinctive character of the earlier marks has been enhanced for the Class 41 services.

Comparison of goods and services

44. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the GC said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

“82. ... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

45. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the

same reasons, the decision taker may address them collectively in his or her decision.”

46. In *Gérard Meric v OHIM*, Case T-133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

47. The contested services are as follows:

Class 35

Fashion show exhibitions for commercial purposes; Organization of fashion shows for promotional purposes; Fashion shows for promotional purposes (Organization of -); Organisation of fashion shows for commercial purposes; Trade show and exhibition services; Trade show and commercial exhibition services; Conducting virtual trade show exhibitions online; Arranging and conducting trade show exhibitions; Promoting the sale of fashion goods through promotional articles in magazines; Retail services in relation to fashion accessories; Organization of fashion parades for sales promotion purposes; Organizing of trade shows; Trade show management services; Shows (Arranging trade -); Trade shows (Arranging of -); Arranging of trade shows; Conducting trade shows in the field of automobiles; Shows (Conducting business -); Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; Conducting of trade shows; Shows (Conducting trade -); Trade shows (Conducting of -).

Class 41

Entertainment in the nature of fashion shows; Fashion shows for entertainment purposes (Organization of -); Organization of fashion shows for entertainment purposes; Organisation of fashion shows for entertainment purposes; Television show production; Organizing and presenting displays of entertainment relating to style and fashion; Presentation of live show performances; Presentation of live

comedy shows; Entertainment in the nature of television news shows; Production of television game shows; Production of revue shows before live audiences; Production of TV shows; Production of entertainment shows featuring dancers; Production of music shows; Live comedy shows; Organization of fashion parades for entertainment purposes; Live show production services; Auditioning for tv game shows; Production of comedy shows; Live music shows; Production of live shows; Show production services; Production of entertainment shows featuring singers; Direction of theatre shows; Entertainment in the nature of air shows; Production of shows; Shows (Production of -); Live stage shows; Entertainment in the nature of ongoing game shows; Production of stage shows; Production of talent shows; Arranging of entertainment shows; Entertainment in the nature of light shows; Production of entertainment shows featuring dancers and singers; Entertainment in the nature of magic shows; Directing of musical shows; Show scenery (Rental of -); Providing online entertainment in the nature of game shows; Presentation of variety shows; Organisation of comedy shows; Production of theatrical shows; Production of entertainment shows featuring instrumentalists; Laser show services; Production of entertainment in the form of a television series; Entertainment services for producing live shows; Planning of movie shows; Production of radio and television shows and programmes; Shows and films production; Organisation of live shows; Directing of theatrical shows; Arranging of music shows; Production of sporting events for television; Organisation and presentation of shows; Showing of prerecorded entertainment; Artistic management of musical shows; Organising of stage shows; Satellite television shows; Organisation of stage shows; Presentation of live entertainment events; Artistic management of theatre shows; Entertainment services in the nature of an amusement park show; Planning of shows; Directing of shows; Production of a continuous series of animated adventure shows; Organisation of ice skating shows for live audiences; Organization of cultural shows; Provision of television news shows; Organization of shows; Road shows being entertainment services; Movie showing; Entertainment in the nature of live performances and personal appearances by a costumed character; Presentation of live entertainment performances; Planning of plays or musical shows; Presentation of live comedy performances; Organising of shows for entertainment purposes; Theatrical shows provided at performance venues; Production of live

entertainment events; Production of amusement park shows; Musical floor shows provided at performance venues; Production of live television programmes for entertainment; Entertainment in the nature of live dance performances; Theatrical floor shows provided at performance venues; Organisation of shows; Production of sporting events for radio; Production of entertainment in the form of television programmes; Arranging for ticket reservations for shows and other entertainment events; Organization of shows [impresario services].

48. The goods and services relied on by the opponent under the 858 mark are as follows:

Class 9

Media content; downloadable image files; downloadable videos; audio visual recordings; computer application software for streaming audio-visual media content via the internet; computer programs and software for image processing using mobile phones; computer software applications, downloadable; computer software applications; computer software for organizing and viewing digital images and photographs; data processing software for graphic representations; downloadable publications; downloadable magazines; downloadable digital content in the form of electronic publications of magazines; printed publications in electronically readable form; podcasts; audiobooks; electronic publications; downloadable virtual goods, namely, downloadable content featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness for use online and in the online virtual worlds.

Class 35

Advertising; business management, organization and administration; licensing of the goods and services of others (commercial administration of the -); administration (commercial -) of the licensing of the goods and services of others; organization of art exhibitions for commercial or advertising purposes; promoting the artwork of others by means of providing online portfolios via a website; retail services in relation to works of art; advertising and marketing services provided by means of social media; advertising and marketing services; online marketing; planning of marketing strategies; product marketing; providing online marketplaces for sellers of goods and of services; artists (business management

*of performing -); arranging and conducting of exhibitions for business purposes
arranging and conducting of commercial exhibitions and shows; arranging and
conducting auctions; arranging and conducting of internet auctions;
auctioneering; auctioneering services; on-line auction bidding for others; on-line
auctioneering services via the internet; organisation of internet auctions;
electronic publications of printed matter for advertising purposes; retail and online
retail services in relation to downloadable publications, downloadable
magazines, downloadable digital content in the form of electronic publications of
magazines, printed publications in electronically readable form, podcasts,
audiobooks, electronic publications, downloadable virtual goods, namely,
downloadable content featuring lifestyle, fashion, couture, culture, technology,
food, cooking, travel, current events, health and fitness for use online and in the
online virtual worlds; retail and online retail services in relation to publications,
clothing, footwear, headgear; providing an online marketplace for display,
exhibition, sale, purchase, exchange, and transfer of non-fungible tokens (NFTs)
and digital collectibles; providing digital collective services, namely, operating an
online marketplace for transactions and registry services using block-chain based
software technology and smart contracts for digital collectibles; retail and online
store services featuring virtual goods, namely downloadable content featuring
clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking,
travel, current events, health and fitness; online retail store services featuring
virtual merchandise in the fields of clothing, design, lifestyle, fashion, couture,
culture, technology, food, cooking, travel, current events, health and fitness;
information, advisory and consultancy services relating to the aforesaid.*

Class 41

*Education; providing of training; entertainment; sporting and cultural activities;
virtual reality arcade services; museums; museum exhibitions; museum services;
providing museum facilities; gallery services (art -); cultural, educational or
entertainment services provided by art galleries; art gallery services; rental of
artwork; organisation of artistic competitions; organizing cultural and arts events;
arranging of exhibitions for cultural or educational purposes; art exhibition
services; art exhibitions; exhibition of video films; fashion shows; providing on-
line non-downloadable images; electronic publication of texts and printed matter,*

other than publicity texts, on the internet; multimedia publishing; electronic publication services; non-downloadable electronic publications; on-line publication of electronic books and journals; publication and selling of printed matter; publication of electronic magazines; publication of electronic books and periodicals on the internet; providing electronic publications; publication of printed matter and printed publications; production of radio and television programmes; providing online electronic publications, not downloadable; publication of texts, other than publicity texts; publication of magazines in the field of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness including online publication; online publication of electronic magazines, namely in the field of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; arranging for ticket reservations for shows and other entertainment events; entertainment ticket agency services; ticket reservation for cultural events; ticket reservation and booking services for education, entertainment and sports activities and events; ticketing and event booking services; arranging and conducting competitions; arranging of competitions for educational purposes; arranging of competitions for entertainment purposes; arranging of competitions for cultural purposes; entertainment services relating to competitions; organisation of conferences, exhibitions and competitions; services for the organisation of competitions; audio, video and multimedia production, and photography; film production; film production for educational purposes; film production for entertainment purposes; film production services; television production; television production for education purposes; television production for entertainment purposes; television production services; live entertainment production services; live show production services; production of films; provision of exhibitions via virtual reality and augmented reality; virtual reality entertainment services; entertainment and educational services, namely, ongoing multimedia programs in the field of general interest, clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness distributed via various platforms across multiple forms of transmission media; providing ongoing video series in the field of general interest, clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; providing over the top (ott) entertainment

programming in the fields of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; podcasting services, namely, providing podcasts featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; media production services, namely video and film production; multimedia entertainment services in the nature of development, production, post-production and distribution services in the fields of video and films; television, film and audiovisual studios; information, advisory and consultancy services relating to the aforesaid.

49. As the applicant did not put the opponent to proof of use of the 041 mark, the opponent may rely on all the services it listed in the Notice of Opposition. These are as follows:

Class 35

Advertising, marketing, promotion, public relations, endorsement and publicity services; representation and agency services for artists, writers, actors, models, performers, photographers and others involved in the entertainment, fashion and media industries; dissemination of advertising, marketing, promotion, public relations, endorsement and publicity materials; distribution of samples; market research services; organization of fairs and trade shows for advertising and promotion purposes; auctioneering services; information, advice and assistance relating to all the aforesaid; including, but not limited to, all the aforesaid services provided via the Internet, the World Wide Web and/or via communications networks.

50. At paragraph 32 of its skeleton argument, the opponent presents a table setting out what it considers to be its best comparisons to the terms in the applicant's specification. I shall use this as the starting point for my analysis.

51. Before doing so, I shall address the arguments made by the applicant in its counterstatement. It submits that the parties' respective services are not identical or similar. One of the reasons it gives is that some of the goods and services are in different classes. However, section 60A of the Act states that:

“(1) For the purposes of this Act goods and services-

(a) are not to be regarded as similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

52. This means that the fact that some of the goods and services are in different classes is not relevant to my comparison.

53. In addition, the applicant submits that its application covers the organisation of fashion shows for commercial purposes, trade shows and exhibition services, which are neither similar nor identical to the services of the opponent which, according to the applicant, comprise “*arranging and conducting of commercial exhibitions and shows*”. It also submits that its entertainment services are not identical or similar to those of the opponent. I have noted these submissions, but will make my own comparison in the light of the case law cited in paragraphs 44 to 46 above.

Class 35

54. The opponent’s first group consists of the following services: *Fashion show exhibitions for commercial purposes; Organization of fashion shows for promotional purposes; Fashion shows for promotional purposes (Organization of -); Organisation of fashion shows for commercial purposes; Trade show and exhibition services; Trade show and commercial exhibition services; Conducting virtual trade show exhibitions online; Arranging and conducting trade show exhibitions; Organization of fashion parades for sales promotion purposes; Organizing of trade shows; Trade show management services; Shows (Arranging trade -); Trade shows (Arranging of -); Arranging of trade shows; Conducting trade shows in the field of automobiles; Shows (Conducting business -); Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; Conducting of trade shows; Shows*

(*Conducting trade -*); *Trade shows (Conducting of -)*. These are terms encompassed by the opponent's *Managing and conducting commercial exhibitions and shows* and so find them identical per *Meric*.

55. The opponent compares the applicant's *Promoting the sale of fashion goods through promotion of articles in magazines* to its own *Advertising and Electronic publication of printed matter for advertising purposes*. The opponent's terms would include the applicant's term, and so find them to be *Meric* identical.

56. The final service in this class is *Retail services in relation to fashion accessories*. The opponent submits that it is identical or similar to *Providing online marketplaces for sellers of goods and/or services* in the specification of the 858 mark. The classic definition of "retail services" was given by the CJEU in *Praktiker Bau- und Heimwerkermärkte AG*, Case C-481/02:

"34. ... it should be noted that the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor."

57. I do not consider the opponent's services to be retail services, as such. However, it is my view that there is an overlap in purpose as both services are intended to provide a way for consumers to access a selection of goods for sale. The *fashion accessories* that are the subject of the applicant's retail services are also likely to be sold through online marketplaces. The users will overlap, as may the method of use and nature of service, given that the applicant's retail services may also be provided through a website. There may be a degree of competition and it is possible that there may be an overlap in trade channels, if a provider of retail services also offers an online marketplace that third parties can use to sell their goods. Taking all these factors into account, I find that there is a medium degree of similarity between the services.

Class 41

58. The following contested services are all included in the broader category of *Entertainment*, which can be found in the specification of the 858 mark and so are identical per *Meric*:

Entertainment in the nature of fashion shows; Fashion shows for entertainment purposes (Organization of -); Organization of fashion shows for entertainment purposes; Organisation of fashion shows for entertainment purposes; Television show production; Organizing and presenting displays of entertainment relating to style and fashion; Presentation of live show performances; Presentation of live comedy shows; Entertainment in the nature of television news shows; Production of television game shows; Production of revue shows before live audiences; Production of TV shows; Production of entertainment shows featuring dancers; Production of music shows; Live comedy shows; Organization of fashion parades for entertainment purposes; Live show production services; Auditioning for tv game shows; Production of comedy shows; Live music shows; Production of live shows; Show production services; Production of entertainment shows featuring singers; Direction of theatre shows; Entertainment in the nature of air shows; Production of shows; Shows (Production of -); Live stage shows; Entertainment in the nature of ongoing game shows; Production of stage shows; Production of talent shows; Arranging of entertainment shows; Entertainment in the nature of light shows; Production of entertainment shows featuring dancers and singers; Entertainment in the nature of magic shows; Directing of musical shows; Show scenery (Rental of -); Providing online entertainment in the nature of game shows; Presentation of variety shows; Organisation of comedy shows; Production of theatrical shows; Production of entertainment shows featuring instrumentalists; Laser show services; Production of entertainment in the form of a television series; Entertainment services for producing live shows; Planning of movie shows; Production of radio and television shows and programmes; Shows and films production; Organisation of live shows; Directing of theatrical shows; Arranging of music shows; Production of sporting events for television; Organisation and presentation of shows; Showing of prerecorded entertainment; Artistic management of musical shows; Organising of stage shows; Satellite

television shows; Organisation of stage shows; Presentation of live entertainment events; Artistic management of theatre shows; Entertainment services in the nature of an amusement park show; Planning of shows; Directing of shows; Production of a continuous series of animated adventure shows; Organisation of ice skating shows for live audiences; Organization of cultural shows; Provision of television news shows; Organization of shows; Road shows being entertainment services; Movie showing; Entertainment in the nature of live performances and personal appearances by a costumed character; Presentation of live entertainment performances; Planning of plays or musical shows; Presentation of live comedy performances; Organising of shows for entertainment purposes; Theatrical shows provided at performance venues; Production of live entertainment events; Production of amusement park shows; Musical floor shows provided at performance venues; Production of live television programmes for entertainment; Entertainment in the nature of live dance performances; Theatrical floor shows provided at performance venues; Organisation of shows; Production of sporting events for radio; Production of entertainment in the form of television programmes; Organization of shows [impresario services].

59. Finally, I come to the contested *Arranging for ticket reservations for shows and other entertainment events*. This is self-evidently identical to the opponent's *Arranging for ticket reservations for shows and other entertainment events*.

Comparison with Goods in Class 9

60. I shall also compare the contested terms to the following goods from Class 9 of the 858 mark: *Downloadable magazines; downloadable digital content in the form of electronic publications of magazines*. These were the terms in respect of which I found that the 858 mark had an enhanced distinctive character.

61. The first term I shall compare is *Promoting the sale of fashion goods through promotional articles in magazines*. The purpose of these services is clear, while the primary purpose of the Class 9 goods is to inform and entertain the reader. This could include informing the potential consumer about particular goods that are available for them to buy. The users are likely to be different, with the services being purchased by businesses that wish to promote the sale of their goods. The Class 9 goods are likely

to be purchased by members of the public, although I accept that trade publications also exist. The method of use and nature differ, given that one is a good and one a service. However, I consider that there is a degree of complementarity between the goods and services, as the goods are essential for the delivery of the services and in my view the average consumer would assume that both are provided by the same undertaking. Consequently, I find that the services are similar to the goods to a medium degree.

62. I shall now compare *Retail services in relation to fashion accessories* to the Class 9 goods *Downloadable magazines* and *Downloadable digital content in the form of electronic publications of magazines*. There is likely to be an overlap in user, but the purpose, nature and method of use of the goods and services are different. The evidence indicates that the opponent offers the services and the goods through its website. However, there is no evidence to tell me whether the goods and services would usually share the same trade channels, sometimes share them, or whether sharing is unique to the opponent. I do not find the goods and services to be complementary or in competition. Consequently, I find them to be dissimilar.

63. The remaining Class 35 services are shows and exhibitions which are commercial in nature. The users of such services are likely to be businesses and professionals in the relevant trade who wish to promote their goods and services to others. This means that there will also be another type of user who simply attends the show to find out about the products and services on offer from others. There is likely to be an overlap in user, particularly as the opponent's goods would cover electronic publications aimed at a trade rather than general audience. In my view, there is a degree of overlap in purpose, at least from the perspective of the attendee, as both the goods and services may provide information on relevant products and development. The method of use and nature are different. I have no evidence to indicate that they would be delivered through the same trade channels. I do not find that they are in competition or complementary. Taking all these factors into account, I find a low degree of similarity.

64. Most of the contested services in Class 41 are different forms of entertainment, largely covering live shows but also those broadcast on television, radio or online. As with the commercial shows, there is likely to be an overlap in user and in purpose, as the goods and services may all be consumed for the purposes of entertainment. The

goods and services are different in nature and method of use and the trade channels are different. I do not consider that they are complementary or in competition. Overall, I find that there is a low degree of similarity between the Class 9 downloadable magazines and most of the services in Class 41.

65. The Class 41 services that must be considered separately are as follows: *Show scenery (Rental of -)* and *Arranging for ticket reservations for shows and other entertainment events*. These services differ in purpose, nature, method of use, trade channels from the Class 9 goods. They are not in competition or complementary. There may be some overlap in user in the case of *Arranging for ticket reservations for shows and other entertainment events*, but this is only on the basis of the user being a member of the general public. Overall, I find the goods and services to be dissimilar.

Average consumer and the purchasing process

66. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes 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 and services in question: see *Lloyd Schuhfabrik Meyer*, paragraph 26.

67. In *Iconix Luxembourg Holdings*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

“16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and customers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the

perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as gender, age, ethnicity and social group. ... It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). ... if having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, then a finding of infringement may properly be made.

18. Thirdly, assessing from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence. ...

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind."

68. The opponent submitted in its skeleton argument that the average consumer of the services at issue would be a member of the general public with a particular interest in the fashion industry.¹² At the hearing, Mr Stobbs acknowledged that the average consumer might also be a professional or a business, still in the field of fashion.¹³ While I accept that some of the services are clearly related to fashion and so would be purchased by people interested in, or businesses involved in, this field, there are also some more general, or non-fashion-related, services, such as *Organizing of trade shows* and *Conducting trade shows in the field of automobiles* in the applicant's Class

¹² Paragraph 33.

¹³ Transcript, page 6.

35 and *Live comedy shows, Production of sporting events for television and Organisation of shows* in the applicant's Class 41.

69. With the exception of the retail services, the average consumer for all the Class 35 services is a business or professional seeking to promote their goods or purchase the goods of third parties. The average consumer of the retail services is a member of the general public. Where the average consumer is a member of the general public, they are likely to pay a medium degree of attention during the purchasing process. Where the average consumer is a business, the level of attention paid is likely to be higher, as the services will be used for promoting their business and its products. Turning now to the Class 41 services, I find that the average consumer could be either a member of the general public wanting to be entertained or a business or professional purchasing the services either for themselves or their clients. In my view, the level of attention paid by a member of the general public is likely to be medium, while it is likely to be slightly higher for the business or professional consumer. The average consumer of the opponent's Class 9 electronic publications would also be a member of the general public or a business. Both types of consumer would pay a medium degree of attention.

70. I consider that the purchasing process for all of these goods and services is likely to be largely visual. The average consumer will see the mark used on promotional literature, websites and, in cases such as the retail services, on signage in the street. There may also be a role for word-of-mouth recommendations and discussions with sales representatives, so the aural aspects of the mark cannot be ignored.

Conclusions on likelihood of confusion

71. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods and services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight

should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa.

72. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

73. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

74. Earlier in my decision, I found that:

a) The contested mark is visually and aurally similar to the earlier marks to a low degree and conceptually similar to the earlier marks to a medium to high degree;

b) The inherent distinctiveness of the earlier marks is low for goods and services related to fashion and medium for other goods and services;

c) The distinctive character of the 858 mark for *Downloadable magazines* and *Downloadable digital content in the form of electronic publications of magazines* had been enhanced from a low to a medium level, in so far as they relate to fashion;

d) The contested services are identical to services covered by the earlier marks or similar to them to a medium degree;

e) The contested services are similar to a medium or low degree or dissimilar to *Downloadable magazines and Downloadable digital content in the form of electronic publications of magazines*;

f) The average consumer is either a member of the general public or a professional or business consumer. The former will pay a medium degree of attention when purchasing the services and the latter will pay a higher degree of attention. Both types of consumer will pay a medium degree of attention when purchasing the goods; and

g) The purchasing process is largely visual, although there is a role for word-of-mouth recommendations and discussions with sales staff.

75. In my view, the differences between the marks are such that the average consumer is unlikely to mistake one for the other, even taking into account imperfect recollection and the identity of many of the services. I make this finding for completeness, noting that Mr Stobbs submitted at the hearing that this was a case where indirect confusion would be more relevant.¹⁴

76. Mr Stobbs also submits that the word “VOGUE” played an independent distinctive role in the contested mark, referring to the decision of the CJEU in *Bimbo*. In *Whyte and Mackay Ltd v Origin Wine UK Ltd & Anor* [2015] EWHC 1271 (Ch), Arnold J (as he then was) considered the impact of the judgment in *Bimbo* on the CJEU’s earlier judgment in *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04. He said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the

¹⁴ Transcript, page 15.

composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meaning of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

77. Mr Stobbs further submitted that the average consumer would perceive the earlier mark as referring to “*fashion designs and trends being featured in Vogue Magazine, i.e. Ever in Vogue [Magazine]*” and so believe there to be an economic connection between the opponent and the applicant.¹⁵

78. At the hearing, he said:

¹⁵ Skeleton argument, paragraph 46.

“We say, in the context of a fashion show, which ultimately is the core of what is covered in 35 and 41, whether a commercial fashion show or an entertainment fashion show, whatever the distinction is, our mark VOGUE is a very significant mark that is known, has an enhanced distinctive character, and a consumer seeing EVER IN VOGUE as a fashion show, and knows that it has seen Vogue World before as a fashion show, it knows that Vogue is distinctive in the context of fashion for our client, for the Opponent, sees EVER IN VOGUE, with a logo that supports EVER IN VOGUE, and it thinks this [is] another fashion show from Vogue.”

79. He made alternative submissions as follows:

“... in case you are not with us on enhanced distinctive character, we say you will be with us in relation to enhanced distinctive character at least in the context of the digital content. We say there is a very high degree of similarity between that content and the shows covered in 35 and 41, in any case. If you wanted to decide on that basis, high degree of similarity because the digital content could be digital content about fashion shows which, honestly, is likely to be a lot of the content that the Opponent is well known for. That distinction is a very fine one, so you get a very high degree of similarity on the goods and services, rather than identity, but that likely does not change your assessment of likelihood of confusion.”¹⁶

80. I have already found that the average consumer would perceive the contested mark as referring to something that would always be fashionable, as the word “VOGUE” would be understood to refer to fashion. In my view, the average consumer would not perceive that word to have distinctive significance independently of the whole of the contested mark. I also do not consider that the average consumer would understand the contested mark in the way described in paragraph 77 above.

81. Mr Stobbs’ arguments at the hearing were based on the premise that the earlier marks enjoyed an enhanced degree of distinctive character. I found this to be the case for only a limited number of the earlier goods and services. Consequently, I find that the earlier marks do not have such a high degree of distinctive character that the

¹⁶ Ibid, page 16.

average consumer would assume that only the opponent would be using it – keeping in mind the particular goods and services I found to be identical or similar to the contested services. Even where I found a medium degree of similarity between the contested *Promoting the sale of fashion goods through promotional articles in magazines* and the opponent's *Downloadable magazines; downloadable digital content in the form of electronic publications of magazines*, the distinctive character of the earlier mark had only been enhanced to a medium degree. Turning to other possible reasons for indirect confusion, I consider that the additional elements in the contested mark are not obvious sub-brands. I find that the average consumer would not assume a connection. The earlier mark may be brought to mind, but that is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81.

82. I find no likelihood of confusion under section 5(2)(b) and the opposition under this ground fails.

Section 5(3)

83. Section 5(3) of the Act is as follows:

“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 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.”

84. The 041 mark is a comparable mark and so Paragraph 10 of Schedule 2A of the Act also applies. It reads:

“(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to-

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union.”

85. IP completion day is 31 December 2020.

86. The case law relevant to this section can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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; *Adidas Salomon*, 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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 on the earlier mark; *L'Oréal*, paragraph 40.

j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

87. The opponent claims that the 858 mark has a reputation for all the goods and services listed in Annex B and that the 041 mark has a reputation for the following goods:

Class 16

Printed matter; prints; posters; photographs; cards; greetings cards; gift tags; calendars; diaries; publications; books; pamphlets; manuals; magazines; periodical publications; newspapers; newsletters.

88. The applicant has not denied the opponent's claims that each of the earlier marks has a reputation. Where a claim has not been denied or put to proof, it is deemed to have been admitted: see *SKYCLUB Trade Mark*, BL O/044/21, paragraphs 23-29. Nevertheless, I must make an assessment of the nature and strength of the reputation.

89. In *General Motors*, the CJEU held that:

"24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

90. The relevant date for assessing whether the marks had a reputation is the filing date of the contested mark, i.e. 15 June 2023. For the period up to IP Completion Day, the relevant territory for the 041 mark is the EU; thereafter it is the UK. For the 858 mark, the relevant territory is the UK. I note here that a single Member State may constitute a substantial part of the territory of the Community: see *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, paragraphs 20-30.

91. Mr Stobbs submitted that the earlier marks had a significant reputation generally in the fashion industry. However, the courts have said that the reputation must be in the goods and/or services covered by the marks relied upon: see *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16, paragraph 27. On the basis of the evidence I have summarised earlier in this decision, I am satisfied that at the relevant date the 041 mark had a very strong reputation for magazines and periodical publications relating to fashion in Class 16. The reputation is of prestige and authority, as "*the fashion bible*": in other words, the curious should turn to the pages of this magazine to find out what is the height of fashion. I am also satisfied that the 858 mark has a strong reputation for the following goods in Class 9 in so far as they are related to fashion: *Downloadable magazines; downloadable digital content in the form of electronic publications of magazines*.

92. For the rest of the goods and services, I find that they are either not shown in the evidence (for example, *greetings cards* and *gift tags* in Class 16 of the 041 mark) or there is insufficient evidence of the extent of the use, the market share, and how the

marks have been promoted in relation to those goods or services. I have indicated these deficiencies at the appropriate points in my summary of the evidence. That said, as the applicant has not denied the claims to reputation, I shall proceed on the basis that the marks have a modest reputation for all the goods and services except those listed in the previous paragraph.

Link

93. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU at paragraph 42 of its judgment in *Intel*. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

94. I have already found that the contested marks are visually and aurally similar to the 041 mark to a low degree and conceptually similar to this mark to a medium to high degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

95. For ease of reference, I set out here the services from the applicant's specification that I consider to be explicitly related to fashion:

Class 35

Fashion show exhibitions for commercial purposes; Organization of fashion shows for promotional purposes; Fashion shows for promotional purposes (Organization of -); Organisation of fashion shows for commercial purposes; Promoting the sale of fashion goods through promotional articles in magazines; Retail services in relation to fashion accessories; Organization of fashion parades for sales promotion purposes.

Class 41

Entertainment in the nature of fashion shows; Fashion shows for entertainment purposes (Organization of -); Organization of fashion shows for entertainment purposes; Organisation of fashion shows for entertainment purposes; Organizing

*and presenting displays of entertainment relating to style and fashion;
Organization of fashion parades for entertainment purposes.*

96. The following terms are broad and would include services related to fashion:

Class 35

Trade show and exhibition services; Trade show and commercial exhibition services; Conducting virtual trade show exhibitions online; Arranging and conducting trade show exhibitions; Organizing of trade shows; Trade show management services; Shows (Arranging trade -); Trade shows (Arranging of -); Arranging of trade shows; Shows (Conducting business -); Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; Conducting of trade shows; Shows (Conducting trade -); Trade shows (Conducting of -).

Class 41

Television show production; Presentation of live show performances; Production of TV shows; Live show production services; Production of live shows; Show production services; Production of shows; Shows (Production of -); Live stage shows; Production of talent shows; Arranging of entertainment shows; Production of entertainment in the form of a television series; Entertainment services for producing live shows; Production of radio and television shows and programmes; Shows and film production; Organisation of live shows; Organisation and presentation of shows; Showing of prerecorded entertainment; Satellite television shows; Presentation of live entertainment events; Planning of shows; Directing of shows; Organization of cultural shows; Organization of shows; Road shows being entertainment services; Presentation of live entertainment performances; Organising of shows for entertainment purposes; Production of live entertainment events; Production of live television programmes for entertainment; Organisation of shows; Production of entertainment in the form of television programmes; Arranging for ticket reservations for shows and other entertainment events; Organization of shows [impresario services].

97. The following services are, in my view, not likely to be related to fashion:

Class 35

Conducting trade shows in the field of automobiles.

Class 41

Presentation of live comedy shows; Entertainment in the nature of television news shows; Production of television game shows; Production of revue shows before live audiences; production of entertainment shows featuring dancers; Production of music shows; Live comedy shows; Auditioning for tv game shows; Production of comedy shows; Live music shows; Production of entertainment shows featuring singers; Direction of theatre shows; Entertainment in the nature of air shows; Entertainment in the nature of ongoing game shows; Entertainment in the nature of light shows; Production of entertainment shows featuring dancers and singers; Entertainment in the nature of magic shows; Directing of musical shows; Show scenery (Rental of -); Providing online entertainment in the nature of game shows; Presentation of variety shows; Organisation of comedy shows; Production of theatrical shows; Production of entertainment shows featuring instrumentalists; Laser show services; Planning of movie shows; Directing of theatrical shows; Arranging of music shows; Production of sporting events for television; Artistic management of musical shows; Organising of stage shows; Organisation of stage shows; Artistic management of theatre shows; Entertainment services in the nature of an amusement park show; Production of a continuous series of animated adventure shows; Organisation of ice skating shows for live audiences; Provision of television news shows; Movie showing; Entertainment in the nature of live performances and personal appearances by a costumed character; Planning of plays or musical shows; Presentation of live comedy performances; Theatrical shows provided at performance venues; Production of amusement park shows; Musical floor shows provided at performance venues; Entertainment in the nature of live dance performances; Theatrical floor shows provided at performance venues; Production of sporting events for radio.

98. I adopt the findings on the nature of the average consumer and the purchasing process from the previous paragraphs. The services that explicitly relate to fashion, or could relate to fashion, are targeted towards the same public as the opponent's Class

16 goods. This is a member of the general public or a business or professional in the fashion industry.

The strength of the earlier mark's reputation

99. I have already found that the 848 mark has a very strong reputation for magazines and periodicals related to fashion.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

100. Where the goods and services concern fashion, the inherent degree of distinctive character is low, given the allusiveness of "VOGUE". Earlier in my decision, I found that the distinctive character of the 848 mark had been enhanced to a medium degree for Class 9 goods related to fashion. The scale of use for the Class 16 goods is, in my view, greater. It is longer established (since 1916) and the figures for print circulation are significantly higher than those for the digital version of the magazine. I consider that the use is such as to enhance the distinctive character of the 041 mark to a high degree for magazines and periodicals related to fashion. While I am proceeding on the basis that there is a modest reputation for the remaining goods and services, I do not find the inherent distinctiveness of the earlier marks to be significantly enhanced on this basis.

Whether there is a likelihood of confusion

101. Section 5(3) provides additional protection for those marks with a reputation. It acknowledges that some marks are so highly distinctive and well known that there is likely to be some confusion almost irrespective of the goods or services in relation to which they are used. I am required to take account of the distinctiveness and repute of the opponent's marks and to decide whether in this particular case the public may be caused to believe that the user of the contested mark for services in Classes 35 and 41 is connected to the user of the earlier marks.

102. In my view, the reputation and distinctiveness of the 041 mark for magazines and periodicals related to fashion are such that there is a risk that members of the public who are familiar with the 041 mark may believe that the user of the contested mark is

connected with the user of the 041 mark if the contested mark is used in relation to services in the context of fashion. This covers the services listed in paragraphs 95 and 96 above.

Conclusions on link

103. A link between two parties' marks is necessarily established where there is a likelihood of confusion: see *Intel*, paragraph 57. It follows that the relevant public for the opponent's reputed goods will make a link between the marks if the applicant's mark is used in relation to the services listed in paragraphs 95 and 96.

104. It does not follow that the relevant public will not make a link between the marks where there is no likelihood of confusion: see *Intra-Press SAS v OHIM*, Joined cases C-581/13 P and C-582/13 P, paragraph 72. Mr Stobbs submitted that, even if I did not find a likelihood of confusion, there would be a link, given the huge reputation of the earlier marks. I agree. The public will be nudged towards making the link by the inclusion of the words "FASHION SHOW" in the contested mark, even where this mark is used for services such as *Production of sporting events for radio*, where the distance between the parties' goods is rather wide. Consequently, I find that a link would be made in the mind of the relevant public if the contested mark were used for any of the services in respect of which registration is sought.

Damage: Unfair Advantage

105. Unfair advantage means that consumers are more likely to buy the goods and services of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. In *L'Oréal*, the CJEU said:

"50. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation 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."

106. Earlier in the same case, the CJEU also said:

“41. As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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.”

107. Where there is a likelihood of confusion, it follows that the applicant would benefit from an unfair advantage. Mr Stobbs also submitted that, if I were to find no likelihood of confusion, unfair advantage through image transfer represented the opponent’s best case of success under this ground. He referred me to the well-known cases of *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC) and *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211. The reputation of the earlier marks is for high fashion and glamour. I consider that this reputation is so strong that the image would transfer to some of the services for which I found that there was no likelihood of confusion. These are ones where there is a strong visual element where high fashion and glamour would be attractive qualities. I consider that this may extend to certain automobiles, as well as theatrical shows. In my view, the applicant would gain an unfair advantage from the use of the contested mark through the transfer of the image of the 041 mark to the following services:

Class 35

Conducting trade shows in the field of automobiles.

Class 41

Entertainment in the nature of television news shows; Production of revue shows before live audiences; Production of entertainment shows featuring dancers; Production of music shows; Live music shows; Production of entertainment shows featuring singers; Direction of theatre shows; Production of entertainment shows featuring dancers and singers; Entertainment in the nature of magic shows; Directing of musical shows; Show scenery (Rental of -); Presentation of

variety shows; Production of theatrical shows; Production of entertainment shows featuring instrumentalists; Planning of movie shows; Directing of theatrical shows; Arranging of music shows; Artistic management of musical shows; Organising of stage shows; Organisation of stage shows; Artistic management of theatre shows; Organisation of ice skating shows for live audiences; Provision of television news shows; Movie showing; Planning of plays or musical shows; Theatrical shows provided at performance venues; Musical floor shows provided at performance venues; Entertainment in the nature of live dance performances; Theatrical floor shows provided at performance venues.

108. I consider there would not be image transfer for the following services:

Class 41

Presentation of live comedy shows; Production of television game shows; Live comedy shows; Auditioning for tv game shows; Production of comedy shows; Entertainment in the nature of air shows; Entertainment in the nature of ongoing game shows; Entertainment in the nature of light shows; Providing online entertainment in the nature of game shows; Organisation of comedy shows; Laser show services; Production of sporting events for television; Entertainment services in the nature of an amusement park show; Production of a continuous series of animated adventure shows; Entertainment in the nature of live performances and personal appearances by a costumed character; Presentation of live comedy performances; Production of amusement park shows; Production of sporting events for radio.

109. This is because I take the view that the applicant would not gain a commercial advantage from the transfer of the image of the 041 mark to the contested mark in relation to the services listed above.

110. As Mr Stobbs indicated that unfair advantage was the opponent's best case, I shall not proceed to assess whether there would be detriment to the distinctive character or reputation of the earlier marks if the contested mark were used for the services listed in paragraph 108 above.

111. The applicant has not pleaded that it has due cause to use the contested mark, and so I find that the section 5(3) ground is partially successful.

OUTCOME

112. The opposition is partially successful. Subject to a successful appeal, Application No. 3923193 is refused for the following services:

Class 35

Fashion show exhibitions for commercial purposes; Organization of fashion shows for promotional purposes; Fashion shows for promotional purposes (Organization of -); Organisation of fashion shows for commercial purposes; Trade show and exhibition services; Trade show and commercial exhibition services; Conducting virtual trade show exhibitions online; Arranging and conducting trade show exhibitions; Promoting the sale of fashion goods through promotional articles in magazines; Retail services in relation to fashion accessories; Organization of fashion parades for sales promotion purposes; Organizing of trade shows; Trade show management services; Shows (Arranging trade -); Trade shows (Arranging of -); Arranging of trade shows; Conducting trade shows in the field of automobiles; Shows (Conducting business -); Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; Conducting of trade shows; Shows (Conducting trade -); Trade shows (Conducting of -).

Class 41

Entertainment in the nature of fashion shows; Fashion shows for entertainment purposes (Organization of -); Organization of fashion shows for entertainment purposes; Organisation of fashion shows for entertainment purposes; Television show production; Organizing and presenting displays of entertainment relating to style and fashion; Presentation of live show performances; Entertainment in the nature of television news shows;; Production of revue shows before live audiences; Production of TV shows; Production of entertainment shows featuring dancers; Production of music shows;; Organization of fashion parades for entertainment purposes; Live show production services; Live music shows; Production of live shows; Show production services; Production of entertainment shows featuring singers; Direction of theatre shows; Production of shows; Shows (Production of -); Live stage shows; Production of stage shows; Production of talent shows; Arranging of entertainment shows; Production of entertainment

shows featuring dancers and singers; Entertainment in the nature of magic shows; Directing of musical shows; Show scenery (Rental of -); Presentation of variety shows; Production of theatrical shows; Production of entertainment shows featuring instrumentalists; Production of entertainment in the form of a television series; Entertainment services for producing live shows; Planning of movie shows; Production of radio and television shows and programmes; Shows and films production; Organisation of live shows; Directing of theatrical shows; Arranging of music shows; Organisation and presentation of shows; Showing of prerecorded entertainment; Artistic management of musical shows; Organising of stage shows; Satellite television shows; Organisation of stage shows; Presentation of live entertainment events; Artistic management of theatre shows; Planning of shows; Directing of shows; Organisation of ice skating shows for live audiences; Organization of cultural shows; Provision of television news shows; Organization of shows; Road shows being entertainment services; Movie showing; Presentation of live entertainment performances; Planning of plays or musical shows; Organising of shows for entertainment purposes; Theatrical shows provided at performance venues; Production of live entertainment events; Musical floor shows provided at performance venues; Production of live television programmes for entertainment; Entertainment in the nature of live dance performances; Theatrical floor shows provided at performance venues; Organisation of shows; Production of entertainment in the form of television programmes; Arranging for ticket reservations for shows and other entertainment events; Organization of shows [impresario services].

113. It may proceed to registration for the following services:

Class 41

Presentation of live comedy shows; Production of television game shows; Live comedy shows; Auditioning for tv game shows; Production of comedy shows; Entertainment in the nature of air shows; Entertainment in the nature of ongoing game shows; Entertainment in the nature of light shows; Providing online entertainment in the nature of game shows; Organisation of comedy shows; Laser show services; Production of sporting events for television; Entertainment services in the nature of an amusement park show; Production of a continuous

series of animated adventure shows; Entertainment in the nature of live performances and personal appearances by a costumed character; Presentation of live comedy performances; Production of amusement park shows; Production of sporting events for radio.

COSTS

114. Both parties have enjoyed some success in these proceedings, with the greater part going to the opponent, who is therefore entitled to a contribution to the costs of the proceedings in line with the scale set out in Tribunal Practice Notice 1/2023, reflecting the balance of success. I award the opponent the sum of £2000, which is calculated as follows

£300 for preparing a statement and considering the other side's statement;

£900 for preparing evidence;

£600 for preparing for and attending a hearing;

£200 for official fees

£2000 in total

115. I therefore order Ever in Vogue Ltd to pay Advance Magazine Publishers Inc the sum of £2000. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of March 2026

Clare Boucher

For the Registrar,

Comptroller-General

ANNEX A: Specification of the Contested Mark

Class 35

Fashion show exhibitions for commercial purposes; Organization of fashion shows for promotional purposes; Fashion shows for promotional purposes (Organization of -); Organisation of fashion shows for commercial purposes; Trade show and exhibition services; Trade show and commercial exhibition services; Conducting virtual trade show exhibitions online; Arranging and conducting trade show exhibitions; Promoting the sale of fashion goods through promotional articles in magazines; Retail services in relation to fashion accessories; Organization of fashion parades for sales promotion purposes; Organizing of trade shows; Trade show management services; Shows (Arranging trade -); Trade shows (Arranging of -); Arranging of trade shows; Conducting trade shows in the field of automobiles; Shows (Conducting business -); Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; Conducting of trade shows; Shows (Conducting trade -); Trade shows (Conducting of -).

Class 41

Entertainment in the nature of fashion shows; Fashion shows for entertainment purposes (Organization of -); Organization of fashion shows for entertainment purposes; Organisation of fashion shows for entertainment purposes; Television show production; Organizing and presenting displays of entertainment relating to style and fashion; Presentation of live show performances; Presentation of live comedy shows; Entertainment in the nature of television news shows; Production of television game shows; Production of revue shows before live audiences; Production of TV shows; Production of entertainment shows featuring dancers; Production of music shows; Live comedy shows; Organization of fashion parades for entertainment purposes; Live show production services; Auditioning for tv game shows; Production of comedy shows; Live music shows; Production of live shows; Show production services; Production of entertainment shows featuring singers; Direction of theatre shows; Entertainment in the nature of air shows; Production of shows; Shows (Production of -); Live stage shows; Entertainment in the nature of ongoing game shows; Production of stage shows; Production of talent shows; Arranging of entertainment shows; Entertainment in the nature of light shows; Production of entertainment shows

featuring dancers and singers; Entertainment in the nature of magic shows; Directing of musical shows; Show scenery (Rental of -); Providing online entertainment in the nature of game shows; Presentation of variety shows; Organisation of comedy shows; Production of theatrical shows; Production of entertainment shows featuring instrumentalists; Laser show services; Production of entertainment in the form of a television series; Entertainment services for producing live shows; Planning of movie shows; Production of radio and television shows and programmes; Shows and films production; Organisation of live shows; Directing of theatrical shows; Arranging of music shows; Production of sporting events for television; Organisation and presentation of shows; Showing of prerecorded entertainment; Artistic management of musical shows; Organising of stage shows; Satellite television shows; Organisation of stage shows; Presentation of live entertainment events; Artistic management of theatre shows; Entertainment services in the nature of an amusement park show; Planning of shows; Directing of shows; Production of a continuous series of animated adventure shows; Organisation of ice skating shows for live audiences; Organization of cultural shows; Provision of television news shows; Organization of shows; Road shows being entertainment services; Movie showing; Entertainment in the nature of live performances and personal appearances by a costumed character; Presentation of live entertainment performances; Planning of plays or musical shows; Presentation of live comedy performances; Organising of shows for entertainment purposes; Theatrical shows provided at performance venues; Production of live entertainment events; Production of amusement park shows; Musical floor shows provided at performance venues; Production of live television programmes for entertainment; Entertainment in the nature of live dance performances; Theatrical floor shows provided at performance venues; Organisation of shows; Production of sporting events for radio; Production of entertainment in the form of television programmes; Arranging for ticket reservations for shows and other entertainment events; Organization of shows [impresario services].

ANNEX B: Goods and Services Relied Upon by the Opponent

UKTM No. 3734858 (“the 858 mark”)

Class 9

Media content; downloadable image files; downloadable videos; audio visual recordings; computer application software for streaming audio-visual media content via the internet; computer programs and software for image processing using mobile phones; computer software applications, downloadable; computer software applications; computer software for organizing and viewing digital images and photographs; data processing software for graphic representations; downloadable publications; downloadable magazines; downloadable digital content in the form of electronic publications of magazines; printed publications in electronically readable form; podcasts; audiobooks; electronic publications; downloadable virtual goods, namely, downloadable content featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness for use online and in the online virtual worlds.

Class 35

Advertising, business management, organization and administration; licensing of the goods and services of others (commercial administration of the -); administration (commercial -) of the licensing of the goods and services of others; organization of art exhibitions for commercial or advertising purposes; promoting the artwork of others by means of providing online portfolios via a website; retail services in relation to works of art; advertising and marketing services provided by means of social media; advertising and marketing services; online marketing; planning of marketing strategies; product marketing; providing online marketplaces for sellers of goods and of services; artists (business management of performing -); arranging and conducting of exhibitions for business purposes; arranging and conducting of commercial exhibitions and shows; arranging and conducting auction; arranging and conducting of internet auctions; auctioneering; auctioneering services; on-line auction bidding for others; on-line auctioneering services via the internet; organisation of internet auctions; electronic publications of printed matter for advertising purposes; retail and online retail services in relation to downloadable publications, downloadable magazines, downloadable digital content in the form of electronic publications of magazines, printed publications

in electronically readable form, podcasts, audiobooks, electronic publications, downloadable virtual goods, namely, downloadable content featuring lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness for use online and in the online virtual worlds; retail and online retail services in relation to publications, clothing, footwear, headgear; providing an online marketplace for display, exhibition, sale, purchase, exchange, and transfer of non-fungible tokens (NFTs) and digital collectibles; providing digital collective services, namely, operating an online marketplace for transactions and registry services using block-chain based software technology and smart contracts for digital collectibles; retail and online store services featuring virtual goods, namely downloadable content featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; online retail store services featuring virtual merchandise in the fields of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; information, advisory and consultancy services relating to the aforesaid.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; virtual reality arcade services; museums; museum exhibitions; museum services; providing museum facilities; gallery services (art -); cultural, educational or entertainment services provided by art galleries; art gallery services; rental of artwork; organisation of artistic competitions; organizing cultural and arts events; arranging of exhibitions for cultural or educational purposes; art exhibition services; art exhibitions; exhibition of video films; fashion shows; providing on-line non-downloadable images; electronic publication of texts and printed matter, other than publicity texts, on the internet; multimedia publishing; electronic publication services; non-downloadable electronic publications; on-line publication of electronic books and journals; publication and selling of printed matter; publication of electronic magazines; publication of electronic books and periodicals on the internet; providing electronic publications; publication of printed matter and printed publications; production of radio and television programmes; providing online electronic publications, not downloadable; publication of texts, other than publicity texts; publication of magazines in the field of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness including online publication; online publication of electronic

magazines, namely in the field of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; arranging for ticket reservations for shows and other entertainment events; entertainment ticket agency services; ticket reservation for cultural events; ticket reservation and booking services for education, entertainment and sports activities and events; ticketing and event booking services; arranging and conducting competitions; arranging of competitions for educational purposes; arranging of competitions for entertainment purposes; arranging of competitions for cultural purposes; entertainment services relating to competitions; organisation of conferences, exhibitions and competitions; services for the organisation of competitions; audio, video and multimedia production, and photography; film production; film production for educational purposes; film production for entertainment purposes; film production services; television production; television production for education purposes; television production for entertainment purposes; television production services; live entertainment production services; live show production services; production of films; provision of exhibitions via virtual reality and augmented reality; virtual reality entertainment services; entertainment and educational services, namely, ongoing multimedia programs in the field of general interest, clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness distributed via various platforms across multiple forms of transmission media; providing ongoing video series in the field of general interest, clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; providing over the top (ott) entertainment programming in the fields of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; podcasting services, namely, providing podcasts featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; media production services, namely, video and film production; multimedia entertainment services in the nature of development production, post-production and distribution services in the fields of video and films; television, film and audiovisual studios; information, advisory and consultancy services relating to the aforesaid.

UKTM No. 904023041 (“the 041 mark”)

Class 16

Printed matter; prints; posters; photographs; cards; greetings cards; gift tags; calendars; diaries; publications; books; pamphlets; manuals; magazines; periodical publications; newspapers; newsletters.

Class 35

Advertising, marketing, promotion, public relations, endorsement and publicity services; representation and agency services for artists, writers, actors, models, performers, photographers and others involved in the entertainment, fashion and media industries; dissemination of advertising, marketing, promotion, public relations, endorsement and publicity materials; distribution of samples; market research services; organization of fairs and trade shows for advertising and promotion purposes; auctioneering services; information, advice and assistance relating to all the aforesaid; including, but not limited to, all the aforesaid services provided via the Internet, the World Wide Web and/or via communications networks.