

O/275/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos. 2547304 & 2547305  
BY TAZMERE LIMITED TO REGISTER THE  
TRADE MARKS**

**SEX@CITY**

**IN CLASS 3**

**AND**

**SEX IN THE CITY**

**IN CLASSES 3 & 25**

**AND:**

**CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS. 100980 & 100981 BY HOME BOX OFFICE INC**

## BACKGROUND

1. On 13 May 2010, Tazmere Limited (“TL”) applied to register the two trade marks shown on the cover page of this decision. The applications were accepted and published for opposition purposes on 18 June 2010 for specifications of goods which read:

### No. 2547304 – SEX@CITY

**Class 3** - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use.

### No. 2547305 – SEX IN THE CITY

**Class 3** – Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use.

**Class 25** - Clothing, footwear, headgear.

2. On 20 September 2010, Home Box Office Inc (“HBO”) filed notices of opposition directed at all the goods in TL’s applications. In relation to trade mark no. 2547304, SEX@CITY, it relies upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to trade mark no. 2547305 SEX IN THE CITY, it relies upon sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Act. In relation to the respective objections brought under sections 5(1), 5(2) and 5(3) of the Act, HBO relies upon the following registered trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods & Services
SEX AND THE CITY	E7558299	29.01.2009	09.09.2009	Although registered in a range of classes, the following are the most relevant:  <b>Class 3</b> - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.  <b>Class 25</b> - Clothing, footwear, headgear.

3. In relation to its ground based upon section 5(2)(b) of the Act against trade mark no. 2547304 SEX@CITY HBO says in its notice of opposition:

“8...The dominant and distinctive feature of [HBO’s trade mark] are the elements SEX and CITY both of which are reproduced in their entirety in the mark in suit.

9. Visually, the marks are very similar, given the reproduction of the element SEX at the beginning of both marks and the element CITY at the end. Phonetically, [TL’s trade mark] would be pronounced “Sex at City” or more probably, “Sex at the City”. It cannot be disputed that the symbol @ is generally defined as “at”, but it is also sometimes used to denote “and”. Therefore the mark could also be seen as SEX AND CITY or SEX AND THE CITY. Either of these two pronunciations would be identical or similar to SEX AND THE CITY as the dominant and distinctive elements appear in the same order. Conceptually, the dominant features of both marks are the elements SEX and CITY.”

4. In relation to its grounds based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act against trade mark no. 2547305 SEX IN THE CITY, HBO says, in its notice of opposition:

“9. It is submitted that the mark in suit has reproduced, without any significant modification or addition, all of the elements constituting [HBO’s trade mark] and that the differences between the two are insignificant enough to go unnoticed by the average consumer in the United Kingdom. As such, it is submitted that the mark in suit and [HBO’s trade mark] are identical.

10. Further, or in the alternative...visually the marks are very similar, both consisting of four words, three of which are identical. Phonetically, the marks are also closely similar, particularly when taking into account that [HBO’s trade mark] will be pronounced SEX N THE CITY or as SEX IN THE CITY by the relevant consumer. Conceptually, the dominant features of both marks are the elements SEX, THE and CITY and the terms IN and AND are often interchanged by the relevant consumer such that [HBO’s brand] is known by both the terms SEX AND THE CITY and SEX IN THE CITY...”

5. In relation to the goods at issue in these proceedings HBO say:

“11. The following goods are contained, word for word, in both [HBO’s and TL’s trade marks]:

**Class 3**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

## **Class 25**

Clothing, footwear, headgear.

As such, these goods are identical.

12. The goods “deodorants for personal use” are contained in [TL’s trade marks] but not in [HBO’s trade mark]. However, it is submitted that these goods are very similar to the soaps, perfumery, essential oils, cosmetics covered by [HBO’s specification in class 3] as they would be sold via the same channels of trade, would be placed in similar sections in supermarkets, are complimentary to each other, may be sold in competition with each other and would have the same end users.”

6. Insofar as its objections based upon section 5(3) of the Act are concerned, HBO states that its SEX AND THE CITY trade mark has, by virtue of the extensive use made of it, acquired a reputation in, inter alia, the United Kingdom. This reputation is, HBO states, in relation to:

“Entertainment services, production and provision of films and television programs, magnetic data carriers, optical data carriers, recording discs and printed matter, clothing, bags, various merchandising and retail services, audio and video recordings.”

7. HBO argues that in view of the reputation its trade mark enjoys, the use of TL’s trade marks would create an association with its trade mark which would in turn allow TL to take advantage of HBO’s marketing efforts without any economic outlay of its own. This, it argues, represents an unfair commercial advantage. Secondly, HBO argues that as its SEX AND THE CITY trade mark has strong associations with luxury, glamour and sophistication, the use of TL’s trade marks in connection with goods that are not of a high quality or have cheap or downmarket connotations may be damaging to the reputation HBO has built up in its trade mark. Finally, HBO argue that as its SEX AND THE CITY trade mark is a highly distinctive trade mark in its own right, whose distinctiveness has been enhanced by the use made of it, registration and use by TL of its trade marks would erode the distinctive character of the earlier trade mark.

8. Finally, insofar as its objection based upon section 5(4)(a) of the Act is concerned, HBO relies upon the same trade mark shown in paragraph 2 above, indicating that the sign has been used in the UK since 1999 in relation to:

“Entertainment services, production of television broadcasts and programs, production of motion pictures, videos, CDs, DVDs, Blu-Ray discs, downloadable publications, clothing, footwear, headgear, sunglasses, jewellery, posters, publications, printed material, photographs, stationery, games and playthings.”

9. On 4 January 2011, TL filed counterstatements. As, in my view, a number of the points raised in the counterstatements are not relevant to the issues I have to decide in these proceedings, I will not record them here; in essence, the counterstatements consist of a denial of the grounds upon which the oppositions are based. However, two points arise both in TL's counterstatements and in its written submissions (see below) which I should mention here. The following paragraphs, taken from TL's counterstatement in relation to its SEX IN THE CITY trade mark, give a flavour of TL's position:

"5. [TL] claims that [HBO] filed the opposition with malicious and bad intent as [HBO] is fully aware of the fact that the mark SEX IN THE CITY is extremely popular in the United States and around the world in class 3 and 25 since last 6 years.

6...The mark SEX IN THE CITY is extensively used by many companies and manufacturers in the classes 3 & 25 in the United States and is distributed around the world.

7.[TL] is ready to produce the evidence that the mark SEX IN THE CITY is registered with other companies around the world with Trade Mark offices in other countries and is extensively used in the United States in the class 3 & 25.

9. The end consumers have awareness about [HBO] as a film making organisation and not a known company on particular brand in cosmetics or clothing...

10. [HBO] is known for entertainment services, production and provision of films and television programmes only worldwide. The evidence attesting to the no use by [HBO] over last six years on the mark will be filed and produced during the course of the proceedings along with the extensive use of the mark SEX IN THE CITY in the United States in class 3 & 25.

22. [TL] also wishes to add that it is a newly formed company with not much knowledge on intellectual rights but sincerely applied for the registration for the trade mark SEX IN THE CITY as there was offer from the Manufacturer and the Distributor who offered these products directly from the United States for the UK and European Market. [TL] carried out extensive research and discussed this with the major operators in the United Kingdom and Europe who were willing to support the product sales in UK/Europe offered from the company in the United States. The company offering the products from United States had participated in major exhibitions around the world including famous Cosmoprof show in LAS VEGAS. The company from the United States are selling the goods since last seven to eight years and the sister concerns hold the rights for the SEX IN THE CITY mark in the Hong Kong..."

I will return to these two points later in this decision.

10. Following the filing of HBO's evidence in chief, the proceedings were consolidated. HBO filed witness statements by Manish Umyashanker Joshi dated 28 April 2011 (accompanied by 14 exhibits) and 19 May 2011 (accompanied by 8 exhibits) and a declaration from Judy McCool dated 25 April 2011 (which was originally filed in related proceedings between the parties at OHIM) accompanied by 9 exhibits. Mr Joshi is a trade mark attorney at Joshi & Welch Limited, HBO's professional representatives in this matter and Ms McCool is the Vice President and Senior Counsel at HBO. While TL did not file any evidence of fact, it did file a witness statement dated 28 October 2011 from Sohrab Goya who is an associate at Sriharans solicitors, TL's professional representatives in this matter.

11. Although I have considered all of the evidence and submissions filed and will bear it in mind when reaching a conclusion, there is, for reasons which will become apparent shortly, no need for me to summarise the evidence and submissions in any detail. I will, however, refer to specific parts of the evidence and submissions as necessary later in this decision.

12. Neither of the parties to these proceedings asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

## **DECISION**

13. In relation to trade mark no.2547304, HBO relies upon, inter alia, section 5(2)(b) of the Act (but not sections 5(1) and 5(2)(a)) whereas in relation to trade mark no. 2547305 HBO relies upon, inter alia, sections 5(1), 5(2)(a) and 5(2)(b) of the Act. These sections read as follows:

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

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. In these proceedings HBO is relying upon the registered trade mark shown in paragraph 2 above which has an application date prior to that of the applications for registration; as such, it qualifies as an earlier trade mark under the above provisions. As TL’s applications for registration were published for opposition purposes on 18 June 2010 and as HBO’s earlier trade mark was registered on 9 September 2009, HBO’s earlier trade mark is not (despite TL’s requests in its counterstatements) subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004. **As a consequence, HBO is entitled to rely upon its earlier trade mark in relation to all of the goods and services for which it stands registered and not only those goods and services for which TL considers it may have actually used its trade mark.**

**Opposition to no. 2547305 – SEX IN THE CITY based upon sections 5(1) & 5(2)(a)**

15. As the opposition based on grounds under section 5(2)(b) has been brought against both applications, I intend to consider this objection first.

**Opposition to both TL’s trade marks under section 5(2)(b)**

**Case law**

16. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

**The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000]

E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

## The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **The average consumer and the nature of the purchasing process**

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In his statement Mr Joshi said:

“19. The goods the subject of the opposition, namely those in classes 3 and 25, are general consumer products and as such the relevant consumer would not exercise a high level of attention when selecting them.”

And:

“52... [The goods at issue] are goods bought and used by all sectors of the public within the United Kingdom. These goods are not highly technical. It is therefore submitted that the level of attention of the relevant consumer in relation to the goods at issue would be at a low-medium level.”

18. In his statement Mr Goya says:

“37...it is staunchly denied that the level of attention of the relevant consumer in relation to perfumery goods would be at a low-medium level...perfumery is a good which is consumer specific and therefore a high level of attention is placed by the relevant consumer in selection.”

19. The goods at issue in these proceedings are, broadly speaking, preparations for cleaning, laundry and personal use and articles of clothing, footwear and headgear. As HBO say these are general consumer goods the average consumer for which would be the public at large. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) said in relation to the selection of clothing:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to

purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

20. As all of the goods at issue in these proceedings are everyday consumer items, they are (as the evidence suggests) most likely to be the subject of self selection from retail outlets, catalogues and websites. In my experience, the cost of some of the goods at issue in these proceedings (some clothing and perfumes for example) can vary considerably. Keeping that in mind, it is, in my experience, not unusual for some retail premises to keep some of the goods (perfumes for example) housed in locked glass cabinets. However, even in those circumstances, the average consumer is likely to have inspected the goods visually before approaching a sales assistant. Considered overall, I think the selection of all of the goods will be predominantly a visual one; while aural considerations may play their part, in my view, it will be to a lesser extent.

21. In its submissions, HBO says the average consumer will pay a low to medium level of attention to the selection of the goods at issue whereas TL characterises the level of attention paid to the selection of perfumes as high. In *New Look* the GC also considered the level of attention taken purchasing goods in the clothing sector. It said:

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

22. Many of the goods at issue e.g. soaps, perfumery, cosmetics, hair lotions, dentifrices, deodorants and articles of clothing are for use on, to be worn by the average consumer or are for his/her personal adornment. When selecting, for example, items of clothing the average consumer will be conscious of factors such as material, size, colour, cost, compatibility with other items of clothing etc. all of which suggests that they will pay a reasonable level of attention when making their selection; a level of attention which is likely, in my view, to increase as the cost and importance of the goods increases. In my view the average consumer is likely to pay far more attention when selecting, for example, an exclusive perfume or tailored suit than they would when selecting, for example, a cleaning preparation for the home or laundry or an inexpensive pair of socks.

## Comparison of goods

23. The goods to be compared are as follows:

HBO's (relevant) goods	TL's goods
<b>Class 3</b> - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.  <b>Class 25</b> - Clothing, footwear, headgear.	<b>Class 3</b> – Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use.  <b>Class 25</b> - Clothing, footwear, headgear.

24. In his statement Mr Goya said, inter alia:

“30. With regard to paragraphs 32-37 [of Mr Joshi's witness statement] the Applicant does not deny the similarity between the goods contained in the marks in question...”

25. That, in my view, is a sensible concession because as HBO point out, the following goods in TL's applications are to be found expressed in identical terms in the specifications of its earlier trade mark:

**Class 3** - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 25** - Clothing, footwear, headgear.

26. Insofar as “deodorants for personal use” are concerned, which appears in class 3 of TL's applications but not in HBO's specification in class 3, in his statement Mr Joshi draws my attention to the comments of the Hearing Officer in BL-O-280-09 in which she said:

“17. That leaves talcum powder, bath and shower gels bath salts and deodorants. These are all highly similar to the IR's body scrubs, eau de toilettes and perfumery/perfumes. Such goods are frequently perfumed, and often form part of a range of goods fragranced with a particular perfume.”

27. For the reasons mentioned above, I agree that the term “deodorants for personal use” appearing in TL's applications in class 3 are highly similar goods to (at least) the soaps and perfumery contained in HBO's specification in class 3.

**In summary, the competing goods are either identical or similar to a high degree.**

## Comparison of trade marks

28. The trade marks to be compared are as follows:

HBO's trade mark	TL's trade marks
SEX AND THE CITY	SEX@CITY
	SEX IN THE CITY

29. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### Distinctive and dominant components

30. HBO's trade mark consists of the words SEX AND THE CITY presented in upper case spaced in a conventional manner. TL's trade marks consist of (i) the word SEX presented in upper case conjoined to the at symbol which in turn is conjoined to the word CITY presented in upper case and (ii) the words SEX IN THE CITY presented in upper case and spaced in a conventional matter. In both its notice of opposition and submissions, HBO argue that the dominant and distinctive elements of the competing trade marks are the words SEX and CITY with the words and symbol AND, @ and IN serving to link the various elements.

31. While I accept that SEX and CITY are the words most likely to make an immediate impact on the average consumer, as all three trade marks contain other elements which, in both HBO's and my own view serve to link these words, the distinctive character of all three trade marks lies, in my view, not in the individual elements of which the trade marks are made up but in the totalities they create.

### Visual and aural similarity

32. I have reproduced in paragraphs 3 and 4 above HBO's view in this regard. In his statement Mr Goya said:

"17. Visually the marks are not similar. It is clear that all three marks differ in appearance. The @ sign is not mistaken for AND THE. The fact that the marks share the words SEX and CITY do not make them visually identical or similar.

18. It is submitted that when viewed as a whole, there is a distinction between [the competing trade marks]. [HBO] is trying to create confusion by associating the words SEX and CITY.

19. [TL] submits that there is no significance to the identical letters appearing in the same order when the mark is viewed as the distinctiveness of the @ sign outlines the marks are visually different....

20...[TL] submits that there is a clear distinction between the marks. The word @ even when swallowed is never confused with AND.

21...it is certainly the case even if one of [TL's] marks, namely SEX IN THE CITY sounds similar to [HBO's trade mark] there is sufficient visual distinction between [the competing trade marks].

22...[HBO's trade mark] SEX AND THE CITY and SEX@CITY, do not share an identical intonation. In addition to this, they differ in rhythm too. [HBO's trade mark] is 5 syllables, whereas [TL's] trade mark is only 4. Thus creating a different rhythm in pronunciation.

23. The use of the symbol @ displays a character difference in the mark applied for...It also outlines that [TL] did not have [HBO's trade mark] in mind when creating its own mark.

24. ...[HBO] is alluding to a high degree of likelihood that SEX IN THE CITY will be pronounced SEX N THE CITY. This is a mere assumption by [HBO]...Regardless of the speed of pronunciation, it is in fact the case that it is easier to pronounce SEX IN THE CITY as it reads than SEX N THE CITY. The reasons for this may well be that there are two hard consonants namely X and C on either side of IN THE....

33. In respect of TL's SEX IN THE CITY trade mark the fact that both parties' trade marks contain four elements three of which i.e. SEX, THE and CITY are identical and which appear in the same order in the trade marks, and bearing in mind that the trade marks differ only to the extent that they contain a different second word i.e. the short words AND and IN, results, in my view, **in them being visually and aurally similar to a very high degree.**

34. As to TL's SEX@CITY trade mark, this is not, in my view, visually or aurally as similar to HBO's trade mark as TL's trade mark mentioned earlier, because the use of the @ symbol breaks the words and is immediately apparent. However, as both trade marks once again contain the words SEX and CITY in the same order, and as TL's trade mark will, in my view, be pronounced as SEX AT CITY, it still, in my view, **results in (at least) a reasonably high degree of visual and aural similarity between them.**

## Conceptual similarity

35. In his statement Mr Goya says:

“27. Conceptually, the marks SEX AND THE CITY and SEX@CITY are completely different. Whilst [HBO’s trade mark] brings to mind the concept of sex and the city as two separate ideas, [TL’s] trade marks makes the two conjoined, bringing the idea of sex at the city and sex in the city.

28. In light of the above, it is submitted that [the competing trade marks] are neither conceptually or visually identical or **extremely** similar.”

36. In his statement Mr Joshi said:

“35. When viewed as a whole [HBO’s trade mark] brings to mind the concept of dating and human relationships within an urban setting. This concept is also brought to mind by [TL’s trade marks]. In this instance the replacement by [TL] of the words [AND THE with @/IN] does not change the conceptual message conveyed at all.

36. It is submitted that [the competing trade marks] are conceptually identical, or at the very least, extremely similar...”

37. In my opinion, HBO’s view of the matter is to be preferred. The presence in both parties’ trade marks of the words SEX and CITY in the same order are, when considered together with the additional linking words or symbol used, likely in my view, to create in the average consumer’s mind either the concept HBO has identified or one very closely related to it. **In my view the competing trade marks are conceptually similar to a very high degree.**

## Distinctive character of HBO’s earlier trade mark

38. I must now assess the distinctive character of HBO’s trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In his statement Mr Joshi said in relation to the inherent distinctiveness of HBO’s trade mark:

“48. The mark SEX AND THE CITY consists of a wholly invented term. The term has no direct links to any of the goods or services for which [HBO’s trade mark] is registered and the mark is therefore highly distinctive in its own right.”

39. In his statement Mr Goya said:

“31...Furthermore in this instance, the earlier mark is not highly distinctive within the scope of the goods [TL] is applying to register its mark for.”

And:

“35. The mark SEX AND THE CITY is not highly distinctive in its own right. It is distinctive in association with media and television entertainment; a market completely different to that of which [TL’s] goods are based in.”

40. Once again it is HBO’s position which is, in my view, is to be preferred. As far as I am aware (and there is no evidence to the contrary) the phrase SEX AND THE CITY neither describes nor is it non-distinctive for, inter alia, the goods in classes 3 and 25 for which its stands registered. It is, absent use, a trade mark possessed of a fairly high degree of inherent distinctive character. While HBO have made use of its SEX AND THE CITY trade mark, given the fairly high degree of inherent distinctive character I have already identified, it is not, in my view, necessary for me to consider to what extent any use may have built upon its trade marks’ inherent distinctiveness.

### **Likelihood of confusion**

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

42. Earlier in this decision I reached the following conclusions:

- As HBO’s earlier trade mark is not subject to proof of use, it is entitled to rely upon this trade mark for all the goods and services for which it stands registered. It is irrelevant whether HBO has actually used its earlier trade mark in relation to any of these goods and services;

- The average consumer of the goods at issue in these proceedings is a member of the general public who will select the goods by predominantly visual means displaying at least a reasonable level of attention when doing so;
- The competing goods are identical or highly similar;
- The trade marks SEX AND THE CITY and SEX IN THE CITY are visually, aurally and conceptually similar to a very high degree;
- The trade marks SEX AND THE CITY and SEX@CITY are visually and aurally similar to (at least) a reasonably high degree and conceptually similar to a very high degree;
- HBO's earlier trade mark is, absent use, a trade mark possessed of a fairly high degree of inherent distinctive character.

43. Based on those conclusions, I have no hesitation reaching the prima facie conclusion that there would be a likelihood of confusion in each case. In relation to TL's SEX IN THE CITY trade mark this is, in my view, likely to take the form of direct confusion i.e. TL's trade mark will be mistaken for HBO's trade mark. The same may also be true of TL's SEX@CITY trade mark, however, even if the differences between the competing trade marks is sufficient to avoid direct confusion, indirect confusion i.e. where the average consumer assumes the goods come from economically linked undertakings is still, in my view, likely. This is so even if the competing trade marks are used on goods at the upper end of the respective markets where the average consumer's level of attention is likely to be heightened. Finally, I need to decide if my prima facie view is disturbed by anything TL has said in its counterstatements or submissions. I have already dealt with TL's point relating to HBO's use of its SEX AND THE CITY trade mark in relation to classes 3 and 25 above. In his statement Mr Goya said:

"30...In contrast [TL] has been selling perfumery under the brand, SEX IN THE CITY for over 5 years...[TL's] motive for wanting to register SEX IN THE CITY and SEX@CITY is to continue with its sale and distribution..."

And:

"34. In considering all the relevant factors, we submit that the Registrar should take into account:

- a) [HBO's] motives only now challenging the use of the mark SEX IN THE CITY when it has been used by various manufacturers worldwide for a long time. The effect of acquiescence **must** be considered when looking at this fact..."

44. The fact that the trade mark SEX IN THE CITY may have been used and registered by other companies in other jurisdictions is not relevant; it is the position in the United

Kingdom with which I am concerned. As to Mr Goya's comment that TL have been selling perfumery under the SEX IN THE CITY trade mark for over five years, Mr Goya does not say whether these sales relate to the United Kingdom. However, even if he had, as I mentioned earlier TL have not filed any evidence in these proceedings in support of such a statement. While there is evidence to suggest that TL have been conducting a trade in perfumery under the SEX IN THE CITY trade mark in the United Kingdom (the statement of Mr Joshi dated 28 April 2011 and Annexes 2, 5, 9 and 10 thereto refer), as far as I can tell, the various pages were either downloaded after the material date in these proceedings, are undated or indicate that the product first became available after the material date in these proceedings. In short, they do not assist TL nor did they persuade me that my prima facie view indicated above should be disturbed.

### **Conclusion under 5(2)(b)**

45. HBO's oppositions have been successful and TL's applications will, subject to any successful appeal, be refused.

### **The grounds based upon sections 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Act**

46. Given my very clear findings under section 5(2)(b) of the Act, there is, in my view, no need for me to consider HBO's other grounds of opposition and I decline to do so.

### **Costs**

47. HBO has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, and whilst noting that although the proceedings were consolidated this only occurred after HBO had filed its evidence-in-chief in both proceedings but keeping in mind the considerable overlap in HBO's evidence, I award costs to HBO on the following basis:

Preparing statements and considering TL's statements:	£600
Preparing evidence:	£800
Official fees:	£400
<b>Total</b>	<b>£1800</b>

48. I order Tazmere Limited to pay to Home Box Office Inc the sum of **£1800**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated the 18<sup>th</sup> of July 2012**

**C J BOWEN  
For the Registrar  
The Comptroller-General**