

O/411/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 187 519: HIGHLAND
FASHION WEEK IN THE NAME OF GRACE LILIAN HAY

AND

IN THE MATTER OF OPPOSITION THERETO BY FASHION ONE TELEVISION
INC

Background and pleadings

1. Grace Lilian Hay (the applicant) applied to register the trade mark no 3 187 519 HIGHLAND FASHION WEEK in the UK on 24th September 2016. It was accepted and published in the Trade Marks Journal on 14th October 2016 in respect of *event marketing* in Class 35.
2. Fashion One Television Inc (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier International Trade Mark (designating the European Union)

No 1 264 287:  The following services are relied upon in this opposition:

Class 35:

Advertising and business management services; exhibitions, trade fairs organization and preparation in the field of fashion, all the mentioned for commercial and advertising purposes.

Class 41:

Organization of exhibitions, fashion shows and trade in the field of culture and entertainment.

3. The opponent argues that the respective services are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. Neither side

filed evidence. No hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

7. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

9. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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”.

10. The earlier services include advertising at large. This will involve the production of advertisement for products or services. The later term is event marketing which will inevitably involve the promotion (including advertising) of particular events. Event marketing and advertising overlap to a significant degree and the former will include the latter. Consequently, applying the MERIC principle the services are identical.

Comparison of marks

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

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

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

13. The respective trade marks are shown below:

	HIGHLAND FASHION WEEK
Earlier trade mark	Contested trade mark

14. The earlier trade mark is a composite mark containing a device of a partially clothed torso with fabric adorn across the shoulder and the words "Fashion Week" as shown. The words are, overall, dominant. However, the device is also eye catching and clearly visible. The later trade mark also contains the words "Fashion Week" together with "Highland". There is no overall dominant feature.
15. Visually, the marks coincide in respect of "Fashion Week" and differ in respect of the additional device/word elements as already described. They are similar to a medium degree.
16. Aurally, it is considered that the addition of highland in the later trade mark has a significant impact on the overall articulation. There however, remains a low to medium degree of similarity in this regard.
17. Conceptually, it is considered that both marks refer to a week long event in relation to fashion, the later trade mark informing that this is geographically limited to a highland area. Bearing in mind the nature of the consumer here, namely that they are domiciled in the UK, it is considered probable that highlands will be understood as referring to the Scottish Highlands. The addition of this word in the later trade mark adds a geographical context, that is, a week long fashion event taking place in the highlands. This is not a clear conceptual gap, but it does have an impact. The marks are therefore considered similar, at least to a low degree.

Average consumer and the purchasing act

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

19. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

20. The average consumer for the relevant services are likely to be professionals such as businesses, but I do not exclude the general public who may also wish to procure such services for particular events. In any case, it is considered that irrespective of the type of customer, advertising and marketing services are likely to involve a good deal of consideration. This is so that prospective consumers can be sure of the quality of the service and that it fits, for example, with a particular business plan or ethos. Such services are also likely to represent a not insignificant financial investment. As such, care is likely to be taken. The purchasing process may involve a period of research and/or word of mouth recommendations. As such, both visual and aural considerations are important. Bearing in mind all of the aforesaid, it is concluded that the level of attention expected to be displayed will be at least average and may indeed be higher than average.

Distinctive character of the earlier trade mark

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

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

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

22. The opponent has not claimed that its earlier trade mark enjoys an enhanced degree of distinctiveness due to use made of it. As such, it must be assessed on a prima facie basis. It is noted that the earlier services which have been found to be highly similar to those of the later trade mark are in respect of advertising services. It is clear that the words “Fashion Week” are directly descriptive of advertising services in respect of fashion or fashion related week-long events. It is possible that there may be services within the earlier term for which this will not be the case. However, it is noted that the remainder of the specification of the earlier trade mark makes explicit reference to fashion and fashion shows. This indicates that this is the area of the market the opponent is interested in and so it is appropriate to assess on this basis. As such, it is considered that the words FASHION WEEK in the earlier trade mark are descriptive. Any distinctiveness that can be attributed to

the mark resides in the mark in totality. In considering the trade mark as a whole, it is noted that it includes a device of a torso, wearing an item of clothing. This, in conjunction with the words achieve a spark of distinctiveness but it cannot be said to achieve more than this. As such, it is considered that the earlier trade mark, as a whole, is distinctive to a below average degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

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

The principles

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

24. The services have been found to be identical. The average consumer is likely to be the business user and the general paying an above average degree of

attention. The marks are visually similar to a medium degree, aurally similar to a low to medium degree and conceptually similar to a low degree. The device in the earlier trade mark, whilst not the dominant element, is eye catching. The addition of highland in the later trade mark also has an impact. These differences, in combination, are considered to counteract any potential effect of imperfect recollection. Together with the above average degree of attention expected to be displayed during the purchasing process, I am more than satisfied that a consumer will not mistake one trade mark for the other. There is no likelihood of direct confusion.

25. However this is not the end of the matter. In considering whether or not there will be indirect confusion, I bear in the mind the following guidance from *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

26. I also take into account the guidance in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, where Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

27. The marks coincide only in respect of "Fashion Week". I have found this to be, for the reasons outlined above, directly descriptive of advertising services. The trade marks each contain additional elements which are quite different from one another: a torso device in the earlier trade mark and additional verbal element (Highland) in the later trade mark. I have considered whether the fabric worn on the torso device in the earlier trade mark is likely to be seen as a plaid, worn as part of traditional Scottish dress. If it would, there is certainly an argument that this links to highlands in the later trade mark and provides a Scottish theme to each. I cannot conclude that this is obvious from the torso device and so it is difficult to see how the later trade mark could be viewed as a natural brand extension. Rather, the inclusion of FASHION WEEK in both will be viewed as coincidental wording. Even if the later trade mark brought the earlier trade mark to mind (which is considered doubtful) this is mere association and not confusion. There is concluded to be no likelihood of indirect confusion.

28. The opposition therefore fails in its entirety.

COSTS

29. The applicant has been successful and is entitled to a contribution towards its costs. The applicant is not represented. As such, it was sent a costs pro forma at the conclusion of the evidence rounds and was informed that no costs would be awarded in the event of it not being returned. The form was not completed and returned to the Tribunal. As such, I make no order as to costs.

Dated 16 July 2019

Louise White

O/411/19

Principal Hearing Officer

For the Registrar