

**O-417-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3198759 BY  
VESPER INTERNATIONAL LTD**

**TO REGISTER THE TRADE MARK:**

**VESPER**

**FOR GOODS AND SERVICES IN CLASSES 3, 16, 26 AND 38**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000640  
BY ROUGE BUNNY ROUGE UK LIMITED**

## BACKGROUND

1) On 25 November 2015 Vesper International Ltd. (“the Applicant”) applied to register the following trade mark:

**VESPER**

The application was published for opposition purposes on 3 February 2017. Registration is sought for goods and services in classes 3, 16, 26 and 38, but only the following are opposed in these proceedings:

**Class 3:** *Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.*

2) The application is opposed by Rouge Bunny Rouge UK Ltd. (“the Opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon UK registration No. 2634850 (“the earlier mark”), for the following mark:

**VESPERS**

The earlier mark is registered for the following goods, all of which are relied on by the Opponent for the purposes of this opposition:

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

The mark was applied for on 14 September 2012 and its registration process was completed on 21 December 2012. The significance of these dates is that (1) the Opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant’s mark.

3) The Opponent claims that the mark applied for is similar to the earlier mark and that the goods of the competing marks are identical or similar, so that there is a likelihood of confusion. The Applicant filed a counterstatement, denying the grounds of opposition. The Opponent is represented in these proceedings by LSGA Solicitors. The Applicant is not professionally represented.

4) Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

The net effect of these provisions is that parties are required to seek leave in order to file evidence (other than the proof of use evidence, which is filed with the notice of opposition) in fast track oppositions. Neither side sought leave to file evidence in these proceedings.

5) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) (“the Rules”) provides that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. Neither side requested a hearing. The Opponent filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

### **SECTION 5(2)(b)**

6) Section 5(2)(b) of the Act reads 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”.

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

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of goods**

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

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services

c) The respective trade channels through which the goods or services reach the market

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

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

10) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (“*Meric*”), the General Court (“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 the 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 (Case T-104/01 *Oberhauser v OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03

*Koubi v OHIM — Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42”.

11) The counterstatement filed by the Applicant with its notice of defence contained what amount to submissions, in which it cited *Les Éditions Albert René SARL v OHIM*, Case T-336/03, as authority for the proposition that “simply because common language is used in the list of goods and services specified does not suffice in and of itself to indicate that the goods and services provided to the public are identical”. The argument is misconceived in this case. The position on the interpretation of terms used in specifications was explained as follows by Floyd J. (as he then was) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

12) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

13) The Applicant's *perfumery, essential oils, cosmetics, hair lotions and soaps* are all explicitly included in the Opponent's specification; they are identical. The Applicant's *make-up, eye make-up, eyeliners, blushers and lipsticks* all clearly fall within the ambit of the Opponent's *cosmetics* and are thus identical under the guidance in *Meric*.

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

14) 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*. 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.”

15) The parties' competing goods are cosmetics or similar items. The average consumer will be a member of the general public. The purchasing act is likely to be primarily a visual one, as the goods will most often be self-selected from a shelf (or the online or catalogue equivalent) and the marks may be exposed visually in advertising and websites etc. However, aural considerations will not be ignored in my assessment, as it is not unusual to find sales assistants and advisors involved in the purchasing process. Cosmetics and similar goods are likely to be available in a broad range of prices – though, as a general rule, they are relatively low value goods, fairly frequent purchases, and are unlikely to demand a higher level of

attention to be paid in their selection than that necessary to establish suitable skin type, particular ingredients, perfume, and so on. The purchasing process will be a normal, reasonably considered one.

### **Comparison of the marks**

16) 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

It would be wrong, therefore, to dissect the trade marks artificially, 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.

17) The marks to be compared are shown below:

<b>The contested mark</b>	<b>The earlier mark</b>
<b>VESPER</b>	<b>VESPERS</b>

18) Both marks consist of a single word. In neither case can this single word be broken down into constituent elements which could be considered dominant within the mark. In both cases the marks' distinctiveness lies in the word as a whole.

19) Both marks consist of the same initial sequence of six letters, the addition of a final S giving the earlier mark seven letters. The only visual difference between the marks consists of the final S of the earlier mark. Neither "vesper" nor "vespers" are words which are very commonly encountered by the relevant public, and I consider that the impact of the presence or absence of the final S on the average consumer's visual perception of the marks will be marginal, his or her attention focusing on the marks as a whole. Overall, there is a high degree of visual similarity between the marks.

20) VESPER will be given its normal English pronunciation in both marks (i.e. VES will be pronounced as in "vest" and PER as in "pert". The final S in VESPERS will be given the normal pronunciation of a final S in English. Thus, the only difference in pronunciation between the marks will consist of the final S in the earlier mark. The Applicant is misguided in asserting that the emphasis in oral use is likely to be on the second syllable. It is on the first syllable of both "vesper" and "vespers" that the spoken stress will most naturally lie for the native English-speaker, and the online version of the Oxford Dictionary of English (3 ed.) ("OED") confirms this. Overall, there is a high degree of aural similarity between the marks.

21) The OED defines "vespers" as "*a service of evening prayer in the Divine Office of the Western Christian Church*" and "vesper" as "[usually as modifier] *evening prayer; vespers: vesper service. Evening prayer ceremony*". I have already identified the average consumer as consisting of the general public. To some in a largely secular society the terms "vespers" or "vesper" may not convey any meaning at all. Such people will see neither conceptual similarity nor conceptual difference between the marks. Many, however, will, irrespective of their religious views or practices, at any rate have encountered the word "vespers" in, for example, literary, musical or historical references. These persons will be at least vaguely aware of the word's ecclesiastical connotation. If they come across the word "vesper", they may not notice the absence of the final "s" at all. If they do, I consider that they will find the

difference so marginal that they will tend to assume (correctly, it would seem, according to the OED) either that “vesper” is a variant of “vespers”, or that it is at any rate obviously related in meaning. Overall, therefore, many consumers will see at least a reasonable degree of conceptual similarity between the competing marks.

### **The distinctiveness of the earlier mark**

22) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, on the basis either of inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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).”

23) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctive character. “Vespers” is neither descriptive nor allusive of the relevant goods. I have found that for some consumers the word “vespers” may not convey any meaning at all. They will assume it to be an invented word, or a word the meaning of which is unknown to them or, possibly, an uncommon name. In any of these cases I consider that the mark would have a somewhat higher than average degree of inherent distinctive character. I have also found that many consumers will have some awareness of the word’s ecclesiastical connotation. The use of such a word in connection with cosmetic products is rather striking. In this case too, therefore, I consider that the mark would have a somewhat higher than average degree of inherent distinctive character.

### **Likelihood of Confusion**

24) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

25) I have found the competing goods to be identical. I have found a high degree of visual and aural similarity between the competing marks and that, while some consumers will see neither conceptual similarity nor difference between them, many will see at least a reasonable degree of conceptual similarity. I have not identified a dominant element in either mark, finding their respective distinctive characters to reside in the marks as a whole. I have found the earlier mark to have a somewhat higher than average degree of inherent distinctive character. I have found that, though both visual and aural aspects may have a role to play, the selection process is likely to be primarily a visual one, and is unlikely to demand a higher level of attention than necessary to establish suitable skin type, perfume, ingredients, etc., cosmetics being generally relatively low value and fairly frequent purchases. The purchasing process will be a normal, reasonably considered one.

26) Given my findings on the average consumer and the purchasing process, and bearing in mind the principle of imperfect recollection, I think it likely that the presence or absence of a final S in the competing marks may well go unnoticed, the average consumer's attention focusing on the respective marks as a whole. In this case, there will be direct confusion of the marks. Even where the difference is noticed, however, the average consumer will not attribute any material distinctive weight to it. Particularly in the light of my findings on similarity and distinctiveness, he or she will simply see the marks as variants of one another, finding it too great a coincidence that two unconnected undertakings would be using marks with such a marginal difference on identical or highly similar goods. The average consumer will believe that the respective goods come from the same or economically linked undertakings. Thus, there is a likelihood of direct confusion, and even if the difference between the marks is noticed there remains in any case a likelihood of indirect confusion, in respect of all the opposed goods. Accordingly, **the opposition succeeds in its entirety.**

### **Outcome**

The opposition having succeeded, **the application may not proceed to registration in respect of the following goods:**

***Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.***

Insofar as they are not contested in other proceedings, the remaining goods of the application, which were not opposed in these proceedings, may proceed to registration.

### **Costs**

28) The Opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. The award

reflects the fact that the pleadings and written submissions were simple and brief. I hereby order Vesper International Ltd. to pay Rouge Bunny Rouge UK Ltd. the sum of £350. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£100
Preparing written submissions	£150

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 7<sup>th</sup> day of September 2017**

**Martin Boyle  
For the Registrar,  
The Comptroller-General**