O/0776/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3896135

IN THE NAME OF

GURPREET NAGPAL

TO REGISTER THE FOLLOWING OF TRADE MARK:

Vogue Couture

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 443218

BY ADVANCE MAGAZINE PUBLISHERS INC.

Background and pleadings

1. On 01 April 2023, Gurpreet Nagpal ("the Applicant") applied to register the trademark shown on the front page of this decision in the UK under application number 3896135. The application was published for opposition purposes on 30 June 2023 and registration is sought for the following goods:

> *Class 25: Clothing; Ready-to-wear clothing; Clothes; Ready-made clothing; Women's clothing; Ladies wear.*

2. On 25 September 2023, ADVANCE MAGAZINE PUBLISHERS INC. ("the Opponent") filed a notice of opposition against the application. The opposition was originally brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). However within their letter dated 12 February 2024, the Opponent stated that for the sake of economy they wished to limit their grounds of opposition and now sought to rely on UKTM 918104097 under section 5(2)(b) only. The Opponent relies upon the following of trade mark:

> **VOGUE**
>
> Comparable UK trade mark (EU) registration no. 918104097 [1]
> Filing date 05 August 2019; registration date 24 January 2020.
> Relying on the goods in class 25 of the registration, namely:
>
> *Class 25: Clothing, in particular hosiery, shoes, headgear.*

3. By virtue of its earlier filing date, the Opponent's mark constitutes an earlier mark within the meaning of section 6 of the Act. As the mark had not completed the registration process more than five years before the relevant date (the filing date of

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

the mark in issue), it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified.

4. The Opponent submits that there is a likelihood of confusion because the Applicant's mark is highly similar to the Opponent's and the respective goods are identical or similar, giving rise to a likelihood of confusion.

5. The Applicant filed a counterstatement denying the claims made.

6. In these proceedings, the Opponent had initially been represented by Beck Greener LLP, but during the course of the proceedings changed its representation to Stobbs. The Applicant is a litigant in person acting without legal representation. Neither party filed evidence nor requested a hearing, though I note that the Opponent filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

Preliminary remarks

7. Within their counterstatement the Applicant has raised points that I intend to address as preliminary issues. Before going further into the merits of the Opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

8. The Applicant states that "the name is not the same and we have never had anyone getting confused between us and their brand". However, absence of evidence of confusion does not necessarily mean an absence of actual confusion: *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 at [80]. I will therefore proceed to make my decision on the likelihood of confusion between the marks by making a multi-factorial assessment based on the particulars of the case before me.

9. The Applicant also states that the goods for which they are seeking registration target only "Prom Girls". However, I bear in mind that how the parties' goods are used and sold in practice (including what consumers they currently target) are not relevant to my assessment. I have to carry out a notional assessment based upon the specifications before me (how the goods within the parties' specifications could be

used and sold), and all the circumstances in which the mark applied for might be used if it were registered. [2] Therefore, this submission does not assist the applicant.

DECISION

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.

Section 5(2)(b)

11. 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".

12. 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:

[2] O2 Holdings Limited & Anor v Hutchison 3G UK Limited, Case C-533/06, paragraph 66.

(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.

Comparison of goods

13. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

> "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 fur 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".

14. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

15. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 25- Clothing, in particular hosiery, shoes, headgear.	**Class 25-** Clothing; Ready-to-wear clothing; Clothes; Ready-made clothing; Women's clothing; Ladies wear.

Clothing

16. I note that the Opponent's specification includes the term 'Clothing, in particular hosiery, shoes, headgear'. The use of the words 'in particular' does not limit the preceding term but are used only to provide examples of goods falling within the wider category. In view of this, the Opponent's 'Clothing, in particular hosiery, shoes, headgear' provides them protection for 'clothing' in class 25 without limitation. The Opponent is therefore entitled to rely upon the term 'clothing' at large. The term *clothing* appears in the specification of both the Applicant and the Opponent and as such is identical.

Ready-to-wear clothing; Clothes; Ready-made clothing; Women's clothing; Ladies wear.

17. The above goods are all forms of clothing. It is my view that these goods would be encompassed by the Opponent's broader term *clothing.* I therefore find the goods to be identical in line with the principle set out in *Meric*.

The average consumer and the nature of the purchasing act

18. 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 the goods are likely to be selected by the average consumer. 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."

19. The goods in question are all forms of clothing and the average consumer will be members of the general public at large. The cost of purchase is likely to vary and the goods will be purchased relatively frequently. The average consumer is likely to be alive to considerations such as the aesthetic appearance, style, material and durability of the goods. Overall, I consider that the average consumer will demonstrate a medium level of attention during the purchasing process.

20. The purchasing act will be predominantly visual in nature, with the average consumer likely to have encountered the goods on the shelves of a retail outlet or online equivalent where they will be chosen by self-selection.[3] I do not however discount the aural consideration where advice is sought from retail assistants or word-of-mouth recommendations play a role.

Comparison of marks

21. 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:

[3] *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03, Paragraph 50

> "…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 relevant 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."

22. 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 trade 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.

23. The marks to be compared are as follows:

Opponent's Mark	Applicant's Mark
VOGUE	**Vogue Couture**

24. The Opponent's mark consists of the ordinary dictionary word "VOGUE". As there are no other additional elements, the overall impression of the mark resides in the word itself.

25. The Applicant's mark is a word only mark consisting of the words "Vogue Couture". The Opponent submits that "Vogue" is the dominant and distinctive element of the mark as it appears first, and that the word "Couture" is descriptive of the goods covered by the application.[4] I agree with the Opponent's submission. However, as I will come to discuss in the conceptual comparison, I bear in mind that the word "vogue" will be understood by the average consumer as being associated with fashion and fashion trends, and thus is also allusive of the goods. On the basis that "Couture" is

[4] Opponent's written submissions in lieu, paragraph 16

directly descriptive of the goods, I find that it will play a lesser role in the overall impression, with "Vogue" playing a slightly greater role.

Visual comparison

26. Visually, the Opponent's word mark, "Vogue", wholly appears at the beginning of the Applicant's mark, a position to which the average consumer pays more attention.[5] This acts as a visual point of similarity. However, the marks differ through the addition of the word "Couture" at the end of the Applicant's mark. Taking this into account, I consider the marks to be visually similar to a medium degree.

Aural comparison

27. Aurally, the word "Vogue" in the Opponent's mark will be given its ordinary dictionary pronunciation. Turning to the Applicant's mark, the words "Vogue couture" will also be given their ordinary dictionary pronunciation. While the marks both share the pronunciation the word "Vogue", they differ in the pronunciation of the additional word "Couture" at the end of the Applicant's mark. Overall, I find the marks to be aurally similar to a medium degree.

Conceptual comparison

28. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

29. The Opponent has submitted that the marks are conceptually highly similar as the term "Couture" is descriptive for goods relating to clothing meaning the conceptual similarity will therefore focus on the term Vogue in both the marks.[6] However, descriptiveness does not render an element negligible,[7] and consequently the term

[5] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[6] Opponent's written submissions in lieu, paragraph 24
[7] *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22

"couture" in the applicant's mark will still contribute to the conceptual message of the mark.

30. The Opponent's mark is comprised solely of the ordinary dictionary word "Vogue". Whilst I appreciate that it has the dictionary definition of "a fashion or general liking, especially one that is temporary",[8] I am not convinced that the average consumer would necessarily be aware of its exact meaning. However, instead, I consider that a significant proportion of consumers will understand that it has some meaning associated with fashion and fashion trends.

31. The Applicant's mark will be viewed as two words, both of which have dictionary definitions. Again, I find that the word "vogue" will be understood to a significant proportion of consumers as being associated with fashion and fashion trends. The second word; "couture", is defined as "the designing, making, and selling of expensive fashionable clothing that is made by hand (not using a machine, factory, etc.), usually for a particular customer, and is not sold in shops, also used to refer to the clothes themselves".[9] I am of the view that the average consumer will recognise and understand this term as evoking expensive and high-end fashionable clothing, even if they are not aware of the exact aforementioned dictionary definition. As such the Applicant's mark conveys the conceptual message of expensive clothing which is fashionable or on trend. In view of this and given that the marks overlap in the conceptual message conveyed by the shared "Vogue" element, I find the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier mark

32. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it is registered and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik*, the CJEU stated that:

[8] https://dictionary.cambridge.org/dictionary/english/vogue
[9] https://dictionary.cambridge.org/dictionary/english/couture

> "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)."

33. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness through the use made of it, nor has it filed any evidence of use. Therefore, I have only the inherent distinctiveness of the mark to consider.

34. As previously discussed in my conceptual comparison at paragraph 30, the Opponent's mark is comprised solely of the ordinary dictionary word "Vogue". Whilst I am not convinced that the average consumer would necessarily be aware of its exact meaning, I consider that a significant proportion of average consumers will understand that it has some meaning associated with fashion and fashion trends. The word

“Vogue” is allusive of the goods relied upon by the Opponent in class 25 as they are all forms of clothing. These goods are well known for being driven by fashions or trends and indeed the production and sale of clothing is often referred to as the “Fashion industry”. Consequently, I consider the mark to be inherently distinctive to between a low and medium degree.

Likelihood of confusion

35. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 and vice versa (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 (*Lloyd Schuhfabrik* at [26]).

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and the goods down to the responsible undertakings being the same or related.

37. Earlier in this decision I concluded that:

- The competing goods are identical;
- The average consumer will comprise members of the general public who will demonstrate a medium level of attention during the selection process;
- The purchasing process will be predominantly visual in nature, though aural considerations will not be discounted;

- The Opponent's earlier mark holds between a low and medium degree of inherent distinctiveness;
- The Opponent's mark is visually similar to the Applicant's mark to a medium degree;
- The Opponent's mark is aurally similar to the Applicant's mark to a medium degree;
- The Opponent's mark is conceptually similar to the Applicant's mark to a medium degree.

38. Taking all of the above into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. I do not consider that a consumer paying a medium degree of attention during the purchasing process will overlook the word "Couture" at the end of the applicant's mark, which albeit descriptive, is not negligible and therefore contributes visually, aurally and conceptually. I do not consider there to be a likelihood of direct confusion.

39. I will now go on to consider whether there is a likelihood of indirect confusion.

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

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

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)."

41. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors [2021] EWCA Civ 1207,* wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria (O/219/16)*, where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

42. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. I also bear in mind the recent appeal decision by Philip Harris, sitting as the Appointed person, in *Natural Pure NATURAL PURE WATER*, Case BL-O/0331/23, stated that:

"23. Accordingly, I think Whyte & Mackay goes much further than Nicoventure. I read the former case as holding that where the first mark is of low distinctiveness overall, and it is replicated (even wholly replicated) in a second

mark, this suggests against a likelihood of confusion provided there is at least one element in the second mark which is sufficiently more distinctive than the element consisting of the first mark. This view also seems to me to be consistent with the extract from the L'Oreal judgment above."

43. In this instance, the Applicant's mark consists of the word "Vogue" and the additional word "Couture". As discussed above, I consider the word "Couture" to be descriptive of the Applicant's goods; with it being a term evoking expensive and high-end fashionable clothing. Consequently, this element of the applicant's mark is not "sufficiently more distinctive" than the "Vogue" element.

44. As such, I consider that the common use of the word "Vogue" in each of the competing marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings. I am of the view that the average consumer will see the additional "Couture" element in the Applicant's mark and perceive it to be a sub brand of the Opponent's mark; with "Vogue" being the house brand and "Vogue Couture" being the sub-brand for its expensive and high-end fashionable clothing. Consequently, I consider there to be a likelihood of indirect confusion between the marks in respect of all of the contested goods.

Conclusion

45. The opposition under section 5(2)(b) of the Act has succeeded in full. Subject to any successful appeal against my decision, the application is refused for the following goods:

Class 5 - Clothing; Ready-to-wear clothing; Clothes; Ready-made clothing; Women's clothing; Ladies wear.

COSTS

46. As the Opponent has been fully successful, they are entitled to a contribution towards their costs. Awards of costs in proceedings commenced on or after 1

February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 1 of 2023. Taking account of that scale, I award the Opponent the sum of £700, calculated as follows:

Preparing a statement and considering the other side's statement:	£250
Filing submissions:	£350
Official fee:	£100 [10]
Total:	**£700**

47. I therefore order Gurpreet nagpal to pay the sum of £700 to ADVANCE MAGAZINE PUBLISHERS INC.. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 21st day of August 2025

Jacob Robinson
For the Registrar

[10] As noted at paragraph 2 above, the Opponent withdrew its grounds under sections 5(3) and 5(4)(a). The official fee for filing an opposition on the basis of section 5(2)(b) only is £100 and the Opponent has been awarded as such.