

O-540-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3099062
BY TESSA CAMPBELL**

TO REGISTER THE TRADE MARK:

Venus In Furs

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000283
BY VENUS FASHION, INC.**

BACKGROUND

1. On 13 March 2015 Tessa Campbell applied to register the mark shown on the cover page of this decision in respect of the following goods:


Class 25:

Womans clothing "jackets", "trousers", "skirts", "dresses", "shirts", "tops", "footwear".

2. The application was published for opposition purposes on 17 April 2015, following which Venus Fashion, Inc. ("the opponent") filed notice of opposition under the fast track opposition procedure.

3. The opposition is based on Section 5(2)(b) of the Trade Marks Act 1994 (the Act) and is directed against all of the goods in the application.

4. The opponent relies upon the earlier UK mark shown below:

Mark details	Goods relied upon
UK 2580053  Filing date: 3 May 2011 Date of entry in the register: 21 October 2011	Class 25 <i>Clothing, footwear</i>

5. Ms Campbell filed a counterstatement in which she denied the basis of the opposition.

6. 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."

7. The net effect of the above is to require parties 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.

8. No leave was sought in respect of these proceedings.

9. Rule 62(5) (as amended) states 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.

10. A hearing was neither requested nor considered necessary. Both parties filed written submissions which I will refer to as necessary, below.

DECISION

11. Section 5(2)(b) of the Act states:

“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. An earlier trade mark is defined in Section 6 of the Act, which states:

“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) Reference 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.”

13. Given its date of filing, the opponent’s mark constitutes an earlier mark in accordance with Section 6 of the Act. The earlier mark had not been registered for more than five years at the date on which Ms Campbell’s mark was published meaning that the proof of use provisions contained in Section 6A do not apply. The opponent can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) case law

14. 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.

Comparison of goods

15. The goods to be compared are as follows:

Opponent's goods relied upon	Ms Campbell's goods
Class 25 <i>Clothing, footwear</i>	Class 25 <i>Womans clothing "jackets", "trousers", "skirts", "dresses", "shirts", "tops", "footwear".</i>

16. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05, the General Court (GC) stated that:

“29. ...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”.

17. Although the opponent's specification covers a wide range of goods and services in a number of classes¹, the only goods it relies on in the instant proceeding are Clothing and Footwear in Class 25.

18. Ms Campbell contends, in her counterstatement, that the parties target different segments of the market, with her target market being 'vintage inspired clothing' for young women aged 16-28. In her view, this is sufficient to exclude identity of the respective goods. Merely because the respective goods are marketed to different segments of the market is not relevant to the comparison I am required to carry out. The opponent's registration is less than five years old and, under Section 5(2)(b), I must consider 'notional' and 'fair' use of its mark across the full range of goods which are relied on and for which the mark is registered and entitled to be used, i.e. across all sectors of the market. The comparison I have to make is based on the parties' specifications as registered and for which registration is applied, neither of which are restricted in terms of segment of the market or demographics they address.

19. Both specifications include the term 'Footwear' in Class 25, thus, to that extent, the competing goods are identical. The registered specification also includes the broad term 'Clothing', while the applied for specification refers to 'Womans clothing' followed by a number of specific items. The way the applied for specification has been drafted is ambiguous and can be construed as either all the listed items being articles of women's clothing or alternatively, as being specific items on their own, whether for women or not. Whatever the interpretation of this part of the applied for specification, both 'womans clothing' and the items specifically listed are forms of clothing and as such, are encompassed by the broad term 'Clothing' contained in the registered specification. The goods covered by the application in suit are either literally identical to the goods covered by the opponent's registration or identical on the principle outlined in *Merica*.

¹ Classes 16, 18, 25 and 35

The average consumer and the nature of the purchasing act

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected in the course of trade.

21. 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.”

22. In the present case, the goods at issue are articles of clothing and footwear in class 25. The average consumer for all these goods is the public at large. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC considered the level of attention paid when and the manner in which clothing is selected. It stated:

“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.

“50..... 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.”

23. The purchase process of all the goods at issue is likely to be primarily visual as it is likely to be made from a physical store on the high street, a catalogue or from a website. That said, as the selection of the goods may, on occasion, involve the intervention of a sales assistant, aural consideration cannot be ignored. As to the degree of care that will be taken when selecting the goods at issue, it is likely to be

no more than average as the goods are bought on a fairly regular basis and, in the main, they are not highly expensive.



Comparison of marks

24. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (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.”

25. It would be wrong, therefore, artificially to dissect the 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.

26. The respective marks are shown below:

Opponent's mark	Ms Campbell's mark
	

Overall impression

27. The opponent's mark consists of the single word 'VENUS', written in block capitals and in a slightly stylised typeface. This is the overall impression it will convey.

28. Ms Campbell's mark consists of the phrase 'Venus In Furs', written in a normal typeface with the letters V, I and F in upper case and the rest of the letters in lower case. In its written submissions, the opponent contends that the word 'Venus' is the first, dominant and distinctive element of the applied for mark and, as such, is what consumers would perceive first and more readily retain. Ms Campbell rebuts this point and states:

“Visually you can't tell which element of the Mark consumers would perceive before the other elements, as it's a phrase conjoined as one.”

29. In English, the eye naturally reads from left to right, so I do not doubt that the word 'Venus' is the first element the average consumer will perceive when faced with the applied for mark. As to the importance of this element in the context of the mark, I accept that as a rule of thumb the beginnings of marks are generally more important than their endings², however, each case must be decided on its merits considering the marks as wholes.

30. In this case, neither the word 'Venus' nor the other elements of the applied for mark are accentuated and the three words form a phrase that 'hangs together'. That said, the word 'Venus' is the first word within the applied for mark and is qualified by the combination 'In Furs'. Whilst Ms Campbell accepts that the words 'In Furs' are non-distinctive per se, her argument is that "when included in the phrase 'Venus In Furs' the trade mark becomes distinctive". On that point, I observe that the words 'In Furs' are strongly allusive or even descriptive in the context of the applied for goods. Whilst the words 'Venus' and 'In Furs' both contribute to the overall impression of the applied for mark, given the positioning of the word 'Venus' and the (at least) strongly allusive quality of the words 'In Furs', it is the word 'Venus' that, in my view, the average consumer will more readily retain in its mind.

Visual comparison

31. If I understand Ms Campbell's submissions correctly, she points out that, in its submissions, the opponent refers to her mark as being in capital letters whereas the application is for the words 'Venus In Furs' in title case. She states, inter alia:

"The Mark is comprised of 11 letters in total over three words, in the style on Venus in Furs, not VENUS IN FURS. Any standard research would of (sic) shown what the mark looked like. Therefore was damaging towards the case. Venus in Furs has two words after Venus, making both marks only similar by one word."

32. Ms Campbell's mark is a word mark and in the case of word marks, what is protected is the word itself. The specific casing in which Ms Campbell's mark is presented is irrelevant as notional and fair use of her mark includes use in different scripts, such as, for example, a format comparable to that used by the opponent's mark³.

33. The marks are similar to the extent that they coincide in the first word 'Venus' while they differ in the additional words 'In Furs' in the applied for mark. Even allowing for use of the applied for mark in a format comparable to the opponent's mark, the applied for mark is noticeably longer and, notwithstanding the shared first element, I find that there is only a moderate degree of visual similarity.

² A similar point was made in conjoined cases T-183/02 and T-184/027, *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81

³ Case T-346/04, *Sadas SA v OHIM*, paragraph 47

Aural similarity

34. The above analysis follows through to my assessment of aural similarity. The similarities and the differences are the same, thus, I find that the level of aural similarity is only moderate.

Conceptual similarity

35. Both parties made extensive submissions on the conceptual comparison of the marks. The opponent states:

“8. VENUS is commonly understood by English speakers to refer to the Roman goddess of love and beauty or the planet of the same name. IN is a preposition and FURS refers to the skin of an animal, usually used to denote items of clothing made from fur. Both of these elements are non-distinctive and in the case of FURS descriptive in the context of the Contested Goods. Altogether, the phrase can refer to a novel written by Leopold von Sacher-Mensch about a man who dreams of speaking to Venus about love while she wears furs.

9. VENUS evokes the idea of beauty but is not directly descriptive of the Earlier or Contested Goods; it is most allusive in so far as it refers to the concept of beauty. The most interesting and distinctive element of the contested mark therefore is VENUS.

[...]

13. [...] Both the Earlier and the Contested Marks therefore evoke the idea of the goddess VENUS, even if some consumers would perceive the Contested Mark to have a slightly extended meaning as the title of a novel. IN FURS is not enough to displace the common meaning arising from VENUS and there is a level of conceptual similarity [...].”

36. In response to the above, Ms Campbell rebuts:

“VENUS is commonly understood by English speakers to refer to the Roman goddess of love and beauty or the planet of the same name” – This is in fact a matter of opinion and for that reason it is completely invalid and irrelevant to the issue. As I have stated, VENUS becomes a non-distinctive word which could be interpreted differently from being to being. With the two extra words of “In Furs” the meaning of venus could be open to many different meanings as the latter words give Venus a completely different context. “IN is a preposition and FURS refers to the skin of an animal, usually used to denote items of clothing made from fur” – Separately these words are non-distinctive however when included in the phrase “Venus In Furs” the trade mark becomes distinctive. You can not base your decision solely on an opinion therefore I believe when looking past the separate meaning of the words you will come to the conclusion that this is irrelevant [...].”

37. In my view, the average consumer will understand the word ‘Venus’ as a reference to either the Roman goddess, or the planet Venus. So far as the words ‘In Furs’ in the applied for mark are concerned, they should be considered as a whole

and will, in my view, be understood by the average consumer to mean 'dressed in an animal skin with fur on it or in a garment made of fabric resembling it'.

38. In my view, while the opponent's mark is open to a binary interpretation (as a reference to either the Roman goddess or the planet named Venus), the words 'In Furs' in the applied for mark will convey the concept of the goddess Venus dressed in fur or in a garment made of fur.

39. In my view, the fact that the competing marks contain the word 'Venus' which may evoke the same conceptual imagery of the Roman goddess (being dressed in fur or otherwise) results in a reasonably high degree of conceptual similarity between the parties' marks.

Distinctive character

40. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods 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.

41. I have no evidence of use to consider so I only need to make a finding in respect of the inherent distinctiveness of the opponent's mark.

42. I have no specific comments from the parties on the distinctive character of the earlier mark, although, when addressing the comparison of marks, the opponent accepts that the term 'VENUS' is "allusive in so far as it refers to the concept of beauty". Even allowing for a degree of allusiveness to the extent that the word 'VENUS' conveys the idea of clothing that make the wearer beautiful, it cannot be said, that the mark is highly allusive of a characteristic of the goods. The mark is endowed with a medium degree of inherent distinctive character.

Likelihood of confusion

43. 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

44. In her submissions, Ms Campbell invites me to take account of the co-existence of the marks in the marketplace. Further, she contends that the opponent's goods are sold over the Internet only and that having conducted an Internet search the results showed an absence of confusion. She states, inter alia:

"If the type of goods are so important to the trademark then there should be no confusion at all. VENUS states that an assessment of the likelihood (sic)

must be based on the perception that the relevant consumer has on the goods. Based on both marks co existing the last year there seems to be no confusion at all. The type of goods Venus are selling aren't to what the contested goods are (sic). They may be under Class 25 but the term clothing is too vast to be considered all the same. Typically consumers know when they are shopping two different brands, especially when one is American and another British.

The likelihood of confusion should also arise when browsing different brands. If there was any confusion between the two brands online search engines would recognize this. Venus In Furs comes up with nothing relating to VENUS and vice versa, mainly because that one word is not enough to relate to one another. If VENUS was such a distinctive word then acknowledgment would be there.

Since VENUS is an online store and cannot be bought over in UK apart from online, I can't see how there would be anymore confusing (sic) in the buying market apart from the internet. As both brands don't cross each other on the internet nor on the UK high street this counters all confusion.

[...] For the past year I have been trading under Venus in Furs and as the Earlier goods cannot provide evidence that there has been a confusion or that Venus In Furs has been damaging, my application should be accepted in its entirety."

45. Caution about the circumstances in which it is appropriate to give weight to the absence of confusion in the marketplace has been expressed in a number of judgments, including *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 in which Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

46. In any case, for coexistence to be relevant, the party presenting such an argument must adduce evidence of parallel trading without confusion. These are fast track proceedings and no request for leave to file evidence has been received, thus, I need say no more about this claim.

47. As to Ms Campbell's reference to the results of an internet search, this argument is not pertinent, as I have to consider the issue of likelihood of confusion from the perspective of the average consumer and not whether an online search engine locates both marks when searching for one or the other.

48. Earlier in this decision, I found that the parties' goods are identical and that the average consumer will pay an average degree of attention when selecting the goods. I also found that the marks are visually and aurally similar to a moderate degree and conceptually similar to a reasonably high degree and that the opponent's 'VENUS' mark is inherently distinctive to a medium degree.

49. The opponent's mark consists exclusively of the word 'VENUS' which is the first word of the applied for mark. In my view, the presence of the words 'In Furs' in the applied for mark is sufficient to dispel the likelihood of direct confusion (i.e. where one mark is mistaken for the other). However, as I mentioned above, the fact that the words 'In Furs' are, at least, strongly allusive will lead the average consumer to more readily retain the word 'Venus' in its mind. Reminding myself that, inter alia, identical goods are involved leads me to conclude that there is a likelihood of indirect confusion, i.e. where the average consumer will believe the respective goods originate from the same or linked undertakings. This is all the more so since, as the opponent noted, it is fairly common practice for clothing companies to use sub-brands to denote different ranges of products.⁴ It would, for example, be reasonable for the average consumer to believe that 'Venus In Furs' is a sub-brand of the brand 'VENUS' or that the undertaking trading under the name 'VENUS' has licensed the mark. Either way, there is a likelihood of confusion.

CONCLUSION

50. The opposition succeeds under section 5(2)(b) of the Act.

Costs

51. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fees: £100

Preparing a statement and considering the other side's statement: £200

Written submissions: £200

Total: £ 500

52. I order Tessa Campbell to pay Venus Fashion Inc. the sum of £500 as a contribution towards its costs. This sum is to 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 19th day of November 2015

**Teresa Perks
For the Registrar
The Comptroller - General**

⁴ Case T-104/01, paragraph 49; Case T-129/01, paragraph 57