

O-264-15

IN THE MATTER OF AN APPLICATION FOR
REGISTRATION OF THE TRADE MARK

GLAMOUR SECRETS

UNDER NO 2627905
BY GLAMOUR SECRETS LICENSING CORPORATION

AND

OPPOSITION THERETO UNDER NO 104122
BY ADVANCE MAGAZINE PUBLISHERS INC

Background

1. On 11 July 2012, Glamour Secrets Licensing Corporation (“the applicant”) filed an application to register the trade mark GLAMOUR SECRETS for the following services:

Class 35

Retail services connected with the sale of hair and beauty products, cosmetics and toiletries

Class 44

Beauty and hair salons

2. Following publication of the application in *Trade Marks Journal* 6953 on 17 August 2012, notice of opposition was filed by Advance Magazine Publishers Inc (“the opponent”). The grounds of opposition are founded on sections 5(2)(b), (3) and (4) of the Trade Marks Act 1994 “the Act”. The opposition under sections 5(2) and (3) is based on the following Community trade marks (“CTM”):

Mark	Relevant dates	Specification relied upon
9056681 GLAMOUR	Filing date: 26 April 2010 Date of entry in register: 12 November 2010	Goods and services in classes 9, 35, 38 and 45
5780648 GLAMOUR	Filing date: 20 October 2003 Date of entry in register: 30 May 2009	Goods and services in classes 19, 28, 35, 40 and 44
183640 GLAMOUR	Filing date: 1 April 1996 Date of entry in register: 1 December 1999	Goods and services in classes 9, 16 and 41

3. The opposition under section 5(4) of the Act is based on use of the sign GLAMOUR in the UK since at least April 2000 in respect of *Magazines relating to beauty, fashion, health, lifestyle and other subjects of general interest to women; advertising services; retail services; information, advice and entertainment relating to beauty, fashion, health, lifestyle and other subjects of general interest to women.*

4. The applicant filed a counterstatement in which, essentially, it denied the claims made. Both parties filed evidence with the applicant also filing written submissions. In those submissions, the applicant indicated that it is “prepared to accept that the Opponents have established a reputation in the word GLAMOUR for “magazines””. The matter came before me for a hearing on 14 May 2015. Mr Philip Harris of

counsel instructed by Oakleigh IP Services Ltd represented the applicant. Mr Ian Bartlett of Beck Greener represented the opponent.

The evidence

The opponent's evidence

5. This takes the form of a witness statement of Pamela Rose Raynor who states she is the Finance Director of The Conde Nast Publications Limited, which employment she took up in 1999. Ms Raynor states that her company is a wholly owned subsidiary of the opponent and that she has full access to the books and records of both companies and is authorised to make the statement of their behalf.

6. Ms Raynor states the opponent is "one of the world's largest and best known publishing businesses" and licenses Conde Nast to publish GLAMOUR in the UK. She states that it is a monthly publication which was first published in the US in 1939 under the title *Glamour of Hollywood* but is now published in numerous countries including the UK, US, Sweden, France, Italy, Germany, Spain, Russia, Greece, Poland, South Africa, Hungary, Romania, Turkey, Bulgaria and the Netherlands as well as a Spanish language edition in Latin America.

7. Ms Raynor states that the magazine was launched in the UK in 2001 and has been published by Conde Nast under the licence from the opponent. She states it is a fashion, beauty, celebrity and lifestyle magazine which took the number one spot the year after launch and maintained that top position until "this year" (her witness statement is dated 8 October 2014) when it dropped to second place.

8. Ms Raynor provides the following details:

Year	Circulation figures (in excess of)	Net Sales Revenue £ (in excess of)	Advertising Sales Revenue £ (in excess of)
2001	850,000	-	-
2002	1,000,000	-	-
2003	1,050,000	-	-
2004	1,100,000	8,500,000	14,500,000
2005	1,050,000	8,000,000	15,500,000
2006	1,000,000	8,500,000	15,000,000
2007	950,000	7,500,000	15,000,000
2008	950,000	8,000,000	12,000,000
2009	900,000	7,000,000	10,000,000
2010	900,000	7,000,000	10,500,000
2011	900,000	7,000,000	10,500,000
2012	800,000	6,000,000	10,500,000

9. Some of the figures for 2012 will be from after the relevant date. Whilst Ms Raynor also gives figures for 2013 I have not included them for the same reason. The advertising sales revenue is said to derive from advertising and promoting third party products.

10. Ms Raynor states there is also an online version of the magazine and gives the following information:

Year	Unique users	Page impressions
2007	162,298	2,960,773
2008	201,498	3,110,154
2009	241,703	4,918,140
2010	362,563	7,187,759
2011	609,473	16,011,305
2012	1,297,587	32,788,377

11. Figures are also given for the following two years but again I have not included them as they date from after the relevant date in these proceedings.

12. The magazine is said to have a Facebook presence (from a date unspecified and said “currently” to have over 2 million likes). It has had a Twitter presence since April 2009. Since 2004, the UK magazine has organised the GLAMOUR Woman of the Year awards “to honour extraordinary and inspirational women from a variety of fields although there is often a strong bias towards fashion, beauty and popular culture” and which is aimed at its “target demographic”. Ms Raynor states the awards cost around £370,000 per annum, with 500 attendees and a further 300 for the after-event party. At PR-3 and PR-4 she exhibits material relating the awards. PR-3 consists of four pages. The source of these pages is not given. Page 1 refers to the 2005 award, page 2 has 2008 handwritten on it, page 3 bears no dates and page 4 has the date 2010 handwritten on it. PR-4 consists of 11 pages. The first eight have been downloaded from the dailymail.co.uk website and is an article dated 9 June 2011. It refers to “last night’s Glamour Awards”. Page 9, downloaded from the telegraph.co.uk website on 8 October 2014 is not clearly printed but bears a reference to the Glamour Women of the Year Awards 2011. The remaining pages are from the glamourmagazine.co.uk website. Headed “Glamour Awards Gossip”, it refers to the 2008 event. Ms Raynor states that it is calculated that the media value generated from the coverage of the awards is worth “about £2-3m each year”.

13. Ms Raynor states that a key focus for the magazine is hair and beauty with “an entire section of the magazine aimed at this topic”. It features, reviews and promotes hair and beauty products, cosmetics, toiletries and related services. At PR-5, she exhibits a photocopy of the October 2011 edition of the magazine which, she states, is “consistent with the level of coverage we give to beauty in each edition”. It contains many pages showing advertising and advertorials for various products and services, many relating to beauty.

14. Ms Raynor states that the magazine usually carries a free sample of certain products within its pages. The October 2011 edition carried a perfume sample. Four times a year, the magazine is sold in a plastic cover or bag and includes a free gift. At PR-11 the cover page of the July 2008 edition shows it had a free “Benefit” lip gloss, the July 2010 edition had a free “Benefit” eye pencil, the December 2010 edition had a free “nails inc” nail polish, the April 2011 edition had a free “Clinique” product, the July 2011 edition a “Benefit” tint, the April 2012 edition a “Percy & Reed” finishing polish, the July 2012 edition a “Benefit” product. In addition, each May from

2008, the magazine has run a beauty giveaway feature, in the magazine and online. Ms Raynor states that brands are approached and asked to provide bulk amounts of their products to be given away each day to readers who enter a prize draw with a chance to win one of those products. Pages showing the various prizes available from 2008 are shown at PR-12. They show products from a wide range of suppliers. In addition, “beauty product free gifts” are given away to readers who take out a subscription for the magazine.

15. Ms Raynor states that “more recent activity” involves the retailing of beauty products in collaboration with a retailer called Latest in Beauty. This company is said to “source, supply and administer the box contents [which the magazine] curates, lend its beauty authority, and design and the use of the GLAMOUR brand”. Whilst I’m not entirely sure what this sentence is intended to mean, I note that the first box is said to have appeared and been promoted only in July 2013 i.e. after the relevant date.

16. Ms Raynor states that members of the magazine and its staff have won a number of awards, including Beauty Journalist of the Year (Pantene Pro-V Award 2002), Beauty Photographer of the Year (Pantene Pro-V Awards 2003), Best Beauty Editor of a Consumer Glossy (P&G Beauty Awards 2006), Most captivating Consumer Feature (Wella Hair Journalism Awards 2008) and Rising Star Award (P&G Beauty Awards 2011).

The applicant’s evidence

17. This takes the form of a witness statement by Alan David Goldring, a trade mark attorney in the employ of the applicant’s legal representatives. Mr Goldring gives evidence as to the applicant’s business as a retailer whose stores include “full services salons” which offer their customers a “full service one-stop beauty shop”. He states it began trading in Canada and the US but later traded in other countries and the EU.

18. Mr Goldring gives details of an earlier CTM for the mark GLAMOUR SECRETS which, he states, is owned by a sister company to the applicant. He states that the two companies share the same address and that “the benefits and rights of the earlier mark and the benefits and rights of the present application all belong to the same overall business and accordingly those benefits and rights are all part of the rights belonging to the applicant.” No evidence is given as to whether there are any agreements in force regarding the “benefits and rights” of this earlier mark but its claim cannot affect the outcome of these proceedings. The position was explained in *PepsiCo Inc v OHIM* T-269/02 where the court stated:

“24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener’s mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not

in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned) Case T6/01 Matratzen Concord v OHIM-Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of national authorities."

19. Mr Goldring also provides details of 6 other marks (4 CTMs and 2 UK registrations) which, he states, include the word GLAMOUR and cover retail services for beauty products and similar services. Whilst he himself provides no explanation of the relevance of this, the applicant has filed submissions to indicate that these registrations show the word GLAMOUR is "not distinctive for "glamour" products" and that "along with the Applicant's earlier registration of the present mark all co-exist quite happily alongside the Opponents marks". I will deal with the distinctiveness point later in this decision. As regards the co-existence point, I note that in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41, Laddie J held:

"22 It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9(1)(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say, s 10.(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered trade mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

20. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, Millett LJ stated:

“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.”

21. No evidence has been filed to show use of any of the third party marks referred to by Mr Goldring. As to use by the applicant of its mark, at GS3, Mr Goldring exhibits an article from *Franchise International Magazine* which consists of 5 pages. On the second page it states:

“Established in Canada as Trade Secrets in 1989, the brand has grown to become Canada’s largest professional retailer of its kind with 66 stores, and has expanded into the USA and Kuwait.”

22. I am not told when the change of name came about, however, the magazine is a Canadian one and no evidence is provided to show it has ever been distributed in the UK. Whilst the article indicates the applicant has traded under the mark in other countries, there is no evidence that any trade has been commenced or carried out in the UK. In all the circumstances, I reject the submissions regarding co-existence and absence of confusion.

23. That completes my summary of the evidence filed to the extent I consider it necessary.

The objection under section 5(2)(b) of the Act

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

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

(a)...

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

25. An earlier trade mark is defined in section 6 of the Act. It states:

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

(a) a registered trade mark, international trade mark (UK), 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,

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) ...”

26. Each of the three marks relied on by the opponent is an earlier mark within the meaning of section 6 of the Act. Given the date it was entered into the register, CTM 183640 would be subject to the requirement that the opponent provide proof of its use, however, the applicant has indicated in its counterstatement that it does not put the opponent to such proof. That being the case, the opponent is entitled to rely on each of its earlier marks for each of the goods and services claimed.

27. 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 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 the respective goods and services

28. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated, at paragraph 23 of its judgment:

“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”.

29. The relevant factors identified by Jacob J. 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 and services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

30. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. stated that:

"... 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."

31. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. 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."

32. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

33. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

34. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

35. In its notice of opposition, the opponent claimed that each of the goods and services it relies upon are identical or similar to the goods and services for which registration is sought by the applicant but gave no further information to explain its position. Given the breadth of the goods and services relied on, the registrar sent a letter to the opponent prior to the hearing seeking confirmation of whether it intended to continue to rely on each of its goods and services and, if so, to provide submissions as to why, specifically, it considered them to be identical or similar. The opponent responded to that letter commenting that the applicant’s counterstatement made no challenge to the alleged identity/similarity. Whilst it maintained its original claim, it also provided submissions on the similarity of a more limited range of goods and services.

36. At the hearing, Mr Bartlett continued to assert that the fact that in its counterstatement the applicant had failed to challenge the opponent’s claim meant that it should be taken to have agreed with it and I should proceed on the basis that each of the respective goods and services were at least similar. For his part, Mr Harris referred me to comments made in *Club Europe* [2000] RPC 329 and *Harlequin Shellac* BL O/500/14 regarding the content of pleadings and the effect of challenges made in evidence and submissions.

37. Whilst I accept that the counterstatement did not contain a specific denial of the opponent’s original claim, neither did it specifically accept it. The applicant was, in fact, silent as to its position. Whilst that is regrettable, as is the fact that the registrar did not seek to clarify matters on receipt of either the notice of opposition or the counterstatement, in my view, it is abundantly clear from the evidence and submissions filed that the parties are not in agreement regarding the similarity or otherwise of the respective goods and services. Furthermore, the original claim made by the opponent is clearly unsustainable. As I pointed out at the hearing, I cannot see any meaningful way in which, for example, the opponent’s *fire-extinguishing apparatus*, as originally relied upon, would be identical or similar to any of the applicant’s services. Mr Bartlett did not try to persuade me otherwise. I

therefore proceed on the basis of the limited range of goods and services as set out in opponent's response to the registrar's letter. With that in mind, the goods and services to be compared are as follows:

Opponent's goods and services	Applicant's services
<p>Class 35: Retail services, mail order services and wholesaling services in connection with the provision of the following, perfumery, cosmetics, cleaning products, beauty products, personal care products, products for the care and appearance of the body, hair, skin, nails and teeth (9056681)</p> <p>Retail services; mail order services (5780648)</p>	<p>Class 35: Retail services connected with the sale of hair and beauty products, cosmetics and toiletries</p>
<p>Class 9 software applications (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices; digital recordings; films; sound, audio, visual and audio visual content and recordings; sound, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web; non-printed, electronic, optical and digital publications (9056681)</p> <p>Class 35 Advertising, marketing, promotion, public relations, endorsement and publicity services; business management; business administration; office functions; business introduction services; dissemination of advertising, marketing, promotion, public relations, endorsement and publicity materials; organisation and management of business incentive and loyalty schemes (9056681)</p> <p>retail services, mail order services and wholesaling services in connection with the provision of the following, perfumery, cosmetics, cleaning products, beauty products, personal care products, products for the care and appearance of the body, hair, skin, nails and teeth, healthcare products, general pharmacy products; (9056681)</p>	<p>Class 44: Beauty and hair salons</p>

<p>Provision of information and advice to prospective purchasers of goods and services (9056681)</p> <p>Class 45 Providing information, advice and assistance about fashion (9056681)</p> <p>Class 35: Mail order services; retail services (5780648)</p> <p>Class 44: physical therapy; Medical and healthcare services (5780648)</p> <p>Class 9: electronic and digital publications; (183640)</p> <p>Class 16: Printed matter (magazines, newsletters and books) (183640)</p>	
--	--

38. The applicant's services in class 35 are, on the basis of *Meric*, identical to the opponent's retail services in class 35 as relied on in earlier CTMs 9056681 and 5780648. The applicant conceded this in its skeleton argument.

39. The applicant's services in class 44 are *Beauty and hair salons*. The opponent claims that these are services which are "highly similar to the unrestricted goods and services of the Opponent's registrations".

40. In respect of its *software applications (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices* (CTM 9056681) the opponent claims they are similar on the basis that:

"...many businesses, including the Opponent's business, project their goods and services by the provision of Apps. The said services in the Opponent's registrations are unrestricted. They would include Apps relating to beauty and hair and to services supplied by a beauty and hair salon or a chain of such salons. The uses of such goods are the same, (ie in the provision of beauty and hair salon services), the users are the same, (ie those who visit hair and beauty salons); the trade channels through which they are provided are the same (namely via beauty and hair salons and their corresponding websites, media channels etc); and the said goods are complementary to the said beauty and hair services (ie they are used together in the provision of beauty and hair salon services.) Such goods and services are therefore similar.

41. I have no evidence that "many businesses....project their goods and services by the provision of Apps", however, even if they do, I do not consider this makes a software application similar to the applicant's beauty and hair salons. Such salons provide services for e.g. beautifying, treating or styling various parts of the body or the hair. Software applications may well "project" a business, including salons,

however, that would, at best, make an application a means of advertising and promoting that business. The uses of the respective goods and services are different. Whilst beauty and hair salons are used by the general public who wish to avail themselves of various personal services, software applications will, on the basis of the opponent's submissions, be used by those who wish to promote their businesses (which could be in any number of different fields). The users of the respective goods and services are different. Beauty and hair salons are premises where customers have e.g. facials or have their hair done. Software applications are programs designed to perform a specific function either directly for the end user or for another application by way of an electronic or computerised device. Whilst they may be a vehicle by which the end user can determine how to do something or what product is suitable for a specific need, they do not provide personal services as are available in salons. The nature and purpose of the respective goods and services are different. Beauty and hair salons are available on the High Street whereas software applications are available for download via the Internet. The trade channels of the respective goods and services are different. Whilst I accept that a software application may be a means by which beauty and hair salons, amongst others, may promote their premises and services, I do not consider them to be complementary as, in my view, the average consumer is unlikely to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. These respective goods and services are not similar.

42. For essentially the same reasons, I find that the opponent's *digital recordings; films; sound, audio, visual and audio visual content and recordings; sound, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web; non-printed, electronic, optical and digital publications* (CTM 9056681) and its *electronic and digital publications* in class 9 and *printed matter (magazines, newsletters and books)* in class 16 (CTM 183640) are not similar to the applicant's services. Whilst each may be methods used by beauty and hair salons to promote their businesses, they are not complementary or similar to them even where the subject matters of the goods are beauty and hair related.

43. Insofar as it relies on its *advertising, marketing, promotion, public relations, endorsement and publicity services; business management; business administration; office functions; business introduction services; dissemination of advertising, marketing, promotion; public relations, endorsement and publicity materials; organisation and management of business incentive and loyalty schemes* (CTM 9056681), the opponent submits they are similar to the applicant's beauty and hair salons because:

"The Applicant proposes to operate a franchise scheme for beauty and hair salons. Advertising, marketing and promotion and the provision of business management and administration advice and assistance, are essential to any franchise scheme. The provision of such services relating to a franchised beauty and hair salon operation are therefore key elements in the operation of franchised beauty and hair salon outlets. The uses of such services are the same, (ie in the provision of franchised beauty and hair salon services), the consumers are the same, (ie those who visit hair and beauty salons); the trade channels through which they are provided are the same (namely via

beauty and hair salons and their corresponding websites, media channels etc) and the said services are complementary to the said beauty and hair services (ie they are used together in the provision of beauty and hair salon services.)

44. Whether or not the applicant is intending to operate a franchise scheme the specifications I have to compare are those as applied for by the applicant and those relied on by the opponent. There is no mention of any such scheme in the applicant's specification. The opponent's services are, essentially, used by businesses to promote, manage and/or operate those businesses whereas beauty and hair salons operate, as indicated above, to provide services such as beautifying various parts of the body or styling the hair of members of the general public. The nature and trade channels of these respective services are different and I can see no meaningful way in which they are in competition or are complementary. These respective services are dissimilar.

45. The opponent also claims that its *retail services, mail order services and wholesaling services in connection with the provision of the following, perfumery, cosmetics, cleaning products, beauty products, personal care products, products for the care and appearance of the body, hair, skin, nails and teeth, healthcare products, general pharmacy products* (CTM 9056681) and *Mail order services; retail services* (CTM 5780648) are similar to the applicant's beauty and hair salons. It submits:

"It is well known that beauty and hair salons retail the third party products that are used in the provision of the services in question. That the Applicant does so is plain from what is [sic] says in its own evidence. The Opponent's services would include the retailing of such goods from beauty and hair salons. Such retailing services are therefore intimately connected with the provision of beauty and hair salons. The services have the same function (ie the provision of beauty and hair care); they have the same users (ie those who visit beauty and hair salons); they would be offered from the same outlets (ie beauty and hair salons); the services are in competition (ie a retailer of beauty and hair care products will be in competition with beauty and hair care salon) and the services are complementary."

46. The opponent's submissions refer to the evidence filed on behalf of the applicant where Mr Goldring states:

"The Applicants retail stores offer for sale a wide range of over 4,500 products relating to hair, skin and beauty and their stores include full service salons, so that through their stores, they offer a full service one-stop beauty shop".

47. Whilst this may be the applicant's method of trading in Canada, there is no evidence that it has traded in the UK or that this is a standard method of trading within the UK. In any event, I repeat that I have to consider the specification of services as registered and for which registration is applied and on a notional basis as it applies to the UK.

48. For its part, the applicant submits:

"The basic nature of [the applicant's beauty and hair salon] services, with which they are primarily associated in the minds of the average consumer is

the provision of a service by trained personnel, administered to the person of the customer – for example a haircut or a beauty treatment. Giving the specification its ordinary and fair meaning these services are dissimilar to the Opponent’s retail services etc.”

49. At the hearing, Mr Harris altered his position a little, submitting that to the extent that beauty and hair salons do sell products for personal use, this was very much ancillary to those services.

50. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the GC held that a registration for ‘retail services’, which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar. With that in mind, I cannot find the opponent’s *retail services* and *mail order services* (CTM 5780648) to be similar to the applicant’s services. In respect of those retail, mail order and wholesaling services registered under CTM 9056681, the goods the subject of those services are specified and I go on to consider them further.

51. I have no evidence to show what the position is in the UK. I am aware from my own experience, however, that beauty and hair salons commonly offer for sale a range of e.g. beauty and hair care products for the client for use either at the salon or to be taken away and used at home at a later point (albeit generally a small range in terms of the number of manufacturers if not types of product). To that extent they provide a retail service. I do not consider the applicant’s services to be similar to the opponent’s *wholesaling services* (CTM 9056681) as the purpose, users and trade channels differ, however, in respect of the opponent’s specific retail and mail order services, there is a degree of overlap in terms of their uses, users and distribution channels. When considered as a whole, I find there is a low degree of similarity between the applicant’s beauty and hair salons and the opponent’s retail and mail order services (CTM 9056681). For the same reasons, I find there is a low degree of similarity between the applicant’s services and the opponent’s *provision of information and advice to prospective purchasers of goods and services* (CTM 9056681) as this is part and parcel of a retail service and providing information and advice about beauty and hair care products suitable for the particular individual will be part of the service provided by the salon. I have no evidence or personal experience to assist me but to the extent that there is any similarity between the applicant’s services and the opponent’s *providing information, advice and assistance about fashion* (CTM 9056681) and *fashion* being a term which can include personal appearance such as hair styles, I consider this will also be of, at best, a low degree.

52. That leaves the opponent’s *Physical therapy; medical and healthcare services* (CTM 5780648). The opponent’s claims are directed only to the applicant’s *beauty salons*. It submits:

“Medical and healthcare services includes cosmetic medical and healthcare services provided from for instance spas and other health and beauty salons. Such services are for the enhancement of beauty. That they involve medical procedures and treatments does not exclude them from the services supplied by a beauty salon. The function of cosmetic medical and healthcare services

is therefore the same as beauty salon services and the users of such services are the same. The services are supplied through the same trade channels and are in direct competition. Similar considerations apply to “physical therapy” which would include such services for the enhancement of beauty.”

53. At the hearing, Mr Bartlett expanded upon this and submitted that the opponent’s medical and healthcare services would include those of a cosmetic nature whilst its physical therapy services would include massages. He submitted that these were highly similar to services provided at beauty salons which would include e.g. massage treatments and injected wrinkle treatments.

54. Mr Harris submitted that the respective services were not similar, not least because medical services are subject to specific legislation limiting by whom and how such services can be provided.

55. Again, I have no evidence to assist me but, from my own experience, I am aware that certain procedures, described as “treatments” and which will include e.g. facials, body wraps or electrical stimulation, may be provided at beauty salons and may be promoted on the basis that they are intended e.g. to provide “lift” to the skin by reducing fluid retention or boosting the circulation or simply to relax (part of) the body and improve the person’s general wellbeing. Given the degree of overlap in terms of the nature, purpose, end user and distribution channels between the opponent’s *physical therapy* and the applicant’s beauty salons, I find there is a reasonable degree of similarity between them. Whilst I am also aware that some beauty salons promote their treatments on the basis that they have quasi-medical benefits (e.g. as ‘non-surgical facelifts’ or on the basis that they are ‘anti-ageing’), I do not consider the average consumer will regard them as a medical or healthcare service and I find these are dissimilar services. Even if I am wrong in this, the degree of similarity will put the opponent in no stronger position.

The average consumer and the nature of the purchasing process

56. 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*.

57. 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.”

58. Each of the services I have found to have at least some degree of similarity is such as will be bought by the general public. The visual aspects of the purchase are likely to be of greater importance given that they are all services that will be offered from shops on the high street and additionally, in the case of those services in class 35, online. I do not discount the fact that aural factors may also come into play given that some services may be purchased after oral recommendations from others. Beauty and hair salon services are widely available and, whilst they may not be an everyday purchase, they are likely to be bought with varying degrees of regularity. In my experience the costs of the services are likely to range from around twenty or thirty pounds for e.g. a basic manicure or ladies' hair cut and blow dry to several hundreds of pounds or more for a complete course of body or facial treatments. The level of attention given to the purchase may also vary to some extent depending on how extensive and intimate are the services which are being bought but all are likely to involve at least a reasonable degree of care given they relate to the appearance or the body. For the same reasons, the opponent's physical therapy services will also be bought with a reasonable degree of care. Retail services and the provision of information and advice are widely available services used regularly and will be purchased with a reasonable degree of care.

Comparison of the respective marks

59. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

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

61. The opponent relies on three earlier marks. As each is the same, I intend to refer to them in the singular. For ease of reference, the marks to be compared are:

Opponent's mark	Applicant's mark
GLAMOUR	GLAMOUR SECRETS

62. The opponent's mark consists of the single word GLAMOUR presented in plain block capitals. As no part of it is emphasised or highlighted in any way, the distinctiveness of the mark rests in its whole.

63. The word GLAMOUR is the first of the two words making up the applicant's mark, the second word being SECRETS. Both words are presented in plain block capitals and they are of equal length. Given that each mark consists of or begins with the word GLAMOUR, there is a reasonable degree of both visual and aural similarity between them.

64. In respect of the conceptual consideration Mr Harris submits:

"...the differences are extremely pronounced. In the Application, the word GLAMOUR is combined with the word SECRETS. In this formulation, SECRETS is the subject noun. The word GLAMOUR is used adjectively to describe the nature of the "secrets" concerned. The words GLAMOUR SECRETS therefore "hang together" to create a new, unitary phrase in which the ordinary emphasis is placed on the word SECRETS as a noun and subject, notwithstanding that GLAMOUR is the first element in the Application. Overall, the marks are conceptually dissimilar or are similar to only a low degree."

65. At the hearing, Mr Bartlett disagreed and submitted:

"...although the Applicant argues that conceptually GLAMOUR SECRETS is very different to GLAMOUR, its premise for this is that the word GLAMOUR...somehow functions as an adjective. That is just not true. It is not functioning as an adjective, it is a noun. The adjectival form of GLAMOUR is glamorous. It is not that the word GLAMOUR conditions the word SECRETS, it is completely the other way around. The Applicant's position is that the mark gives the suggestion that this is secrets about glamour but, even on that analysis, GLAMOUR would remain the subject matter of the mark. It is not as if its emphasis is then shifted and then is placed on the word SECRETS. Even on the Applicant's analysis, the word GLAMOUR remains the subject matter of the mark and it is the SECRETS element which conditions the word GLAMOUR rather than the reverse, which is what the Applicant would have us think. Therefore, even if the Applicant were correct the emphasis would remain on the word GLAMOUR. However, in our submission this is not, in any event, the correct way of reading the mark. The more likely reading, in our submission, is that the mark says this is secrets from an entity or a brand called Glamour, this is Glamour's secrets. That is the message which is, in our submission, the more likely one to be given by the mark... What we say is this, that the message given by the mark is GLAMOUR and SECRETS from an entity or a brand called GLAMOUR, a sub-brand of GLAMOUR or something that is being produced by GLAMOUR".

66. The average consumer is not going to spend time considering whether words within a mark are adjectives or nouns (assuming that the average consumer even knows the difference); instead he will simply look at the mark as a whole. In my view, the average consumer will not consider the mark GLAMOUR SECRETS to mean secrets from a company called Glamour (as Mr Bartlett indicates, this would mean the mark being seen as "Glamour's secrets" which I do not consider will be the case). Rather than being seen as a sub-brand of GLAMOUR, I consider the mark will be seen as two words that hang together to refer to the provision of services for the

enhancement of beauty and of a nature not known to the wider general public. Given the opponent's mark will also bring to mind beauty or attractiveness, there is a degree of conceptual similarity between the respective marks, albeit a low one.

Distinctiveness of the earlier mark

67. 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).”

68. Mr Harris submitted that the word GLAMOUR is a “weak, descriptive/non-distinctive element” for goods and services relating to beauty. Mr Bartlett disagreed. He submitted that the word GLAMOUR is “absolutely not coterminous or synonymous with the word beauty” and went on to submit “A glamorous man or woman is not necessarily beautiful. A beautiful man or woman is not necessarily glamorous”. The word GLAMOUR is, he submitted “by its very nature extremely nebulous. It is vague, it is intangible, it is almost impossible to pin down. By its nature therefore...it is apt to function distinctively and it does so.”

69. GLAMOUR is defined as follows:

Collins English Dictionary: “fascinating or voluptuous beauty, often dependent on artifice”

Oxford English Dictionary: “Beauty or charm that is sexually attractive”

70. Whilst I accept that glamour is a subjective concept, it is clear that it is closely associated with or suggestive of (i.e. synonymous with) beauty (an equally subjective concept). The word GLAMOUR is an ordinary, well-known word in the English language which readily conveys the idea of beauty and attractiveness in terms of personal appearance. Given that the opponent confirms the magazine they produce

contains features on this subject, I consider the mark falls into a category with the very lowest level of inherent distinctiveness in relation to such goods.

71. The opponent has filed evidence to show the use made of its earlier mark. At the hearing, Mr Harris commented on the figures provided by Ms Raynor in her witness statement. He stated that given the number of magazines said to be sold each month (which the evidence showed had had a cover price of £2 for a significant period of time), the “annual net sales revenue” figures provided did not appear to be correct. As a consequence, he submitted, doubt should be cast on all of the figures provided by her.

72. No explanation has been given to clarify what “annual net sales revenue” means, (it could, for example, relate to more than sales of the magazine itself). Whilst the figures are not plainly incredible, I cannot be sure what would be included within them. That said, I do not consider the lack of clarity matters in the circumstances of this case. This is because, as Mr Harris acknowledged, the applicant has not sought to challenge the opponent’s evidence in this regard, either when it was filed or through cross examination of the witness (see *Extreme*) but also because the applicant has accepted that the opponent has established a reputation in the word GLAMOUR for magazines. In answer to my question, Mr Harris further conceded that the magazine focuses on beauty. I shall return to this later in this decision.

73. In relation to the opponent’s other goods and services, there is no evidence of any use having been made of the mark and thus I have only its inherent distinctiveness to consider. In its skeleton arguments the applicant submits:

“The Opponent’s evidence and the specifications of those Earlier Marks make it clear this mark was chosen because the Opponent’s interest is directly and literally concerned with “glamour”, a dictionary term meaning charm, attraction, beauty. It is in common English use as an everyday adjective or laudatory term almost certainly known to all of the relevant public, especially in relation to matters of fashion and beauty...

The paucity of distinctive character is emphasised by the comments of the 1st Board of Appeal in case R0399/2008-1. It is surprising the Earlier Marks were accepted for registration at all.

Notwithstanding the merest scintilla of inherent distinctive character must be presumed from the fact of registration (per C-196/11P, *F1-Live*), no more than is justified by the nature of the mark need be imparted and the penumbra of protection should be confined most closely. It is manifestly clear that for matters related to glamour, fashion and beauty GLAMOUR is a mark which, in registered form, can only have the benefit of the barest possible penumbra of protection, if is not to impact unfairly on the rights of all traders to use and register that term adjectively in other marks.”

74. The Board of Appeal case referred to noted that the word GLAMOUR “may have a laudatory meaning in several Member states.” As an addition to its own skeleton argument, Mr Bartlett advised that the decision referred to by Mr Harris had been superseded by a further decision (R0204/2012-2) in which it was stated that the

earlier decision referred to was regarded as irrelevant to the case then under consideration. None of this assists here. This latter decision was one involving a different mark and I have to consider the distinctive character of the mark before me in relation to the average consumer in the UK. Having done so, and taking into account the *F1-Live* decision referred to above, I consider that for goods and services which have beauty as their subject matter or focus, the mark GLAMOUR is one with the very lowest level of inherent distinctive character.

Likelihood of confusion

75. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact 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.

76. Earlier in this decision I found:

- The applicant's retail services in class 35 are identical to the opponent's retail services in the same class (CTMs 9056681 and 5780648). They are services which will be bought by members of the general public who will take a reasonable degree of care over the purchase, that purchase being predominantly visual;
- The applicant's services in class 44 are similar to a low degree to the opponent's retail services and provision of information and advice to prospective purchasers of goods and services in class 35 (CTM 9056681). They are also at best of low similarity to the opponent's services of providing information and advice about fashion (CTM 9056681). All are services which will be bought by members of the general public who will take a reasonable degree of care over the purchase with that purchase being predominantly visual;
- The applicant's beauty salon services in class 44 are similar to a reasonable degree to the opponent's physical therapy services in class 44 (CTM 5780648). Whilst I have found the opponent's *medical and healthcare* services to be dissimilar to the applicant's beauty salon services, I acknowledged that if I am wrong in this, any similarity will be at no more than a reasonable level. The average consumer for the opponent's services will be a member of the general public who will take a reasonable degree of care over the purchase. The purchase will be predominantly visual though aural considerations may also come into play;

- The remaining goods and services relied on by the opponent are not similar to the services of the applicant;
- The respective marks have a reasonable degree of visual and aural similarity and a low degree of conceptual similarity;
- It is accepted that the opponent has a reputation in the mark GLAMOUR in relation to magazines which have beauty as a focus, goods which I have found not to be similar to the services of the applicant;
- In relation to the services I have found to be similar/identical, the earlier mark has the very lowest level of distinctive character which has not been shown to have been enhanced through use.

77. As set out above, I have found that in respect of some of the goods and services relied on by the opponent, they are not similar to the applicant's services. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

78. That being the case, the opposition must fail in respect of the goods and services of the opponent which I have found to be not similar.

79. In determining the likelihood of confusion where I have found there to be at least some similarity of services, I also take into account the findings in *Bimbo SA v OHIM*, Case T-569/10, where the GC held:

"96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60)."

80. In *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), Arnold J. stated that:

"47. In my view the principle which I have attempted to articulate in [45] above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to

that significance. Thus in *Bulova Accutron* the earlier trade mark was ACCURIST and the composite sign was BULOVA ACCUTRON. Stamp J. held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.

48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion.”

81. In *Annco, Inc. V OHIM*, Case T-385/09, the GC considered an appeal against OHIM’s decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the ‘ann taylor’ element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the ‘loft’ element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public’s level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue.”

82. I was also referred to the decision of Arnold J in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Dolce Co Invest Inc* CH/2014/0462 and the *Common Communication on the Common Practice of Relative Ground of Refusal-Likelihood of Confusion (Impact of Non-distinctive/weak Components)* issued by the European Trade Mark and Design Network on 2 October 2014 as part of the Convergence Programme between the Trade Mark Offices of the European Union. As was commented on in this former decision, the *Common Communication* needs to be treated “with a degree of caution as [it...] has no legal force at all.”

83. As set out above, I found that the two words making up the applicant's mark hang together with the word GLAMOUR not being an independent or a distinctive element in relation to the relevant services.

84. My findings above are supportive of the opponent on some issues, the applicant on others whilst others are neutral. Taking all matters into account as I am required to do, I do not consider that there is a likelihood of confusion even where identical services are involved.

The objection under section 5(3)

85. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

86. The opponent relies on the three earlier trade marks set out above. All are for the word GLAMOUR and again, I will consider them as one mark taking into account the goods and services for which reputation is claimed. These are:

Electronic publications, advertising and promotion, retailing, providing information, advice and assistance about fashion (CTM 9056681), retailing (CTM 5780648) and electronic and digital publications, magazines and printed matter, electronic information and entertainment services accessible via global computer networks and via non global computer networks (CTM 183640).

87. In determining an objection under this section, I take into account the following case law:

General Motors Corp v Yplon SA [2000] RPC 572 (CJEU), *C.A. Sheimer (M) Sdn Bhd's TM Application* [2000] RPC 484 (AP), *Premier Brands UK Limited v Typhoon Europe Limited* [2000] FSR 767 (HC), *Valucci Designs Ltd v IPC Magazines BL O/455/00* (AP), *Daimler Chrysler v Alavi* [2001] RPC 42 (HC), *Davidoff & Cie SA v Gofkid Ltd* [2003] ETMR 42 (CJEU), *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10 (CJEU), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7 (HC), *Mastercard International Inc and Hitachi Credit (UK) Plc* [2005] RPC 21 (HC), *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU), *L'Oreal SA and others v Bellure NV and others* - C-487/07 (CJEU) and the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or

similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

88. I set out, earlier in this decision, a summary of the evidence filed on behalf of the opponent. I do not intend to repeat that analysis here but whilst I found that it does not show the opponent to have a reputation in anything other than its magazine, I intend to set out my findings in more detail in respect of the reputation claimed under this ground.

89. As Ms Raynor states in her witness statement, the opponent "is one of the world's largest and best known publishing businesses". It is said to publish a number of famous titles and licenses Conde Nast to publish GLAMOUR in the UK. It is clear from this that the opponent's primary area of interest is as a publisher. I accept, as does the applicant, that the magazine promotes various products and services whether through articles in the magazine or the distribution of free samples or "gifts". Whilst this advertises the products of third parties and the evidence suggests the magazine accrues significant income for the publisher from the advertising appearing in it, there is no evidence the opponent (or its licensee) offers any advertising or promotion services under the mark GLAMOUR. I do not consider the evidence is sufficient to show the opponent has a reputation for advertising and promotional services under the mark.

90. I also accept there is evidence that GLAMOUR magazine "usually carries inside its pages samples/small free gifts of beauty related products", that it regularly attaches such "free gifts" to the cover, runs a "giveaway special" each May and gives away free beauty gifts to those readers taking out a subscription but in each case, what is given away are the products of third parties and are intended, as Ms Raynor states, to "encourage sales of [the] magazine". As the CJEU stated in *Silberquelle GmbH v Maselli-Strickmode GmbH*, Case C-495/07:

"21. In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings."

91. In my view, the fact that goods are given away is not evidence that the opponent provides any retail services or has any reputation in respect of them. There is no evidence any of the items given away bore the mark GLAMOUR, and certainly, there is no evidence of any turnover, extent of trade or advertising of any such services under the mark.

92. As regards its claimed reputation in respect of *providing information, advice and assistance about fashion* (CTM 9056681), again there is no specific evidence though Ms Raynor does refer to the provision of beauty and hair advice which, she says, is "a key area both in our print magazine and online". Whilst the magazine is shown to contain articles about beauty and hair, that does not, in my view, mean the opponent offers an information and advice service per se. Similarly, whilst Ms Raynor exhibits screenprints taken from YouTube showing two videos entitled "A Flirty Makeup Look

to Refresh Your Style-Glamour's Bad Hair Day Bonus" (2554 views) and "How Side Swept Bangs and Light Layers Can Reinvent Your Look-Glamour's Bad Hair Day" (4512 views) these do not show it has the reputation claimed. These later videos might possibly be said to be evidence of the opponent providing *electronic information and entertainment services accessible via global computer networks and via non global computer networks* (CTM 183640), however, such small numbers of views would not support it having a reputation in these services. In addition, I note that the screenprints date from September and October 2014 both of which are well after the relevant date so do not assist it in establishing the position at that relevant date in any event.

93. In light of the foregoing, the opposition under this ground falls at the first hurdle insofar as the opponent relies on the following claimed services: advertising and promotion, retailing (CTM 9056681), retailing (CTM 5780648), providing information advice and assistance about fashion (CTM 9056681) and electronic information and entertainment services accessible via global computer networks and via non global computer networks (CTM 183640).

94. The opponent also relies on a claimed reputation in respect of electronic publications (CTM 9056681) and electronic and digital publications, magazines and printed matter (CTM 183640). There is no evidence that the opponent has supplied any printed matter other than magazines. The applicant accepts the opponent has a reputation for magazines and I am prepared to accept that the reputation extends to both print and electronic versions.

95. The opponent's goods are publications. This is an area of trade self-evidently different to the services applied for. It is well established that it is not necessary for the respective goods and services to be similar in order to establish confusion between the respective marks and succeed under this ground (see *Typhoon* at page 1094 et seq). If the similarities between the marks are such as to lead to an association being made between them, which in turn lead to one of the adverse consequences envisaged by the section, then the opponent may succeed.

96. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

"The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited)."

97. In my view, the point of similarity between the marks relied on by the opponent and the mark applied for is not extensive, rests in a word which is non-distinctive for beauty products and services and is far outweighed by their differences having regard to the distinctive character of the respective marks. Whilst there does not have to be similarity of goods and services, in this case they are so distant that, coupled with the distance in the marks, no link would be made. Even if I am wrong and the opponent's customers, when exposed to the applicant's mark, would bring the opponent's mark to mind, the nature of the link is such that it would not result in any unfair advantage or detriment to the opponent. Any notion of a commercial link between the two marks would be quickly dismissed. The opposition under section 5(3) fails.

The objection under section 5(4)(a) of the Act

98. At the hearing, Mr Bartlett indicated that his primary case rested on the objection under s5(2) of the Act, supplemented by the objection under s5(3). Whilst he did not withdraw the objection under s5(4), it was accepted that the opponent's case under this ground would be no stronger than that under s5(2). That being the case, I decline to deal with the objection under this ground.

Summary

99. The opposition fails in its entirety.

Costs

100. The applicant having succeeded, it is entitled to an award of costs in its favour according to the published scale set out in Tribunal Practice Notice 4/2007. I take account that both sides filed evidence and that a hearing has taken place. I award costs as follows:

Considering the statement of case and preparing counterstatement:	£300
Evidence:	£900
Preparing for and attending hearing:	£800
Total:	£2000

101. I order Advance Magazine Publishers Inc to pay Glamour Secrets Licensing Corporation the sum of £2000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of June 2015

**Ann Corbett
For the Registrar
The Comptroller-General**