TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2334368
BY THE CONDE NAST PUBLICATIONS LIMITED
TO REGISTER THE TRADE MARK
VOGUE
IN CLASS 3
AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 92259
BY UNITED TOILETRIES & COSMETICS LIMITED

BACKGROUND

1) On 28 October 1996, Conde Nast Verlag Gmbh of Ainmillerstrasse, 8 Munchen 80801, Germany, applied under the Trade Marks Act 1994 for registration of the trade mark VOGUE, in respect of the following goods:

> In Class 3: "Bleaching preparations, detergents, cleaning preparations, degreasing agents, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices; but not including polishes for floor, furniture and shoes and leather dressings."

2) On 27 April 2004 the mark was assigned to The Conde Nast Publications Limited of Vogue House, Hanover Square, London, W15 1JU.

3) On 23 January 2004 United Toiletries & Cosmetics Ltd of 42/44 Norwood High Street, London, SE27 9NR filed notice of opposition to the application. The ground of opposition is in summary:

> The opponent has used the trade mark VOGUE extensively in the UK since at least 1985 in respect of perfumes and has established a substantial reputation and goodwill. The application offends against section 5(4)(a) of the Trade Marks Act .

4) The applicant subsequently filed a counterstatement denying the opponent's claims, counterclaiming that registered and common law rights in the mark VOGUE belonged to the applicant.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 26 September 2006 when the opponent was represented by Mr Edenborough of counsel instructed by Messrs Venner Shipley LLP. The applicant was represented by Mr Bartlett of Messrs Beck Greener.

OPPONENT'S EVIDENCE

6) The opponent filed thirteen witness statements. The first, dated 31 December 2004, is by Peter Howard James Jackson the Managing Director of Milton-Lloyd Ltd (hereinafter MLL). He states that in 1978 MLL began a relationship with Union Trading Company of Kuwait "to develop and build a perfume business initially in Kuwait, and subsequently throughout the Middle East, Europe and beyond". He states that in 1982, after carrying out a search for conflicting marks by their trade mark agent, the company decided to use the mark VOGUE on perfume. The mark was registered in Algeria, Morocco, Sudan, Bahrain, Jordan, Libya, Iraq, Lebanon, Egypt, Tunisia and UAE. Copies of these registrations are provided at exhibit PHJJ2.

7) Mr Jackson states that in 1982 United Toiletries and Cosmetics Ltd (the opponent) was formed and the trade mark VOGUE is registered in the opponent's name with MLL a de-facto licensee which manufactures and distributes world wide all of the opponent's perfumes and pays a commission to the opponent for all sales including those under VOGUE. MLL has effectively managed and administered the business of the opponent. Mr Jackson states:

> "In 1997, and following the advertisement in the Trade Marks Journal of the proposed UK registration of VOGUE by United Toiletries, Conde Nast Publications Ltd (Conde Nast) commenced an action for passing-off against Milton-Lloyd Holdings Plc, Milton-Lloyd Limited and United Toiletries & Cosmetics Limited under reference CH 1997-C-No 6766. Following correspondence between the lawyers acting on behalf of the parties during which Milton-Lloyd pointed out the length of time for which the Trade Mark VOGUE had been used for perfumes, the action was effectively abandoned by Conde Nast. Conde Nast were thus made aware of the usage of the Trade Mark VOGUE by United Toiletries in 1997 although they did not pursue the passing-off claim. We understand that in the USA Conde Nast have a magazine "ALLURE" and have noted that Chanel perfumes also market a perfume brand internationally by the same name."

8) Mr Jackson states that attempts were made to settle the dispute with Conde Nast but were unsuccessful. He states that the opposition is directed to "Soaps, perfumery, essential oils, cosmetics, hair lotions, dentrifices" and that the opponent's do not object to "bleaching preparation, detergents, cleaning preparations, degreasing agents". He states that the application does not include "polishes for floor, furniture and shoes and leather dressings" and he is advised that this restriction was made to overcome an objection from a third party. Thus, he claims the applicant has accepted the principle of others having the rights to the Trade Mark VOGUE in respect of various products.

9) Mr Jackson states that his company first used the trade mark VOGUE on perfumes in 1982, but it was not a success. A different perfume with a different design, get up and logo but still called VOGUE was launched in 1984. He states that product was and still is marketed as a 50ml spray and a 10ml roll-on. Although sales figures for this period are not available he estimates that for the years 1984 to 1991 an average of 2,000 units per year were sold in the UK with approximately 98,000 sold internationally.

10) He provides the following sales figures for VOGUE 55ml parfum de Toilette sprays sold in the UK:

Year	Units sold in the UK
1992	1,044
1993	2,724
1994	7,622
1995	7,004
1996	12,580
1997	14,004
1998	21,540
1999	27,972
2000	25,392
2001	22,572
2002	29,532
2003	26,784
2004 (to September)	17,136

11) Mr Jackson states that "In volume terms, the sale of between 7,000-8,000 sprays in 1994/5 and 12,500 sprays in 1996 of VOGUE perfume make the brand one of the most substantial selling fragrances in the UK. In addition, during the period 1994 to the present time Milton-Lloyd has sold additional other assorted VOGUE branded 10ml roll-on perfumes, 50ml deodorant roll-ons and 75ml/150ml body sprays". He states that his company sells its perfumes through wholesalers and through independent retailers in the UK. He states that across their brands they sell 750,000 bottles of 50ml glass perfumery annually in the UK and 10 million bottles world wide. This he claims makes them, in volume terms, one of the leading fragrances companies in the UK. He states that his company attends trade fairs worldwide, including The Gift Show in Birmingham in February. At each exhibition he states that they have exhibited VOGUE perfumes.

12) He states that the company policy of using wholesalers and not advertising the products leads to the product being sold at a low price to the consumer which leads to "exceptional consumer loyalty". He states that his company has used catalogues to show the range of products and he provides examples at exhibit PHJJ3. He provides printouts which show a date of 1998 and the VOGUE perfume product; a catalogue range which has a date of 1999 and shows a listing for VOGUE; as well as three colour sheets which show photographs of VOGUE perfumes and are labelled "80's", "90's" and "current" At exhibit PHJJ4 he provides an example of packaging used currently on the VOGUE 55ml perfume. This is identical to the photographs of the product in the 1980s and 1990s. It has a large letter "V" at the start and is slightly stylised. It is easily read and is clearly the word VOGUE.

13) Mr Jackson states that he believes that the trade mark VOGUE is well known in the perfumery field as being associated exclusively with his company and the opponent.

14) Mr Jackson also supplied a supplementary statement, dated 4 March 2005. At exhibit PHJJ1 he states that he provides sales figures for VOGUE 55ml perfume de toilette spray for the UK for the years 2000-2004. However, the single sheet of paper at this exhibit is very badly photocopied and all that can be seen is that in Oct 2004 there is a figure of 300 relating to Vogue body spray 150ml. Underneath there are five figures given for each month of 2004 which relate to "Vogue 55ml pdt (ribbed)". It is not clear what these figures relate to, possibly units sold, or why there are five figures per month.

15) He states that the UK fine fragrance market is currently worth around £350 million with bottled perfume accounting for approximately £175 million of this figure. He states that the average price per bottle is £30 and so the UK market for bottled perfumery equates to between 5-6million units per annum. VOGUE spray perfume has approximately 0.5% of the UK market although this figure does not include other types of perfume such as roll-on perfume and body spray, also sold under the VOGUE mark.

16) The opponent also filed witness statements by the following, which I have briefly summarised:

- Ian Clifford Bartrum, dated 10 January 2005, works for Bespak Europe Ltd who have been providing aerosol valves for glass bottle fragrances to the opponent. He confirms that the opponent has been selling VOGUE perfumes for at least 10-15 years.

- Thomas E Daniel, dated 6 January 2005, worked as a salesman for Milton-Lloyd Limited and sold VOGUE perfume, which was produced by the opponent, in the UK during the period October 1984 – March 1986.

- Charles Dupin Drayson, dated 16 January 2005, worked for Robertet (UK) Ltd from 1971-1985 when he resigned as the Managing Director to join Firmenich UK Ltd for whom he worked until retiring in June 2004. Both the companies he worked for were suppliers of perfume oils and concentrates which he states are "created for and then sold in bulk to perfume brand owners such as YSL, Estee Lauder, Givenchy, United Toiletries and Cosmetics, Milton-Lloyd and most other famous fragrance names". He states that Milton-Lloyd Ltd created the VOGUE perfume on behalf of the opponent in 1982, with Robertet (UK) Ltd supplying the actual product. He states that initially it was not successful, but was re-launched in 1984 and has remained on sale from this date to the present day. He states that he is not aware of anyone else using the mark VOGUE on perfumes.

- Daniel Hasso, dated 2 February 2005, the owner of Union Trading Company in Kuwait. He confirms that the perfume VOGUE produced by Milton-Lloyd Ltd has been sold in Kuwait since 1982 and is still sold there.

- Graham Peter Robinson, dated 10 January 2005, Chief Executive of G.W.B. Products Ltd. He states that between 1992 and 1999 his company acted as a contract manufacturer of roll-on perfume for the opponent. He states that he has no knowledge of the product prior to this date nor does he know about the packaging of the product. He states that in his thirty-one years in the perfume business he has not encountered any use of the mark VOGUE other than by the opponent.

- Roger Slade, dated 17 January 2005, Managing Director of Robertet (UK) Ltd. He states that he has been with his company since 1976 and confirms that in the early 1980's his company began selling a product called VOGUE to Milton-Lloyd Ltd.

- Thomas Stoker, dated 10 January 2005, Managing Director of Glassprint Ltd. He has worked for numerous glass manufacturers before being appointed to his current position. He states that he worked with Milton-Lloyd Ltd for many years supplying printed bottles. Since 1987 he has been supplying glass bottles with VOGUE printed upon them to Milton Lloyd Ltd.

- Stanley Stride, dated 10 January 2005, of Stride Group Plc. He states that he founded his company in 1970, and that his company has worked with all of the major names in the perfumery business. He states that in the early to mid 1980s his company began supplying Milton-Lloyd Ltd with glass perfumery type bottles bearing the name VOGUE. He states that his company has a

wealth of experience of the perfumery market and was estimated that at one time his company supplied 85% of all the glass aerosol bottles that were filled in the UK. He is unaware of anyone other than the opponent using the mark VOGUE on perfumes.

- John Callaghan, dated 1 March 2005, a design consultant for the perfumery industry for approximately 40 years. He states that in 1984 he designed a VOGUE logo for Milton-Lloyd Ltd (MLL) which was then "applied extensively to MLL perfume and the VOGUE brand became known within the commercial perfumery market as belonging exclusively to MLL".

- Raymond John Grundy, dated 28 February 2005, Business development Manager at Boxes (Prestige) Ltd (BPL). He states that BPL and its predecessors in business have since the mid 1980s supplied Milton-Lloyd Ltd with VOGUE packaging.

- Harry Joseph Perris, dated 1 March 2005, owner of Contec Export Ltd which acted mainly in the Middle East as a representative for Constance Carroll Group of companies. He states that "I have personally seen the VOGUE Trade Mark on display on the MLL stand at the Cosmoprof Exhibition in Bologna over many years".

APPLICANT'S EVIDENCE

17) The applicant filed a witness statement, dated 8 November 2005, by Pamela Rose Raynor the Finance Director and Company Secretary of the applicant company. She states that her company is a subsidiary of Advance Magazine Publishers Inc. She states that it was the parent company that was the applicant for the Community Trade Mark (CTM) from which the current application is derived. The CTM was then assigned to Conde Nast Verlag GmbH another wholly owned subsidiary of the American parent and then subsequently assigned to the applicant company. She disputes the claim that the opponent has any goodwill in the mark VOGUE for perfumes. She states that: "Vogue" magazine is widely regarded as the most influential fashion and beauty magazine in the world and has been so regarded for 50 years or more."

18) At exhibit PRR1 she provides a copy of the October 2005 magazine, which is after the relevant date. This does have a large number of advertisements for perfumes and cosmetics, and also it does contain articles and editorial comment on such items.

19) Ms Raynor states that VOGUE "is an aspirational publication which is aimed at the "top end" of the market, and for years has enjoyed an iconic status in the fashion world as the "bible" of fashion, beauty, style and trends." At exhibit PRR2 she provides a print-out of the entry for VOGUE magazine at Wikipedia, the web based free encyclopaedia. This reads: "*Vogue* is a fashion and lifestyle magazine published in several countries under several names. It is widely considered the most influential fashion magazine in the world." Also part of this exhibit is a definition from The New Shorter Oxford English Dictionary which has, at line 29, of the definition of the word "Vogue" "[f. the fashion magazine *Vogue*]". She provides a history of the magazine stating that the UK magazine has been published for almost 90 years. She states that

the monthly circulation of the magazine is "in the region of 150,000 copies. She also claims that other editions from the US, France, Italy, Australia and Japan also have circulations in the UK.

20) Ms Raynor states that features and advertising relating to clothing and beauty form the core content of "Vogue" magazine. She states that this extends to beauty products including perfumes. She states that for many years the magazine has attracted substantial advertising from "makers of beauty products and perfumes including those who wish to enhance sales of their products by association with the image promoted by the magazine. Those perfumes are largely identified by reference to their maker's brand rather than the VOGUE name, but I believe they are and always have been perceived by advertisers as benefiting from association with the VOGUE brand by inclusion in the magazine". She refers to pages 75, 89, 101 116, 128-129, 134, 137, 177 and 196 of exhibit PRR1 which show advertisements for perfumes from respectively, *Vera Wang, Dior, Givenchy, Moschino, Michael Kors, Marc Jacobs, Issey Miyake, Dolce & Gabbana* and *Ghost*. She also refers to pages 224 and 373-374 of the same exhibit which have editorial comment and articles on scents and perfumes. Ms Raynor also comments that the magazine contains other advertisements and editorial comment on other beauty products. She states that as a result the magazine's readership is accustomed to seeing items such as perfumes forming a significant part of the magazines content and in her view would perceive a strong association between the VOGUE brand and such products.

21) At exhibit PRR3 she provides a copy of the magazine from September 1980 and points out that it too has numerous advertisements for perfumes as well as editorial comment on the same. In addition it also has advertisements and editorial references to cosmetics and skin care products. She states her view that "the strong presence of the VOGUE brand in relation to fashion and beauty has created a climate in which, if the VOGUE brand had been used for perfumes, members of the public would have assumed such products were connected with Conde Nast's VOGUE magazine and brand. I think this situation would have existed in October 1996 and at the time when as I understand it, United Toiletries say they first marketed such products, namely in the mid-1980's.

OPPONENT'S EVIDENCE IN REPLY

22) The opponent filed a witness statement, dated 5 May 2006, by Alan John Venner, the opponent's Trade Mark Attorney. He points out that the Wikipaedia site referred to by the applicant is not an authoritative site as it allows anyone to edit its content, which makes the content unreliable. He also points out that in the exhibits provided by the applicant every advertisement for perfume is clearly identified by the makers' brand, in contrast to the statement by Ms Raynor where she implied that some were identified by the Vogu name rather than the makers brand. This, Mr Venner contends, shows that readers of the magazine are instantly aware in each case that the perfume originates from the brand owner and therefore the reputation rests with the brand owner and not the magazine.

23) Mr Venner states that the word VOGUE is used extensively in the fashion and beauty industry. At exhibit AJV1 he provides a list of trading companies using the name Vogue. This however must be regarded as "state of the register evidence".

24) Lastly, Mr Venner states that the word "Vogue" itself is allusive and has a laudatory connotation. He states that the dictionary definition provided by Ms Raynor at exhibit PRR2 defines the word as meaning "prevailing fashion or style at a particular time". He comments that "Since the word lacks inherent distinctiveness for fashion and style and goods related thereto, The Conde Nast Publications Limited is highly unlikely to be able to show that all such usage of the term in relation to such goods would be associated with it".

APPLICANT'S ADDITIONAL EVIDENCE

25) The applicant filed a second witness statement, dated 24 August 2006, by Ms Raynor. She states that in relation to two instances of use of the word Vogue by traders they are in fact under licence from the applicant or associated companies.

26) That concludes my review of the evidence. I now turn to the decision.

DECISION

27) At the hearing a preliminary point was raised regarding the eligibility of the additional evidence filed by the applicant. However, having listened to the arguments put forward against the evidence being accepted into the case I determined that the evidence should be accepted. The basis for my decision was that all of the points for rejecting the evidence related to aspects of the evidence which do not affect my decision.

28) The only ground of opposition is under section 5(4)(a) which reads:

> "5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
>
> (b) ……..
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

29) In deciding whether the mark in question "VOGUE" offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

> "The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purpose of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

> In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:
>
> > (a) the nature and extent of the reputation relied upon;
> >
> > (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
> >
> > (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
> >
> > (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
> >
> > (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.
>
> In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.'"

30) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Ltd* [1981] RPC 429. There is no evidence of the mark in suit being used prior to the date of application. The relevant date is therefore 28 October 1996. This was accepted by both sides at the hearing.

31) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision.

32) The opponent claims to have been using its mark "VOGUE" on perfume since the mid 1980s, with a false start in 1982 and a successful re-launch in 1984. The opponent has supplied sales figures for the UK which whilst relatively modest (averaging approximately 4,600 units per annum for the four years 1992-1995 inclusive) are still substantial enough to provide goodwill. The opponent also sold roll-on perfume, deodorant and body spray under the mark although sales figures are not provided for these items. The opponent has also provided witness statements from suppliers of the bottles and components, packaging, the actual perfume and the roll-on perfume. All state that they supplied goods for a product called VOGUE. The opponent has also provided statements from salespersons involved in selling the product, both in the UK and also world-wide.

33) The applicant contended that the evidence filed was merely assertion of sales in the UK by the opponent and that the sales had not been verified. However, the claims made in the witness statements of Mr Jackson were not contested in the written evidence of the applicant and no request was made to cross examine Mr Jackson. I accept that the evidence is not perfect as statements from retailers would have bolstered the opponent's case. However, the absence of such should not negate the evidence filed. Mr Jackson's witness statements are acceptable as evidence of use.

34) The applicant also questioned whether the comments of trade suppliers should be accepted as they were in a contractual relationship with the opponent and had no knowledge of whether the end product was being sold in the UK and under what mark it was being sold. I accept that the statements by the suppliers do not, by themselves, amount to evidence of sales of the product in the UK. But they do add to the overall story, and can be viewed as evidence that within the Fragrance industry in the UK the opponent had a reputation for perfumes under the VOGUE mark. Even if all of the output were sold overseas, which Mr Jackson states was and is not the case, then the opponent would have a protectable goodwill in the UK. In *MACY'S* Trade Mark [1989] RPC 546 it was held that "(2) the effect of Section 31 is that the marking of goods for export is qualifying use for Section 11 of 1938 Act". I accept that this is an "old Act" case. However, I believe that the underlying principles remain applicable.

35) At the hearing Mr Bartlett drew my attention to the evidence filed by Mr Venner for the opponent. Mr Barlett stated that when Mr Venner searched the name VOGUE in relation to cosmetics there was no listing in a number of trade directories such as, inter alia, *Chemist and Druggist monthly Price List, Chemist and Druggist generics, Cosmetic International Directory & Industry Guide, The Perfume Handbook and Gower Handbook of Cosmetic* and *Personal Care Additives*. Mr Bartlett asked the question "Where is the opponent's mark? If they enjoyed this magnificent goodwill in the UK, which we are told by Jackson in his second statement". Without the full results of the search it is not clear if the term "cosmetics" resulted in identifying manufacturers of perfume. I do not therefore attach much significance to the absence of any mention of the opponent. It is also possible of course that Mr Venner was automatically deducting any mention of the opponent as he was seeking information on use of the term VOGUE by either the applicant or other traders.

36) In order to succeed under this head of opposition, the opponent must show that as at the date of the application, 28 October 1996, it could have prevented use of the applicant's trade mark under the law of passing off. In my opinion the opponent has shown that at the relevant date it enjoyed goodwill and reputation in its mark "VOGUE" in relation to perfumes.

37) The opposition is limited to part of the applicant's specification, specifically "soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices". The opponent does not oppose "Bleaching preparations, detergents, cleaning preparations, degreasing agents,; but not including polishes for floor, furniture and shoes and leather dressings."

38) Clearly, the opponent's reputation is for perfumes which are identical goods to "perfumery" whilst being similar with respect to "essential oils, soaps, cosmetics, hair lotions and dentrifices". Mr Bartlett sought to distinguish between the products,

referring to the fact that perfumes are sometimes held behind the counter in chemists as they are of high value, a point I accept although I have seen cheaper varieties on normal shelves in chemists shops. He also sought to contend that the perfume market is "quite apart" from the colour cosmetics market, the toothpaste market and the hair and body lotion market. Again, I accept that there are differences but overall the goods must be considered similar.

39) The applicant has sought to register the mark VOGUE in a plain font in capital letters. The opponent has shown how it has used the mark, and the use has been consistent. The mark as used by the opponent begins with a large letter "v" and the whole mark is slightly stylised. However, it is unquestionably the word VOGUE and would not be mistaken for anything else. The applicant has not challenged the contention by the opponent that the mark used is the word VOGUE. The two marks are extremely similar, the slight stylisation does not affect the way that the average consumer would view the mark.

40) In my opinion, the similarities between the marks and the goods are such that members of the relevant public would believe that the goods offered by the applicant are goods of the opponent or that the businesses are connected.

41) In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 RPC 429 Goddard L.J. stated:

> "But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man's business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage."

42) Consequently in the instant case if the opponent has established a goodwill and shown deception then damage can be considered as the automatic sequitur and the three elements of the classic trinity of passing-off will have been established. The ground of opposition under 5(4)(a) therefore succeeds.

43) Mr Bartlett sought to rely upon his clients reputation as a lifestyle magazine covering fashion, cosmetics, perfumes etc to stave off the challenge. His main contention seemed to be that the applicant had considerable reputation with regard to its magazine. The magazine reports, as the name implies, on fashion and also lifestyle issues. As part of this there have been articles on perfumes, cosmetics and soaps. He also makes the point that a number of major fragrance manufacturers advertise in the magazine on a regular basis. These are all points I accept, however, I do not accept his

view that "..the Vogue name is inextricably associated with the kind of products which are advertised in the medium of this magazine". From the exhibits provided it is clear that each advertisement, whatever the product, carried the brand name of the product very clearly. This surely is the whole point of advertising. I do not accept that the average reader would associate Channel perfume with Vogue magazine. They might believe that it is the sort of product that would be advertised in the magazine but that would be the limit of any such association. He relied upon the case of Stacey v 2020 Communications Plc [1991] FSR 49 where an interlocutory injunction was refused. To my mind the authority relied upon is not on all fours with the instant case.

COSTS

44) As the opponent is successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £2000. This sum 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 19th day of October 2006

George W Salthouse
For the Registrar,
the Comptroller-General