

O-185-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2518253
BY
THOMAS FILLEAU
TO REGISTER THE TRADE MARK**

The logo consists of the letters 'Vip' in a highly stylized, cursive script. The 'V' is tall and elegant, with a long, sweeping tail that curves over the 'i' and 'p'. The 'i' and 'p' are smaller and more compact, with the 'p' having a distinct loop at the bottom.

VERY IMPORTANT PERFUMES

IN CLASS 3

AND

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 100012
BY
MESYL LIMITED**

**Trade Marks Act 1994
IN THE MATTER OF application 2518253
By Thomas Filleau
To register the trade mark**



VERY IMPORTANT PERFUMES

**In Class 3
AND IN THE MATTER OF opposition thereto
Under no. 100012
By Mesyl Limited**

BACKGROUND

1. On 10 June 2009, Thomas Filleau (hereafter 'Mr Filleau') applied to register the above mark for goods in Class 3 of the Nice Classification System.¹
The goods are as follows:

Soaps; perfumery, essential oils, cosmetics, hair lotions

2. The application was published on 16 October 2009 in the Trade Marks Journal.

3. On 18 January 2010, Mesyl Limited (hereafter 'ML') filed a notice of opposition, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

4. The opposition is directed at all of the goods in Class 3. ML relies on two identical marks and relies on all of the goods in Class 3 of its earlier UK trade mark registration 2456843 and all of the goods in Class 3 of its earlier Community Trade Mark (CTM) 5978192. Both marks were applied for on 29 May 2007 and were registered with identical goods specifications. For the purposes of this decision I will refer to them together as 'the earlier marks', the relevant details of which are:

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

| Mark details | Services relied upon |
|---------------------|---|
| VIP EXPERT BY TERRY | <p>Class 3</p> <p><i>Cosmetics, perfumes, eau de toilette, eau-de-cologne, essential oils, soaps, cleansing milks, deodorants for personal use; creams, gels, milks, lotions, masks, pomades, powders and cosmetic preparations for skin care, cosmetic sunblocks, cosmetic suntan preparations; depilatory products; hair sprays and lotions, shampoos; cosmetic preparations for baths; make-up and make-up removing products; false eyelashes, cosmetic sets.</i></p> |

ML claims that:

“...the marks VIP EXPERT BY TERRY and VIP Very Important Perfumes are similar given the identity between the distinctive and dominant component of the respective marks, namely, VIP.”

5. Mr Filleau subsequently filed a counterstatement on 25 March 2010 denying the grounds of opposition:

“...the Applicant asserts the marks are not similar and therefore there cannot be any likelihood of confusion on the part of the public taking into account the average consumer.”

6. ML’s marks were applied for on 29 May 2007. The UK mark completed its registration procedure on 9 November 2007, while the CTM completed its registration process on 28 April 2008. Mr Filleau’s application was published for opposition purposes on 16 October 2009. Therefore, ML’s marks are earlier marks not subject to proof of use as, at the date of publication of the application, they had not been registered for five years.²

7. Only ML filed evidence;³ neither side requested a hearing and both sides filed written submissions in lieu of a hearing, both being content for a decision to be made from the papers on file.

Evidence

8. ML’s evidence was not filed in the correct format and therefore cannot be considered formal evidence. It also contained numerous submissions and I will bear in mind the content of these, in so far as they are arguments in support, when making this decision. I have chosen not to offer the opponent an opportunity to

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

³ The format in which this evidence was filed will be discussed below.

formalise its evidence as the expense is not warranted. This is due to the fact that the material provided consists of, inter alia, a list of other marks owned by ML in other jurisdictions and a selection of website reviews and interviews, none of which is relevant to my considerations under section 5(2) of the Act.

9. Mr Filleau has not filed evidence but he has made submissions regarding the relevance of the material provided by ML under the banner of opponent's evidence and I have borne these in mind.

10. ML's evidence in reply has also not been filed in the correct format and once again I have opted not to offer an opportunity to formalise it. However, I will briefly note some of the factual information recorded in these submissions.

Turnover figures for products sold under the mark 'VIP EXPERT BY TERRY' have been provided as follows:

| | |
|------|-------------|
| 2008 | £333,538.14 |
| 2009 | £142,906.52 |
| 2010 | £241,527.08 |

In addition, ML has provided a list of 61 stores, operating under the name SPACE NK, through which its products are sold and has provided two photographs of trade stands, branded with 'VIP EXPERT BY TERRY'.

DECISION

11. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994, which states:

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

....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12. The leading authorities pertinent to this ground are from the Court of Justice of the European Union (CJEU), namely: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)* C-334/05 P (*LIMONCELLO*).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*;

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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: *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components: *Sabel BV v Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it: *Sabel BV v Puma AG*;

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2): *Sabel BV v Puma AG*;

(i) further, 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: *Marca Mode CV v Adidas AG and Adidas Benelux BV*;

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (hereafter *Canon*);

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in

question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components: *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*;

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element: *LIMONCELLO*

Comparison of goods

13. For ease of reference the goods are as follows:

| ML's goods | Mr Filleau's goods |
|--|---|
| Cosmetics, perfumes, eau de toilette, eau-de-cologne, essential oils, soaps, cleansing milks, deodorants for personal use; creams, gels, milks, lotions, masks, pomades, powders and cosmetic preparations for skin care, cosmetic sunblocks, cosmetic suntan preparations; depilatory products; hair sprays and lotions, shampoos; cosmetic preparations for baths; make-up and make-up removing products; false eyelashes, cosmetic sets | Soaps; perfumery, essential oils, cosmetics, hair lotions |

14. *Soaps, essential oils and hair lotions* are included in both Mr Filleau's application and in the specification of ML's earlier registrations, therefore they are self evidently identical.

15. In *G rard Meric v OHIM*, Case T-133/05, the General Court (GC) held that goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark. *Perfumery* in the application can be considered a wider term which encompasses *perfumes, eaux de toilette, eau-de-cologne* in ML's earlier marks. The same can be said of *cosmetics* in Mr Filleau's specification as it is a wider term which encompasses *creams, gels, milks, lotions, masks, pomades, powders and cosmetic preparations for skin care, cosmetic sunblocks, cosmetic suntan preparations* in ML's registrations. Applying the test laid down by the GC in *Meric*, these can be considered identical goods. I find Mr Filleau's perfumery and cosmetics are identical to goods contained in ML's earlier marks.

The average consumer and nature of purchasing act

16. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process.

ML states:

“Cosmetic goods are not big ticket items like cars or fine watches, they are essentially fast moving consumer items, and therefore, the level of attention paid by consumers when purchasing cosmetic items is average.”


Mr Filleau submits:

“...the average consumer is well-informed as to cosmetic and perfume brands. They are likely to look carefully at differences between marks in order to determine the origin of the goods.”

17. As the respective goods are identical it follows that the average consumer will be the same, namely the cosmetics and perfume buying members of the general public. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase. There is a wide range of goods within the class which includes soap, which may be a fairly frequent, inexpensive purchase but also high end perfume, which will be a less frequent and more expensive one. The level of attention paid by the average consumer during the purchasing act will vary accordingly. The purchasing act is primarily visual as the goods will be selected from shelves, display counters or from a webpage. However, I do not ignore the part that aural considerations may play in relation to these goods, particularly as I am aware that in some cases cosmetics and perfume are displayed behind a counter or in locked cabinets, resulting in the purchasing process including an aural element.

Comparison of marks

18. The marks to be compared are:

| ML’s earlier mark | Mr Filleau’s mark |
|--------------------------|---|
| VIP EXPERT BY TERRY |  VERY IMPORTANT PERFUMES |

19. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant

components,⁴ but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Distinctive and dominant components

20. Mr Filleau's mark features the stylised letters 'VIP' above the words 'VERY IMPORTANT PERFUMES'. The VIP element is considerably larger than the remaining words. ML's mark consists of the words 'VIP EXPERT BY TERRY' with no emphasis added to any part of the mark.

21. In terms of position and size 'VIP' is dominant in Mr Filleau's mark. Owing to its position and size the eye will be directed to the stylised 'VIP' element. The words below are considerably smaller and are noticeably subservient to the 'VIP' element.

22. ML's mark will be read by the average UK consumer from left to right with a natural break between the words 'VIP EXPERT' and the words 'BY TERRY'.

23. Taking these factors into account I find 'VIP' to be the distinctive and dominant element of Mr Filleau's mark while in ML's mark, 'VIP EXPERT' shares at least equal dominance with the word 'TERRY'.

Visual comparison

24. Mr Filleau submits:

"In addition to the VIP elements (which the Applicant does not concede are similar) the Applicant's and Opponent's marks also feature the words VERY IMPORTANT PERFUMES and EXPERT BY TERRY respectively. These components have no similarities at all. The Applicant therefore submits that when appreciated as a whole, visually the marks are not similar."

25. ML submits:

"Both marks comprise the word VIP followed by three other words. It is submitted that the relevant consumer will naturally focus on the dominant VIP element of each mark and apply far less attention to the following three words..."

26. I cannot agree with Mr Filleau that the marks share no visual similarities. As ML submits, the visual similarity between the marks rests in the 'VIP' element. In both cases it is the first part of the mark. In Mr Filleau's mark it is the stylised element which is presented above the words 'VERY IMPORTANT PERFUMES'. The V of 'VIP' extends between the lower part of the letter 'I' and the tittle. However, it can clearly be read as 'VIP'. In ML's mark 'VIP' is the first part of the mark and is followed by the three words 'EXPERT BY TERRY'. Taking these factors into account, I find the marks share a moderate level of visual similarity.

⁴ *Sabel v Puma AG*, para. 23

Aural comparison

27. When considering the aural similarity, Mr Filleau claims that his mark consists of ten syllables while ML's mark is made up of eight. The VIP element makes up three syllables in both marks, with the remainder being different. Therefore, he concludes, the marks are not aurally similar. ML maintain the view that emphasis will be placed at the beginning of the mark, on the 'VIP' element, as people tune into particular parts of a phrase, it concludes that the marks *"must therefore be considered as being phonetically similar"*.

28. Both parties make clear in their submissions that the 'VIP' element in both marks will be pronounced VEE-EYE-PEE and not VIP, I agree that this is the case.

29. It is clear to me that the point of aural similarity between the marks rests in the 'VIP' element, which in both marks will be read first. The remainder of the marks will be pronounced, in Mr Filleau's mark, VE-REE IM-POR-TANT PER-FUMES and in ML's mark, X-PERT BY TE-REE. These are clearly different and share no similarity.

30. Despite these clear differences, the 'VIP' element is present at the beginning of both marks. For these reasons, I conclude there is a moderate degree of aural similarity between the marks.

Conceptual comparison

31. Both marks have the 'VIP' element in common. Mr Filleau states that 'VIP' in the application is *"clearly an acronym for very important perfumes"*, whereas 'VIP' in ML's mark is *"in the absence of any other references ...the well known phrase 'very important person'"* and as a consequence, concludes that there are no conceptual similarities. Conversely, ML states that the marks *"share very similar meanings"*, as the conceptual characteristics of Mr Filleau's mark are almost exclusively resultant from the 'VIP' element and therefore, both marks convey a clear message of exclusivity and 'VIP' status.

32. The Oxford Dictionary definition of 'VIP' is *'very important person'*.⁵ This is an everyday term that is likely to be understood by the vast majority of the UK public.

33. Even though Mr Filleau's mark includes the phrase 'VERY IMPORTANT PERFUMES' underneath the stylised element, the prominence of 'VIP', together with the relatively small size of the additional phrase and the common understanding of the term 'VIP', is likely to result in the consumer attaching the 'very important person' meaning to the 'VIP' element in Mr Filleau's mark. If I am wrong and the average UK consumer perceives Mr Filleau's mark as having the meaning 'VERY IMPORTANT

⁵ *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 16 May 2011
<<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e63424>>

PERFUMES', such a perception will not avoid a finding of the existence of some similarity. This is because the common understanding of 'VIP' as meaning 'very important person' will still be present in the mind of the average UK consumer and may give rise to a dual meaning.

34. The 'VIP' element in Mr Filleau's mark and 'VIP EXPERT' in ML's mark both create an impression of exclusivity of the goods and in this respect result in a further degree of conceptual similarity. The remainder of ML's mark is the two words 'BY TERRY' which conveys an impression of a person called Terry, which could be a first or second name, providing expertise. This serves to enhance the exclusive feel of the mark.

35. Taking all of these factors into account, I find the respective marks have a moderate degree of conceptual similarity.

36. I have found that the marks share a moderate degree of visual, aural and conceptual similarity which results in a moderate degree of similarity overall.

Distinctive character of the earlier mark.

37. I have to consider whether ML's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. In its written submission ML states:

"...it is contended that the Opponent's mark VIP EXPERT BY TERRY enjoys a good deal of inherent distinctiveness and that this distinctiveness is enhanced not only by the longevity of the range of the Opponent's products in the market, but also the widespread sales and distribution of these products throughout the United Kingdom and worldwide under the VIP EXPERT BY TERRY brand."

38. 'VIP', 'EXPERT' and 'BY' all have clear dictionary meanings. 'TERRY' is likely to be considered a given name or surname. In relation to class 3 goods the trade mark is neither descriptive nor allusive of the goods. There is no connection other than perhaps the impression of exclusivity and possibly an element of expertise from a person with the name of Terry. As a consequence the mark enjoys a reasonably high level of inherent distinctive character.

39. I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to

limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in DUONEBS should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in Reed Executive & Ors v Reed Business Information Ltd & Ors, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

40. ML has provided turnover figures which are sufficient to show an established business in the UK and has provided a list of 61 SPACE NK stores through which its products are sold. As I have already discussed at paragraph 7 this material has not been provided in the correct evidential format. However, even if it were, it would fall short of demonstrating an enhanced distinctive character because of the use made of it. No information has been provided in respect of ML’s market share. The size of the cosmetics market in the UK is very substantial and the turnover figures provided are very small in this context. I find the information provided is not sufficient to demonstrate a level of use in the UK that will have the effect of enhancing the inherent distinctive character of ML’s mark.

Likelihood of confusion

41. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has in kept in his mind.⁶ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

42. I have found that the marks share a moderate degree of visual, aural and conceptual similarity, resulting in a moderate level of similarity overall. I have also identified a reasonably high level of distinctive character in ML’s earlier mark. In respect of the goods I have concluded that Mr Filleau’s goods are identical to ML’s goods. I have identified the average consumer, namely the cosmetics and perfume buying members of the general public and have concluded that the purchasing act will, generally, be visual (though aural considerations must also be borne in mind) and will involve a varying degree of care and attention.

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

43. When considering conceptual similarity of the marks, I found that the 'VIP' element would be perceived by the average consumer as meaning 'VERY IMPORTANT PERSONS'. I also noted that if I was wrong and the 'VIP' element of Mr Filleau's mark is perceived as 'VERY IMPORTANT PERFUMES' this is not sufficient to negate any finding of similarity as, in light of the common meaning of 'VIP', this may give rise to the average UK consumer perceiving a dual meaning within the mark.

44. Taking all the above factors into account, and considering the marks as a whole, I conclude that the differences between the marks are not sufficient to outweigh the obvious similarity, namely the VIP element of both marks. Whilst 'VIP' is a well known acronym, it has no meaning in the context of the relevant goods and will therefore be a memorable part of both marks in the mind of the consumer. 'VIP' is the dominant element of Mr Filleau's mark and is at the beginning of ML's mark forming part of the phrase 'VIP EXPERT'. It is clear from decisions such as joined cases T-183/02 and T-184/02⁷ that the first parts of words catch the attention of consumers. Further, as the UK consumer reads from left to right, it can be inferred that this guidance is also relevant where the first part of the mark is the same, rather than the first part of a word. In the context of identical goods I find the average consumer is likely to believe that the goods provided under one mark are provided by the same or a linked undertaking as the goods provided under the other.

45. I find that the opposition succeeds in respect of all the goods opposed and the application is refused in its entirety.

COSTS

45. The opposition having succeeded, Mesyl Limited, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that it filed written submissions in lieu.

Preparing a statement and considering the other side's statement: £500
(including opposition fee)

Written submissions: £500

Total: £1000

46. I order Thomas Filleau to pay Mesyl Limited the sum of £1000. 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 2 day of June 2011

**Ms Al Skilton
For the Registrar,**

⁷ *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81