

**O-029-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3063184  
BY LISA WELDEN**

**TO REGISTER**

**Stylopedia**

**AND**

**The Stylopedia**

**AS A SERIES OF TWO TRADE MARKS**

**IN CLASSES 16, 35 AND 45**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 403312 BY THE NET-A-PORTER GROUP LIMITED**

## BACKGROUND AND PLEADINGS

1. On 7 July 2014, Lisa Welden applied to register, as a series of two, the trade marks **Stylopedia** and **The Stylopedia** for the following goods and services in classes 16, 35 and 45:

Class 16 Books.

Class 35 Advertising services provided via the internet.

Class 45 Consultancy services relating to personal appearance.

The application was published for opposition purposes on 29 August 2014.

2. The application is opposed by The Net-a-Porter Group Limited (“the opponent”). The opposition was originally based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, the opponent filed no evidence and, in accordance with Rule 20(3) of the Trade Marks Rules 2008 (“the Rules”), the opposition under sections 5(3) and 5(4)(a) was deemed withdrawn. The opposition is therefore based upon section 5(2)(b) only and is directed against all of the goods and services in the application. The opponent relies upon all of the goods and services for which its earlier trade marks are registered. The trade marks relied upon are shown below:

Mark details	Relevant dates	Specification relied upon
<b>UK trade mark 2588339</b> <b>STYLEPEDIA</b>	Filing date: 19 July 2011  Date of entry in the Register: 11 November 2011	Goods and services in classes 9, 16, 35 and 41.
<b>Community Trade Mark (“CTM”) number 10545473</b> <b>STYLEPEDIA</b>	Filing date: 6 January 2012  Date of entry in the Register: 21 August 2012  Priority date: 19 July 2011	Goods and services in classes 9, 16, 35 and 41.

3. In its Notice of Opposition, the opponent claims that there is a likelihood of confusion because “[t]he respective marks are similar and cover identical and/or similar goods and services”.

4. Ms Welden filed a counterstatement in which she denies the basis of the opposition.

5. Only Ms Welden filed evidence. Whilst neither party asked to be heard, both parties filed written submissions in lieu of attendance at a hearing. I will bear these submissions in mind and refer to them, as necessary, below.

### **The applicant’s evidence**

6. The evidence consists of the witness statement of Lisa Welden, with five exhibits. Ms Welden states that she is the owner of [www.TheStylopedia.com](http://www.TheStylopedia.com) and exhibits to her witness statement a number of printouts from that website (exhibits LW1 – LW3). At exhibits LW4 and LW5 there are printouts from the opponent’s website. I do not intend to describe the evidence in detail here but will refer to it below as I consider appropriate.

### **Preliminary issues**

7. In her submissions and evidence, Ms Welden argues that the likelihood of confusion will be avoided because the parties’ websites target consumers of different ages and genders. She argues, in her counterstatement, that there is no similarity of content between the parties’ respective websites. Ms Welden is also concerned that the opponent has not provided evidence of use, as she requested in her counterstatement (although the official letter of 9 February 2015 did advise Ms Welden that the proof of use provisions do not apply in this case). Before going further into the merits of this opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

8. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods and services for which it is registered.

9. Neither of the marks relied on by the opponent had been registered for five years at the date on which the application was published. Consequently, the opponent does not need to prove use for any of the goods or services for which its marks are registered. The earlier marks are entitled to protection against a likelihood of confusion with the applicant’s mark based on the ‘notional’ use of the earlier marks for all the goods and services listed in the register. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. ....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 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".

10. So far as Ms Welden's use of the applied for mark is concerned (all of which took place after the application was filed), in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, even though Ms Welden's evidence shows that she has been using the mark as part of an online blog, my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade marks. Any differences between the goods and services provided by the parties, or differences in their trading styles, are irrelevant unless those differences are apparent from the applied-for and registered marks.

## **DECISION**

11. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6. - (1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

13. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 2, which qualify as earlier trade marks under the above provisions. As I explained at paragraph 9, neither trade mark is subject to proof of use, as per section 6A of the Act, and the opponent can, as a consequence, rely upon all of the goods and services it has identified for each mark.

14. In its submissions, the opponent does not differentiate between the two earlier trade marks upon which it relies. The earlier marks themselves are identical. Despite slightly different wording, the specifications are virtually the same. However, as that of CTM 10545473 is marginally wider I will focus on that trade mark: if the opposition fails in relation to the CTM, the opponent has no better a prospect of success with the UK trade mark.

### **Section 5(2)(b) – case law**

15. 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 goods and services**

16. The opponent's earlier right covers a wide range of goods and services. I list below the goods and services which I consider to be closest to the applicant's specification. The full specifications of both earlier marks are included as an Annex to this decision. The competing goods and services are therefore as follows:

Opponent's goods and services (CTM 10545473)	Applicant's goods and services
<p><u>Class 16</u> Books.</p> <p><u>Class 35</u> Retail services relating to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; advertising for others; provision of advice and assistance in the selection of goods.</p>	<p><u>Class 16</u> Books.</p> <p><u>Class 35</u> Advertising services provided via the internet.</p> <p><u>Class 45</u> Consultancy services relating to personal appearance.</p>

17. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“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”.

18. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) 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”.

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating 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”.

22. As for whether the goods and services are complementary, in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the 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”.

23. Regarding complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

24. In its Notice of Opposition, the opponent claimed that the goods and services are identical or similar. Ms Welden did not challenge this statement in her counterstatement but in her written submissions (p.1), she claims that “[t]he Applicant’s goods and services are not identical or similar to those of the Opponent [...]”.

25. “Books” is included in class 16 of both the opponent’s and the applicant’s specifications. It is self-evident that these goods are identical.

26. The opponent’s specification includes, in class 35, “advertising for others”. This encompasses “advertising services provided via the internet”. Applying the principle outlined in *Meric*, the services are identical.

27. The remaining term in the applied for mark is “consultancy services relating to personal appearance” in class 45. The most relevant definition in the Oxford English Dictionary (“OED”) of “appearance” is:

“1. the way that someone or something looks: *she checked her appearance in the mirror.*

■ an impression given by someone or something: *she read it with every appearance of interest*”.<sup>1</sup>

With the above definition in mind, “consultancy services relating to personal appearance” are services provided to an individual offering personalised advice and information on their appearance, namely clothing, jewellery and accessories (e.g. handbags, belts). The term would include services such as personal shopping services

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<sup>1</sup> *Oxford Dictionary of English* (3<sup>rd</sup> ed., OUP 2010)

or the services of a fashion stylist. By virtue of its inclusion in class 45, the services provided are of a personal, not a general, nature, so that the term could accurately be read as “personal consultancy services relating to personal appearance”.

28. The opponent identifies at paragraph 18 of its written submissions a number of services covered by its earlier mark (it does not distinguish between the two marks) which it considers are closest to “consultancy services relating to personal appearance”. It refers in particular to the retail services, provision of films, electronic publications, electronic applications and online publications in the field of fashion covered by the earlier mark. In my view, the opponent’s best case rests in its class 35 services for “retail services relating to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags” and “provision of advice and assistance in the selection of goods”. I am of the view that the opponent would not be in any better a position were I to consider the other services it has identified and will therefore restrict my assessment to the services I have specified.

29. The nature of the above retail services involves the gathering together of goods and offering a variety of services to encourage the consumer to purchase those goods. While a consultancy service relating to appearance may also result in the sale of goods, the purpose of the service is to provide advice regarding the suitability of items of clothing, jewellery or accessories, tailored to the requirements of an individual. The essential nature of the services at issue is, therefore, different. Insofar as the users are concerned, both of the services at issue may equally be provided to individual consumers. Retail services will be provided via retail premises on the high street, amongst others, as well as via the internet. In my experience, services such as personal shoppers (covered by the applicant’s specification in class 45) are available in retail premises, particularly in department stores. I therefore consider the channels of trade to be the same. I do not think that the services are in competition: one would not select the one instead of the other. I am, however, of the view that the services are complementary. I come to this conclusion not only because the services at issue are available in the same place but also because they supplement one another: the consumer can seek the advice of the personal shopper who will provide a range of goods, chosen from among the goods offered by the retailer, according to the needs of the individual consumer. Taking all of the above into account, I consider that “retail services relating to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags” and “consultancy services relating to personal appearance” are similar, albeit to a low degree.

30. As regards the “provision of advice and assistance in the selection of goods”, the nature of the service is providing information to consumers about the goods offered for sale, albeit general rather than personalised advice. I consider that the service will be provided in retail premises on the high street and via the internet and that the service may be provided to individual users. Bearing in mind my comments, above, regarding the applicant’s consultancy services, I am of the view that “provision of advice and

assistance in the selection of goods” and consultancy services relating to personal appearance” are similar to a low degree.

### **The average consumer and the nature of the purchasing act**

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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”.

32. In light of my findings at paragraphs 25, 26, 29 and 30, I will consider the average consumer of the goods and services in the applicant’s mark, along with, in the earlier mark, the identical goods and services and the services I have identified as similar at paragraphs 29 and 30. An assessment of the average consumer of the opponent’s other goods and services would not improve the opponent’s position.

33. The average consumer of books is a member of the general public. In my experience, these goods are commonly displayed on shelves in bricks and mortar retail premises (for example, bookshops and supermarkets) and their online equivalents, where they will be viewed and self-selected by the consumer. This method of selection involves primarily visual considerations, although there may be an aural component, particularly if advice is sought from a salesperson. The goods are not, in general, terribly expensive but the consumer will wish to select a particular title, author or genre. I consider that the average consumer will pay an average degree of attention to the selection of these goods.

34. The average consumer of “advertising services for others” is a member of the general public or a business user. The services are likely to be purchased both through visual inspection of, for example, promotional brochures and websites, and aural means, for example, following word-of-mouth recommendations. In my experience, for a member of the general public, these services are not, in general, terribly expensive, though the consumer will wish to select the most suitable service according to, for example, the target audience. For a business user, the cost of the services will probably be significant and the consumer will be keen to ensure the appropriateness of the service chosen, so that, for example, the consumer’s business is presented in a suitable

way. There may also be additional considerations, such as lengthy contracts. I conclude that the member of the public will pay an average degree of attention in selecting the services, whereas, for the business user, the services are of the kind where a reasonably high degree of attention will be paid in their selection.

35. Given the personal nature of “consulting services relating to personal appearance”, I consider that the average consumer of such services will be a member of the general public. I also think that the services at issue will be selected both visually (such as via the internet) and by aural means (such as oral recommendations). I am of the view that a reasonably high degree of attention will be paid in selecting the services, as the consumer will be anxious to ensure that the consultant is able to offer the desired image.

36. I consider that the average consumer both of the retail services in the earlier right and of “provision of advice and assistance in the selection of goods” is a member of the general public. The retail services are offered in shops on the high street (or the online equivalents). The purchase is predominantly visual, with the consumer selecting the retail service following visual inspection of the shop front or website, though I do not discount an aural component. I also consider that the selection of “provision of advice and assistance in the selection of goods” will be mainly visual, though there may be an aural component, for example through verbal recommendations. Neither service is particularly specialised and, insofar as the retail services are concerned, clothing and accessories are regular consumer purchases. Overall, consumers will pay an average degree of attention when selecting an appropriate retail channel. In the main, I also consider that the average consumer will pay an average degree of attention in selecting the source of advice and assistance about products, though I accept that if the consumer is seeking advice about very expensive or technical goods, a higher degree of attention may be paid.

### **Comparison of trade marks**

37. 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgement 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”.

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 the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

38. The trade marks to be compared are as follows:

<b>Opponent's trade mark</b>	<b>Applicant's trade mark (series of two)</b>
STYLEPEDIA	Stylopedia The Stylopedia

39. The first mark in the applicant's series of two word marks consists of the ten-letter word "Stylopedia". The first letter is capitalised and the remaining letters are in lower case. The second mark consists of the words "The Stylopedia", with the first letter of each word in upper case and the remaining letters in lower case. The overall impression of the first mark in the series is contained in the word itself. The definite article at the start of the applicant's second mark is of little or no distinctive character and the overall impression of the mark is therefore dominated by the word "Stylopedia".

40. The opponent's mark consists of the ten-letter word "STYLEPEDIA", presented in capital letters. There are no other elements to contribute to the overall impression, which is contained in the word itself.

41. Visually, there is a difference between "STYLEPEDIA" and "Stylopedia" in that the fifth letter of the opponent's mark is 'E', while the fifth letter of the applicant's mark is 'o'. The opponent's mark shares with the applicant's mark the first four letters ('STYL'/'Styl') and the final five letters ('PEDIA'/'pedia'). As the concept of fair and notional use would allow either mark to be used in upper or lower case, it matters not that the opponent's mark appears in capitals while the applicant's mark is in title case. I consider there to be a high degree of visual similarity.

42. Aurally, the opponent's mark will be pronounced "STYLE-PEDIA" while the applicant's mark will be pronounced "Sty-lo-pedia". Taking these factors into account, and bearing in mind the position of the different element, I am of the view that there is a high degree of aural similarity.

43. Conceptually, the opponent's mark appears to be an invented word made from the ordinary dictionary word "STYLE" with the suffix "-PEDIA". I do not think that the average consumer would know the derivation of "-pedia". However, I do consider that the average consumer would recognise and understand the meaning of "-pedia" as a collection of knowledge, having encountered it in words such as "encyclopaedia" and, in

recent years, “Wikipedia”. I am therefore of the view that the average consumer would perceive the opponent’s mark as alluding to a collection of information about style. Notwithstanding that the applicant’s mark begins with the letters “Stylo” rather than “Style”, I think that the average consumer would understand “Stylo” as relating to style and view the mark as relating to a compendium of information about style. I find that the marks are conceptually identical.

44. I have carried out my assessment based on the first mark in the applied for series, as this represents the opponent’s best case. For the avoidance of doubt, I consider that the additional word “The” in the second mark of the series is of such low distinctiveness that it would be largely overlooked by the average consumer and that it would have no material effect on my assessment of visual, aural or conceptual similarity.

### **Distinctive character of the earlier trade mark**

45. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. 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-2779, 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)”.

46. I have no submissions from Ms Welden regarding the distinctiveness of the earlier mark. The opponent asserts that its earlier marks are “highly distinctive, fanciful and unusual” (paragraph 17 of its written submissions). It has filed no evidence of use, so I have only the inherent position to consider. Although the word “STYLEPEDIA” is, as far as I am aware, invented, it is devised from two easily recognisable elements. I find that the mark has an average degree of inherent distinctiveness.

### **Likelihood of confusion**

47. 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 necessary for me to bear in mind the distinctive character of the opponent’s 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.

48. Earlier in this decision I found that:

- the marks are visually and aurally similar to a high degree and conceptually identical;
- “books” in class 16 are identical to the same goods in the earlier mark;
- “advertising services provided via the internet” are identical to “advertising for others”;
- “consulting services relating to personal appearance” are similar to a low degree to “retail services relating to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags” and to “provision of advice and assistance in the selection of goods”;
- the average consumer is a member of the public or a business user and the level of attention paid in selecting the goods and services will be average or reasonably high;
- the earlier mark has an average degree of inherent distinctive character.

Bearing all of these factors in mind, and notwithstanding the average to reasonably high degree of attention that will be paid to the selection of the goods and services at issue (thus making the average consumer less prone to the effects of imperfect recollection), I

am satisfied that the degree of similarity I have identified in the marks will still lead to a likelihood of direct confusion between them, i.e. the average consumer will mistake one mark for another. Although I recognise that the applicant's "consulting services relating to personal appearance" are only of low similarity with the opponent's retail services and "provision of advice and assistance in the selection of goods" in class 35, I consider that this is outweighed by the similarity between the marks.

## **Conclusion**

49. The opposition succeeds in full.

## **Costs**

50. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. The opposition was initially based on grounds other than 5(2)(b) and therefore attracted a higher official fee of £200. These grounds were deemed withdrawn as a result of the opponent's failure to file evidence. If the opposition had been brought under section 5(2)(b) only, the official fee would have been only £100. I do not, in those circumstances, think it fair to make Ms Welden pay the full £200. Ms Welden's evidence amounted to only fourteen pages in total, while the written submissions filed by the opponent were not substantial. Using TPN 4/2007 as a guide but bearing in mind my comments, above, I award costs to the opponent on the following basis:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£200
Considering the other side's evidence	£100
Written submissions:	£200
Total:	£600

51. I order Lisa Welden to pay The Net-a-Porter Group Limited the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of January 2016**

**Heather Harrison  
For the Registrar,  
the Comptroller-General**



## **ANNEX**

### **Community Trade Mark number 10545473**

#### **STYLEPEDIA**

##### Class 9

Information in electronic form; electronic downloadable publications in the fields of fashion, news, lifestyle, culture, entertainment, travel, social networking; electronic applications for electronic telecommunications equipment.

##### Class 16

Printed publications; printed matter, namely magazines and publications in relation to fashion and lifestyle; books; address books; pamphlets; manuals; magazines; periodical publications; newspapers; newsletters; decalcomanias; pressure sensitive stickers; photographs; cards; greeting cards; gift tags; calendars; diaries, postcards, posters, stationery; writing or drawing implements; tissues; calendars; office requisites.

##### Class 35

Retail services relating to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; the bringing together for the benefit of others of clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags enabling customers to conveniently view and purchase those goods; the provision of retail services via a mail order catalogue in relation to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; the provision of on-line retail services from an internet website in relation to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; the provision of retail services via a television channel in relation to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; the provision of retail services via a telephone or mobile phone or mobile telecommunications device in relation to clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; the provision of retail services by way of direct marketing in connection with clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; the provision of information and advice in relation to retail services; fashion show services, production of fashion shows provided online from a computer database or the internet or transmitted via wireless communication device or broadcast via network or satellite television, all for promotional purposes; business

management consultancy; provision of advice and assistance in the selection of goods; advertising for others.

#### Class 41

Entertainment and educational services featuring electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and related information via the internet and other communications networks in the field of fashion, general interest, cultural events and entertainment related topics; production of films on videotapes or on all types of audiovisual or sound media in the field of fashion, general interest, cultural events and entertainment related topics; production of television and radio programs; electronic publishing of on-line books, magazines and periodicals in the field of fashion, general interest, cultural events and entertainment related topics; providing on-line electronic publications (not downloadable) in the field of fashion, general interest, cultural events and entertainment related topics; digital video, audio and multimedia entertainment publishing services in the field of fashion, general interest, cultural events and entertainment related topics; online digital publishing services in the field of fashion, general interest, cultural events and entertainment related topics; fashion show services, production of fashion shows provided online from a computer database or the internet or transmitted via wireless communication device or broadcast via network or satellite television, all for entertainment, educational or cultural purposes; news reporting; providing information about entertainment, current events, cultural events and activities; publication of electronic applications for fashion, entertainment; consultancy, information and advisory services relating to the aforesaid; providing electronic library services containing images, pictures, photographs, text and other multimedia content via an online computer network and other electronic communication networks or broadcast via network or satellite television; publishing online journals, namely blogs featuring personal information and opinions; publishing services, namely photo sharing via the internet and wireless communication devices; organising entertainment and cultural events; entertainment in the nature of contests, competitions and games; education, entertainment, sporting and cultural activities.

#### **UK trade mark 2588339**

#### **STYLEPEDIA**

#### Class 9

Information in electronic form; electronic downloadable publications in the fields of fashion, news, lifestyle, culture, entertainment, travel, social networking; electronic applications for electronic telecommunications equipment.

#### Class 16

Printed publications; printed matter, namely magazines and publications in relation to fashion and lifestyle; books; address books; pamphlets; manuals; magazines; periodical publications; newspapers; newsletters; decalcomanias; pressure sensitive stickers; photographs; cards; greeting cards; gift tags; calendars; diaries, postcards, posters, stationery; writing or drawing implements; tissues; calendars; office requisites.

### Class 35

Retail services connected with the sale of clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; the bringing together for the benefit of others of clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags enabling customers to conveniently view and purchase those goods; retail services provided via a mail order catalogue connected with the sale of clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; retail services provided online from an Internet website connected with the sale of clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; retail services provided via a television channel connected with the sale of clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; retail services provided via a telephone or mobile phone or mobile telecommunications device connected with the sale of clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; retail services provided by way of direct marketing connected with the sale of clothing, headgear and footwear, jewellery, watches, fashion accessories, textiles, cosmetics, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags; the provision of information and advice in relation to retail services; business management consultancy; on-line trading services; provision of advice and assistance in the selection of goods; advertising for others.

### Class 41

Entertainment and educational services featuring electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and related information via the Internet and other communications networks in the field of fashion, general interest, cultural events and entertainment related topics; production of films on videotapes or on all types of audiovisual or sound media in the field of fashion, general interest, cultural events and entertainment related topics; production of television and radio programs; electronic publishing of on-line books, magazines and periodicals in the field of fashion, general interest, cultural events and entertainment related topics; providing on-line electronic publications (not downloadable) in the field of fashion, general interest, cultural events and entertainment related topics; digital video, audio and multimedia entertainment publishing services in the field of fashion, general interest, cultural events and entertainment related topics; online digital publishing services in the field of fashion, general interest, cultural events and entertainment related topics; fashion show services, production of fashion shows provided online from a computer database or the Internet or transmitted via wireless communication device

or broadcast via network or satellite television; news reporting: providing information about entertainment, current events, cultural events and activities; publication of electronic applications for fashion, entertainment; consultancy, information and advisory services relating to the aforesaid; providing electronic library services containing images, pictures, photographs, text and other multimedia content via an online computer network and other electronic communication networks or broadcast via network or satellite television; publishing online journals, namely blogs featuring personal information and opinions; publishing services, namely photo sharing via the Internet and wireless communication devices; organising entertainment and cultural events; entertainment in the nature of contests, competitions and games; education, entertainment, sporting and cultural activities.