

O-119-19

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3126748
BY FACE OF EUROPE & THE WORLD LTD
TO REGISTER

FACE OF EUROPE AND THE WORLD

AS A TRADE MARK
IN CLASS 41
AND OPPOSITION THERETO (UNDER NO. 406377)
BY
EARTH GIRLS LTD

Background & Pleadings

1. Face of Europe & The World Ltd ('the applicant') applied for the trade mark **FACE OF EUROPE AND THE WORLD** on 13 September 2015. The mark was accepted and published on 8 January 2016 for the following services in class 41.

41: Organising of beauty pageants; entertainment in the nature of beauty pageants; organisation of competitions; coaching and education services relating to modelling; organisation of charitable events and competitions; provision of non-downloadable electronic information, books and publications; on-line journals, namely, blogs featuring personal and biographical information, photographs and opinions; providing information regarding entertainment and recreational matters and events from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks; online photograph gallery services; information, advice and consultancy in relation to all the aforesaid services.

2. Earth Girls Ltd ('the opponent') opposes the application under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of its EU trade mark set out below.

EU TM No.11330701	Services relied on
<p data-bbox="209 1424 751 1480">Face Of The World</p> <p data-bbox="209 1749 632 1783">Filing date: 8 November 2012</p> <p data-bbox="209 1805 667 1839">Registration date: 8 March 2013</p>	<p data-bbox="810 1312 1385 1619">Class 35: Advertising; Business management; Business administration; Office functions; Organisation of exhibitions for commercial and advertising purposes; Organisation of fashion shows for commercial purposes.</p> <p data-bbox="810 1693 1385 1951">Class 41: Education; Providing of training; Entertainment; Cultural activities; Booking of seats for shows; Film production services; Organisation of competitions; Organisation of beauty</p>

	contests; Production of shows; Photography services
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3. The opponent claims under section 5(2)(b) that the applied for mark is similar to its earlier mark and has similar services to the earlier mark and there exists a likelihood of confusion.

4. The applicant filed a counterstatement in which it denied that the marks were confusingly similar. The applicant conceded that the specific terms *organisation of beauty contests* and *organisation of competitions* in its class 41 'overlapped' with the opponent's services and offered to delete these services.

5. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act, but as it had not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

6. The applicant is represented by Trade Mark Direct and the opponent by Wilson Gunn in these proceedings.

7. No hearing was requested. The applicant filed evidence and both sides filed written submissions in lieu. I make this decision following a consideration of the material before me.

Preliminary issues

8. The applicant raises a number of issues in its written submissions which are appropriate to address before proceeding further in this decision.

9. Firstly the applicant asserts in its written submissions that the opponent has

'failed to demonstrate sufficient evidence of use of the Prior Mark in the UK in the past five years'.

10. I would point out that there is no onus on the opponent to provide any evidence as the earlier mark is not subject to proof of use in these proceedings.

11. Secondly the applicant claims there has been an absence of confusion in the market place as the marks at issue have been 'co-existing for at least 5 years'. This matter was addressed in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

12. With regard to the above, nothing before me in the consideration of this decision has established that there has been opportunity for consumers in the UK market to be exposed to both marks to a sufficient degree to satisfactorily demonstrate an absence of actual confusion.

13. Thirdly and finally the applicant states that it is 'a charity pageant company and has no interest in breaking into the fashion, model or photographic industry'. Even if I accept that it had been proved that the applicant and the opponent currently operate in different markets, this would not in any case be relevant to the issue of confusion which I must decide in these proceedings. It is settled law that in assessing whether there is a likelihood of confusion I must make my comparison on the basis of notional and fair use over the whole range of services covered by the applicant's and (since

the earlier mark is not subject to proof of use under section 6A of the Act) the opponent's respective specifications. It is the *inherent* nature of the services of the specifications which I have to consider. Current use and business strategy are not relevant to this notional comparison. My task, therefore, is to conduct the comparison simply on the basis of the services as they are set out in the respective specifications. The concept of 'notional and fair use' is also outlined in the *Roger Maier* decision, particularly paragraph 78,

"78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."

14. In addition I am also guided in this matter by the comments of Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 particular at paragraph 22,

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market-place but no confusion has been caused, then there cannot exist a likelihood of confusion under Art.9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s.10(2). So, no confusion in the market-place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to

be a finding of infringement. Similarly, even when the proprietor of a registered 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.

Applicant's evidence

15. I have read the applicant's evidence but do not intend to summarise here as I do not consider it to be relevant to the case before me since it concerns issues of ownership, sponsorship, domain names and social media.

Decision

16. Section 5(2)(b) of the Act is 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.

17. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 services

18. The case law relating to the comparison of goods and services is set out below.

In *Canon*, the CJEU stated at paragraph 23 of its judgment that:

“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”.

19. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Merici’*), the General Court (*‘GC’*) held:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

21. The services to be compared are:

Opponent’s services	Applicant’s services
<p>Class 35: Advertising; Business management; Business administration; Office functions; Organisation of exhibitions for commercial and advertising purposes; Organisation of fashion shows for commercial purposes.</p> <p>Class 41: Education; Providing of training; Entertainment; Cultural activities; Booking of seats for shows; Film production services; Organisation of competitions; Organisation of beauty contests; Production of shows; Photography services</p>	<p>Class 41: Organising of beauty pageants; entertainment in the nature of beauty pageants; organisation of competitions; coaching and education services relating to modelling; organisation of charitable events and competitions; provision of non-downloadable electronic information, books and publications; on-line journals, namely, blogs featuring personal and biographical information, photographs and opinions; providing information regarding entertainment and recreational matters and events from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual</p>

	information, on computer and communication networks; online photograph gallery services; information, advice and consultancy in relation to all the aforesaid services.
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22. The applicant conceded in its counterstatement that the terms *organising of beauty pageants* and *organisation of competitions* overlapped with the opponent's services.

23. The opponent contends in its written submissions that,

“The applicant's services in class 41 are wholly contained within the broad terms **‘education; providing of training; entertainment; organising of competitions; organising of beauty contests; production of shows; photography services’** in the opponent's class 41 services specification. The respective services are therefore identical or in the alternative highly similar”.

24. Clearly *organising of beauty pageants* and *organisation of competitions* in the applicant's specification are identical to *organising of competitions; organising of beauty contests* in the opponent's specification. I also find that *organisation of charitable competitions* in the applicant's specification would be covered by the broader term *organising of competitions* in the opponent's specification and is considered identical on the *Meric* principle.

25. I find that *entertainment in the nature of beauty pageants; coaching and education services relating to modelling; providing information regarding entertainment and recreational matters and events from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks; advice and consultancy in relation to all the aforesaid services* in the applicant's specification would be covered by the broader terms *education; Providing of training; entertainment* in the opponent's specification and are considered identical on the *Meric* principle.

26. With regard to *online photograph gallery services* in the applicant's specification, this would be covered by the broader term *Photography services* in the opponent's specification and is considered identical on the *Merix* principle.

27. Regarding the term *organisation of charitable events* in the applicant's specification, this is a broad term as it covers any and all types of events which relate to charities. It is quite possible to envisage that a 'charitable event' could be in the form of an entertainment event. To the extent that this is the case, when the *Canon* criteria are applied, I find that the nature of the applicant's services are identical, ie the organisation of charitable event being the organisation of an entertainment event for charitable purposes. The intended purpose is also identical as the applicant's services are organising events albeit for charity which falls under *entertainment services* at large. There is also an element of competition between the services. Overall I find that *organisation of charitable events* in the applicant's specification is identical to *entertainment services* in the opponent's specification.

28. Turning to the terms *provision of non-downloadable electronic information, books and publications; on-line journals, namely, blogs featuring personal and biographical information, photographs and opinions* in the applicant's specification, the opponent submits that these are,

“...ancillary/complimentary to the Opponent's services. The nature, use, users, trade channels of the respective services are highly similar. The services are in competition and will likely be provided by similar commercial methods”.

29. I have considered the opponent's submissions. It is highly likely that the applicant is providing e-information, books, publications and blogs relating to the organising of beauty pageants and competitions. I find there is complementarity and thus at least a low degree of similarity with the opponent's services.

Average consumers and the purchasing process

30. I now consider who the average consumer is for these services and how the services themselves are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the

average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

31. 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. The average consumers for the contested services are the general public. Taking into account the fact that the cost of attending entertainment events or entering competitions will vary I find that consumers will pay at least a reasonable degree of attention during the purchasing process. The services are likely to be accessed visually, indeed beauty pageants by their nature are visual events. However I do not discount any aural aspect, for example such as radio or podcasting advertising, to the purchasing process.

Comparison of the marks

33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by

means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

35. The marks to be compared are:

Opponent's mark	Applicant's mark
Face Of The World	FACE OF EUROPE AND THE WORLD

36. The opponent's mark consists of the words **Face Of The World** in title case. There are no other aspects to it and the overall impression resides in these words as a whole phrase.

37. Likewise the applicant's mark consists of the words **FACE OF EUROPE AND THE WORLD** in block capitals. It has no other aspects to it and the overall impression resides in these words as a whole phrase.

38. In a visual comparison of the marks, the applicant's mark encompasses the whole of the opponent's mark in the same word order and differs only by the addition of the two words **EUROPE AND**. Overall I find there to be a high degree of visual similarity.

39. Similarly in an aural comparison, the applicant's mark encompasses the whole of the opponent's mark in the same word order and differs only by the addition of the two words **EUROPE AND**. These additional words will be vocalised but even taking this into account I find there to be a high degree of aural similarity.

40. With regard to the conceptual comparison, the opponent submits that,

“the concept of both marks is almost identical. Europe is part of the ‘world’ and so the additional reference to ‘Europe’ in the applicant’s mark simply reinforces and emphasis the message and concept of the mark FACE OF THE WORLD.”

41. I agree with the opponent that the message brought to the mind of the average consumer by the shared words FACE OF THE WORLD will be the same for both marks. I do not find that the additional word EUROPE as part of the applicant’s mark will make a significant difference to its overall concept. Europe will be seen merely as a geographical region. It is not uncommon for beauty pageants to be designated by geographical region and will likely be seen by consumers in this way. Taking all of this into account, I find there is a high degree of conceptual similarity.

Distinctive character of the earlier mark

42. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

43. I have no evidence before me showing use of the earlier mark for the services relied on so I can only consider its inherent distinctiveness.

44. The earlier mark consists of the phrase **FACE OF THE WORLD**. Whilst the mark does not directly describe the services for which it is registered, I find the earlier mark is allusive for services such as *organisation of beauty contests* and as such I would characterise the mark as having a lower than average degree of inherent distinctiveness.

Likelihood of confusion

45. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 17:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

46. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

47. So far, I have found that some of the contested services are identical and some are similar on the basis of complementarity, and that the average consumer will pay reasonable degree of attention during the purchasing process. In addition, I have found that the earlier mark has a lower than average level of inherent distinctiveness. Lastly, I have found that there is a high degree of visual, aural and conceptual similarity.

48. Taking all of this into account, I find in particular that the conceptual similarity of both marks being '**FACE OF**' plus geographical location, is a key factor in my decision. In my view, any visual, aural and conceptual differences, merely being two additional words **EUROPE AND** and given that geographical regions are common for beauty pageant services, between the marks are insufficient to offset the similarities in the mind of the average consumer purchasing the services. I must consider that the average consumer rarely has the chance to make a direct comparison of the marks, instead relying on the imperfect picture of them that they have kept in their mind, and bearing in mind the fact that both parties' marks contain the identical elements **FACE OF THE WORLD**, in my view the average consumer will believe the services being offered under the marks will come from the same or related economic undertakings. As such I find there is a likelihood of direct confusion.

Conclusion

49. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against my decision, the application is refused in its entirety.

Costs

50. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using the guidance in that notice I make the following award:

£100 Official fee for filing the Notice of Opposition

£300 Preparing the Notice of Opposition & considering counterstatement

£400 Preparing written submissions

£800 Total

51. I order Face of Europe & The World Ltd to pay Earth Girls Ltd the sum of £800. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 1 March 2019

**June Ralph
For the Registrar,
The Comptroller General**