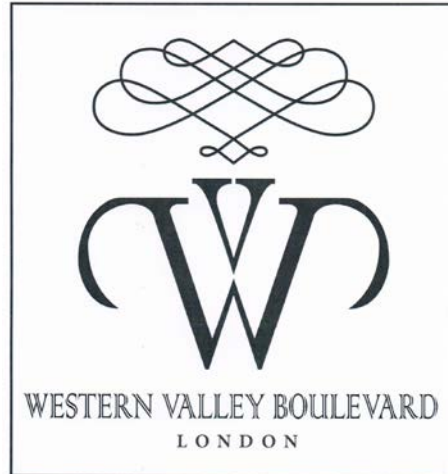


O-126-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3078968
BY WESTERN VALLEY BOULEVARD LIMITED**

TO REGISTER:



AS A TRADE MARK IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 403984 BY VOLKSWAGEN AG**

BACKGROUND

1. On 28 October 2014, Western Valley Boulevard Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods in class 3:

Perfumes; eau de parfum; eau de toilette; colognes; fragrances; scented water; soaps; preparations for the bath; preparations for the shower; moisturisers.

The application was published for opposition purposes on 16 January 2015.

2. The application is opposed by Volkswagen AG (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon the goods (shown below) in Community Trade Mark (“CTM”) registration no.9383514 for the trade mark:



which was applied for on 2 September 2010 and for which the registration procedure was completed on 25 February 2011:

Class 3 - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, rust removers, abrasive paper; soaps; perfumery, essential oils, cosmetics; tissues impregnated with cosmetic lotions; hair lotions; dentifrices.

3. The applicant filed a counterstatement in which it denies the basis of the opposition.

4. Only the opponent filed evidence; it also filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind and refer to them, as necessary, below.

The opponent's evidence

5. This consists of a witness statement (accompanied by one exhibit) from Rigel Moss McGrath, a trade mark attorney at WP Thompson, the opponent's professional representatives. Ms McGrath, states:

“3. I have researched the extent and manner in which car manufacturers apply their respective trade marks to the packaging of aftershaves, colognes and the like.”

6. Exhibit RKM 1 consists of pages obtained from a range of websites which demonstrates that other car manufacturers i.e. Jaguar, Ferrari, Mini (BMW), Rover and Porsche have conducted a trade in fragrances. I will return to the relevance of this evidence later in my decision.

DECISION

7. 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.”

8. 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.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before

the publication date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent is, as a consequence, entitled to rely upon all of the goods in class 3 it has identified.

Section 5(2)(b) – case law

10. 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 greater 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

11. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 3 - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, rust removers, abrasive paper; soaps; perfumery, essential oils, cosmetics; tissues impregnated with cosmetic lotions; hair lotions; dentifrices.	Class 3 - Perfumes; eau de parfum; eau de toilette; colognes; fragrances; scented water; soaps; preparations for the bath; preparations for the shower; moisturisers.

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

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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”.

14. For reasons which will shortly become obvious, it matters not if I proceed on the basis that all of the goods at issue are identical. For the sake of completeness, however, I shall compare briefly the competing goods. As “Perfumes; eau de parfum; eau de toilette; colognes; fragrances; scented water” in the application will all be encompassed by the term “perfumery” in the earlier trade mark, the competing goods are identical on the *Meric* principle. As “soaps” appears in both parties’ specifications, these goods are literally identical. As to the goods which remain i.e. “preparations for the bath; preparations for the shower; moisturisers”, the opponent argues that these are similar to “cosmetics; tissues impregnated with cosmetic lotions; hair lotions” on the basis that:

“17...The parties’ goods are all personal care items, all for the purpose of cleansing, moisturising and adding scent to human skin and hair. They are all “grooming products” used by human individuals. Due to the similarity of the goods, they are marketed to the same groups of people and are therefore in competition with one another.”

15. Whilst the physical nature of the competing goods may differ, the users are the same as may be the intended purpose and method of use. The goods are also, in my experience, routinely sold in close proximity to one another in, for example, supermarkets and department stores. Whilst there may be an element of competition between them as the opponent suggests, more likely, in my view, is that there is a complementary relationship which would lead consumers to believe think that the responsibility for the goods lies with the same undertaking. As a consequence, there is, in my view, at least a medium degree of similarity between “preparations for the bath; preparations for the shower; moisturisers” in the application and “cosmetics; tissues impregnated with cosmetic lotions; hair lotions” in the earlier trade mark.

The average consumer and the nature of the purchasing act

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods 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.”



17. The average consumer of the relevant goods at issue in these proceedings is a member of the general public. As such a consumer will, in my experience, most often obtain such goods by self-selection from the shelves of, for example, a bricks and mortar retail outlet such as a department store or supermarket or from the on-line equivalent, visual considerations are likely to dominate the selection process. I do not, however, discount aural considerations in circumstances where, for example, a sales assistant may be involved in the purchasing process or where the goods are the subject of word-of-mouth recommendations. As to the degree of care that a consumer will display when selecting such goods, the goods are, in the main, relatively frequent purchases which are unlikely to be terribly expensive. However, as all of the relevant goods will be used on the person and as the consumer will wish to ensure that it selects (where possible) goods which have the most suitable aroma and which, for example, do not contain ingredients which may cause adverse reactions, I would expect an average degree of attention to be paid. Infrequency of selection or heightened cost (designer perfumes for example) will, inevitably, elevate the consumer's level of attention.

Comparison of trade marks

18. 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 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.”

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

opponent's trade mark	applicant's trade mark
	

20. In its written submissions, the opponent states:

“9. Visually, the marks are dominated by the letters V and W, both in size, position and distinctiveness. In both marks the letters V and W are arranged one over the other, and aligned so that the base of the letter “V” is exactly above the apex of the middle strokes of the letter “W” below it. In both marks the letters are stylised, but are clearly recognisable as the letter “V” above the letter “W”.

10. There are visual differences between the marks; the applied for mark also includes a “flourish script” device at the head of the mark and the words “Western Valley Boulevard London” at the bottom of the mark. The flourish script lacks any distinctive character and is origin neutral. “Western Valley Boulevard London” appears to be an address and therefore again lacks inherent distinctive character. On that basis we submit that, visually, it is the “VW” element of the contested trade mark which dominates the contested mark.

11. The opponent’s earlier trade mark consists of the letters “V W” arranged in a stylised format, within a circular device consisting of two rings, one represented in white and the other in black. We respectfully submit that the letters “VW” dominate the opponent’s earlier trade mark.

12. It is the opponent’s case that the visual differences between the marks are insufficient to outweigh the visual similarities between the marks. We submit that despite the differences the marks are dominated by the letters “V W” arranged one over the other in exactly the same manner. The similarity is striking and renders the trade marks visually similar to one another.

13. Aurally the relevant elements of the marks are “V W” and “V W WESTERN VALLEY BOULEVARD London”. The letters are arranged in such a fashion that they are pronounced “VW” rather than “W V”. Therefore aurally the marks are similar to one another to the extent that they both begin with the letters “V W”.

14. It is submitted that neither mark possesses a conceptual value.”

21. Although the opponent’s trade mark is sufficiently stylised to be open to interpretation, it would, in my view, be unrealistic for me not to take judicial notice of the fact that the opponent is a well-known vehicle manufacturer whose vehicles bearing the earlier trade mark have been available in the United Kingdom for many years. Consequently, despite the degree of stylisation present in the earlier trade mark, I am satisfied that the overall impression conveyed to the average consumer by it will be of the letters “VW” presented in white and contained within a predominately black roundel device.

22. As to the applicant’s trade mark, this contains a number of elements. The first, which appears at the top of the trade mark, is described by the opponent as a “flourish script”; the opponent concludes that this “flourish script lacks any distinctive character

and is origin neutral”; I agree. The second and largest element consists of two letters one placed above the other. The letter “V” is presented in an unremarkable typeface and is much smaller than the letter “W” which accompanies it and which contains flourishes emanating from (to use the opponent’s terminology) the outer strokes of the letter; I shall return to these letters in a moment. The third element, which appears at the bottom of the trade mark, is the words “WESTERN VALLEY BOULEVARD” presented in upper case. The final element is the word LONDON presented in upper case and in a much smaller font than the words which appear above it; the word LONDON is geographical and has no distinctive character. In its submissions, the opponent states that “Western Valley Boulevard London” appears to be an address and therefore again lacks inherent distinctive character”. I accept that the presence of the word “BOULEVARD” (meaning a wide usually tree-lined road in a city) in the phrase “WESTERN VALLEY BOULEVARD” may lead the average consumer to construe the totality as a reference to a road in the western valley area of a city. However, given the size of the words “WESTERN VALLEY BOULEVARD” in relation to the word “LONDON”, and as there is nothing to suggest that such a road exists, it is, in my view, equally likely that the words will be construed as a reference to a commercial undertaking called “WESTERN VALLEY BOULEVARD” which is based in London.

23. Returning to the letters in the applicant’s trade mark, although it would be more natural for the average consumer to read these letters from top to bottom i.e. as “V W”, given the size of the letter “W” in relation to the letter “V” and as the words “WESTERN VALLEY BOULEVARD” are, in my view, a distinctive and dominant element of the applicant’s trade mark, it is, in my view, equally plausible that the letters will be understood as relating to the first two words which appear in the applicant’s trade mark i.e. “WESTERN VALLEY” and, as a consequence, will be construed as “VW”; however they are construed, the letters “VW” or “WV” are a distinctive element of the applicant’s trade mark.

24. I shall now bring these findings together. Given the size and positioning of the letters “VW”/“WV” and notwithstanding the relative size and positioning of the words WESTERN VALLEY BOULEVARD, but bearing in mind the non-distinctive/geographical nature of the other elements of which the applicant’s trade mark is made up, the overall impression conveyed by it will, in my view, be dominated by the distinctive letters “VW”/“WV” and the distinctive words “WESTERN VALLEY BOULEVARD.”

25. I have concluded that both trade marks may be construed as containing the letters “VW”; it is in that element alone that any similarity exists. In approaching the matter, I remind myself of the comments of Mr Iain Purvis Q.C. in his role as the Appointed Person (“AP”) in BL-O-010-16 in which he stated:

“12. Secondly, the difference between ‘no visual similarity’ and ‘a low degree of visual similarity’ is not only impossible to define but quite subjective. It is hard to imagine a case in which the spread of reasonable opinions about visual similarity could not cover both of these characterisations. This is not, therefore, fertile ground upon which to base an alleged error of principle.

13. Thirdly, I do not have any difficulty with the notion (which Mr Stobbs appeared to be contending was illogical) that two representations of the same thing may have no visual similarity. In the world of art, the visual representation of a horse in Picasso's Guernica has little or nothing in common with the visual representation of a horse in one of George Stubbs' portraits. I do not think it unreasonable to say that they have no visual similarity, whilst having some limited conceptual similarity (they are both paintings of horses). "

26. In my view, that is the position here. Even if both trade marks are understood as containing the letters "VW", the manner in which these letters are presented is so vastly different that there is no visual similarity between the competing trade marks. However, even if that conclusion is considered to be in error, as the applicant's trade mark also contains the distinctive and dominant words WESTERN VALLEY BOULEVARD, there is, in my view, at the very most, only the lowest degree of visual similarity between them.

27. The opponent's views on aural similarity are shown above. Although the opponent's position is not unreasonable, as I mentioned above, it is, in my view, equally plausible that the letters will be understood as relating to the first two words which appear in the applicant's trade mark i.e. "WESTERN VALLEY" and, as a consequence, will be pronounced as "WV"; as to the word "LONDON", it is, in my view, entirely possible (indeed probable) that this word will not be verbalised at all. The high point of the opponent's case rests in the proposition that its trade mark will be verbalised as "VW" (with which I agree) whereas the applicant's trade mark will be verbalised as "VW WESTERN VALLEY BOULEVARD". Even in those circumstances, and notwithstanding that the letters "VW" will be verbalised first, the presence of the words "WESTERN VALLEY BOULEVARD" results, in my view, in, at best, a medium degree of aural similarity between the competing trade marks. If the applicant's trade mark is verbalised as "WV WESTERN VALLEY BOULEVARD" there is no aural similarity.

28. The opponent argues that neither parties' trade mark will convey any concrete conceptual message to the average consumer; if that is correct, the conceptual position is neutral. However, if the words WESTERN VALLEY BOULEVARD creates in the average consumer's mind the image of a road, then this creates a conceptual difference between the competing trade marks, albeit, I accept, that the opponent would argue that this is a non-distinctive difference.

Distinctive character of the earlier trade mark

29. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 for which it has been registered as coming from a particular undertaking and thus to distinguish those

goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

30. As the opponent has filed no evidence going to the distinctiveness of its earlier trade mark, I have only its inherent credentials to consider. Consisting as it does of the letters "VW" presented in a fairly stylised manner, the opponent's trade mark is possessed of a fairly high degree of inherent distinctive character for the goods relied upon, the distinctiveness residing in the stylised manner in which the letters are presented rather in the letters "VW" *per se*.

Likelihood of confusion

31. 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 vice versa. As I mentioned above, it is also necessary for me to keep 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, 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. I have concluded that:

- while a brief analysis of the competing goods results in either identity or a medium degree of similarity, I shall proceed on the basis that the competing goods are identical;
- the average consumer is a member of the general public who will select the goods at issue by predominately visual means and will pay at least an average degree of attention when doing so; aural considerations will also play their part in the selection process;
- even if the letters in the applicant's trade mark are construed as the letters "VW", there is no visual similarity between the competing trade marks; however, if that conclusion is considered to be in error, the competing trade marks are visually similar to at the very most, only the lowest degree;
- proceeding on the basis most favourable to the opponent, the competing trade marks are at best aurally similar to a medium degree and conceptually neutral;
- the opponent's earlier trade mark is possessed of a fairly high degree of inherent distinctive character which stems from the manner in which the letters "VW" are presented rather in the letters "VW" *per se*.

32. In its submissions, the opponent states:

“20. Further, and of particular relevance to this case is the frequency with which car manufacturers offer ranges of aftershaves or colognes...The exhibits...clearly demonstrate that Jaguar, Ferrari, Mini (BMW), Rover and Porsche have all applied their brands to aftershaves/cognes and based upon this evidence, we submit that it would be reasonable to infer that brand extension in this manner is common practice and that the relevant public, the general public purchasing cologne or aftershave, is well aware of such collaborations....”

33. I am prepared to accept that by the date of the application for registration in October 2014, the average consumer was likely to be aware that some car manufacturers also conducted a trade in a range of goods of the type mentioned by the opponent. Notwithstanding that conclusion and proceeding on the basis that the letters in the applicant’s trade mark will be construed as the letters “VW (i.e. the opponent’s best case), as the purchasing process for what I am treating as the identical goods at issue is a predominately visual one, and as the average consumer will be paying at least an average degree of attention during the selection process, the very different ways in which the letters “VW” are configured (and in which the distinctive character of the opponent’s trade mark resides) is more than sufficient to avoid a likelihood of either direct or indirect confusion. The presence of the distinctive and dominant words “WESTERN VALLEY BOULEVARD” in the applicant’s trade mark simply reinforces this conclusion. I reach the same conclusion in relation to what I consider to be the much less frequent mode of selection i.e. when the goods are selected by oral means. In those circumstances, and even if the applicant’s trade mark is verbalised as “VW WESTERN VALLEY BOULEVARD”, the presence of the words “WESTERN VALLEY BOULEVARD” are, once again, in my view, more than sufficient to avoid a likelihood of either direct or indirect confusion. It follows that the position in relation to both modes of selection is even starker if the letters in the applicant’s trade mark are construed as “WV”. In my view, the AP’s comments in the case mentioned earlier are equally applicable to these proceedings i.e.

“15...In essence his argument was that there was bound to be a likelihood of confusion in this case because of the aural ‘identity’ between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for ‘RA’ goods, just as one would ask for the applicant’s goods). This argument seems to me to fly in the face of the necessary ‘global’ assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out. Particularly in the case of an earlier mark which is a heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result.”

Conclusion

34. The opposition has failed, and subject to any successful appeal, the application will proceed to registration.

Costs

35. As the applicant has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis

Preparing a statement and considering the other side's statement:	£200
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Considering the opponent's evidence:	£100
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Total:	£300
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36. I order Volkswagen AG to pay to Western Boulevard Limited the sum of **£300**. 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 8th day of March 2016

C J BOWEN
For the Registrar
The Comptroller-General