

O-020-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3119641 BY
FSI EVENTS LTD TO REGISTER:**

Fashion Scout

AS A TRADE MARK

IN CLASSES 35 & 41

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 405223 BY
FASHION ONE TELEVISION LIMITED**

BACKGROUND & PLEADINGS

1. On 27 July 2015, FSI Events Ltd (“the applicant”) applied to register **Fashion Scout** as a trade mark. The application was published for opposition purposes on 4 September 2015 for the following services:

Class 35 - Fashion show exhibitions for commercial purposes; Organisation of fashion shows for commercial purposes; Fashion shows for promotional purposes (Organization of -).

Class 41 - Entertainment in the nature of fashion shows; Organizing and presenting displays of entertainment relating to style and fashion; Education services relating to fashion; Organisation of fashion shows for entertainment purposes; Fashion shows for entertainment purposes (Organization of -); Beauty contests (arranging of-); Beauty contests (conducting of-); Beauty contests (organising of-); Modelling services for artists; Education services relating to modelling.

2. The application is opposed by Fashion One Television Limited (“the opponent”) under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition, which is directed against all of the services in the application, is based upon the services (shown below) in the following United Kingdom trade mark registration:

No. 3123907 for the trade mark: **Fashion Scout** which was applied for on 25 August 2015 (claiming an International Convention priority date of 26 May 2015 from an earlier filing in Germany) and entered in the register on 27 November 2015:

Class 35 - Advertising consultation; arrangement of advertising; classified advertising; advertising research; commercial or industrial management assistance; exhibitions and trade fairs and preparation for commercial and advertising purposes in the field of fashion.

Class 38 - Telecommunication services; transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet.

Class 42 - Technical and professional services in the field of design, graphic arts and technical research in the field of fashion.

3. The opponent claims that the competing trade marks are identical as, in its view, are the competing services in class 35. In relation to the services in class 41 of the application, the opponent states:

“11. With regards to the opponent’s earlier UK mark, without any doubt, the services are highly similar to the applicant’s services. The applicant’s services in class 35 and 41 can be considered to be all included in the services offered by the opponent in class 35...”

And:

“13. Moreover, the services for which the applicant seeks protection are to be considered as complementary due to the close connection between them in the sense that one is indispensable or important for the use of the other and is not merely auxiliary or ancillary. This weights in favour of similarity. Customers may think that the responsibility for providing these services is on the same entity... This factor is of importance, where the nature (for example – fashion and fashion shows related services), the purpose (updating and educating the public on latest fashionable clothes, accessories and trends/following fashion – creating fashion awareness), the method of use (wearing fashionable clothes and accessories – in fashion shows and beauty contests) are same and the goods or services are in competition.

14. Under the foregoing circumstances, applying the above mentioned concept to the present case, the opponent hereby submits that the services that seek protection in class 35 and 41 under the subject mark by the applicant are complementary to the services protected in the earlier mark in class 35, 38 and 42 by the opponent...”

Although in its Notice of opposition the opponent refers to its Fashion One Television Network and makes submissions based upon its alleged trade in this regard (submissions to which the applicant responded in its counterstatement and evidence), as the opponent chose not to file any evidence in these proceedings, this point does not assist it and I need say no more about it in this decision.

4. The applicant filed a counterstatement in which it challenges, inter alia, the basis of the opponent’s claim to the International Convention priority date mentioned above. It goes on to state:

“3. It is first submitted that the priority claim is invalid under section 35(1) of the Trade Marks Act 1994. UK registration no. 3123907 has been filed in the form “Fashion Scout” whereas [the German registration upon which it is based) takes the form “FashionScout” as a conjoined word. Accordingly, the marks are not “the same” in accordance with section 35(1) of the act.”

5. In addition, although the applicant accepts that its trade mark and the UK trade mark of the opponent are identical, it denies that “all goods and services covered by the application are identical or similar to those covered by the application (sic)”. The applicant goes on to explain that it has used the trade mark “FASHION SCOUT” for many years, with its first use commencing in 2006. Having provided a brief summary of its use, it states:

“6. As such, it is in fact, the applicant that has used the mark which is the subject of the opposed application in the UK since 2006.

7. Therefore, the applicant is the proprietor of an unregistered trade mark through use of the mark in the UK since 2006 in respect of fashion shows, the organisation of fashion shows and services relating to the aforesaid.

8. Based on the above, the applicant intends to file an invalidation action against the opponent's mark."

6. A review of the tribunal's records prior to issuing this decision indicates that no request to invalidate the opponent's trade mark has been filed.

7. In these proceedings, the opponent has represented itself; the applicant is represented by Keltie LLP. Only the applicant filed evidence. The opponent filed written submissions during the course of the evidence rounds. Although neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing.

Evidence

8. The applicant's evidence consists of a witness statement from Azhar Sadique, a Director at Keltie LLP. Mr Sadique confirms that while he is authorised to speak on the applicant's behalf, the information in his statement comes from his own personal knowledge. He states:

"4. A provision that is clear in accordance with section 35(1) is the fact that the trade marks must be the same. The space between the mark as filed "Fashion Scout" and the form from which priority claimed "FashionScout" in addition to the capitalisation of the "S" following the lower case "n" affects the identity of the trade mark. Accordingly, the marks are not "the same"...and the priority claim is invalid..."

9. He repeats the summary of the applicant's use of the words "Fashion Scout" contained in the counterstatement and provides exhibits A1 to A7 in support. Although I

have reviewed these exhibits, for the reasons given in paragraph 46 of this decision, it is not necessary for me to summarise their contents here.

DECISION

10. The opposition is based upon sections 5(1) and 5(2)(a) of the Act which read as follows:

“5 - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(b)...

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

11. 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.”

12. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above which has a filing date of 25 August 2015 (i.e. later than the application) but which claims an International Convention priority date of 26 May 2015 from an earlier filing in Germany which, if substantiated, would make it an earlier trade mark under section 6(1)(a) of the Act. In a letter to the opponent dated 8 October 2016, I stated:

“I note that the opposition is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 with the opponent relying exclusively upon United Kingdom trade mark registration no. 3123907 “Fashion Scout”. This registration was applied for on 25 August 2015 by Fashion One Television Limited and claimed an International Convention priority date of 26 May 2015 from an earlier filing in Germany.

As the applicant’s trade mark was filed on 27 July 2015, the opponent’s claim to the International Convention priority date mentioned is, of course, crucial; this point has, I note, been in issue since the proceedings commenced. Section 35(1) of the Act reads as follows:

“35. - (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a “Convention application”), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.”

Exhibit 1 attached to the Notice of opposition contains an extract from the German Patent and Trade Mark Office's database which shows the applicant as Gleissner, Michael; other than the classes applied for i.e. 9, 18, 35, 38 and 42, this document provides no indication of the actual goods and services for which registration was sought. I note that Mr Gleissner also appears to be the applicant in the document you provided with your letter of 12 February 2016. In that letter, you also provided English translations of the goods and services contained in the German application. As far as I am aware, however, you did not provide any indication of the provenance of those translations.

In view of the above, I direct the opponent, under the provisions of rules 62(1)(a) and 62(1)(b) of The Trade Marks Rules 2008 to:

(i) explain the apparent discrepancy between the name of the applicant in the German application and the opponent in these proceedings and, if necessary, provide any supporting documentation in this regard; and

(ii) provide a certified translation into English of the specifications for which the German application was filed and upon which the opponent relies.

A period of 14 days from the date of this letter is allowed for this purpose. Your response should be copied to Keltie LLP, who upon receipt of same is allowed a further period of 14 days in which to comment. I will consider the parties' submissions and indicate how I intend to proceed."

13. In a letter dated 21 November 2016 (copied to the applicant) the opponent responded to that direction. In its letter, the opponent provided (i) a certified translation dated 17 November 2016 by Ms Martina Hollweck, and (ii) an assignment document dated 20 August 2016 between Michael Gleissner and the opponent in relation to the German application. Despite being given the opportunity, the applicant elected not to comment upon these documents.

The opponent's claim to the International Convention priority date

14. Although the applicant has not commented upon the documents filed by the opponent in response to my directions, I must begin by determining whether the opponent's claim to the International Convention priority date claimed is valid; if it is not, that is, of course, the end of the matter and the opposition will fall at the first hurdle. This breaks down into three distinct issues.

1. Ownership of the earlier right

15. The German application upon which priority is based was filed in the name of Michael Gleissner, whereas the opponent's trade mark stands in the name of Fashion One Television Limited. In response to my directions, the opponent provided a copy of an assignment document dated 20 August 2015 between Michael Gleissner ("the assignor") and Fashion One Television Limited ("the assignee"); I note that Mr Gleissner has signed the assignment document on behalf of the assignee in his role as a Director of the opponent. The assignment document specifically mentions the German trade mark application (referred to as the "Filed Application"). The assignment contains the following wording:

"AND WHEREAS the Assignor has agreed for the consideration hereinafter appearing to assign and transfer unto the Assignee the said Filed Application..."

The assignment goes on to refer to "the whole of the goodwill of the business in the goods" (the German application having also been filed in classes 9 and 18) and, oddly, to "the said Registered Trademark". As the applicant chose not to comment upon the assignment document, I think it not unreasonable for me to proceed on the basis that, like me, it is satisfied that the opponent is the successor in title to the applicant named in the German trade mark application.

2. The trade mark relied upon

16. In its counterstatement and evidence, the applicant points to the wording of section 35(1) of the Act (shown above) and to the form in which the trade mark was applied for in Germany i.e. “FashionScout” with no space between the two words. Given that the wording of Section 35(1) of the Act refers to “the same trade mark”, the applicant argues that “the priority claim is invalid.”

17. The only difference between the trade mark in the German trade mark application and the trade mark relied upon by the opponent and registered in this country, is the space between the letter “n” of the word “Fashion” and the “S” of the word “Scout”. In reaching a conclusion on this point, I am guided by the decision of the Court of Justice of the European Union (“CJEU”) in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34 .The Court concluded:

“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

18. Although decided in the context of what constitutes an identical trade mark for relative grounds purposes, the above decision provides, in my view, helpful guidance as to how one should construe the meaning of the phrase “the same trade mark” as it appears in section 35(1) of the Act. Approached on that basis, I am satisfied that as the average consumer will view both trade marks as consisting of the two words “Fashion” and “Scout”, the difference I have identified above is so insignificant it may unnoticed by the average consumer and, as a consequence, the trade mark shown in the German application being relied upon and the trade mark registered in this country should be considered to be “the same trade mark.”

3. The services relied upon

19. The opponent's earlier trade mark stands registered in the United Kingdom for the services shown below; also shown below is the list of services contained in the German application as they appear in the certified translation.

Opponent's services (as registered in the United Kingdom)	Opponent's services (as translated from the German application)
<p>Class 35 - Advertising consultation; arrangement of advertising; classified advertising; advertising research; commercial or industrial management assistance; exhibitions and trade fairs and preparation for commercial and advertising purposes in the field of fashion.</p> <p>Class 38 - Telecommunication services; transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet.</p> <p>Class 42 - Technical and professional services in the field of design, graphic arts and technical research in the field of fashion.</p>	<p>Class 35: Advertising and marketing; Arranging and concluding commercial transactions for others; Arranging contracts for purchasing and selling of goods; Providing information on supply and demand for used and new fashion items of all kinds; Dissemination of advertising for others via electronic online communications networks; Providing and rental of advertising space, in particular on the Internet and in other new media: Collating of data in computer databases; Promotional publication of information on the Internet, in particular, on clothing, fashion articles and fashion accessories.</p> <p>Class 38: Telecommunications; Network telecommunications; Collection and delivery of messages; Data and image transmission via computers; Online services, such as gathering and transmitting information on, texts, drawings and images via telecommunications;</p>

	<p>Online services, namely gathering and supplying information, texts, drawings and images via telecommunications; Providing access to information, text, drawings and images via telecommunications; Operating a call center; Internet services, such as providing access to information on the Internet; Providing and leasing of access time on the Internet; Integrated voice and data communications; Providing a computer-based market in terms of used and new fashion items if all kinds, such as the gathering, supplying and transmission of information on supply and demand for used and new fashion items if all kinds; E-mail data services; Providing access to computer databases; Services related to a database, such as data transmission; Providing access to data, information, images and sound via global computer networks (Internet); Rental of access time to a computer database for downloading information via electronic media (Internet).</p> <p>Class 42: Design of network pages and their posting on the Internet for others as computerized markets for various products and services, in which suppliers and buyers using computerized detection of supply and demand are brought together, especially using the Internet and call</p>
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	<p>centers: Creating programs for data processing; Creating databases and multimedia information systems in tele-communicative networks; Development and maintenance of computer programs, such as maintenance and care, especially internet-based and computer-consulting services, in particular internet-based ones; Creating computer databases; Conducting scientific studies on animals, Rental and maintenance of memory space for websites for others (hosting); Putting web pages on the Internet for others (web hosting).</p>
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20. As these specifications are clearly not the same, I need to determine which services, if any, the opponent is entitled to rely upon in these proceedings.

Class 35

21. As “Advertising consultation”; “arrangement of advertising”; “classified advertising”; and “advertising research” in the United Kingdom registration would all be encompassed by the term “advertising” which appeared in the specification of the German trade mark application, the opponent is entitled to rely upon all these services. As to “commercial or industrial management assistance” which appears in the United Kingdom registration, this is a broad term which may include many (if not all) of the services which appeared in the German trade mark application in this class. However, as it may also include services which were not specified in the German trade mark application, it should, in my view, only be interpreted as including the actual services itemised in the German application. That leaves “exhibitions and trade fairs and preparation for commercial and advertising purposes in the field of fashion” which

appears in the United Kingdom registration to consider. In my view, these services fall within the broad term “marketing” which appeared in the German trade mark application; the applicant is, as a consequence, entitled to rely upon such services in these proceedings.

Class 38

22. As all of the opponent’s services in the United Kingdom registration would, at least, be included within the term “telecommunications” which appeared in the specification of the German trade mark application, the applicant is entitled to rely upon all the services in this class.

Class 42

23. All the opponent’s services in the United Kingdom registration should, in my view, be interpreted as all relating to the field of fashion; an approach which appears to be consistent with the opponent’s own view of the matter (the underlined part of the quotation which appears in paragraph 32 below refers). While all of the services which appeared in the German trade mark application may also be provided in the field of fashion, as they are narrower in scope than the services which appear in the United Kingdom registration, the opponent is, in my view, only entitled to rely upon the named services which appeared in the German application, albeit limited to the field of fashion.

Conclusion on the priority claim

24. Although I have found that the International Convention priority date claimed is valid, I have concluded that the opponent is not entitled to rely upon all the services specified in the United Kingdom trade mark registration. I shall return to the latter point when I compare the competing services.

The opposition based upon Section 5(1) of the Act

Comparison of trade marks

25. The competing trade marks are identical.

Comparison of services

26. For present purposes, the relevant comparison is between:

Opponent's services in class 35 (includes):	Applicant's services in class 35
Exhibitions and trade fairs and preparation for commercial and advertising purposes in the field of fashion.	Fashion show exhibitions for commercial purposes; Organisation of fashion shows for commercial purposes; Fashion shows for promotional purposes (Organization of -).

27. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court ("GC") stated:

"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)."

28. As the applicant’s “fashion show exhibitions for commercial purposes” and “organisation of fashion shows for commercial and promotional purposes” “would all be encompassed by “exhibitions and trade fairs and preparation for commercial and advertising purposes in the field of fashion” which appears in the opponent’s specification, the competing services are, on the principle outlined in *Meric*, to be regarded as identical. As I have found the opponent’s named services in class 35 to be identical to the services of the applicant in this class, it is not necessary for me to also compare them with any other services upon which the opponent may be entitled to rely.

Conclusion on the opposition based upon section 5(1) of the Act

29. As both the competing trade marks and services are identical, the opposition to class 35 of the application succeeds.

The opposition based upon section 5(2)(a) of the Act

Comparison of trade marks

30. The competing trade marks are identical.

Comparison of services

31. Based on my conclusions reached above, the services to be compared are as follows:

Opponent’s services	Applicant’s services
Class 35 - Advertising consultation; arrangement of advertising; classified advertising; advertising research; (i.e. as they appear in the specification of the registration);	Class 41 - Entertainment in the nature of fashion shows; Organizing and presenting displays of entertainment relating to style and fashion; Education services relating to fashion; Organisation of fashion shows for

<p>Advertising and marketing; Arranging and concluding commercial transactions for others; Arranging contracts for purchasing and selling of goods; Providing information on supply and demand for used and new fashion items of all kinds; Dissemination of advertising for others via electronic online communications networks; Providing and rental of advertising space, in particular on the Internet and in other new media: Collating of data in computer databases; Promotional publication of information on the Internet, in particular, on clothing, fashion articles and fashion accessories; (i.e. as opposed to the phrase “commercial or industrial management assistance” which appears in the specification of the registration);</p> <p>exhibitions and trade fairs and preparation for commercial and advertising purposes in the field of fashion.(i.e. as they appear in the specification of the registration);</p> <p>Class 38 - Telecommunication services; transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet. (i.e. as they appear in the specification</p>	<p>entertainment purposes; Fashion shows for entertainment purposes (Organization of -); Beauty contests (arranging of-); Beauty contests (conducting of-); Beauty contests (organising of-); Modelling services for artists; Education services relating to modelling.</p>
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of the registration);

Class 42 - Design of network pages and their posting on the Internet for others as computerized markets for various products and services, in which suppliers and buyers using computerized detection of supply and demand are brought together, especially using the Internet and call centers; Creating programs for data processing; Creating databases and multimedia information systems in tele-communicative networks; Development and maintenance of computer programs, such as maintenance and care, especially internet-based and computer-consulting services, in particular internet-based ones; Creating computer databases; Conducting scientific studies on animals, Rental and maintenance of memory space for websites for others (hosting); Putting web pages on the Internet for others (web hosting). **(i.e. as they appear in the specification of the German application and limited to “all in the field of fashion” as it appears in the registration).**

In the judgment of the 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”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- 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.

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to

the normal and necessary principle that the words must be construed by reference to their context.”

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.”

In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated 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.”

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”.

Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13 that:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....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.

32. In approaching the comparison, I begin by reminding myself of the comments of Jacob J in *Avnet*. In its written submissions, the opponent states:

“6. Furthermore we reiterate that even the services offered by the opponent in class 38 and 42 clearly encompass the fashion related services offered by the applicant in class 35 and 41 for the reason that the applicant cannot provide its services to the customers without using the telecommunications networks, wireless communication networks and the Internet, or technological services or research in the field of fashion.”

33. If one considers the “core” meaning of the opponent’s telecommunication services in class 38, the nature, intended purpose, method of use and trade channels of such services are quite different to the applicant’s services in class 41. The respective services are clearly not in competition with one another nor, in my view, are they as the opponent suggests, complementary in the sense outlined in the case law. Although a

provider of the applicant's services in class 41 may utilise the opponent's services in class 38 in the course of its business that does not make them complementary. One would not, I think, expect a provider of telecommunication services in class 38 to also be a provider of the applicant's services in class 41.

34. As to the applicant's services in class 42 (and notwithstanding that I have concluded that the services in this class should be construed as all being limited to being provided in the "field of fashion"), the intended purpose, method of use and trade channels of the competing services are different to the applicant's services in class 41. The respective services are clearly not in competition with one another nor, in my view, are they complementary in the sense outlined in the case law. Once again, although a provider of the applicant's services in class 41 may utilise such services in the course of its business that does not make them similar. For example, one would not expect a provider of, for example, computer programming services (even if the computer programming was in the field of fashion) to also be a provider of the applicant's services in class 41.

35. That leaves the opponent's services in class 35 to be considered. It is this class which, in my view, offers the opponent the best prospect of success. Given what is likely to be the similarity in at least the nature, intended purpose and method of use of the opponent's services relating to exhibitions and trade fairs in the field of fashion and the applicant's "Entertainment in the nature of fashion shows; Organizing and presenting displays of entertainment relating to style and fashion; Organisation of fashion shows for entertainment purposes; Fashion shows for entertainment purposes (organisation of)" there must, in my view, be (at the very least) a low degree of similarity between such services.

36. Although the opponent's specification in class 35 contains a range of business related services (some of which relate to fashion), the core meaning of these business related services are, in my view, different to the core meaning of the applicants "education services relating to fashion" and "education services relating to modelling"

both of which are, self-evidently, educational rather than business related services. Although both sets of services may be provided in, broadly speaking, the field of fashion, the nature of the services is different, as is the method of use and their intended purpose. The services mentioned are neither competitive nor complementary. The applicant's educational services are not similar to any of the services upon which the opponent is entitled to rely.

37. I reach the same conclusion in relation to the applicant's arranging, conducting and organisation of beauty contests. Although the organisation, arranging and conducting of exhibitions and trade fairs in the field of fashion may engage many of the same skills involved in the arranging, conducting and organisation of beauty contests and notwithstanding that, in my experience, fashion plays a not insignificant role in beauty contests, the core meanings of the services are, in my view different i.e. one is to promote fashion items whereas the other is to ascertain who, having applied a range of criteria, is the most "beautiful" individual. There is no competition between the services nor, in my view, are they complementary in the sense outlined in the case law. The applicant's arranging, conducting and organisation of beauty contests are not similar to any of the services upon which the opponent is entitled to rely.

38. Finally, I need to consider the applicant's "modelling services for artists". I construe this phrase as analogous to the services provided by a modelling agency. Approached on that basis, the nature, intended purpose and method of use differs to the opponent's services in class 35; once again, the services are neither in competition nor are they complementary. The applicant's "modelling services for artists" are not similar to any of the services upon which the opponent is entitled to rely.

39. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by

holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

40. Having concluded there is no similarity between any of the services upon which the opponent is entitled to rely and: “education services relating to fashion”, “education services relating to modelling”, “arranging, conducting and organisation of beauty contests” and “modelling services for artists” in class 41, the opposition against these services fails and is dismissed.

The average consumer and the nature of the purchasing decision

41. At this point in my decision I would normally determine who is the average consumer of the services I have found to be similar. Having done so, I would then decide how these services are likely to be selected by the average consumer in the course of trade i.e. by visual or aural means (or a combination) and assess the degree of care the average consumer will display when selecting such services. However, even if the average consumer of all the services at issue is a professional user paying the highest degree of attention during the selection process, the fact the competing trade mark are identical makes such an analysis redundant.

Distinctive character of the earlier trade mark

42. As the competing trade marks are identical, it is not necessary (as would normally be the case) for me to assess the distinctive character of the earlier trade mark.

Likelihood of confusion

43. In determining whether there is a likelihood of confusion, 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 services and vice versa, must be kept in mind.

44. Earlier in this decision I concluded that the competing trade marks are identical and that the services identified in paragraph 35 are similar to the some of the opponent's services to at least a low degree. Having applied the interdependency principle mentioned above to those conclusions, I am satisfied that in relation to the named services there is a likelihood of direct confusion and the opposition based upon section 5(2)(a) of the Act against these services succeeds accordingly.

Conclusion under section 5(2)(a) of the Act

45. The opposition succeeds in relation to: Entertainment in the nature of fashion shows; Organizing and presenting displays of entertainment relating to style and fashion; Organisation of fashion shows for entertainment purposes; Fashion shows for entertainment purposes (organization of).”

Comments on the applicant's evidence

46. Although the applicant has filed evidence to demonstrate that it has used its trade mark, any use it may have made does not assist it for the reasons explained in Tribunal Practice Notice (“TPN”) 4/2009 (the relevant part of which appears below):

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

Overall conclusion

47. The opposition based upon either section 5(1) or 5(2)(a) of the Act has succeeded in relation to:

Class 35 - Fashion show exhibitions for commercial purposes; Organisation of fashion shows for commercial purposes; Fashion shows for promotional purposes (Organization of -).

Class 41 - Entertainment in the nature of fashion shows; Organizing and presenting displays of entertainment relating to style and fashion; Organisation of fashion shows for entertainment purposes; Fashion shows for entertainment purposes (Organization of -);

But failed in relation to:

Class 41 – Education services relating to fashion; Beauty contests (arranging of-); Beauty contests (conducting of-); Beauty contests (organising of-); Modelling services for artists; Education services relating to modelling.


Costs

48. Although both parties have achieved a measure of success, as the opponent has been more successful than the applicant, it is, in my view, entitled to an award of costs. Awards of costs are governed by Annex A of TPN 4 of 2007. Using that TPN as a guide, but reducing any award (other than in relation to expenses) on a “rough and ready” basis to reflect the extent of the applicant’s success and bearing in mind that the opponent has represented itself, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£150
Filing of written submissions (including considering and commenting upon the applicant’s evidence):	£250
Expenses:	£100
Total:	£500

49. I order FSI Events Ltd to pay to Fashion One Television Limited the sum of **£500**. 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 23RD day of January 2017

A handwritten signature in black ink, appearing to be 'C J Bowen', written in a cursive style.

C J BOWEN
For the Registrar