O/1150/25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO.3918468

BY CHAMELEON CAPITAL LIMITED

TO REGISTER

Bare by Vogue

AS A TRADE MARK

IN CLASS 3

AND OPPOSITION THERETO (UNDER NO.443932)

BY

ADVANCE MAGAZINE PUBLISHERS INC

Background & Pleadings

1. Chameleon Capital Limited ("the applicant") applied for the trade mark **Bare by Vogue** on 2 June 2023. It was published for opposition purposes on 1 September 2023 in class 3 for the following goods:

> *3: After sun moisturisers; artificial tanning preparations; balms for the skin and for the body; colour cosmetics for the skin; cosmetic preparations adapted for sun-tanning; cosmetic preparations for skin tanning; cosmetic preparations for tanning the skin; cosmetic preparations for use in giving a sun-tan effect; cosmetic sun-tanning preparations; cosmetics for bronzing the skin; cosmetics for skin tanning; cosmetics for suntanning; creams for tanning the skin; creams, lotions and balms for the skin and for the body; exfoliating scrubs for the skin and body; lotions, creams, oils and sprays to prevent tanning and burning from the sun; self-tanning creams [cosmetic]; self-tanning creams; self-tanning lotions [cosmetic]; self-tanning lotions; self-tanning mists; self-tanning preparations; self-tanning lotions, creams, mousse and gels; self-tanning preparations [cosmetics]; skin care preparations; sun block; sun protection preparations; sun screen; sun screening preparations; sun tan accelerator products and preparations; sun tan gel; sun tan lotion; sun tan oil; sun tanning preparations; sunscreen preparations; sunscreens [for cosmetic use]; sunscreens; suntan creams [self-tanning creams]; suntan lotion; suntan milk; suntan oils; suntan preparations; sun-tanning creams; sun-tanning gels; sun-tanning lotions; sun-tanning oils; sun-tanning preparations [cosmetics]; sun-tanning preparations; tan lotions; tanning compositions; tanning creams; tanning oils; tanning preparations; tanning removing preparations.*

2. Advance Magazine Publishers Inc ("the opponent") opposed the application under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") on the basis of the following two earlier registrations.[1] The goods and services relied on by the opponent under sections 5(2)(b) and 5(3) are set out in Annexes 1-3 of this decision.

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[1] In the Notice of Opposition, the opponent initially relied on a third earlier registration namely UK TM No.909944547 but this was withdrawn by the opponent in its skeleton argument.

UK TM No.3669733	UK TM No.3734858
VOGUE Filing date: 16 July 2021 Registration date: 26 November 2021	**VOGUE** Filing date: 20 December 2021 Registration date:29 April 2022

3. Under section 5(2)(b) the opponent relies on UK TM No. 3669733 and claims that the respective goods and services are highly similar and that the respective marks are similar. As such there exists a likelihood of confusion, including a likelihood of association.

4. Under section 5(3) the opponent relies on both UK TM Nos. 3669733 and 3734858 and claims that the application would take unfair advantage of, and be detrimental to, the distinctive character of opponent's marks. In addition, the opponent claims that the application would free ride on the opponent's reputation which would lead to tarnishment and dilution of the distinctive character of the opponent's earlier registrations.

5. The registrations relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. Neither of the earlier marks completed their registration procedure more than five years prior to the application date of the contested mark. The opponent is only relying on UK TM No. 3669733 under section 5(2)(b), as such that mark is not subject to the proof of use conditions, as per section 6A of the Act.

6. The applicant filed a counterstatement in defence of the application and denied all grounds of opposition and put the opponent to proof of its claims.

7. Both sides have been professionally represented during these proceedings. The applicant has been represented by Briffa and the opponent by Stobbs.

8. Only the opponent filed evidence during the proceedings and a hearing was requested. I heard the matter on 27 March 2025, via video conference. The applicant was represented by Ms Iona Berkeley of Counsel, instructed by Briffa. The opponent was represented by Mr Julius Stobbs of Stobbs.

9. I make this decision based on a reading of all the material before me and the submissions made at the hearing.

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts that predate the UK's withdrawal from the EU.

Section 5(2)(b)

11. Section 5(2)(b) of the Act reads as follows:

> "5 (2) A trade mark shall not be registered if because -
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> […]
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> (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,
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> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

12. Section 5A is also relevant and reads:

> "5A. […] Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only".

13. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

14. In *Canon*[2], the Court of Justice for the European Union (CJEU) stated at paragraph 23 of its judgment:

"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."

15. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case)[3], where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;

[2] *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97
[3] [1996] R.P.C. 281

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

16. In addition I find the following case law to be useful in these proceedings where in *Oakley, Inc v OHIM*,[4], the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

17. In *Tony Van Gulck v Wasabi Frog Ltd*[5], Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

> "9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for

[4] Case T-116/06, at paragraphs 46-57

[5] Case BL O/391/14

determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

18. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM,* Case T-105/05*,* at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

19. The goods and services to be compared are set out in the following table. In its skeleton argument, the opponent set out the services, taken from its earlier registration no.3669733, which it claimed represented its best case. I have reproduced these services below.

Opponent's services	**Applicant's goods**
35: Provision of space in magazines, electronic publications, magazines and websites for advertising goods and services; retail services, mail order services and wholesaling services in connection with the provision of the following, perfumery, cosmetics, beauty products, personal care products, products for the care and appearance of the body, hair, skin, nails, fashion and clothing accessories.	*3: After sun moisturisers; artificial tanning preparations; balms for the skin and for the body; colour cosmetics for the skin; cosmetic preparations adapted for sun-tanning; cosmetic preparations for skin tanning; cosmetic preparations for tanning the skin; cosmetic preparations for use in giving a sun-tan effect; cosmetic sun-tanning preparations; cosmetics for bronzing the skin; cosmetics for skin tanning; cosmetics for suntanning; creams for tanning the skin; creams, lotions and balms for the skin and for the body; exfoliating scrubs for the skin and body; lotions, creams, oils and sprays to prevent tanning and burning from the sun; self-tanning creams [cosmetic]; self-tanning creams; self-tanning lotions [cosmetic]; self-tanning lotions; self-tanning mists; self-tanning preparations; self-tanning lotions, creams, mousse and gels; self-tanning preparations [cosmetics]; skin care preparations; sun block; sun protection preparations; sun screen; sun screening preparations; sun tan accelerator products and preparations; sun tan gel; sun tan lotion; sun tan oil; sun tanning preparations; sunscreen preparations; sunscreens [for cosmetic use]; sunscreens; suntan creams [self-tanning creams]; suntan lotion; suntan*

	milk; suntan oils; suntan preparations; sun-tanning creams; sun-tanning gels; sun-tanning lotions; sun-tanning oils; sun-tanning preparations [cosmetics]; sun-tanning preparations; tan lotions; tanning compositions; tanning creams; tanning oils; tanning preparations; tanning removing preparations.

20. The applicant's goods in class 3 all relate to tanning or bronzing preparations in different forms (i.e. creams, gel, oil and sprays) for the skin. The opponent has retail services for cosmetics, beauty products, personal care products, products for the care and appearance of the body and skin. In the opponent's skeleton argument, I was referred to *Oakley* in that I can find that retail services for particular goods may be complementary to those goods, being distributed through the same trade channels, and therefore similar to a degree. The opponent also stated that it is not uncommon for a producer of cosmetic products to also retail such products in a physical premises or using a concessionary arrangement in a large retail facility. Taking the complementarity of retail services and goods into account, I find that the opponent's retail services are similar to a low degree to the applicant's class 3 goods.

Average Consumer

21. I next consider who the average consumer is for the contested goods and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect[6]. 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[7].

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[6] *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)
[7] *Lloyd Schuhfabrik Meyer,* Case C-342/97.

22. The average consumer for the contested goods is the general public. The contested goods are a reasonably frequent and a relatively inexpensive purchase. I find the purchasing public will pay a medium to high degree of attention when purchasing, as class 3 goods will be applied to the skin, so care will be taken in consideration of constituent ingredients, allergens and possibly even the method of production (e.g. cruelty free products) as well as the aesthetic considerations of fake tan and bronzing products. Purchasing will be primarily visual as consumers will examine the goods in either a bricks and mortar retail environment or an online equivalent website. But I do not discount any aural considerations such as word of mouth recommendations or advice from sales staff.

Mark comparisons

23. 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 *Bimbo SA v OHIM*[8], 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."

24. It would be wrong, therefore, to artificially 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.

25. The respective trade marks to be compared are:

[8] Case C-591/12P

Opponent's earlier registration	Applicant's mark
VOGUE	Bare by Vogue

26. The opponent's earlier registration consists of a single word **VOGUE** in capital letters. The registration has no other aspect to it and the overall impression is derived solely from this word.

27. The applicant's mark consists of three words **Bare by Vogue** in title case. The mark has no other aspect to it. In its skeleton arguments the opponent drew my attention to a previous Registry decision[9] in which the word "bare" was considered in relation to cosmetics. The conclusions drawn in that decision were that the word "bare" when applied to cosmetics would be seen by consumers as providing a natural or bare faced appearance. I find that to be a reasonable finding in relation to cosmetic products and would make the same finding here that **Bare** is weaker in distinctiveness. Taking that factor into account, the third word **Vogue** will make the greater contribution to the overall impression with the words **Bare by** making a lesser contribution.

28. In a visual comparison the word in common to the respective marks is **Vogue** which is the entirety of the opponent's earlier registration and the last word in the applicant's three-word mark. The points of difference occur with the addition of the words **Bare by** at the beginning of the applicant's mark. In the applicant's skeleton argument, my attention was drawn to the settled case law[10] in which it was accepted that the consumers pay more attention to the beginnings of marks than the ends. I understand the point made by the applicant, but I also have to consider that the words at the beginning of the contested mark are less distinctive than the word that the respective marks share. Overall I find there is a medium degree of visual similarity

29. In an aural comparison the shared word **Vogue** will be pronounced identically in each case. The additional words in the applicant's mark, **Bare by**, are regular

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[9] *Bareface Cosmetics Limited* v *Shiseido Americas Corporation* BL O/061/21
[10] Case T-34/04 *Plus Warenhandelsgesellschaft mbh v OHIM* (CFI) [2006] ETMR 67 at [56]

dictionary words and will be given their usual pronunciations. Overall I find there is a medium degree of aural similarity.

30. In a conceptual comparison, the word **Vogue** will likely bring to mind its usual dictionary meaning of something which is the prevailing fashion at a particular time. This will be the same for the respective marks. The additional word **Bare** in the applicant's mark, in relation to cosmetics, is likely to bring to mind the concept of something that is natural looking. In grammatical terms the meaning of the preposition **by** in an English phrase or sentence structure shows that something has been produced by the action of something or someone else. I think that is the concept consumers will bring to mind here. In my view a consumer seeing **Bare by Vogue** will take it to mean that **Bare** is related to or has been produced by **Vogue.**

31. The shared **VOGUE** element gives the respective marks a medium degree of conceptually similarity.

Distinctive character of the earlier mark

32. The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion between it and the contested mark (*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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
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> 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)."

33. I will first consider the inherent distinctiveness of the earlier registration **VOGUE.** The mark is a recognised dictionary word but has no meaning in relation to its registered services. As such I find that the mark has a medium degree of inherent distinctiveness.

34. I next consider whether the opponent can claim enhanced distinctiveness of its earlier mark, because of the use made of it. The relevant market I must consider is the UK and I bear in mind the *Chiemsee* factors given above. Although evidence of genuine use was not provided in this case, I have examined the evidence provided for the earlier registration no. 3669733 under the section 5(3) ground of opposition.

35. In Mr Eric Gisolfi's witness statement of 12 April 2024, he states that **VOGUE** has been in use as a magazine title in the UK since 1916. The magazine has features on culture, fashion, lifestyle and beauty. In 2022 British Vogue had an online and print readership of 796k.[11] In relation to the class 35 services identified by the opponent as its best case, I note that the VOGUE website does have provision for retail services of third party products such as clothing, sunglasses and handbags.[12] Specifically in relation to beauty products, Mr Gisolfi provides evidence of the annual Vogue Beauty awards,[13] the annual Five Days of Beauty event,[14] and access to "Vogue Insider" being a beauty club membership scheme for readers to join for access to curated content.[15]

[11] Exhibit EG3
[12] Exhibit EG11
[13] Exhibit EG19
[14] Exhibit EG20
[15] Exhibit EG22

Although no turnover figures or market share have been provided for the specific retail services in relation to beauty products, I find that the opponent's mark as a magazine title is probably the best known of all such publications relating to fashion, beauty and style as evidenced by its long publishing history and by its readership totals. Taking this into account I find that the distinctiveness of the opponent's mark has been enhanced by use to a high degree.

Likelihood of confusion

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The factors are interdependent and include the principle that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's registrations, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alert to 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 that they have retained in their mind.

37. So far in this decision, I have found that:

- The opponent's services are considered complementary to the applicant's goods and similar to a low degree.
- The purchasing process is predominantly visual but I do not discount and aural aspect. The degree of attention paid during purchasing process is medium to high.
- There is a medium degree of visual and aural similarity between the respective marks.

- There is a medium degree of conceptual similarity for the shared VOGUE element.
- The earlier registration is inherently distinctive to a medium degree but has been enhanced through use to a high degree.

38. The word in common to both marks is **VOGUE** and it is the most distinctive element of the applicant's mark. However I note that **VOGUE** is the third of a three word mark and whilst **Bare by** are weaker is distinctiveness, they are not negligible in the construction of the mark and it is my view that an average consumer would recall them and would not directly confuse the marks, i.e. to mistake one mark for the other.

39. As I did not find a likelihood of direct confusion, I will go on to consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*,[16] Mr Iain Purvis Q.C., sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
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> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

[16] Case BL O/375/10.

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

40. I bear in mind that the categories listed above in *L.A. Sugar* are not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it could or tends to occur.

41. If the additional word elements, namely **Bare by**, are recalled, then to my mind they would be seen as consistent with a brand extension or sub-brand. These words elements are weakly distinctive in relation to cosmetic skin products and fall into at least two of the sub-categories set out above. The average consumer will perceive **VOGUE** as the distinctive element of the respective marks and see the **Bare by Vogue** brand coming from the opponent's stable, i.e. a new range of cosmetics to create a natural appearance from an entity which has a connection to beauty retail. Consequently, I find there is a likelihood of indirect confusion for those services.

42. The opposition brought under section 5(2)(b) succeeds in full.

Section 5(3)

43. Under section 5(3), the opponent relied on both of its earlier registrations. However at the hearing, the opponent submitted that its best case for reputation lay in electronic publications and related goods for class 9 and publishing and entertainment content in class 41.[17] These goods and services are covered by earlier registration no. 3734858 in Annex 3 of this decision.

44. Section 5(3) of the Act provides, as follows:

> "(3) A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
>
> (3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

45. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (CJEU): *General Motors Corporation v Yplon SA*, C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel Corporation, Inc. v CPM United Kingdom Limited,* 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.,* C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L'Oréal & Ors v Bellure & Anor*, C-487/07, EU:C:2009:378, [2009] ETMR 55; *Interflora & Anor v Marks & Spencer & Anor*, C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, C-383/12P, EU:C:2013:741. The law appears to be as follows:

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[17] Hearing transcript, page 3.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public: G*eneral Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness: *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future: *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors: *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark: *L'Oréal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future: *Intel,* paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character: *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: *L'Oréal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it: *L'Oréal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure).*

46. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its registrations and the application are similar. Secondly, the opponent must show that its registrations have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier registrations being brought to mind by the contested mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the

relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

47. The first hurdle that the opponent must overcome under section 5(3) of the Act is to show that the earlier mark had a reputation in the UK on the date that the applicant's mark was filed. The relevant date in these proceedings is, therefore, 2 June 2023. If the evidence does not establish the existence of a reputation on the relevant date in respect of the earlier mark, the opponent's case must fail. This is because, without a qualifying reputation, there can be no link made in the consumer's mind between the contested mark and the earlier mark nor can there be any unfair advantage taken of, or damage to, the same.

48. In *General Motors,* the CJEU gave guidance on what is required to establish the necessary reputation:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

49. The evidence provided has established that VOGUE is a longstanding publication which covers a variety of topics and articles but in his witness statement Mr Gisolfi

states that VOGUE magazine is referred to as the “fashion bible”. The selection of its cover stars is frequently considered noteworthy in the media. I note its readership circulation of 796k in 2022,[18] and its annual print and digital copies reaching several hundred thousand between 2016 and 2023.[19] I note that in addition to its online magazine and book publishing, the opponent also has a daily and weekly newsletter option for readers to sign up to, although no figures are given for take up of these newsletters.[20] The newsletters are said to include fashion and beauty tips. Taking all this into account I find that the opponent has demonstrated the required reputation.

Link

50. As noted above, the assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* underlined below are:

The degree of similarity between the conflicting marks

51. Previously in this decision, I found that the respective marks are visually and aurally similar to a medium degree and conceptually similar to a medium degree for the shared word VOGUE.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

52. The contested goods are cosmetic products for the skin. They will be purchased by the general public paying a medium to high degree of attention. The opponent’s services are for publishing of content relating to fashion and beauty. The degree of closeness between the respective goods and services is perhaps less than would be the case for retail, but nevertheless I find there will be an overlap of users reading content about beauty products and using beauty products. There is also likely to be an overlap in trade channels.

[18] Exhibit EG3
[19] Eric Gisolfi witness statement, paragraph 10
[20] Exhibit EG9

The strength of the earlier marks' reputation

53. The earlier marks have established a reasonable reputation for publishing content relating to fashion and beauty.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

54. The earlier marks are inherently distinctive to a medium degree. Given the use which has been made of the earlier marks, I find that their distinctiveness has been enhanced to a high degree.

Whether there is a likelihood of confusion

55. I found there to be a likelihood of indirect confusion.

56. Therefore, in addition to finding a likelihood of confusion, I find that the public will make a link between the marks for these goods.

Damage

57. I next assess whether any of the pleaded types of damage will arise.

58. I bear in mind that unfair advantage has no effect on the consumers of the goods of the earlier marks, but instead the taking of unfair advantage of the reputation and distinctive character of earlier marks means that consumers are more likely to purchase the goods and services of the later mark than they would otherwise have done if they had not been reminded of the earlier marks.

59. In *Jack Wills Limited v House of Fraser (Stores) Limited,*[21] Arnold J. (as he then was) considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice

[21] [2014] EWHC 110 (Ch)

> interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

60. As set out above, I found sufficient evidence that the opponent enjoys a reputation for its publishing content relating to fashion and beauty. I find therefor that there is the potential for the applicant to gain an unfair advantage, as per the opponent's claim, which would be a commercial advantage, benefitting from the opponent's reputation without paying financial compensation and would therefore be creating an association with the earlier marks. To my mind, it is reasonable to find a consumer may think that the contested mark for beauty/skin related goods has a link, i.e. an economic connection, to the opponent's publications which have a reputation for content about beauty products.

61. As damage is made out on the basis of unfair advantage, it is not necessary for me to go on and consider the other heads of damage.

62. The opposition claim brought under section 5(3) succeeds in full.

Overall conclusion

63. The opposition succeeds in full and, subject to any appeal of this decision, the application will be refused registration.

Costs

64. The opponent has been successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the TPN, I award costs as follows:

£200	Official fee
£500	Preparing a notice of opposition and considering the counterstatement
£800	Preparing evidence
£800	Preparing for the hearing
£2300	**Total**

65. I order Chameleon Capital Limited to pay Advance Magazine Publishers Inc the sum of £2300. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of December 2025

June Ralph
For the Registrar
The Comptroller-General

Annex 1
Services relied on by opponent under section 5(2)(b) for earlier registration no. 3669733

35: Distribution of samples; purchasing services; retail services, mail order services and wholesaling services in connection with the provision of the following, perfumery, cosmetics, cleaning products, beauty products, personal care products, products for the care and appearance of the body, hair, skin, nails and teeth, healthcare products, general pharmacy products, communications products, computing products, optical, photographic, electronic and electrical products, films, videos, audio, visual and audio-visual recordings and products, games, toys and entertainment products, clothing, footwear, headgear, fashion and clothing accessories, textiles, household linen goods, fashion products, luggage and bags, publications, printed materials, stationery, gift items, toys, games, sports equipment, jewellery, horological instruments, household equipment and utensils, furniture and furnishings, foods and grocery products and beverages; organisation and management of business incentive and loyalty schemes; administrative processing and organising of mail order services; information, advice and assistance relating to all the aforesaid; including (but not limited to) all the aforesaid services provided online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless communication networks.

Annex 2

Services relied on by opponent under section 5(3) for earlier registration no. 3669733

35: Advertising, marketing, promotion, public relations, endorsement and publicity services; business management; business administration; office functions; business introduction services; representation and agency services for artists, writers, actors, models, performers, photographers and others involved in the entertainment, fashion and media industries; dissemination of advertising, marketing, promotion, public relations, endorsement and publicity materials; compilation and transcription of data; compilation of advertisements for use as web pages on the Internet; compilation of directories; provision of space in publications, electronic publications, magazines and websites for advertising goods and services; advertising, marketing and promoting goods and services by distribution and transmission of advertisements including advertisements in the nature of audio, video, text messages and emails via wireless and mobile devices; distribution of samples; market research services; organization of fairs and trade shows for business, advertising and promotion purposes; auctioneering services; business information, research, assistance and advice; accountancy services; data-processing services; personnel and human resource services; recruitment services; purchasing services; retail services, mail order services and wholesaling services in connection with the provision of the following, perfumery, cosmetics, cleaning products, beauty products, personal care products, products for the care and appearance of the body, hair, skin, nails and teeth, healthcare products, general pharmacy products, communications products, computing products, optical, photographic, electronic and electrical products, films, videos, audio, visual and audio-visual recordings and products, games, toys and entertainment products, clothing, footwear, headgear, fashion and clothing accessories, textiles, household linen goods, fashion products, luggage and bags, publications, printed materials, stationery, gift items, toys, games, sports equipment, jewellery, horological instruments, household equipment and utensils, furniture and furnishings, foods and grocery products and beverages; organisation and management of business incentive and loyalty schemes; administrative processing and organising of mail order services; arranging of business introductions; business research and survey services; business forecasting services; provision of business,

clerical and secretarial services; news and current affairs clippings services; provision of information and advice to prospective purchasers of goods and services; answering and message handling services; operation of telephone call centres; managing remote monitoring centres; data management and electronic stocktaking services; information, advice and assistance relating to all the aforesaid; including (but not limited to) all the aforesaid services provided online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless communication networks.

Annex 3

Goods and services relied on by the opponent under section 5(3) for earlier registration no. 3734858

Class 9: media content; downloadable image files; downloadable videos; audio visual recordings; computer application software for streaming audio-visual media content via the internet; computer programs and software for image processing used for mobile phones; computer software applications, downloadable; computer software applications; computer software for organizing and viewing digital images and photographs; data processing software for graphic representations; downloadable publications; downloadable magazines; downloadable digital content in the form of electronic publications of magazines; printed publications in electronically readable form; podcasts; audiobooks; electronic publications; downloadable virtual goods, namely, downloadable content featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness for use online and in the online virtual worlds.

Class 35: Advertising; business management, organization and administration; licensing of the goods and services of others (commercial administration of the -); administration (commercial -) of the licensing of the goods and services of others; organization of art exhibitions for commercial or advertising purposes; promoting the artwork of others by means of providing online portfolios via a website; retail services in relation to works of art; advertising and marketing services provided by means of social media; advertising and marketing services; online marketing; planning of marketing strategies; product marketing; providing online marketplaces for sellers of goods and or services; artists (business management of performing -); arranging and conducting of exhibitions for business purposes; arranging and conducting of commercial exhibitions and shows; arranging and conducting auctions; arranging and conducting of internet auctions; auctioneering; auctioneering services; on-line auction bidding for others; on-line auctioneering services via the internet; organisation of internet auctions; electronic publication of printed matter for advertising purposes; retail and online retail services in relation to downloadable publications, downloadable magazines, downloadable digital content in the form of electronic publications of magazines, printed publications in electronically readable

form, podcasts, audiobooks, electronic publications, downloadable virtual goods, namely, downloadable content featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness for use online and in the online virtual worlds; retail and online retail services in relation to publications, clothing, footwear, headgear; providing an online marketplace for display, exhibition, sale, purchase, exchange, and transfer of non-fungible tokens (NFTs) and digital collectibles; providing digital collectible services, namely, operating an online marketplace for transactions and registry services using blockchain-based software technology and smart contracts for digital collectibles; retail and online store services featuring virtual goods, namely downloadable content featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; online retail store services featuring virtual merchandise in the fields of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; information, advisory and consultancy services relating to the aforesaid.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; virtual reality arcade services; museums; museum exhibitions; museum services; providing museum facilities; gallery services (art-); cultural, educational or entertainment services provided by art galleries; art gallery services; rental of artwork; organisation of artistic competitions; organizing cultural and arts events; arranging of exhibitions for cultural or educational purposes; art exhibition services; art exhibitions; exhibition of video films; fashion shows; providing on-line non-downloadable images; electronic publication of texts and printed matter, other than publicity texts, on the internet; multimedia publishing; electronic publication services; non-downloadable electronic publications; on-line publication of electronic books and journals; publication and editing of printed matter; publication of electronic magazines; publication of electronic books and periodicals on the internet; providing electronic publications; publication of printed matter and printed publications; production of radio and television programmes; providing online electronic publications, not downloadable; publication of texts, other than publicity texts; publication of magazines in the field of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness including online publication; online publication of electronic magazines, namely in the field of

clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; arranging for ticket reservations for shows and other entertainment events; entertainment ticket agency services; ticket reservation for cultural events; ticket reservation and booking services for education, entertainment and sports activities and events; ticketing and event booking services; arranging and conducting competitions; arranging of competitions for educational purposes; arranging of competitions for entertainment purposes; arranging of competitions for cultural purposes; entertainment services relating to competitions; organisation of conferences, exhibitions and competitions; services for the organisation of competitions; audio, video and multimedia production, and photography; film production; film production for educational purposes; film production for entertainment purposes; film production services; television production; television production for education purposes; television production for entertainment purposes; television production services; live entertainment production services; live show production services; production of films; provision of exhibitions via virtual reality and augmented reality; virtual reality entertainment services; entertainment and educational services, namely, ongoing multimedia programs in the field of general interest, clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness distributed via various platforms across multiple forms of transmission media; providing ongoing video series in the field of general interest, clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; providing over the top (ott) entertainment programming in the fields of clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; podcasting services, namely, providing podcasts featuring clothing, design, lifestyle, fashion, couture, culture, technology, food, cooking, travel, current events, health and fitness; media production services, namely, video and film production; multimedia entertainment services in the nature of development, production, post-production and distribution services in the fields of video and films; television, film and audiovisual studios; information, advisory and consultancy services relating to the aforesaid.