

O-081-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2550985
BY VINTAGE ENTERTAINMENT LIMITED
TO REGISTER THE TRADE MARK**

VINTAGE TV

IN CLASSES 9, 16, 35, 38 & 41

AND:

**OPPOSITION THERETO UNDER NO. 101443
BY VINTAGE BY HEMINGWAY LTD**

BACKGROUND

1. On 18 June 2010, Vintage Entertainment Limited (“VEL”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 22 October 2010 for the following goods and services:

Class 9: Computer hardware; computer game programs; computer game cartridges and discs; apparatus for recording, transmission or reproduction of sound or images; video and audio tapes, compact discs, DVDs; recording discs and tapes; computer and video games; magnetic data carriers; recorded media; decorative magnets; downloadable electronic publications; digital music; mouse pads.

Class 16: Paper, cardboard and goods made from these materials; printed matter; stationery, books, newspapers, magazines, newsletters, periodicals, posters, stickers, transfers, decals, pens, pencils, pencil sharpeners, erasers, pen and pencil cases, note books, papers, envelopes, diaries, address books, art prints, cards, postcards, gift cards, greeting cards, calendars, paintings, photographs, writing paper, writing implements; packaging materials.

Class 35: Advertising; electronic data storage; advertising services provided via the Internet; production of television and radio advertisements; retail services connected with the sale of musical recordings, articles of clothing, motor vehicles and ornamental objects.

Class 38: Radio and television broadcasting; communications and telecommunications; interactive broadcasting and communications services; electronic mail services; provision of access to world wide web facilities and structures; communications for access links to databases and computer networks; digital communications services; networking of television programmes, films, animated films, sound and video recordings; information and advisory services relating to all of the aforesaid services.

Class 41: Organisation, production, presentation, distribution, syndication and rental of television programmes, films, animated films, sound and video recordings; entertainment; sporting and cultural activities; education, cultural and entertainment services by or relating to television or radio; film, music, sport, video and theatre entertainment services; production of live entertainment features and of television features; organisation, production and presentation of events for educational, entertainment, sporting and cultural purposes; organisation, production and presentation of games, competitions, contests, sporting events, sporting tournaments, exhibitions, quizzes, sporting events, concerts, road shows, staged events, live performances, music concerts, live music performances, music in the form of archives, musical reviews; organisation, production and conducting of exhibitions, conferences, seminars,

workshops, training courses, symposiums, congresses and colloquiums; publishing services; publication of books, training manuals, periodical publications, magazines, newspapers and newsletters; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; production and presentation of interactive entertainment, CDs, CD-ROMs and computer games; information relating to education, entertainment, sporting and cultural events provided on-line from a computer database or the Internet; reservation and booking services for educational, entertainment, sporting and cultural events; information and advisory services relating to all of the aforesaid services.

2. On 21 January 2011, Vintage At Limited (now, following assignment, Vintage By Hemingway Limited (“VBH”)), filed a notice of opposition directed against all of the goods and services in VEL’s application. VBH’s opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which it relies upon trade mark registration no. 2540073 of the trade mark:



This trade mark was applied for on 24 February 2010 and completed its registration procedure on 9 December 2011. VBH relies upon the following goods and services:

9 - Magnetic data carriers, recording discs, carriers and storage media including records, circuits, discs, wires, tapes, film, cassettes, cartridges, fibres and cards bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs or information; software and programs including downloadable programs and computer programs; amusement apparatus, equipment and instruments; games; optical apparatus and instruments; goggles, eye glasses, sunglasses, spectacles and lens including contact lenses; frames, containers, cases and accessories therefor; publications (downloadable) provided on-line from databases, from the internet or from any other communications network including wireless, cable or satellite.

16 - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; magazines, publications, books, newspapers, news sheets and newsletters; pamphlets, booklets, catalogues, guides, programs, directories, brochures and manuals; bookmarks; diaries, calendars, address books; posters, photographs, pictures, paintings, drawings (graphic), calligraphic works; photograph holders (other than frames), stamps, seals and sealing wax; cards, greeting cards, post cards, trading cards; transfers

(decalcomanias), stickers; albums, scrapbooks, yearbooks; atlases, maps, plans, globes; stands and holders for photographs and pictures; bags and containers, packaging and wrapping materials; writing, painting and drawing instruments, easels, drawing boards, canvases for painting, pallets for painters; pencils, pens, light-up pens, crayons, pastels, paintbrushes; erasers; rulers; pencil sharpeners; pen and pencil boxes and cases; pen and pencil holders; blotters; stencils; labels, envelopes, notepaper, writing pads, notepads, notebooks, sketchbooks; binders, folders, covers; figurines (statuettes) of papier mache, paperweights, bookmarks, coasters; instructional and teaching materials, writing machines, office machines and typewriters; printing and artists' materials; printing, drawing and painting sets; staplers and staples; office requisites; handkerchiefs, tissues, diapers, napkins, cloths, tablecloths and towels; flags, rosettes, pennants; bunting and banners made from paper and cardboard; printed computer programs; paper, tape and cards for use in data processing; tickets, badges; vouchers, cards, notes, cheques, orders, certificates, passes and tokens; time and date stamping machines; signboards made of cardboard and paper; folders of paper and card; money clips; parts and fittings for all the aforesaid goods.

35 - Advertising; business management; business administration; office functions; organisation and management of incentive and loyalty schemes; business services relating to the provision of sponsorship; marketing, promotion and publicity organisation, advice, consultancy and information services; mail order services; connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery and printed matter, publications, leather goods, luggage, bags, umbrellas, equestrian articles, furniture, household containers and utensils, furnishings, textiles, clothing and clothing accessories, footwear, headwear, haberdashery, toys and games, sports equipment, small items of metal-ware, ornaments, mobels and figurines, decorative and commemorative plaques and plates, games and playthings; business referral services; market and marketing research; arranging and conducting of exhibitions for business purposes; retail services including through shops, catalogues and on-line, connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery and printed matter, publications, leather goods, luggage, bags, umbrellas, equestrian articles, furniture, household containers and utensils, furnishings, textiles, clothing and clothing accessories, footwear, headwear, haberdashery, toys and games, sports equipment, small items of metal-ware, ornaments, mobels and figurines, decorative and commemorative plaques and plates, games and playthings; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery and printed matter, publications, leather

goods, luggage, bags, umbrellas, equestrian articles, furniture, household containers and utensils, furnishings, textiles, clothing and clothing accessories, footwear, headwear, haberdashery, toys and games, sports equipment, small items of metal-ware, ornaments, mobels and figurines, decorative and commemorative plaques and plates, games and playthings; auctioneering; compilation, transcription, reproduction of data; compilation of advertisements including for use as web pages on the internet; compilation of directories; provision of space on websites for advertising goods and services; database and data processing services; data management and stock taking; subscription services; provision of market and office facilities; organisation, arrangement, management and officiation at and hosting of shopping markets and shopping fayres; information, consultancy and advise relating to the aforesaid.

38 - Telecommunications services; chat room services; portal services; email services; providing use or access to the Internet; radio and television broadcasting.

41 - Education; providing of training; entertainment; on-line entertainment; sporting and cultural activities; electronic games services provided by means of the Internet; the provision of on-line electronic publications; services for writing, composition, preparation, production, promotion, distribution, direction, presentation, conducting, exhibition, rental and performance of educational, cultural and entertainment events both live and recorded, indoor and outdoor and over the Internet; provision of recreational and sporting facilities; publishing; entertainer services; organisation, arrangement, management, officiation at and hosting of events, sporting events, races, rodeos, competitions, shows, games, quizzes, pageants, ceremonies, functions, tournaments, wine tastings, awards, contests, festivals, galas, parties, dances, balls, meets, meetings, circuses, concerts, recitals, roadshows, displays, product launch parties, fayres, musical performances, exhibitions, conventions, seminars, workshops, congresses, symposia and conferences; cultural, entertainment and recreation services; library services; booking seats for entertainment events and shows; ticket agency; provision of recreational park and outdoor facilities; press cutting services; information advice and consultancy relating to the aforesaid.

3. On 1 April 2011, VEL filed a counterstatement in which the basis of the opposition is denied.

4. Neither party filed evidence, asked to be heard or filed submissions in lieu of attendance at a hearing. As the only comments I have from the parties are contained in their respective notice of opposition/counterstatement, I will refer to these comments as necessary below.

DECISION

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

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

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

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

6. 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.”

7. In these proceedings VBH is relying upon the trade mark shown in paragraph 2 above which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which VEL’s application was published i.e. 22 October 2010 and the date on which VBH’s application completed its registration procedure i.e. 9 December 2011, VBH’s registration is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

8. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

9. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services and then to determine the manner in which these goods and services will be selected by the average consumer in the course of trade. VBH say:

“The average consumer of [VEL's] goods and services is a person interested in viewing/hearing music from the 60s, 70s, 80s and 90s via a television channel. The average consumer of [VBH's] goods and services is a person interested in vintage fashion, lifestyle and music, including music from the 40s, 50s, 60s, 70s and 80s...”

VEL say:

“10. [VBH] is incorrect in its narrow characterisation of the average consumer of [VEL's] goods and services...It is also incorrect in its narrow characterisation of the average consumer of its own goods and services...”

11. The average consumer of [VEL's] goods and services will be members of the general public, save that in relation to the following services the average consumer may be also or solely a business:

- a. Advertising;...advertising services provided via the Internet; production of television and radio advertisements (class 35);
- b. ...networking of television programmes, films, animated films, sound and video recordings (class 38);
- c. ...publishing services (class 41).

12. The average consumer for [VBH's] goods and services is a member of the general public, save that in relation to the following services the average consumer is also or solely a business:

Advertising; business management; business administration; office functions; organisation and management of incentive and loyalty schemes; business services relating to the provision of sponsorship; marketing, promotion and publicity organisation, advice, consultancy and information services; business referral services; market and marketing research; arranging and conducting of exhibitions for business purposes; auctioneering; compilation, transcription, reproduction of data; compilation of advertisements including for use as web pages on the internet; compilation of directories; provision of space on websites for advertising goods and services; database and data processing services; data management and stock taking; subscription services; provision of market and office facilities; organisation, arrangement, management and officiation at and hosting of shopping markets and shopping fayres; information, consultancy and advise relating to the aforesaid (class 35);

Services for writing, composition, preparation, production, promotion, distribution, direction, presentation, conducting, exhibition, rental and performance of educational, cultural and entertainment events both live and recorded, indoor and outdoor and over the Internet; publishing; organisation, arrangement, management, officiation at and hosting of events, sporting events, races, rodeos, competitions, shows, games, quizzes, pageants, ceremonies, functions, tournaments, wine tastings, awards, contests, festivals, galas, parties, dances, balls, meets, meetings, circuses, concerts, recitals, roadshows, displays, product launch parties, fayres, musical performances, exhibitions, conventions, seminars, workshops, congresses, symposia and conferences; cultural, entertainment and recreation services; press cutting services; information advice and consultancy relating to the aforesaid (class 41).

14. Selection of the goods and services at issue by the average consumer (whether a member of the general public or a business) will be dominated by visual considerations. In particular, in relation to (at least) the average consumer of television broadcasts, the choice to receive the relevant channel will be overwhelming based upon visual clues and the level of attention paid by the average consumer is likely to be high. The nature, character and quality of the visual and audio programming is inextricably linked to the programming reputation of (and the ability to accurately identify) the provider of the channel.”

10. Both parties' specifications include a wide range of disparate goods and services. While I agree with VEL that for the majority of these goods and services the average consumer will be a member of the general public, I also agree that for some of the goods and services VEL have identified above, the average consumer is more likely to be a business user. However, notwithstanding the wide ranging nature of the goods and services at issue, it is, as VEL suggests, likely that (as it is for many goods and

services) the selection process will be predominantly a visual one. Of course, that does not mean that aural considerations should be ignored and in relation to some goods and services aural considerations may take on greater significance. As to the degree of care the average consumer will take when selecting the goods and services at issue, this is also likely to vary widely. For example, a member of the general public is likely to pay a much lower degree of attention to the selection of a routine item of stationery, than would a business user wishing to engage a company to provide advertising services. In those circumstances, I do not intend to identify here the average consumer for the individual goods and services at issue or the manner in which these goods and services will be selected by the average consumer in the course of trade. I will, however, return to this issue later in this decision when I consider the likelihood of confusion.

Comparison of goods and services

11. VBH say:

“There is substantial overlap between the goods and services in all classes applied for by [VEL]. Where the goods/services are not identical, they are at least highly similar.”

12. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

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

13. In reaching a conclusion, I will also keep in mind the decision of the GC in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“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).”

14. In relation to complementary goods and services the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

15. And finally, insofar as the comparison of services are concerned, the comments of Jacob J in *Avnet Incorporated v Isoact Limited* - [1998] FSR 16 are relevant i.e:

“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.”

16. In its counterstatement, VEL identifies a number of what it describes as “examples” of goods and services in its application which it considers not to be similar to the goods and services in VBH’s registration. However, as it uses both the word “examples” and the phrase “but without limitation”, it would, I think, be unsafe for me to proceed on the basis that it accepts that the other goods and services not specifically mentioned in its counterstatement are either identical or similar to VBH’s goods and services.

17. In the tables below I have identified the goods and services in VEL’s application and, where appropriate, the goods and services in VBH’s registration in the

corresponding class which I consider to be either identical (either because the terms used are identical, because the terms used are alternative ways of saying the same thing or because the competing goods and services are identical on the principles outlined in *Meric*) or similar. Where I have not found the competing goods/services in the same class to be identical or similar, I have identified (where appropriate) other classes in VBH's registration where I consider similarity to exist. Where, in my view, no similarity exists, I have identified these services in bold.

Class 9

VEL's goods	VBH's goods
Computer hardware.	Amusement apparatus, equipment and instruments.
Computer game programs.	Games. Software and programs including downloadable programs and computer programs
Computer game cartridges and discs.	Games. Carriers and storage media including... discs...cartridges...bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs or information.
Apparatus for recording, transmission or reproduction of sound or images.	Amusement apparatus, equipment and instruments.
Video and audio tapes, compact discs, DVDs. Recording discs and tapes. Magnetic data carriers. Recorded media.	Magnetic data carriers, recording discs, carriers and storage media including records, circuits, discs, wires, tapes, film, cassettes, cartridges, fibres and cards bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs or information.
Computer and video games.	Games.
Decorative magnets.	As they are both decorative items, decorative magnets are similar to, for example, transfers and stickers in VBH's registration in class 16.
Downloadable electronic publications.	Publications (downloadable) provided on-line from databases, from the internet or from any other communications network including wireless, cable or satellite.

Digital music.	Magnetic data carriers, recording discs, carriers and storage media including records, circuits, discs, wires, tapes, film, cassettes, cartridges, fibres and cards bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs or information.
Mouse pads	As mouse pads often form part of a coordinated set of desk accessories they are similar to, for example, office requisites in VBH's registration in class 16.

Class 16

As all of the goods in VEL's application either find exact counterparts in VBH's registration in class 16, or are included in broader terms in class 16 which would include the named goods, the goods at issue are identical.

Class 35

VEL's services	VBH's services
Advertising. Advertising services provided via the Internet.	Advertising.
Electronic data storage.	Compilation, transcription, reproduction of data. Database and data processing services; data management and stock taking.
Production of television and radio advertisements.	Advertising. Compilation of advertisements including for use as web pages on the internet.
Retail services connected with the sale of articles of clothing and ornamental objects.	Retail services including through shops, catalogues and on-line, connected with the sale of ...clothing and clothing accessories, footwear, headwear, ornaments.
Retail services connected with the sale of musical recordings, motor vehicles.	Insofar as "retail services connected with the sale of musical recordings" is concerned, these are, on the principle outlined in case T-116/06 <i>Oakley Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)</i> , complementary to VBH's "Magnetic data carriers, recording discs,

	carriers and storage media including records, circuits, discs, wires, tapes, film, cassettes, cartridges, fibres and cards bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs or information” in class 9. I can, however, find no similarity between “retail services connected with the sale of motor vehicles” and any of VBH’s goods and services in any class.
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Class 38

VEL’s services	VBH’s services
Radio and television broadcasting. Interactive broadcasting and communications services. Networking of television programmes, films, animated films, sound and video recordings	Radio and television broadcasting.
Communications and telecommunications. Communications for access links to databases and computer networks. Digital communications services.	Telecommunications services.
Electronic mail services.	Email services.
Provision of access to world wide web facilities and structures.	Providing use or access to the Internet.
Information and advisory services relating to all of the aforesaid services.	These services would, on the principle outlined in <i>Boston Scientific</i> , be complementary to VBH’s services in this class.

Class 41


VEL’s services	VBH’s services
Organisation, production, presentation, distribution, syndication and rental of television programmes, films, animated films, sound and video recordings.	Services for writing, composition, preparation, production, promotion, distribution, direction, presentation, conducting, exhibition, rental and performance of educational, cultural and entertainment events both live and

	recorded, indoor and outdoor and over the Internet.
Entertainment. Cultural and entertainment services by or relating to television or radio. Film, music, sport, video and theatre entertainment services.	Entertainment. Cultural, entertainment and recreation services.
Sporting and cultural activities.	Sporting and cultural activities.
Education services by or relating to television or radio.	Education.
Production of live entertainment features and of television features.	Services for writing, composition, preparation, production, promotion, distribution, direction, presentation, conducting, exhibition, rental and performance of educational, cultural and entertainment events both live and recorded, indoor and outdoor and over the Internet.
Organisation, production and presentation of events for educational, entertainment, sporting and cultural purposes. Organisation, production and presentation of games, competitions, contests, sporting events, sporting tournaments, exhibitions, quizzes, sporting events, concerts, road shows, staged events, live performances, music concerts, live music performances, music in the form of archives, musical reviews. Organisation, production and conducting of exhibitions, conferences, seminars, workshops, training courses, symposiums, congresses and colloquiums.	Organisation, arrangement, management, officiation at and hosting of events, sporting events, races, rodeos, competitions, shows, games, quizzes, pageants, ceremonies, functions, tournaments, wine tastings, awards, contests, festivals, galas, parties, dances, balls, meets, meetings, circuses, concerts, recitals, roadshows, displays, product launch parties, fayres, musical performances, exhibitions, conventions, seminars, workshops, congresses, symposia and conferences.
Publishing services. Publication of books, training manuals, periodical publications, magazines, newspapers and newsletters.	Publishing.
Providing on-line electronic publications (not downloadable).	The provision of on-line electronic publications.

Publication of electronic books and journals on-line.	
Production and presentation of interactive entertainment, CDs, CD-ROMs and computer games.	Entertainment. Electronic games services provided by means of the Internet.
Reservation and booking services for educational, entertainment, sporting and cultural events.	Booking seats for entertainment events and shows. Ticket agency.
Information relating to education, entertainment, sporting and cultural events provided on-line from a computer database or the Internet. Information and advisory services relating to all of the aforesaid services.	Information advice and consultancy relating to the aforesaid.

Comparison of trade marks

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

VEL's trade mark	VBH's trade mark
VINTAGE TV	

19. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

20. VBH say:

“In addition, VINTAGE is the dominant and distinctive element of [VEL's] mark. TV is merely descriptive of some of the services in the application.....As VINTAGE is the distinctive and dominant element of both marks, the average

consumer will recall this element as the main feature of both marks and will naturally assume a commercial connection between [the competing goods and services].

21. VEL say:

“17....The word VINTAGE is not, on its own, and without more, a mark capable of distinguishing between different traders and may, in fact, be descriptive of the goods/services offered. Whilst it is accepted that the word VINTAGE appears to be a dominant component [in both parties’ trade marks], the distinctive parts are highly significant...”

18. The distinctive feature of [VBH’s] mark is the highly stylised letters forming the word VINTAGE. These elements play an independent distinctive role within the mark and cannot be disregarded as negligible. In particular, at least the highly stylised first letter V, which is a solid black with white horizontal lines, is a distinctive and dominant component of [VBH’s] mark. In light of the above, [VBH] has no rights in the word VINTAGE per se, but only in the stylised form applied for.

19. The distinctive feature of [VEL’s trade mark] is the combination of the words VINTAGE and TV which together give the mark its individual character. It must be appreciated globally.”

22. VEL’s trade mark consists of the word VINTAGE and the letters TV presented in upper case. VBH’s trade mark consists of seven characters presented in the form of a word. There can be little argument that the third to seventh characters would, despite their varying degrees of stylisation, be recognised by the average consumer as the letters N, T, A, G and E. If considered in isolation, the average consumer’s view of the first two characters of VBH’s trade mark would, in my view, be open to debate. However, as they appear as the first two characters of a seven character string, the last five characters of which would be understood as the letters mentioned above, they will, in my view, lead the average consumer to equate these first two characters to the letters V and I, which they resemble of themselves in any event, resulting in the trade mark as a whole being construed by the average consumer as the word VINTAGE.

23. VBH argues, and VEL agrees, that the word VINTAGE is the dominant element of both parties’ trade marks. As to the distinctiveness of this word and the letters TV in VEL’s trade mark, VBH argue that it is the word VINTAGE which is the distinctive element adding that the letters TV are “merely descriptive of some of the services of the application.” VEL argue that the word VINTAGE “may, in fact, be descriptive of the goods/services offered”, and conclude that as a consequence, VBH have “no rights in the word VINTAGE per se, but only in the stylised form applied for”.

24. I turn first to the word VINTAGE which VBH say is distinctive. However, VEL argue that this word “may, in fact, be descriptive of the goods/services offered”, adding that

“the word VINTAGE on its own is a well known dictionary word and “**might** convey the concept of the high quality of a past time” (my emphasis).

25. Notwithstanding the use by VEL of the words “may” and “might”, I note that *Collins English Dictionary 2000* defines the word VINTAGE as meaning inter alia, (i) a time of origin, (ii) representative of the best and most typical, (iii) of lasting interest and importance and (iv) old-fashioned. In my view, the average consumer is most likely to interpret the word VINTAGE as meaning old fashioned.

26. The word VINTAGE per se is, in my view, likely to be considered by the average consumer to be descriptive of and/or non-distinctive for the vast majority of the goods and services at issue in these proceedings. Of course, VBH’s trade mark does not consist of the word VINTAGE per se but of this word presented in a stylised format, and the stylisation present in VBH’s trade mark is a factor I must keep in mind.

27. As to the letters TV in VEL’s trade mark, I note that while VBH argue that the letters are descriptive in relation to some of VEL’s services, they do not actually identify which services they mean. As the letters TV will be well known to the average consumer as meaning television, they will, as a consequence, be considered by the average consumer to be either descriptive of or non-distinctive for the vast majority of the goods and services for which VEL seek registration.

28. As both the word VINTAGE per se and the letters TV are likely to be descriptive of and/or non-distinctive for the vast majority of the goods and services at issue in these proceedings, the distinctiveness of VEL’s trade mark will, as VEL argue, lay in the totality of its trade mark rather than the individual elements of which it is made up. Similarly, the distinctiveness of VBH’s trade mark lies in the stylised manner in which the word VINTAGE is presented. I will now approach the visual, aural and conceptual comparisons with these conclusions in mind.

29. VBH says that the competing trade marks are visually and conceptually very similar and aurally similar.

Visual similarity

30. VEL say:

“20...there is little or no visual similarity between the marks...”

31. Irrespective of the distinctiveness of the word VINTAGE and the letters TV in VEL’s trade mark, when compared as totalities, the degree of stylisation present in VBH’s trade mark results in only a limited degree of visual similarity between the competing trade marks.

Aural similarity

32. VEL say:

“20...Moreover, although the average consumer is unlikely to refer to the marks orally when selecting the goods/services at issue, if it were referred to orally [VEL’s] mark would always be mentioned with the word TV. As such, there is little or no aural similarity between the marks.”

33. Notwithstanding that VEL’s trade mark also contains the letters TV, as the word VINTAGE is the first element of VEL’s trade mark and the only word by which VBH’s trade mark would be referred to by the average consumer, in my view, there is a reasonably high degree of aural similarity between the trade marks at issue.

Conceptual similarity

34. VEL say:

“21. The word VINTAGE on its own is a well known dictionary word and might convey the concept of the high quality of a past time. However, the stylisation of [VBH’s] mark conveys the concepts of high-end, eclectic and eccentric design styles to the average consumer. In contrast, [VEL’s] mark conveys the concept of dated (e.g. black and white) television content and broadcaster. As such, the marks are conceptually different, particularly when the perceptions of the average consumer are considered.”

35. In my view, the concept that VEL’s trade mark will convey to the average consumer is one of old fashioned television. Whilst VBH’s trade mark is likely to evoke the same concept of being old fashioned in the mind of the average consumer, as the letters TV are absent from its trade mark, this concept will be a more general one. Considered overall, as the conceptual message sent by VEL’s trade mark is very specific i.e. old fashioned television whereas the message sent by VBH’s trade mark is more general, the competing trade marks are, in my view, conceptually distant.

Distinctive character of VBH’s earlier trade mark

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

37. As VBH has not filed any evidence in these proceedings, I have only the inherent characteristics of its trade mark to consider. I have already concluded that the word VINTAGE per se is likely to be considered descriptive of and/or non-distinctive for the vast majority of the goods and services for which VBH's trade mark stands registered. Bearing in mind the descriptive/non-distinctive nature of the word upon which it is based, I concluded earlier in this decision that the distinctive character in VBH's trade mark lies in the way in which it is presented. It is, as a consequence, possessed of a relatively low degree of inherent distinctive character.

Likelihood of confusion

38. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of VBH's trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

39. It is clear from the decision of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, that it is not permissible for me to regard VBH's earlier trade mark as having no distinctive character. However, given what I consider to be the descriptive/non-distinctive nature of the word upon which it is based, I have already concluded that any distinctiveness it has lays in the way in which it was presented. In reaching a conclusion on the likelihood of confusion, I note the following comments of the CJEU in *L'Oréal SA v OHIM – Case - C-235/05 P*:

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must

be assessed globally, taking into account all factors relevant to the circumstances of the case.

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

40. Earlier in this decision I concluded that with the exception of "retail services connected with the sale of motor vehicles", VEL's goods and services were either identical or similar to the goods and services in VBH's registration. Given the cumulative nature of the test, there can be no likelihood of confusion when the goods and services are not similar. As I have found that there is no similarity between VBH's goods and services and VEL's "retail services connected with the sale of motor vehicles", VBH's opposition to these services must fail. I also concluded that while there was a reasonably high degree of aural similarity, there was only a limited degree of visual similarity and that the competing trade marks were conceptually distant. As to the inherent distinctive character of VHB's trade mark, for the reasons mentioned earlier, I characterised this as relatively low.

41. Having concluded that the average consumer is likely to select the vast majority of the goods and services at issue primarily by visual means, the limited degree of visual similarity and conceptual distance between the competing trade marks is, notwithstanding the identity/similarity in the majority of the goods and services at issue, sufficient, in my view, to avoid either direct or indirect confusion. I reach this conclusion even in circumstances where the average consumer is a member of the general public, the goods and services are relatively inexpensive and only a limited degree of attention will be paid to the selection. As the cost and sophistication of the goods and services or the average consumer increases, the likelihood of confusion is, in my view, likely to decrease still further. Finally, I am also satisfied that even in circumstances where aural considerations are in play, the presence of the letters TV in VEL's trade mark (which "hang together" and which, as a consequence, I see no reason to assume will be dropped by the average consumer) are, once again, sufficient to avoid either direct or indirect confusion even in the first scenario mentioned above.

Conclusion

42. VBH's opposition to VEL's application fails in its entirety.

Costs

43. As VEL has been successful it is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to VEL on the following basis:

Preparing a statement and considering VBH's statement:	£300
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Total	£300
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44. I order Vintage By Hemmingway Ltd to pay to Vintage Entertainment Limited the sum of **£300**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of February 2013

C J BOWEN
For the Registrar
The Comptroller-General