

O-279-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3039638
BY COSMETIC WARRIORS LIMITED**

TO REGISTER THE TRADE MARK:

BOMBSHELL

IN CLASSES 3 AND 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000103
BY VICTORIA'S SECRET STORES BRAND MANAGEMENT, INC.**

BACKGROUND AND PLEADINGS

1. On 28 January 2014, Cosmetic Warriors Limited (“the applicant”) applied to register the trade mark **BOMBSHELL** for the following goods and services in classes 3 and 35:

Class 3 Perfumes; shower and bath preparations; non-medicated toilet preparations; cosmetic preparations; lotions, powders and creams all for use on the skin; non-medicated bath salts containing effervescent materials, emollients and skin moisturizers; bath melts; deodorants; toilet articles; preparations for care of the hair; shampoos; soaps; essential oils; massage creams and lotions.

Class 35 The bringing together, for the benefit of others, of a variety of goods, namely cosmetics and toiletries, enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of a variety of goods, namely cosmetics and toiletries, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site.

The application was published for opposition purposes on 14 February 2014.

2. The application is opposed by Victoria’s Secret Stores Brand Management, Inc. (“the opponent”) under the fast-track opposition procedure.

3. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods and services in the application. The opponent relies upon the goods in class 3 for which its earlier trade marks are registered. The trade marks and specifications relied upon are shown below:

Mark details	Relevant dates	Specification relied upon
<p>European Union Trade Mark (“EUTM”) number 9521469</p> <p>VICTORIA’S SECRET BOMBSHELL</p>	<p>Filing date: 15 November 2010</p> <p>Date of entry in the Register: 2 May 2011</p>	<p>Personal care products and perfumery products, namely, perfume, eau de parfum, eau de cologne, eau de toilette, body splash, body mist, body spray, body scrub, body wash, body soap, body butter, body cream, body lotion, body powder, bubble bath, shower gel, hand soap, hand cream, hand lotion; hair shampoo, hair conditioner,</p>

		hair spray.
EUTM number 11952827 BOMBSHELLS IN BLOOM	Filing date: 3 July 2013 Date of entry in the Register: 28 November 2013	Personal care products and perfumery products, namely, perfume, eau de parfum, eau de cologne, eau de toilette, body splash, body mist, body spray, body scrub, bubble bath, shower gel, body wash, body soap, body cream, body lotion, body powder, hand lotion and hand cream.

4. On 19 November 2015, the applicant filed a counterstatement in which it denies the basis of the opposition.

5. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings. I note that, attached to the applicant’s submissions dated 23 March 2016, are a number of annexes containing evidence. By way of a letter dated 20 April 2016, the tribunal advised the applicant that the routine filing of evidence was not permitted under the fast-track procedure and that, as a consequence, the evidence attached to the written submissions would be disregarded. No permission has been sought or given for the applicant to file evidence and the evidence filed will form no part of my decision.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was requested by the applicant. Following an interlocutory hearing on the point, the request for an oral hearing was refused for the reasons given in my decision dated 2 March 2016. No leave was sought to appeal that decision and I need say no more about this matter. Both parties filed written submissions, which I have read carefully and will refer to, as necessary, below. As the majority of the opponent’s comments on the substantive issues are contained within its first set of written submissions, references are to its submissions dated 11 January 2016 unless otherwise indicated.

Preliminary issues

8. Despite being professionally represented, the applicant relies upon a number of factors, both in its counterstatement and in its submissions, which it states will avoid a likelihood of confusion. These are that:

- i. the parties are using the marks in different ways for very different reasons;
- ii. the pattern of trade mark filings carried out by the opponent means one particular meaning must be attributed to its mark;
- iii. each party has an extensive reputation in a distinct field;
- iv. the applicant owns a number of marks containing the word “BOMB” already on the Register, which should be taken into account.

9. Some of these are familiar arguments in trade mark oppositions. Before going further into the merits of this opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

10. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. The trade marks relied on by the opponent had not been registered for five years at the date on which the application was published. Consequently, section 6A of the Act is not engaged and the opponent does not need to prove use for any of the goods it relies upon. The earlier marks are entitled to protection against a likelihood of confusion with the applicant’s mark based on the ‘notional’ use of the earlier marks for all the goods listed in the register. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22.It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

11. So far as the use of the applied-for mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade marks. Any differences between the goods and services provided by the parties, or differences in their trading styles or marketing approach, are irrelevant unless those differences are apparent from the applied-for and registered marks and their respective specifications.

12. As the comparison is made on a notional basis between the applied-for and earlier marks, the existence of other trade marks on the register, no matter who they belong to, is not relevant to the decision I must make (on this point, see the decision of the General Court (“GC”) in *Zero Industry Srl v OHIM*, Case T-400/06). Similarly, since the opponent is not seeking to rely on an enhanced distinctive character due to the use made of its mark, any reputation that the parties may enjoy is not relevant to the comparison to be made under section 5(2)(b).

The opponent’s best case

13. In my view, the opponent’s best case rests in its EUTM number 9521469 for the mark “VICTORIA’S SECRET BOMBSHELL”, which also has a marginally wider specification than the opponent’s other mark. I will focus on the opponent’s case under its “VICTORIA’S SECRET BOMBSHELL” trade mark to begin with, as it is unlikely that, if the opposition fails in respect of this mark, it will succeed in relation to the other.

DECISION

14. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

15. 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”.

16. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 3, which qualify as earlier trade marks under the above provisions. As I indicated at paragraph 10, they are not subject to proof of use, as per section 6A of the Act.

Section 5(2)(b) – case law

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

The principles:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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.

The average consumer and the nature of the purchasing act

18. 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. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

19. In its written submissions, the applicant submits that “the relevant consumer of the Applicant’s goods is an ethically minded person who would pay close attention to the source of the ingredients and the method of production of the goods not only the goods themselves” (paragraph 29). It also states that:

“It is clear from the status of the current use of the marks that a select portion of the average consumers may well be the same, and we accept that both the Applicant and the Opponent offer fast moving consumer goods. However the average consumer would be attracted to the brands for different reasons and due to the distinct areas in which the parties operate, the consumer is likely to pay closer attention to the goods” (paragraph 31).

20. The opponent states that “the average consumer is [...] the general public” (paragraph 30) and that “the level of care and attention taken by the consumer will be relatively low, or at most average” (paragraph 31).

21. I have explained at paragraphs 10-11 why the parties’ actual use of the marks in the marketplace is not relevant to the decision I have to make. The goods and services at issue are not specialised and I agree with the opponent that the average consumer is a member of the general public.

22. In my experience, the goods at issue are commonly displayed on shelves in bricks and mortar retail premises (for example, pharmacies and supermarkets) and their online equivalents, where they will be viewed and self-selected by the consumer. This method of selection involves primarily visual considerations, although there may be an aural component, particularly if advice is sought from a salesperson. The average consumer’s level of attention will vary across the category but s/he will wish to ensure that they purchase, for example, the correct scent or colour, or that the goods suit a particular skin type. Overall, I consider that the average consumer will pay an average degree of attention when selecting the goods at issue.

23. The services at issue are offered in shops on the high street (or the online equivalents). The purchase is predominantly visual, with the consumer selecting the retail service following visual inspection of the shop front or website, though I do not discount an aural component. The average consumer will wish to ensure, for example, that the desired product range is offered for sale, or that individual items are in stock. Overall, consumers will pay an average degree of attention when selecting an appropriate retail channel.

Comparison of goods and services

24. The competing goods and services are as follows:

Opponent’s goods	Applicant’s goods and services
<u>Class 3</u> Personal care products and perfumery	<u>Class 3</u> Perfumes; shower and bath preparations;

<p>products, namely, perfume, eau de parfum, eau de cologne, eau de toilette, body splash, body mist, body spray, body scrub, body wash, body soap, body butter, body cream, body lotion, body powder, bubble bath, shower gel, hand soap, hand cream, hand lotion; hair shampoo, hair conditioner, hair spray.</p>	<p>non-medicated toilet preparations; cosmetic preparations; lotions, powders and creams all for use on the skin; non-medicated bath salts containing effervescent materials, emollients and skin moisturizers; bath melts; deodorants; toilet articles; preparations for care of the hair; shampoos; soaps; essential oils; massage creams and lotions.</p> <p><u>Class 35</u> The bringing together, for the benefit of others, of a variety of goods, namely cosmetics and toiletries, enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of a variety of goods, namely cosmetics and toiletries, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site.</p>
---	--

25. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the 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”.

26. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

27. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

28. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

29. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

30. As for whether the goods are complementary, in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

31. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

32. The applicant has not commented at any length on the similarity of the goods and services. It does, however, concede “that there is a degree of overlap between the goods covered by the Application and the Earlier Marks” (paragraph 25).

Class 3

33. The opponent submits that the class 3 goods of the applied-for mark are identical or, in the alternative, “closely similar” to the goods covered by the class 3 specification of the earlier mark (paragraphs 15-16). It states that the services of the application are similar to the goods of the earlier mark (paragraph 20).

34. Use of the word “namely” in the opponent’s class 3 specification must be approached as follows (as indicated in the Trade Mark Registry’s classification guidance):

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

35. Accordingly, the scope of the specification relied upon by the opponent is, in effect, “perfume, eau de parfum, eau de cologne, eau de toilette, body splash, body mist, body spray, body scrub, body wash, body soap, body butter, body cream, body lotion, body powder, bubble bath, shower gel, hand soap, hand cream, hand lotion; hair shampoo, hair conditioner, hair spray”.

36. “Perfume” appears in both specifications: these goods are self-evidently identical.

37. Although expressed in different terms, the applicant’s “lotions, powders and creams all for use on the skin” and “shampoos” are identical to the opponent’s “body lotion”, “body powder”, “body cream” and “hair shampoo”, respectively.

38. The applicant’s “shower and bath preparations” and “non-medicated toilet preparations” would include the opponent’s “body wash”. The applicant’s “cosmetic preparations” would include “body powder” in the earlier mark. As the goods in one specification fall within the ambit of the other, they are, on the principle outlined in *Meric*, identical.

39. The most relevant definition in the *Oxford English Dictionary* (“OED”) of the term “toilet” (as a modifier) is:

“denoting articles used in the process of washing, dressing, and attending to one’s appearance: *a bathroom cabinet stocked with toilet articles*”.¹

In light of the above definition, and bearing in mind that the goods are in class 3, the applicant’s “toilet articles” is broadly synonymous with “toiletries”. As a consequence, the term would include articles such as “body wash” in the opponent’s specification and the goods are, applying *Meric*, identical.

40. The term “preparations for care of the hair” in the applied-for specification includes “hair conditioner” in the earlier specification. On the same principle as outlined above, these goods are identical.

41. The applicant’s “soaps” includes “body soap” in the earlier mark. These goods are, following *Meric*, identical.

42. The applicant’s “massage creams and lotions” would be included in the terms “body cream” and “body lotion” in the earlier specification. These goods are also identical.

43. The applicant’s “non-medicated bath salts containing effervescent materials, emollients and skin moisturizers” and “bath melts” are similar to a high degree to “bubble bath” in the earlier mark. I come to this view because, while the physical nature of the goods is likely to be different, the intended purpose (i.e. to enhance the bathing experience and/or, for example, to moisturise the skin), users and channels of trade are identical. The goods may be complementary and are likely to be in competition.

44. “Deodorants” in the applicant’s specification are similar to a high degree to “body spray” in the opponent’s specification. The physical nature, users and channels of trade are identical. The intended purpose of deodorants is to conceal or prevent an

¹<http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0868730?rskey=UCMqSH&result=1> [accessed 5 May 2016]

unpleasant odour. The purpose of a body spray may be the same, although I acknowledge that it may also be more akin to a perfume, i.e. to provide a pleasing scent rather than to prevent or conceal an unpleasant one. The goods may be in competition and there may be a complementary relationship, for example with both types of product being sold as part of a range.

45. I recognise that the terms in the applicant's class 3 specification which I have found to be identical to the opponent's goods under *Meric* are wider than those in the opponent's specification. The terms in the applied-for mark would, notionally speaking, cover goods not included in the opponent's specification (an example is the applicant's "shower and bath preparations" against the opponent's "body wash"). However, no fall-back specification has been provided to limit to such goods and, in any event, such goods would still, in my view, be highly similar: the nature of the goods may differ (for example, in size and shape) but the users, channels of trade and intended purpose are identical, they may be in competition and there may also be a complementary relationship between the goods.

Class 3 v Class 35

46. I outlined at paragraph 34 the correct approach to the use of "namely" in specifications. The same considerations apply to the applicant's specification in class 35. Accordingly, the scope of the applied-for specification is, in effect, "the bringing together, for the benefit of others, of cosmetics and toiletries, enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of cosmetics and toiletries, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site".

47. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use from 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.

48. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, 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 determining whether, when and to what degree services are 'similar' to goods are not clear cut".

49. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*,² and *Assembled Investments (Proprietary) Ltd v. OHIM*,³ upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*,⁴ 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 GC'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).

50. The goods and services are different in nature and purpose and they are not in competition. However, the retail services applied for are those which would normally be associated with the goods relied upon by the opponent. In my view, the goods and services are complementary. I consider that the respective goods and services share a low degree of similarity.

Comparison of trade marks

51. 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.

² Case C-411/13P

³ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁴ Case C-398/07P

The CJEU stated at paragraph 34 of its judgement in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

52. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

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

Opponent's trade marks	Applicant's trade mark
VICTORIA'S SECRET BOMBSHELL	BOMBSHELL

54. The applicant asserts that “[v]isually, the marks differ completely” (paragraph 10), “[c]onceptually, the marks have very different meanings” (paragraph 17) and that “[a]urally, the earlier marks BOMBSHELLS IN BLOOM and VICTORIA'S SECRET BOMBSHELL have a completely different pronunciation compared to the word BOMBSHELL alone” (paragraph 21).

55. The opponent submits that the marks are “visually similar” (paragraph 10), “aurally reasonably similar” (paragraph 11) and “conceptually very closely similar” (paragraph 13).

56. The applicant's trade mark consists of the dictionary word “BOMBSHELL”, presented in capital letters. There are no other elements to contribute to the overall impression, which is contained in the word itself.

57. The opponent's trade mark consists of the three words “VICTORIA'S SECRET BOMBSHELL”, presented in capital letters. None of the words is descriptive of the goods and services. The applicant submits that:

“It must be obvious to the consumer that the dominant and distinctive feature of the mark VICTORIA'S SECRET BOMBSHELL is the very well-known brand name VICTORIA'S SECRET. This name will immediately indicate the origin of the Opponent's products and dominate the mark. The word

BOMBSHELL appears at the end of the mark almost as a descriptive feature” (paragraph 19).

58. The opponent states that:

“The relevant consumer is highly likely to perceive this as a composite mark, comprising the “housemark” VICTORIA’S SECRET and the sub-brand BOMBSHELL. BOMBSHELL consequently forms a distinctive and separate element within the mark as a whole” (paragraph 9).

59. I have no evidence to show the strength of the VICTORIA’S SECRET brand in the UK. The mark could be subject to different interpretations by the average consumer (e.g. the BOMBSHELL of VICTORIA’S SECRET, or the SECRET BOMBSHELL of VICTORIA). However, to my mind, the parties’ submissions, above, represent a realistic assessment of the likely perception of a significant proportion of average consumers. I agree that the average consumer is most likely to perceive “VICTORIA’S SECRET” as a unit and a separate element from “BOMBSHELL”. I accept that the words “VICTORIA’S SECRET” appear at the beginning of the mark and have marginally greater visual impact than “BOMBSHELL”. However, that is not to say that “BOMBSHELL” is negligible or that it does not contribute to the mark’s distinctiveness. On the contrary, I am of the view that the discrete elements make a roughly equal contribution to the overall impression of the earlier mark.

60. In the alternative, where the average consumer perceives the mark as meaning the “SECRET BOMBSHELL” of “VICTORIA”, I consider that neither element would dominate and they would also make a roughly equal contribution to the overall impression.

61. Visually, the marks share the word “BOMBSHELL”. The difference between the marks is in the words “VICTORIA’S SECRET”, which are at the beginning of the opponent’s mark but absent from the applied-for mark. Given the positioning of the word “BOMBSHELL” in the opponent’s mark, I consider there to be a medium degree of visual similarity between the marks.

62. Consisting, as they do, of dictionary words, the pronunciation of both marks will be entirely predictable. There is a medium degree of aural similarity because, although the word “BOMBSHELL” is identical, the words “VICTORIA’S SECRET” are not present in the application and will be the first words heard in the opponent’s mark.

63. Addressing the conceptual meaning of the marks, the applicant provides the *Collins English Dictionary* definition of “bombshell” at paragraph 14 of its written submissions. The definition is as follows:

“noun

(a) (especially formerly) a bomb or artillery shell

(b) A shocking or unwelcome surprise [...]

(c) (informal) an attractive girl or woman (esp in the phrase **blonde bombshell**)”.

64. The applicant asserts that:

“In the context of the Opponent’s use the mark can have only one meaning which would be to identify an attractive girl or woman. The Opponent’s mark does not fit with the first and second meanings above. Conversely for the Applicant, the mark BOMBSHELL alone could have all of the above meanings” (paragraph 17).

65. The opponent, meanwhile,

“does not accept that the relevant consumer would readily connect any of the signs with any of the dictionary definitions provided by the Applicant in its counterstatement [reproduced at paragraph 14 of the applicant’s submissions]. None of those meanings have a direct and obvious connection to the goods and services at issue” (paragraph 12).

66. I have already explained why the opponent’s (or the applicant’s) actual use of the marks is not relevant to my decision. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer.⁵ The word “bombshell” is a common dictionary word with known, albeit multiple, meanings and I see no reason why the average consumer would not attribute one of those meanings to the word when confronted with it in either mark. I dismiss the opponent’s contention that the average consumer will attribute no conceptual meaning to either mark. In the context of the goods and services at issue, I am of the view that the most likely meaning that the average consumer will attribute to the applied-for mark is that of an attractive woman.

67. The opponent’s mark contains the additional elements “VICTORIA’S SECRET”, which convey the meaning that the BOMBSHELL is that of VICTORIA’S SECRET. This additional possessive element introduces a difference in the conceptual meaning. However, I consider that the meaning attributed by the average consumer to the “BOMBSHELL” element will also be that of an attractive woman. I accept that some average consumers may perceive one of the other meanings of the word ‘bombshell’ but whichever of these is attributed to one mark is as likely to be attributed to the other. The difference therefore remains in the words “VICTORIA’S SECRET”. I find that there is a medium degree of conceptual similarity.

68. I recognise that some average consumers will not be familiar with the “VICTORIA’S SECRET” brand and will perceive the alternative meaning of the opponent’s mark (i.e. that the SECRET BOMBSHELL is VICTORIA’S). Nonetheless, the meaning attributed

⁵ See Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

to the word BOMBSHELL will be the same even if it is seen as qualified by the adjective “SECRET”. In such circumstances, I consider that there would still be a medium degree of conceptual similarity.

Distinctive character of the earlier trade mark

69. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods 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. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)”.

70. This being a fast-track opposition, no evidence has been filed by the opponent in support of a claim of enhanced distinctiveness and I therefore have only the inherent position to consider. The applicant has made no submissions on the distinctiveness of the earlier mark, save for a claim that “[t]he Earlier Mark VICTORIA’S SECRET BOMBSHELL is simply distinctive because it contains the brand name VICTORIA’S SECRET” (paragraph 41). The opponent submits that the earlier mark “should [...] be considered to have at least a normal level of distinctiveness” (paragraph 25).

71. Invented words usually have the highest degree of inherent distinctive character; words which are descriptive of the goods and services relied upon normally have the lowest. The earlier mark is made up of dictionary words but none is either descriptive or allusive in relation to the goods relied upon. For that reason, I do not accept the applicant's argument that the distinctiveness lies only in the words "VICTORIA'S SECRET". This is important as I must bear in mind that it is the distinctiveness of the common element which is key.⁶ I consider that the mark as a whole has an average degree of inherent distinctiveness.

Likelihood of confusion

72. 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 bear in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind.

73. I have found that the parties' marks are visually, aurally and conceptually similar to a medium degree and that the earlier mark has an average degree of inherent distinctive character. I have identified the average consumer to be a member of the general public, who will select the goods and services primarily by visual means, though I do not discount an aural component. I have concluded that an average degree of attention will be paid in selecting the goods and services. I have found that the applicant's services are similar to a low degree to the opponent's goods and that the goods applied for are highly similar or identical to the earlier specification.

74. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks— visually, aurally and conceptually— as a whole. In *Medion v Thomson* and subsequent case law,

⁶ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13 at [38-39].

the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors”.

75. Whilst the marks both contain the word “BOMBSHELL”, I consider the differences between them sufficient to ensure that the marks will not be misremembered or mistakenly recalled as each other. I am satisfied that the consumer will not simply mistake one mark for another and that there is, therefore, no risk of direct confusion. That is not the end of the matter, however, as I must now decide whether there will be indirect confusion. Indirect confusion was described in the following terms by Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(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”).

It is clear that the categories identified by Mr Purvis are illustrative not exhaustive (see *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at [29]).

76. There are, undoubtedly, differences between the marks. However, as I have indicated at paragraph 58, I consider that a significant proportion of average consumers will interpret “BOMBSHELL” in the opponent’s mark as an independent and distinctive element in the *Medion* sense, although I acknowledge that not all average consumers will perceive the mark in that way. The word “BOMBSHELL”, present in both marks, will convey an identical conceptual message, which is qualified but not altered by the presence of “VICTORIA’S SECRET” in the opponent’s mark. I find that, notwithstanding the presence of the words “VICTORIA’S SECRET” in the earlier mark, the word “BOMBSHELL” is likely to fix itself in the average consumer’s mind and that it will act as an important hook in prompting his/her recall of the competing trade marks. Even when considering the services at issue, which are only similar to a low degree to the opponent’s goods, and in circumstances where an average degree of attention is paid to the purchase, this conceptual hook is likely to lead the average consumer to assume that the undertakings are the same or economically linked. I consider that there will be an expectation on the part of the average consumer that all of the goods and services at issue come from the same or economically linked undertakings. There is a likelihood of indirect confusion.

77. Given my findings, above, there is no need for me to consider the opponent’s other trade mark.

Conclusion

78. The opposition succeeds in full.

Costs

79. As the opponent has been successful, it is entitled to a contribution towards its costs.

80. At the interlocutory hearing, the applicant requested that any decision on costs in relation to that hearing be on the normal scale. It has made no further submissions on costs, save for a request in its written submissions that the opposition be dismissed and an award be made in its favour (paragraph 47). The opponent requested that off-scale costs be awarded in respect of the interlocutory hearing; although I indicated in my decision of 2 March 2016 that I did not consider that an award off the scale was appropriate, the opponent now asks me to reconsider that decision (paragraphs 11 and 25-26 of its submissions filed on 12 April 2016). The basis of the opponent's request is that it has incurred unnecessary and disproportionate costs as a result of the applicant's request for a substantive hearing and because of the evidence filed by the applicant with its written submissions.

81. The relevant chronology, as recorded on the official file, is as follows:

9 December 2015 The Tribunal writes to the parties, setting deadlines of 23/12/16 for the parties to request leave to file evidence or a substantive hearing with "full written reasons", and 11/01/2016 for written submissions;

21 December 2015 Applicant files bare request for a hearing;

7 January 2016 Tribunal refuses applicant's request for a hearing as no reasons have been provided. The relevant part of Tribunal Practice Notice 2/2013 is quoted in full;

11 January 2016 Opponent files its written submissions;

Applicant files further reasons in support of its request for a hearing. These are that "a hearing would require the Opponent to fully set out its opposition" and that "(A) both parties are large 'brand name' businesses; (B) The Applicant has already used the mark in the UK, online and in its stores". The applicant attaches sales figures to its letter but makes no request for leave to file evidence. It files no submissions;

12 January 2016 Opponent files a detailed response to applicant's request for a hearing. It characterises the request as "misconceived" and asks that any costs award reflect the "extra, wholly unnecessary, workload" (p. 3);

15 January 2016 Applicant responds, claiming that the opponent's submissions contain evidence and requesting that the Tribunal either refuse to admit the submissions or convert the fast-track opposition to a standard opposition;

27 January 2016 Tribunal writes to the applicant refusing the request for a substantive hearing and giving the parties until 10 February 2016 to request to be heard on the issue. It advises that the opponent's submissions were filed in line with fast-track procedure;

[Interlocutory hearing appointed and held]

2 March 2016 Interlocutory decision issued refusing applicant's request for a hearing. Applicant given 21 days to file submissions, opponent allowed a further 21 days to respond;

23 March 2016 Applicant files submissions, including 70+ pages of evidence. It makes no request for leave to file evidence;

12 April 2016 Opponent files submissions in reply.

82. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. The guidance regarding off-scale costs is as follows:

"5. TPN 2/2000 recognises that it is vital that the Comptroller has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. Whilst TPN 2/2000 provides some examples of unreasonable behaviour, which could lead to an off scale award of costs, it acknowledges that it would be impossible to indicate all the circumstances in which a Hearing Officer could or should depart from the published scale of costs. The overriding factor was and remains that the Hearing Officer should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this in itself is not indicative of unreasonable behaviour".

83. As this opposition was launched before 1 October 2015, it is not affected by the costs cap in Tribunal Practice Notice 2/2015.

84. It is clear that the request for a substantive hearing came about because of the failure of the applicant's representatives to understand and comply with the fast-track procedure, despite that procedure being set out in letters from the Tribunal, most notably that of 9 December 2015. This has inevitably increased costs for the opponent. At the procedural hearing, the applicant argued that the opponent had filed evidence in its submissions, in contravention of fast-track procedure (in my view, it had not). It was made aware in my decision of 2 March 2016 that leave is required before evidence can be filed in fast-track proceedings. The applicant cannot have it both ways. It is inappropriate, given its unjustified complaints about the opponent's submissions, that the applicant filed a significant amount of what is clearly evidence with its own written submissions, without requesting leave. Although the opponent, very sensibly, decided not to respond to the evidence in detail, it still had to review it and I will bear this in mind.

85. Notwithstanding my comments, above, I remain of the view that the award of costs should be on the usual Registry scale. While the applicant's pursuit of the hearing request and the filing of evidence increased costs for the opponent, its conduct has not been of that egregious nature which might persuade me that compensatory costs are appropriate. Using TPN 4/2007 as a guide but mindful of my comments, above, I award costs to the opponent on the following basis:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£200
Preparing and attending procedural hearing (including filing a skeleton argument):	£500
Written submissions:	£400
Total:	£1200

86. I order Cosmetic Warriors Limited to pay Victoria's Secret Stores Brand Management, Inc. the sum of **£1200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of June 2016

**Heather Harrison
For the Registrar
The Comptroller-General**