

**O/1088/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003681220  
BY VICTORIA'S SECRET STORES BRAND MANAGEMENT, LLC  
TO REGISTER THE FOLLOWING TRADE MARK:**

**VS&Co**

**IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 429462 BY VISUAL SUPPLY CO.**

## **Background and Pleadings**

1. On 13 August 2021, Victoria's Secret Stores Brand Management, LLC ('the Applicant') filed an application to register the following figurative trade mark:

VS&Co

2. The application was published for opposition purposes in the *Trade Marks Journal* on 24 September 2021. Registration is sought in respect of the following services in Class 35:

*Retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel, personal care products, bags, and fashion accessories; on-line retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel, personal care products, bags, and fashion accessories*

3. On 21 December 2021, the application was opposed by Visual Supply Co., ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Opponent relies on the following earlier registration, relying on all of the goods in its specification:

UK00003715084

**VSCO**

Filing date: 28 October 2021

Date of entry in register: 28 January 2022

Priority date: 30 July 2021

Priority country: United States of America

Registered for the following goods:

Class 18:	<i>Luggage; tote bags; beach bags; all-purpose sport and carrying bags; shoulder bags; backpacks; messenger bags; purses; clutch bags; book bags; diaper bags; wallets.</i>
Class 25:	<i>Bras; briefs; capris; caps being headwear; hats; clothing, namely, half zip tops; scarves; clothing, namely, long sleeve tops; t-shirts; pajamas; pants; jackets; clothing, namely, short sleeve tops; shorts; skirts; socks; sports bras; clothing, namely, sun protection tops; sweatshirts; swimwear; tank tops; tights; underwear; vests; visors being headwear; yoga pants; children and infant wear, namely, t-shirts and one-piece garments for infants and children; shoes; sleepwear; loungewear; undergarments; active wear, namely, track suits, athletic shirts and pants, and yoga shirts and pants, swimwear, beachwear, leotards, leggings, robes, jackets, coats, suits, rainwear, shorts, pants, dresses, skirts, shirts, tank tops, sweatshirts, sweaters, vests, blouses, belts, scarves, gloves, mittens, socks; footwear; headwear.</i>

4. The Opponent claims that:

- the parties' marks are visually and phonetically highly similar;
- the parties' goods are highly similar;
- and
- that there is therefore a likelihood of confusion between the marks by imperfect recollection.

5. The Applicant filed a Defence and Counterstatement in which it denies the claim against it in its entirety, arguing that:

- the applied-for mark is 'visually, phonetically and conceptually distinguishable from the Opponent's marks';<sup>1</sup>

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<sup>1</sup> The Opponent initially relied upon three earlier marks. It subsequently withdrew its reliance on the two other earlier registrations: 801107914 and 801212354.

- there is ‘dissimilarity between the applied for retail services in Class 35 and the goods covered by the Opponent’s Marks;<sup>2</sup> and
  - that there is therefore no likelihood of confusion between the parties’ marks.
6. The Opponent is represented by Bristows LLP; the Applicant is represented by Burges Salmon LLP.
7. Only the Applicant filed evidence. A hearing was neither requested nor thought necessary. Both parties filed written submissions in lieu of a hearing.
8. The following decision has been made after careful consideration of the papers before me.

### **Applicant’s evidence**

9. The Applicant’s evidence comes from Melissa Barnett, ‘Director and Senior Intellectual Property Counsel’ of the Applicant company. Ms Barnett’s Witness Statement is dated 12 July 2022. There are 8 Exhibits: MB01 to MB08. Ms Barnett states that “The information contained in this Witness Statement and its Exhibits clearly demonstrates that the Applied for Mark operates as and will be understood as an abbreviation of the corporate name of the Applicant’s parent company Victoria’s Secret & Company distinguishing the Applied for Mark from Visual Supply Co. and its registrations for VSCO.”<sup>3</sup>

### **10. Exhibit MB01**

Exhibit MB01 – comprises a press release dated 3 August 2021<sup>4</sup> in which it is announced that ‘Victoria’s Secret & Co’ has separated from ‘Bath & Body Works, Inc.’ to become ‘a newly independent public company’. I note that the press release includes a reference to ‘VS&Co’.

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<sup>2</sup> Subsequent references to the Opponent’s ‘marks’ or ‘registrations’ are to be read as referring to earlier registration **UK00003715084 only**.

<sup>3</sup> Witness Statement of Melissa Barnett, paragraph [7.1].

<sup>4</sup> This item is duplicated in Exhibit MB02.

11. Exhibits MB02 – MB05

Exhibits MB02 – MB05 are intended to demonstrate use of the Applicant's mark 'across the company's corporate website, social media pages, press releases in reference to the Company [...]'.<sup>5</sup>

12. Exhibit MB02 – comprises the Applicant's 'Linkedin' page, accessed 30 June 2022. Information provided on the page includes, *inter alia*, the year that the Applicant company was founded, i.e. 2021.

13. Exhibit MB03 – comprises 7 press releases<sup>6</sup> dated from April to May 2022. The subject matter of these press releases includes: the launch of brands under the 'Victoria's Secret & Co' umbrella; updates on the Applicant company's corporate success; and information on the Applicant's executive leaders and appointments to the Board of Directors.

14. Exhibit MB04 – comprises Wayback prints<sup>7</sup>, dated 30 June 2022, of the Applicant's web page providing information on some of its associates.

15. Exhibit MB05 – comprises Wayback prints, dated 10 September 2021, from the Applicant's website focusing on the values of the company and the 'mission' behind its brand.

16. While it is noted that there are various references to 'VS&Co' in these materials, how the Applicant (or Opponent) is currently using its mark is irrelevant to my assessment of whether there is a likelihood of confusion between the parties' marks. I must consider only the notional use of the parties' marks i.e. all of the possible circumstances in which the marks *might* be used.

17. The Court of Justice of the European Union ('CJEU') has stated the following<sup>8</sup>:

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<sup>5</sup> Witness Statement of Melissa Barnett, paragraph 4.4.

<sup>6</sup> I have excluded the press release dated 3 August 2021 because it is a duplicate of Exhibit MB01.

<sup>7</sup> Captures of web pages, as they appeared on certain dates in the past, obtained via the web archiving service 'The Wayback Machine'.

<sup>8</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06.

“Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.

18. Furthermore, the way in which the Applicant references itself (i.e. as VS&Co), or intends its mark ‘VS&Co’ to be understood, does not necessarily reflect the average consumer’s perception of the contested mark.

19. Exhibits MB06 – MB07

Exhibit MB06 – comprises a press release, dated 26 May 2022, published on the Applicant’s website, announcing the launch of a digital platform called ‘VS&Co-Lab’ through which to showcase certain brands. References to the mark ‘VS&Co-Lab’ have been highlighted in yellow.

20. Exhibit MB07 – comprises pages from the website for the above-mentioned platform. The annotation on the Exhibit states that this page was accessed 25 May 2021. I presume this to be an error given that the press release announcing the launch of the platform is dated 2022.

21. Ms Barnett has stated that these Exhibits show use of the applied-for mark. I disagree. ‘VS&Co-Lab’ is a separate mark from the applied-for mark ‘VS&Co’. That said, even if this evidence did include references to the applied-for mark, as noted above at [15], how the Applicant is currently using its mark is irrelevant to my assessment of whether there is a likelihood of confusion between the parties’ marks.

## 22. State of the Register Evidence: Exhibit MB08

Exhibit MB08 comprises records, from the Intellectual Property Office website, for 13 of the Applicant's previously registered trade marks. Ms Barnett has stated that 'Customers are accustomed to associating and understanding VS as an abbreviation of the Victoria's Secret brand'. While this submission is noted, the presence, or otherwise, of the Applicant's other marks on the register which include the element 'VS', has no bearing on the instant case. These proceedings are concerned only with the parties' marks pertinent to the opposition i.e. the applied-for mark and the earlier mark upon which the Opponent seeks to rely.

23. I bear in mind the decision of *46 Maras*<sup>9</sup> in which Thomas Mitcheson Q. C. (as he then was), sitting as the Appointed Person, held that:

'...It is well established that mere evidence of the state of the register is of little assistance in determination of disputes of this nature. Without evidence of use and reputation, the existence of other registrations can have no bearing on the question of the likelihood of confusion.'

## **Decision**

### **Section 5(2)(b) of the Act and related case law**

24. Section 5(2)(b) of the Act states:

"5(2) A trade mark shall not be registered if because –

(a) ...

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

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<sup>9</sup> O/112/21 at para [20].

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

25. In accordance with section 6 of the Act, the Opponent’s mark is an earlier mark because the date from which it claims priority (30 July 2021) fell before the filing date of the applied-for mark (13 August 2021).

26. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the date from which the Opponent claims priority for its earlier mark fell less than 5 years prior to the date on which the Applicant filed its application. The Opponent is therefore entitled to rely upon all of the goods that it seeks to rely upon.

27. The following principles are derived from the decisions of the Court of Justice of the European Union<sup>10</sup> (“CJEU”) 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 C120/04; *Shake 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;

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<sup>10</sup> Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.



(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

28. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

29. The CJEU in *Canon*, Case C-39/97, stated:

“[23] “In assessing the similarity of the goods or services concerned [...] 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”.

30. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.<sup>11</sup> In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court described “complementary” in the following terms: “[...] 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”.<sup>12</sup> In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.

31. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281,<sup>13</sup> identified the following factors for assessing similarity of the respective goods and services:

- (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.

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<sup>11</sup> *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

<sup>12</sup> Paragraph 82

<sup>13</sup> *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

32. For the purpose of considering the issue of similarity of goods (or services), it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.<sup>14</sup>

33. The goods and services to be compared are as follows:

Earlier mark:	Applied-for mark:
<p>Class 18: <i>Luggage; tote bags; beach bags; all-purpose sport and carrying bags; shoulder bags; backpacks; messenger bags; purses; clutch bags; book bags; diaper bags; wallets.</i></p> <p>Class 25: <i>Bras; briefs; capris; caps being headwear; hats; clothing, namely, half zip tops; scarves; clothing, namely, long sleeve tops; t-shirts; pajamas; pants; jackets; clothing, namely, short sleeve tops; shorts; skirts; socks; sports bras; clothing, namely, sun protection tops; sweatshirts; swimwear; tank tops; tights; underwear; vests; visors being headwear; yoga pants; children and infant wear, namely, t-shirts and one-piece garments for infants and children; shoes; sleepwear; loungewear; undergarments; active wear, namely,</i></p>	<p>Class 35: <i>Retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel, personal care products, bags, and fashion accessories; on-line retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel, personal care products, bags, and fashion accessories.</i></p>

<sup>14</sup> *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

<p><i>track suits, athletic shirts and pants, and yoga shirts and pants, swimwear, beachwear, leotards, leggings, robes, jackets, coats, suits, rainwear, shorts, pants, dresses, skirts, shirts, tank tops, sweatshirts, sweaters, vests, blouses, belts, scarves, gloves, mittens, socks; footwear; headwear.</i></p>	
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34. The Opponent has submitted that the Opponent’s goods in classes 18 and 25 have ‘at least a medium degree of similarity’<sup>15</sup> with the Applicant’s services.<sup>16</sup>

35. The Applicant has submitted that:

- the following of its services are dissimilar to the Opponent’s goods due to their different natures, purposes and methods of use:<sup>17</sup>

*Retail store services in relation to [...] personal care products [...] and fashion accessories; on-line retail store services in relation to [...] personal care products [...] and fashion accessories.*

and

- that the following of its services ‘are by their nature very different’ to and, at best, have a low level of similarity to the Opponent’s goods:<sup>18</sup>

*Retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel [...] bags [...]; On-line retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel [...] bags [...].*

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<sup>15</sup> The Opponent claimed that the respective goods and services were *highly* similar in its original pleading and therefore appears to have changed its position somewhat.

<sup>16</sup> Opponent’s written submissions in lieu of a hearing, paragraph [29].

<sup>17</sup> Applicant’s written submissions in lieu of a hearing, paragraph [31].

<sup>18</sup> Applicant’s written submissions in lieu of a hearing, paragraph [32].

Contested services: *Retail store services in relation to clothing, namely, intimate apparel, lingerie [...]; on-line retail store services in relation to clothing, namely, intimate apparel, lingerie [...].*

36. I compare these services with the Opponent's *Bras; briefs; pants; tights; underwear and undergarments* in class 25.

37. When comparing goods against the retailing of goods, I bear in mind *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, in which the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

38. I also note that on the basis of the European courts' judgments in *Sanco SA v OHIM*,<sup>19</sup> and *Assembled Investments (Proprietary) Ltd v. OHIM*,<sup>20</sup> upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*,<sup>21</sup> Geoffrey Hobbs QC (as he then was) sitting as the Appointed Person in the *MissBoo* case,<sup>22</sup> 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;

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<sup>19</sup> Case C-411/13P

<sup>20</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>21</sup> Case C-398/07P

<sup>22</sup> *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14; see paragraph 9 of that ruling.

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

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

39. The Applicant's services entail bringing together and making available for sale, either in physical outlets or online, the goods 'intimate apparel' and 'lingerie'. These goods, to my mind, will encompass the Opponent's above-mentioned *Bras; briefs; pants; tights; underwear and undergarments*. The Opponent's goods are intended to clothe the body i.e. to provide warmth, coverage and/or decoration. The respective goods and services will therefore differ in purpose and methods of use. There will be user overlap; purchasers of the Opponent's goods will, in many cases, necessarily also be consumers of the Applicant's retail services. The goods and services are different in nature; the Opponent's goods being tangible items as compared to the Applicant's acts of service. Trade channels are shared; both the Applicant's retail services and the goods to which they relate will be accessed/purchased from the same physical or online stores. The respective goods and services will be complementary; the Opponent's goods are necessary in order to deliver the retail services in respect of those goods, and the average consumer may presume both to originate from the same undertaking, since it is quite normal for a retailer to sell goods under its own mark. I find the parties' goods and services to have a medium level of similarity.

Contested services: *Retail store services in relation to clothing, namely [...] loungewear [...]; on-line retail store services in relation to clothing, namely, [...] loungewear [...].*

40. I compare these services with the Opponent's *loungewear* in class 25. The Applicant's services entail bringing together and making available for sale, either

in physical outlets or online, the goods 'loungewear'. For the reasons set out above at [39], I find the parties' goods and services to have a medium level of similarity.

*Contested services: Retail store services in relation to clothing, namely [...] athletic apparel [...]; on-line retail store services in relation to clothing, namely, [...]*

41. I compare these services with the Opponent's *active wear, namely, track suits, athletic shirts and pants [...]* and *sports bras* in class 25. The goods to which the Applicant's retail services relate (i.e. athletic apparel) will, to my mind, encompass the Opponent's aforementioned goods. For the reasons set out above at [39], I find the parties' goods and services to have a medium level of similarity.

*Contested services: Retail store services in relation to clothing, namely [...] bags [...]; on-line retail store services in relation to clothing, namely, [...] bags [...].*

42. I compare these services with the Opponent's *tote bags; beach bags; all-purpose sport and carrying bags; shoulder bags; backpacks; messenger bags, clutch bags; book bags; diaper bags* in class 18. The goods to which the Applicant's retail services relate (i.e. bags) will encompass the Opponent's aforementioned goods. For the reasons set out above at [39], I find the parties' goods and services to have a medium level of similarity.

*Contested services: Retail store services in relation to [...] fashion accessories; on-line retail store services in relation to [...] fashion accessories.*

43. I compare these services with the following of the Opponent's goods: *clutch bags* in class 18; and *scarves* and *belts* in class 25. The goods to which the Applicant's services relate (i.e. fashion accessories) will, in my view, encompass the Opponent's aforementioned goods. Fashion accessories, to my mind, include items that are worn or carried, whose purpose is to enhance or complement one's attire e.g. a belt or a clutch bag. For the reasons set out above at [39], I find the parties' goods and services to have a medium level of similarity.



Contested services: *Retail store services in relation to [...] personal care products [...]; on-line retail store services in relation to [...] personal care products.*

44. To my mind, 'personal care products' will encompass products that are applied to the face, hair or body with the aim of cleansing, or enhancing the condition or appearance of, an aspect of the person. Examples might include shampoo or lotion. The Opponent's specification, broadly speaking, covers clothing and bags/wallets/purses. In my view, the Opponent's specification does not include any 'personal care products'. The Opponent has submitted that 'there is [...] a clear overlap, both in terms of consumer, trade channels etc.'<sup>23</sup> The Applicant's services entail bringing together and making available for sale, either in physical outlets or online, the goods 'personal care products'. The Opponent's class 25 goods are intended to clothe the body; its class 18 goods function as receptacles for items carried about the person. The respective goods and services will therefore differ in purpose and methods of use. The goods and services are different in nature; the Opponent's goods being tangible items as compared to the Applicant's acts of service. The respective services and goods are not in competitive relationship; neither is substitutable for each other. I do not find the parties' goods and services to be complementary. Although the average consumer may presume both the Applicant's retail services and the Opponent's goods to be provided by the same undertaking, neither good/service is necessary or important for the other. Trade channels may overlap, in that in some instances the Applicant's retail services relating to personal care products and the Opponent's goods in classes 18 and 25 may be accessed/purchased from the same physical or online stores. There will be user overlap to the extent that many purchasers of clothing or bags will also be users of retail services relating to personal care products of some sort. However, in my view, the possible general overlap in user and trade channel are insufficient to support a finding of similarity between goods/services. I find the parties' goods and services to be dissimilar.

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<sup>23</sup> Opponent's written submissions in lieu of a hearing, paragraph [31].

### Average consumer and the purchasing act

45. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word “average” denotes that the person is typical. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

46. The average consumer of the goods and services in this opposition will be the general public. The purchasing act will be primarily visual. The bags and clothing will be picked up, examined or tried on before purchase, and those accessing the services will have entered a physical premises or accessed a retailer's website, before surveying the goods available for purchase. There may also be an aural aspect to the purchasing process, for instance, where a purchaser has accessed the services having first been alerted to the retailer by ‘word of mouth’. In my view, the average consumer would pay no more than a medium level of attention when accessing the services or selecting the goods, taking into account factors such as, *inter alia*: the range of goods available for sale; the size/fabric composition of the garment or suitability of the accessory, as the case may be.

### Comparison of the marks

Opponent's (earlier) mark	Applicant's (contested) mark
<b>VSCO</b>	<b>VS&amp;Co</b>

47. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant

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

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

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

49. The Opponent’s mark is a word mark<sup>24</sup> consisting of ‘VSCO’. The overall impression of the mark resides in the mark in its entirety.

50. The Applicant’s mark is identified in the register as a figurative mark, but it comprises no more than 4 letters and an ampersand, all presented in a fairly plain font. More specifically, the Applicant’s mark consists of ‘VS&Co’, the ‘V’, ‘S’ and ‘C’ characters rendered in upper case, and the ‘o’ rendered in lower case. In my view, although the ampersand accords a measure of separation between the ‘VS’ and ‘Co’ elements, the coalescence of the characters means that the overall impression resides in the mark in its entirety.

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<sup>24</sup> Although ‘VSCO’ is not, technically speaking, a word, in *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

‘ [...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).’

### Visual comparison

51. The Opponent has submitted that the parties' marks are "virtually identical, save for the *de minimis* and commonplace '&' " present in the Applicant's mark which is absent from the Opponent's mark.<sup>25</sup>
52. The marks share the characters 'V', 'S', 'C' and 'O' in that order. The fact that in the representation of the Applicant's mark provided, the 'o' is presented in lower case is of no consequence because, as per the case of *LA Superquimica*,<sup>26</sup> whether the character appears in lower or upper case amounts to normal and fair use of a word mark and does not amount to any real point of difference between the marks. The only point of visual difference between the parties' marks is the presence of the '&' between the 'VS' and 'Co' elements of the Applicant's mark, which is absent from the Opponent's mark. I find the marks to be visually similar to a high degree.

### Aural comparison

53. The Opponent has submitted that the earlier mark "is likely to be pronounced either by sounding out each letter "V" "S" "C" "O" or as "V" "S" "CO" *but by also including the word AND between the letters 'S' and 'C'*" [my italics].<sup>27</sup> The Opponent argues that the respective marks have 'a very high degree of aural similarity'. I disagree with the submission in italics. In my view, the average consumer would articulate the Opponent's mark by sounding out each letter, i.e. 'VEE-ESS-SEE-OH'. The average consumer would not, in my view, insert an 'AND' between the 'VEE-ESS' and 'SEE-OH'. The Applicant's mark would be articulated as 'VEE-ESS-AND-COE'. In my view, the presence of the ampersand between the 'VEE-ESS' and 'Co' elements would naturally prompt the average consumer to articulate the 'Co' as 'COE'. The use of the element '&Co' as part of a trade mark, is, in my view, fairly ubiquitous and will be a familiar sight to the average consumer. The first two syllables of the marks, 'VEE-ESS', are aurally identical. Points of aural difference are: the presence of the 'AND' in the Applicant's mark, which is absent from the Opponent's mark; the articulation of the 'CO' as 'SEE-OH' in the Opponent's mark

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<sup>25</sup> Opponent's written submissions in lieu of a hearing, paragraph [19].

<sup>26</sup> As above footnote 22.

<sup>27</sup> Opponent's written submissions in lieu of a hearing, paragraph [21].

as compared to 'COE' in the Applicant's mark. In the light of the foregoing, I find the parties' marks to be aurally similar to a medium to high degree.

#### Conceptual comparison

54. The Opponent's mark will, in my view, be perceived by the average consumer as initials for some unknown words or name(s). There is no concept to which the initials 'VSCO' will attach. The Applicant's mark will, to my mind, be perceived as the initials 'VS', for some unknown name or words, followed by '&Co' which will be understood as an abbreviation of the phrase 'and Company'. For the average consumer, there is no concept to which the initials 'VS' will attach. The '&Co' element, as an abbreviation of 'and Company', is often included as part of a trade mark or trade name and is therefore an element to which the average consumer will have been often exposed. The '&Co' element will therefore be low in distinctive character. In the light of the foregoing, I find the respective marks to be more or less conceptually neutral.

#### **Distinctive character of the earlier mark**

55. *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-0000, 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).”

56. Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.

57. ‘VSCO’ will be perceived by the average consumer as initials to some unknown words or name(s). The mark is neither descriptive of, nor allusive to, the goods in respect of which the mark is registered. However, I consider that the average consumer will be accustomed to seeing marks in the form of initials. I bear in mind *Kunze Folien GmbH v Kartell UK Limited*, BL O/084/14, in which Iain Purvis QC (as he was then), sitting as the Appointed Person, referred with approval to a decision of the fourth Board of Appeal of OHIM (now the EUIPO), *Alfa-Beta Vissilopoulos AE v Agro de Bazan*, Case R 82/2011-4.<sup>28</sup> The Board of Appeal considered the letters AB in a stylised form against AB in a different stylised form, saying at paragraph 16:

“As to the distinctive character of the letter combination ‘AB’ in the earlier marks and of the contested mark, either perceived as the letter ‘B’ or as a possible letter combination such as ‘PB’ or ‘AB’, it should be noted that letters or letter combinations of two or three letters are inherently weak, given the limited

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<sup>28</sup> European Intellectual Property Office.

number of letters in the alphabet, the great number of meanings that acronyms and abbreviations may have and the fact that consumers frequently encounter abbreviations and letter combinations of all kinds in every day life and business as generic abbreviations but not as marks. In view of this, the graphical design in which the letter combinations appear strongly influences the consumer's perception. The distinctive character of the conflicting marks to a large extent rests in their specific graphic elements.”

58. A mark comprising letters must be assessed for distinctive character in relation to the goods or services in respect of which the mark is registered, as with other types of marks.<sup>29</sup>

59. Although comprising four letters, the Opponent's mark has, in my view, a low level of inherent distinctive character owing to its plain sans serif typeface and absence of stylisation.

60. No evidence has been submitted by the Opponent. I am therefore unable to make a finding in respect of enhanced distinctive character.

### **Likelihood of confusion**

61. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*<sup>30</sup>. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*<sup>31</sup>, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the

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<sup>29</sup> *OHIM v Borco-Marken-Import Matthiesen GmbH & Co. KG*, Case C-265/09 P, at [28] – [32].

<sup>30</sup> Case BL O/375/10 at [16].

<sup>31</sup> *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

62. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [27]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

63. I have found the following of the Applicant’s services to have a medium level of similarity with the Opponent’s goods:

*Class 35: Retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel, [...] bags, and fashion accessories; on-line retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel, [...] bags, and fashion accessories.*

64. In my view, a significant proportion of average consumers would confuse the marks. The respective marks have a high level of visual similarity and are aurally similar to a medium to high degree. The marks are more or less conceptually neutral. I note the observation by the General Court in the case of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 that the beginnings of words tend to have more of a visual and aural impact than the ends of words, although I recognise that this is merely a rule of thumb. In the instant case, the parties’ marks share the same beginning and ending, i.e. ‘VS’ and ‘CO’; the only visual difference being the presence of the ‘&’ in the Applicant’s mark, flanked by the ‘VS’ and ‘CO’ element common to both marks. It is my view that when the average consumer encounters the Opponent’s mark, they may mistake it for the Applicant’s mark (or vice versa) because the mind’s eye has failed to register or recall the visual difference at the centre of the Applied-for mark, and consumers do not compare marks side by side. The average consumer will pay no more than a medium degree of attention when accessing the Applicant’s services. There is a likelihood of direct confusion based on imperfect recollection.



65. There will be no likelihood of confusion in respect of those of the Applicant's services that I have found to be dissimilar to the Opponent's goods:

*Class 35: Retail store services in relation to [...] personal care products [...]; on-line retail store services in relation to [...] personal care products [...].*

## Conclusion

66. The Opposition has been partially successful. Subject to any successful appeal:

- The application is **refused** in respect of the following:  
*Class 35: Retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel, [...] bags, and fashion accessories; on-line retail store services in relation to clothing, namely, intimate apparel, lingerie, loungewear, and athletic apparel, [...] bags, and fashion accessories.*
- The application **may proceed** only in respect of the following class 35 terms:  
*Retail store services in relation to [...] personal care products [...]; on-line retail store services in relation to [...] personal care products [...].*

## COSTS

67. The Opponent has enjoyed the greater measure of success and is therefore entitled to a contribution based upon the published scale<sup>32</sup>. I award the Opponent the sum of £600 calculated as follows:

Preparation of statement and consideration of the Applicant's statement:	£200
Official fee for a section 5(2)(b) claim only:	£100
Written Submissions:	£300
<b>Total:</b>	<b>£600</b>

<sup>32</sup> Tribunal Practice Notice 2/2016

68. I therefore order Victoria's Secret Stores Brand Management, LLC to pay to Visual Supply Co Limited **the sum of £600**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 9th day of December 2022**

**Mx N. R. Morris**  
**For the Registrar,**  
**the Comptroller-General**