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VOGUE is distinctive enough to be registered as an EU trade mark

*Trinity Haircare AG v. EU Intellectual Property Office and
Advance Magazine Publishers Incorporated
Case T-453/15*

Article by David Bowden

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In the latest of a long standing spat between the publishers of Vogue magazine and Trinity Haircare AG who use the trademark 'Vogue de Trinity', the Court of Justice of the EU has had to rule on 3 challenges by Trinity in relation to an EU trademark that the publishers of Vogue had obtained. This trademark was limited in scope covering only Nice Class 3 for cosmetic products. Trinity said that the trademark registration for 'Vogue' was invalid on absolute grounds because either it consisted exclusively of signs or indications, or because it was devoid of any distinctive character. Trinity also claimed that the publishers of Vogue had acted in bad faith when it filed its application for the EU trade mark. In upholding the ruling of the EU IPO and its Board of Appeal, the CJEU dismissed all Trinity's claims. 'Vogue' will accordingly remain a registered EU trademark for cleaning and toilet preparations.

Trinity Haircare AG v. EU Intellectual Property Office and Advance Magazine Publishers Incorporated
Case T-453/15 15 September 2016
Court of Justice of the European Union, 8th Chamber (Judges Gratsias, Kancheva and Wetter)

What are the facts?

On 11 April 2011 Advance Magazine Publishers Inc. (who publish 'Vogue') magazine, obtained an EU-wide trademark registration for 'Vogue' under number: 9944547 for beauty products. Trinity Haircare AG ('Trinity') applied in July 2012 to have this trademark registration declared invalid claiming it lacked distinctiveness. In July 2014 the EU IPO's cancellation division rejected Trinity's application. An appeal against that was dismissed on 27 May 2015 by the EU IPO's 4th Board of Appeal.

In what Nice categories was it sought to register 'Vogue'?

Vogue magazine sought to register the mark 'Vogue' in Class 3 only (www.wipo.int/classifications/nice/en/). Class 3 covers mainly cleaning preparations and toilet preparations. At the top end this covers glossy or high end products that would no doubt complement the Vogue magazine such as:

'beauty preparations and substances; cosmetics; make up; lip-stick and lip gloss; fragrances, perfumery, cologne, toilet waters and eau de colognes; essential oils; aromatherapy products; massage oils; powders, creams and lotions; nail polish; preparations and substances for the conditioning, care and appearance of the skin, body, face, eyes, hair, teeth and nails'

It also covered grungier things that it is questionable Vogue magazine would ever want to market:

'Cleaning, scouring and polishing preparations and substances; non-medicated toilet preparations and substances; dentifrices; anti-perspirants; depilatory preparations and substances; shaving cream and shaving soaps; nail polish remover; non-medicated baby wipes'

What was the action before the CJEU?

Trinity appealed against the Board of Appeal's decision to the CJEU. Trinity maintained in this appeal that the mark 'Vogue' lacked distinctiveness. The publishers of 'Vogue' magazine intervened in the appeal.

What does EU Regulation 207/2009 say?

This Regulation dated 26 February 2009 on the Community trade mark deals with 'absolute grounds for refusal' to register an EU trademark. Article 7 provides as follows:

'Absolute grounds for refusal'

1. The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service'.

Article 52 deals with 'Absolute grounds for invalidity' and provides that:

'1. A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) where the Community trade mark has been registered contrary to the provisions of Article 7;

(b) where the applicant was acting in bad faith when he filed the application for the trade mark.'

What were the 3 issues the CJEU had to determine?

It had to determine whether any of the 2 absolute grounds for refusal to register that Trinity claimed applied were made out or not. It also had to decide if the publishers of Vogue had been acting in bad faith as Trinity claimed or not.

What did the CJEU rule on Article 7(1)(c)?

On whether 'Vogue' consists exclusively of signs or indications, the CJEU said that trade marks falling within the ambit of Article 7(1)(c) shall not be registered. It said '*signs and indications*' which may serve '*in normal use*' which it said was the '*point of view of the target public*' which refer to '*their essential characteristics*' were caught by this provision.

It went on to say that for a sign to be caught that there had to be a '*sufficiently direct and specific relationship between the sign and the goods...to enable the public concerned immediately to perceive without further thought*' that the mark was a description of either the goods or services, or their characteristics. As to this it said the Board of Appeal was correct when it said the '*relevant public*' was '*the average consumer who is reasonably well informed and reasonably observant and circumspect*'. It endorsed the Board of Appeal who also found that such a consumer would be bilingual in French and English.

Whilst the CJEU noted that there were well known expressions such as '*en vogue*' on '*in vogue*' which meant '*fashionable tendency*', it ruled that Trinity had '*not demonstrated that the word "vogue" was used as a synonym for those expressions*'. In evidence Trinity had adduced the results of various internet searches for the word 'Vogue'. However the CJEU said that '*this did not prove that the word "vogue" is descriptive of the goods*' covered by Nice Class 3. It was heavily sceptical of this evidence saying that the fact that the internet search '*displays around 850 million results does not prove by itself that "vogue" is descriptive*'.

Although trade mark registration authorities in both Germany and Switzerland had refused to register 'Vogue', it said this was irrelevant because the EU system is '*an independent system*' and that a '*contested mark must be assessed only on the basis of the relevant EU rules*' and that '*national decisions can in no circumstances call into question the validity*' of the EU IPO decision to register 'Vogue' as a trademark. Trinity's challenge under Article 7(1)(c) was therefore rejected.

What did the CJEU rule on Article 7(1)(b)?

On whether 'Vogue' is devoid of any distinctive character, the CJEU said that distinctiveness had to be assessed in relation to:

- the goods or services for which registration has been requested, and
- the perception of the public concerned being those consumers of those goods or services.

The Board of Appeal had ruled that 'Vogue' was distinctive and Trinity had not demonstrated that it was '*commonly used in advertising as a laudatory term*'. The CJEU said that the Board of Appeal had not committed any error in ruling that 'Vogue' was not descriptive. Finally the CJEU expressly ruled that the word 'vogue' was '*not used as a synonym of the word "fashion" or the expression "en vogue"*'.

Trinity's challenge under Article 7(1)(b) was therefore rejected.

What did the CJEU rule on Article 52(1)(b)?

As to whether the publisher of 'Vogue' had been acting in bad faith when it filed the application for the trade mark, the CJEU said that '*account must be taken of all the relevant factors specific to the particular case*' and singled out these 3 factors in particular:

- whether an applicant knows or must know that someone else is using an identical or similar sign for an identical or similar product that could be confused with the mark,
- an applicant's intention of preventing that 3rd party from using such a sign, and
- the degree of legal protection enjoyed by the both the 3rd party's and the applicant's sign.

The CJEU said that it could not be bad faith to try and seek registration for a mark with the protection that this confers across the EU because that '*was the very object of the EU trade mark system*'. Trinity said Vogue's publisher had submitted trademark registrations for 'Vogue' in Class 3 in numerous EU member states between 1962 and 2003. Trinity said Vogue's publisher did this '*without the intention of using them but with the sole consequence of avoiding consequences of non-use*'. Both EU IPO and Vogue's publisher disputed this.

The CJEU noted that '*Vogue*' had been registered as a trademark in many countries including UK, Ireland, Spain, Italy and France. '*Vogue*' was also registered internationally as a trademark in August 1998. The CJEU said there was a clear distinction to the *Canal+* case **R1260/2013-2** where the EU IPO

Trinity Haircare AG v. EU IPO and Advance Magazine Publishers Inc - Case T-453/15
Vogue is distinctive enough to be registered as a trade mark

had to determine the extent to which an earlier trade mark might be relied upon. It said this was different to the assessment of bad faith.

Although the publishers of Vogue had withdrawn its opposition to Trinity's application to register 'Vogue de Trinity' in the Spanish Patent and Trademark Office, the CJEU said withdrawal did '*not constitute evidence of non-use of the contested name*'. The CJEU said that an '*EU trade mark enjoys a presumption of validity*'. Trinity's final challenge under Article 52(1)(b) was also therefore rejected.

What will happen next?

The CJEU ordered Trinity to pay the costs of both EU IPO as well as those of the publisher of Vogue. As this is a CJEU decision there is no further appeal. However it seems that there may still be other battles between the 2 companies over 'Vogue de Trinity' in other countries and relating to other Nice classes.

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David Bowden is a solicitor-advocate and runs David Bowden Law which is authorised and regulated by the Bar Standards Board to provide legal services and conduct litigation. He is the cases editor for the Encyclopedia of Consumer Credit Law. If you need advice or assistance in relation to consumer credit, financial services or litigation he can be contacted at info@DavidBowdenLaw.com or by telephone on (01462) 431444.

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