

**O-265-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 3 088 393 "AMY-ELLE"  
IN CLASSES 03 AND 44 IN THE NAME OF AMY-ELLE ROBINSON**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 404 038 BY  
HACHETTE FILIPACCHI PRESSE**

## Background and pleadings

1. Ms Amy-Elle Robinson (the applicant) applied to register the trade mark AMY-ELLE under No 3 088 393 in the UK on 07/01/2015. It was accepted and published in the Trade Marks Journal on 23/01/2015 in respect of the following goods and services:

Class 03:

Massage oil; Massage creams, not medicated; Massage oils, not medicated; Massage gels other than for medical purposes; Skin lotion.

Class 44:

Information relating to massage; Massage and therapeutic shiatsu massage; Massage services; Health care relating to therapeutic massage; Massage; Massage and therapeutic shiatsu massage; Health care relating to therapeutic massage; Personal therapeutic services relating to circulatory improvement; Personal therapeutic services relating to muscle re-education; Therapeutic treatment of the body; Therapeutic treatment of the face.

2. Hachette Filipacchi Presse (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of the following:
  - a) European Union (formerly Community) Trade Mark No 1 008 4572 ELLE which relies upon some services in Class 44 only, namely Hygiene and beauty care; hairdressing salons, beauty salons; Manicure salons, massage, beauty care, beauty consultancy, make-up consultancy, nutritional consultancy; Balneotherapy consultancy; Health and fitness services, spa, aromatherapy, thalassotherapy, balneotherapy, chromotherapy (colour and light therapy), sound therapy services; Fitness services using saunas, hammams and baths fitted with pressurised water jets, medical services; Hairdressing salons, Plastic surgery, Hair implantation, Manicuring; Hospices.
  - b) International Trade Mark (designating the EU) No 546 813 **ELLE** which relies upon goods in Class 03 only, namely cosmetic and beauty preparations; perfumery.
  - c) The opponent argues that the respective goods and services are identical or similar and that the marks are similar.
  - d) The opponent also opposes the application on the basis of Section 5(4)(a) of the Act. This is on the basis of its claimed earlier right in ELLE which it claims has been used since January 1985 throughout the UK in respect of

*cosmetics, toiletries, magazines, clothing, fashion accessories, information relating to fashion beauty and lifestyle.*

- e) The opponent also claims that ELLE is a well known mark under the provisions of Section 6(1)(c) and as such is entitled to protection under the Paris Convention in respect of magazines, cosmetic and beauty goods, fashion accessories such as jewellery, and goods and services related to female interest and lifestyle. As such, the later mark is contrary to Section 56(1).
3. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier International trade mark No 546 813 relied upon).
4. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
5. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## **Evidence**

### **The Opponent's Evidence**

6. This is comprised of two witness statements. The first is from Casey Joly, dated 9<sup>th</sup> September 2015. Mr Joly is a lawyer in charge of intellectual property matters on behalf of the opponent, a position held for 23 years.
7. In response to the applicant's request for proof of use in respect of earlier International Trade Mark No 546 183, Mr Joly explains that the opponent granted an exclusive licence to the well-known cosmetic and fashion house Yves St Laurent in 2007, renewed in 2011, 2014 and then on a non-exclusive basis as of January 2015. The licence grant concerns the use of ELLE for both perfumes and for derived cosmetic products such as body lotions and deodorants. Details of the agreement are included in Exhibit 1 to the witness statement.
8. Exhibit 2 to the witness statement provides turnover figures for the year 2011. This is 11,110,000 euros, of which 27% is turnover in the UK. Figures are also provided for 2012 in Exhibit 3: 8,940,000 euros, of which 25% is turnover in the UK. Both of these exhibits display photographs of packaged goods. These are predominantly perfumes with a smattering of lotions and cosmetics. Mr Joly goes on to state that according to his information (derived from archives), the sales in the UK of ELLE cosmetics and perfumes totalled 4,561,700 euros in 2010; 2,850,000 in 2011; 2,247,000 in 2012 and 1,147,000 in 2013 (all amounts in euros).
9. Mr Joly goes on to provide details of further licensing deals, effective in the European Union from 2014 onwards, including one with Berdoues for

perfumes and Measa in respect of cosmetics and beauty preparation. Further, details are provided of a perfume aimed at children launched in March 2015 and of a make-up line launched in France in September 2014. Exhibit 8 contains information regarding advertisements, shops selling the products etc. Mr Joly is of the view that all of the aforesaid information fully supports use shown of earlier International Trade Mark 546 813.

10. As regards reputation of ELLE in the UK, Mr Joly goes on to describe the success of the ELLE UK magazine which has been sold in the UK for 30 years with an average reach of 865,000 readers and an average circulation of 155,000 per issue. ELLE's UK digital presence through its mobile, tablet and desktop applications represent 550,000 unique visitors each month and 5.5 million page impressions each month. On social media, ELLE UK's presence on Facebook adds 13,000 fans per day; their Twitter account has 689,000 followers; on Instagram they have 310,000 followers and their presence on Pinterest represents 27,000 followers. There is mention of an ELLE online beauty shop, a collection of 4000 beauty products with recommendations from the beauty team. There is no other information however, including how this shop has been performing etc.
11. Mr Joly concludes his witness statement by describing a number of awards the ELLE magazine has won from 2006 onwards and ends by describing the ELLE Beauty awards which were launched in 2012. Mr Joly is of the view that this supports the assertion that ELLE enjoys a considerable reputation in respect of magazines.
12. The second witness statement is dated 30<sup>th</sup> October 2015 and is from Nick Bowie, a Senior Associate at Keltie LLP, the opponent's representatives in these proceedings. The relevant information contained therein is as follows:
13. Exhibit EL4 is annual revenue figures generated from the sale of Class 3 products bearing the trade mark ELLE. UK figures are: 2009: 4.5 million euros; 2010: 4.6 million; 2011: 2.9 million; 2012: 2.2 million. It is noted that these have not been split according to particular products.
14. The remaining exhibits are included so as to provide registration details of the earlier trade marks relied upon and also to reinforce previous information regarding the content of ELLE magazines. That is, that they are in respect of fashion and beauty. Exhibit 7 contains announcements of the ELLE Beauty Awards in UK, Finnish and Italian editions of the ELLE magazine. It is noted that the Beauty Awards in effect review beauty products according to particular categories (face, body, hair for example) and then decide on a "winner". It, in effect, provides information about particular products and publishes this information along with choosing a winner in its magazines.

## Conclusions on the opponent's evidence

15. In respect of proof of use of earlier International trade mark No 546 813, it is noted that this trade mark designates the European Union (EU) and so evidence of use in other relevant EU countries will count. This trade mark is registered in respect of goods in Class 03, namely cosmetic and beauty preparations; perfumery. In assessing the evidence filed, I bear in mind the following statutory provisions and case law:

### Proof of use

#### Relevant statutory provision: Section 6A:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in

accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. The evidence filed overwhelmingly demonstrates that the earlier trade mark 546 813 has been used in respect of perfumes. The opponent has therefore clearly managed to clear that hurdle. There is also evidence that prior to the relevant date in these proceedings, namely 1<sup>st</sup> January 2015 that an extensive range of cosmetic and beauty products were offered for sale throughout France. The evidence filed does persuade me that the earlier trade mark 546813 has been put to genuine use and in respect of the entire class 03 goods for which it is registered: cosmetic and beauty preparations; perfumery.

## DECISION

### Section 5(2)(b)

19. Sections 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### Comparison of goods and services

20. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

21. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- 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.



The earlier goods and services are:

- a) International Trade Mark No 546 813 **ELLE** which relies upon (and for which has been proven) goods in Class 03:

Cosmetic and beauty preparations; perfumery.

- b) European Union (formerly Community) Trade Mark No 1 008 4572 ELLE which relies upon some services in Class 44:

Hygiene and beauty care; hairdressing salons, beauty salons; Manicure salons, massage, beauty care, beauty consultancy, make-up consultancy, nutritional consultancy; Balneotherapy consultancy; Health and fitness services, spa, aromatherapy, thalassotherapy, balneotherapy, chromatherapy (colour and light therapy), sound therapy services; Fitness services using saunas, hammams and baths fitted with pressurised water jets, medical services; Hairdressing salons, Plastic surgery, Hair implantation, Manicuring; Hospices.

The later goods and services are:

Class 03:

Massage oil; Massage creams, not medicated; Massage oils, not medicated; Massage gels other than for medical purposes; Skin lotion.

Class 44:

Information relating to massage; Massage and therapeutic shiatsu massage; Massage services; Health care relating to therapeutic massage; Massage; Massage and therapeutic shiatsu massage; Health care relating to therapeutic massage; Personal therapeutic services relating to circulatory improvement; Personal therapeutic services relating to muscle re-education; Therapeutic treatment of the body; Therapeutic treatment of the face.

Comparison of goods in Class 03:

22. The earlier goods include cosmetic and beauty preparations at large. These include a large number of products which improve the condition of and/or beautify the skin in some way. Massage oils, creams and gels are obviously used during the provision of a massage service and are used to aid circulation, drainage of fat cells and the overall appearance and texture of the skin. The later massage related goods are therefore considered to be identical. The later skin lotions are also considered to be included in the earlier terms.

## Comparison of services in Class 44:

23. The earlier services include massage services at large. The following contested services are examples of services which fall within the umbrella of the earlier term: *information relating to massage; Massage and therapeutic shiatsu massage; Massage services; Health care relating to therapeutic massage; Massage; Massage and therapeutic shiatsu massage; Health care relating to therapeutic massage*; They are all considered to be identical. The later terms: *Personal therapeutic services relating to circulatory improvement and Personal therapeutic services relating to muscle re-education* also involve the use of massage (or otherwise utilise knowledge of massage techniques as an integral part of the provision of this service). They are also considered to be identical or at least highly similar. The remaining contested terms are *Therapeutic treatment of the body; Therapeutic treatment of the face*. This will include activities such as facials, body wraps etc. The earlier services include terms such as *beauty care*, which is highly likely to include the contested activities. They are also therefore considered to be identical.
24. The sum of all this is that the later terms are all either identical and/or highly similar to the earlier terms.

## Comparison of marks

25. 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 Court of Justice of the European Union 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.”
26. 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.

27. The respective trade marks are shown below:

ELLE <b>ELLE</b>	AMY-ELLE
Earlier trade marks	Contested trade mark

28. As regards distinctive and dominant components, the earlier trade marks are comprised of one element and so the answer is straightforward. The element ELLE in the later sign does not jump out as being a more distinctive or dominant feature than AMY-. Indeed it is the – that connects it to AMY thus creating a whole (and different) name. All of the marks will be appreciated instantly as a whole and so the correct comparison is to be made on this basis.

29. Visually, there is a point of coincidence in respect of the element ELLE which comprises the entirety of the earlier sign and the second half of the later mark. This is tempered with the differences, namely the addition off AMY- in the later mark. This is considered to have an important visual impact and as such, the degree of visual similarity is considered to be low.

30. Aurally, the matter is very similar. The earlier trade mark is one syllable – ELLE and the later trade mark is three – A-MY-ELLE. This difference is important and the overall degree of visual similarity is considered to be low.

31. Conceptually, it is doubtful as to whether the name of a person can be a concept in the true sense of the word. However, in giving the opponent the benefit of the doubt, each are female first names with two first names being used together in the case of the later mark. In the abstract they can be argued to be conceptually similar as they are both female given names. However, they are different female names and the addition of AMY provides this clear difference. There is no shared concept here.

## **Average consumer and the purchasing act**

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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*.

33. 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.”

34. The goods and services in question will not be purchased on a daily basis, but equally not infrequently either. There will be a range of expense involved, from relatively low amounts in respect of Class 03 goods, to relatively higher amounts in respect of the Class 44 services. The goods will be purchased visually, aurally and as a result of word of mouth. The services are also likely to be chosen via word of mouth and also chosen according to individual need. Choosing the correct, for example, massage oil can include factors such as smell, suitability for skin type etc. The same thought process applies to lotions. In respect of, for example, massage services, there are a number of different types of massage available and a decision as to the exact type will be taken according to the needs of the individual involved. Other therapeutic treatments will often involve skin testing prior to a treatment taking place. All in all, it is considered that the purchase of these goods and services will be a fairly considered one, with the relevant consumer (in this case the general public) paying a medium degree of attention during the purchasing process.

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

35. 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-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).”

36. It is noted that the perfumery products sold are sold under two trade marks: ELLE and YVES ST LAURANT. Further, the turnover figures provided are not put into any clear context, such as the size of the marketplace. Evidence of advertising activity in the UK as regards perfumery is limited. So while it is accepted that there has been use of the ELLE trade mark in respect of perfumes, I am not persuaded that this has been of a nature to ensure that ELLE is elevated to enjoying an enhanced degree of protection. Rather it is considered that it will be seen as a female name and so has an average degree of distinctiveness.

37. There has been no evidence provided to suggest that the earlier EU trade mark: ELLE enjoys an enhanced degree of protection in respect of the earlier services. As such, the matter must be judged on a prima facie basis. ELLE is a female first name; is not wildly popular but not unusual either. It is considered to have an average degree of distinctiveness in respect of all the earlier goods and services.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

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

39. It is true that the goods and services have been found to be identical and/or highly similar. This is important as the interdependency principle is in full

operation here. The marks have been found to be visually and aurally similar to only a low degree. Further, there is no shared concept. The marks are female names, but differing female names. The earlier marks cannot be properly said to have an independent distinctive role in the later trade mark: the later mark is merely a differing first name, with AMY- connecting it clearly to ELLE to create a double barrel first name. It is true that the earlier trade mark has an average degree of distinctiveness, but this does not overcome the impact on the clear differences between the signs, especially as it does not have the effect of elevating the element ELLE to a place of greater importance within the later mark. It is also the case that the relevant public will display a medium degree of attention during the purchasing process. This reduces the impact of imperfect recollection. Bearing in mind all of the foregoing, it is considered that there is no likelihood of the relevant public mistaking one mark for the other and so direct confusion is not found.

40. However this is not the end of the matter as the aforesaid only considers the issue of direct confusion. As regards indirect confusion, I bear in mind the following:

In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

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

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).”

41. It is considered that the trade marks in question here clearly do not fall within any of the categories listed above (though this is of course a non-exhaustive list). ELLE is not so strikingly distinctive that the relevant public would assume AMY-ELLE is from the same brand owner; the later mark does not simply add a non-distinctive element: AMY- combines with ELLE to create a whole with a clearly differing identity and finally the earlier trade marks do not consist of a number of elements with a change of one element appearing logical and consistent with a brand extension. It is concluded that there is no likelihood of indirect confusion here.

42. The sum of all this is that the opposition under Section 5(2)(b) fails.

## **Section 5(4)(a) – Passing Off**

### **Legislation**

43. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”



## Case Law – Passing Off

44. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

45. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently

similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

## Goodwill

46. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

47. Bearing in mind the evidence filed, it is clear that ELLE enjoys a significant goodwill in respect of magazines, specifically fashion, beauty and lifestyle magazines. In respect of other goods however, the evidence is scant, with the majority of use in respect of other products (cosmetics and beauty products for example) being in France. As such, they do not demonstrate use in the UK. It is true that use has been shown in the UK in respect of perfumes but this product is not specifically part of the claim under Section 5(4)(a).

However, toiletries are, of which perfumes may be a specific example. As such, it is considered that the claim under Section 5(4)(a) should be restricted to that in respect of fashion, beauty and lifestyle magazines and perfumes only.

## Misrepresentation

48. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

49. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the

plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

50. The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration:

'...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':

(*Annabel's (Berkeley Square) Ltd. v. G. Schock* (trading as *Annabel's Escort Agency*) [1972] R.P.C. 838 at page 844 per Russell L.J).

51. In the *Lego* case *Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.
52. Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.
53. Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on

plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

54. It is accepted that ELLE has acquired a significant goodwill in respect of beauty, fashion and lifestyle magazines. Though not the same field of activity as the trade mark applied for, they are not a million miles apart either. However, as I have already found, the trade marks in question here are differing female names. Even in considering the impact of a significant goodwill in respect of ELLE it is difficult to see how there will be a misrepresentation as the later trade mark contains ELLE as only one element which cannot be viewed in isolation as it is clearly a double barrelled first name in conjunction with AMY-. The significant goodwill in beauty, fashion and lifestyle magazines does not take the opponent any further.
55. Likewise, in respect of perfumes, for which ELLE has a more modest (but still protectable) goodwill, it is difficult to see how this places the opponent in a better position. There is a stronger claim to a common field of activity between perfumes and the goods and services applied for by the applicant. However, the important differences between the signs remain. There is no misrepresentation here either.
56. The claim under Section 5(4)(a) therefore also fails.

## **Final Remarks**

57. It is noted that the opponent also claims that ELLE is a well known mark under the provisions of Section 6(1)(c) and as such is entitled to protection under the Paris Convention in respect of magazines, cosmetic and beauty goods, fashion accessories such as jewellery, and goods and services related to female interest and lifestyle. As such, the later mark is contrary to Section 56(1). As already found above, ELLE has been used in France (a Paris Convention country) in respect of cosmetic and beauty preparations;

perfumery. Further there is clearly use shown in respect of magazines in the same country. However, it is considered that ELLE is only well known in the United Kingdom in respect of beauty, fashion and lifestyle magazines. Bearing in mind all of the findings above, it is difficult to see how the well known claim places the opponent in a better position. It is concluded therefore that this claim also fails.

58. As such, the opposition has failed in its entirety.

## **COSTS**

59. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering Notice of Opposition and accompanying statement: £200

Considering evidence - £300

60. I therefore order Hachette Filipacchi Presse to pay Ms Amy-Elle Robinson the sum of £500. The above sum should 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 25<sup>th</sup> day of May 2016**

**Louise White**

**For the Registrar,  
The Comptroller-General**