

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2,505,006  
FOR YELP (AND DEVICE) (SERIES OF 4) IN CLASSES 35, 38, 41, 42 AND 45 IN THE NAME OF  
YELP! INC**

**AND IN THE MATTER OF OPPOSITION NO. 99222 THERETO BY YELL LIMITED**

**AND IN THE MATTER OF THE APPEAL BY YELL LIMITED AGAINST  
THE DECISION OF MR OLIVER MORRIS DATED 6 JUNE 2011**

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**DECISION**

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1. This is an appeal against a decision of Mr Oliver Morris, the Hearing Officer for the Registrar, dated 6 June 2011, in which he rejected an opposition brought by Yell Limited upon the basis of section 5(2)(b) of the 1994 Act against a trade mark application made by Yelp Inc. for a series of 4 marks consisting of the word Yelp and a device.
2. The thrust of the appeal by Yell Limited, (“the opponent”), was to criticise the Hearing Officer’s conclusions that there was no likelihood of confusion between the parties’ respective marks. It sought permission to adduce evidence on the appeal which had not been put before the Hearing Officer which, it said, amounted to evidence of actual confusion. For the reasons set out below, I do not consider that it would be appropriate to grant permission to the opponent to adduce that evidence and I have not, therefore, taken it into account on the appeal. Further, for the reasons which I give below, I do not accept that there were material errors or errors of principle made by the Hearing Officer in his decision in this case which would

justify me setting aside his decision and substituting my own conclusions as to the likelihood of confusion. The appeal therefore fails.

**Background**

3. Yelp! Inc (“the applicant”) applied to register its marks on 17 December 2008. The application is for a series of four trade marks, consisting of the mark set out below in four different colourways: all black, black/grey, black/red and all red:



4. The application covered a wide range of services in Classes 35, 38, 41, 42 and 45. For reasons which will become clear, I do not need to set these out here.
5. The opponent opposed all of the marks for all of the services in the specification on the basis of section 5(2)(b). 17 earlier trade marks were relied upon including some earlier marks which were then at the application stage. Six were device marks and the rest word marks. All of the earlier marks included the word “YELL.” Mr Morris took the view that the closest of the opponent’s marks to the applicant’s mark were:
  - a. A Community trade mark application No 2172682 (“the CTM”) filed on 10 April 2001 in classes 9, 16, 35, 36, 37, 38, 39, 41 & 42 for the device mark:



- b. A UK registration No 2451074 (“the UK Mark”) filed on 28 March 2007 in classes 9, 16, 35, 36, 37, 38, 39, 41 & 42 for the word mark series:

YELL.COM

**Yell.com**

6. The CTM and the UK Mark were put forward by the opponent as their 'best' marks for the opposition, and the Hearing Officer considered the merits of the opposition in relation to those marks alone, on the basis that if it failed for those marks it could not succeed for the rest. Moreover, he considered the likelihood of confusion in relation to certain services in Class 35 which fell within both parties' specifications, and which he considered to be identical services, again on the basis that if the opponent could not succeed in those circumstances, it would be unlikely to succeed otherwise.
7. Proof of use was not required for either of the earlier marks. However evidence was filed by both sides, together with lengthy written submissions, and there was also a hearing before Mr Morris at which Mr James Mellor QC represented the opponent and Mr Henry Ward represented the applicant. At the hearing of the appeal, the same counsel represented the parties and I am grateful to them for their detailed submissions.

### **The Grounds of Appeal**

8. All of the Grounds of Appeal relate to the Hearing Officer's assessment of the likelihood of confusion. I can summarise them as follows:
  - (1) The Hearing Officer over-analysed the marks;
  - (2)/(3) The Hearing Officer did not find a high enough degree of conceptual similarity (this point was foreshadowed by Ground (1));
  - (4) The Hearing Officer misapplied the law about the distinctive/dominant components of the marks when considering the visual similarity between the marks;

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- (5) This affected the Hearing Officer's decision on aural similarity;
- (6) The Hearing Officer attributed too high a level of attention to the appropriate consumer;
- (7) All of these points vitiated the assessment of the likelihood of confusion;
- (8) The Hearing Officer failed to consider how confusion might have arisen;
- (9) The opponent sought permission to adduce fresh evidence on the appeal which allegedly showed actual confusion;
- (10) The Hearing Officer gave insufficient weight to the reputation of the earlier marks; and
- (11) The Hearing Officer should not have taken "comfort" from the lack of any evidence of actual confusion.

### **The Standard of Review**

9. There was some discussion before me as to the current state of the law on the standard of review on an appeal of this nature, though it was common ground that the appeal is by way of a review, not a rehearing. Mr Mellor QC suggested that the modern trend was simply to cite *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*"), to the effect that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal, and to bear in mind that just because a decision could have been better expressed does not disclose an error of principle. In *Reef*, Robert Walker LJ (as he then was) said:

*"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle"* (*Reef*, para. 28).

10. So I would need to be satisfied that there is a distinct and material error of principle in the decision or that the Hearing Officer was clearly wrong. Those principles have since been affirmed by the House of Lords in *Datec Electronics Holdings Ltd & Ors v.*

*United Parcels Services Ltd* [2007] UKHL 23, [2007] 1 WLR 1325. Mr Daniel Alexander QC sitting as the Appointed Person in case BL O/471/11, *Petmeds*, 14 December 2011, summarised the position:

“*Datec* and other cases since *REEF* and *BUD* all reinforce the need for caution before overturning a finding of the tribunal below of the kind in issue in this case. Difference of view is plainly not enough ... However, those cases and the practice of appellate tribunals specifically to trade mark registration disputes show that the degree of caution should not be so great as to permit decisions based on genuine errors of approach to go uncorrected.”

11. Mr Mellor QC suggested to me that Mr Alexander QC's decision in *Petmeds* was a more up-to-date and appropriate analysis of the position following *Datec* than Mr Alexander's own earlier decision in *Digipos* [2008] Bus LR 1621, upon which Mr Ward sought to rely. The relevant passage in *Digipos* read:

“5. It is important at the outset to bear in mind the nature of appeals of this kind. It is clear from *Reef Trade Mark* [2003] RPC 5 (“*Reef*”) and *BUD Trade Mark* [2003] RPC 25 (“*BUD*”) that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle” (*Reef*, para. 28)

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer's decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from

the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference. I approach this appeal with that in mind.”

12. It does not appear to me that there is a significant distinction to be drawn between those two judgments of Mr Alexander QC sitting as the Appointed Person. Both cases follow the principles laid down in *Reef*, and the approach which I need to adopt to this appeal is to decide whether there are in the Hearing Officer's decision errors of principle or material errors, which Mr Alexander called "genuine errors of approach". In my view, the fact that the appeal is limited to a review would not prevent me from overturning the decision if such an error was committed. If so, the decision should be set aside, even if the error relates to the assessment of the likelihood of confusion; if not, the decision should not be set aside, even if I would not have reached the same conclusion as the Hearing Officer or am surprised by his conclusions.

**The basis of the decision below**

13. The relevant part of the decision starts at [32]. For brevity, I have deleted the Hearing Officer's footnotes from passages quoted below. Mr Morris noted that the average consumer normally perceives a mark as a whole and does not analyse its various details, so 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. He said  

“It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.”
14. Mr Morris referred to the parties' competing submissions as to the dominant characteristics of the marks and to paragraphs 39-42 of the CJEU's judgment in *Shaker di L. Laudato*. He went on

“34) In view of the above guidance, it would only be possible to make the comparison solely on the basis of the words YELL/YELP if I were satisfied that the additional aspects of the respective marks were negligible. I am far from satisfied that that is the case. Nevertheless, ... the words YELL and YELP constitute the dominant and distinctive elements of the respective marks. In terms of [the applicant’s] mark, whilst it also has a device element which is distinctive in its own right, this element plays a subordinate role in its overall impression on account of its positioning, its slightly lower contribution to the visual aspect of the mark (than YELP) and that it plays no role in its aural and conceptual aspects. ... in this case, the rule of thumb that words speak louder than devices applies. Although the device element is not the dominant and distinctive element it still, though, constitutes a dominant element of the mark, it is simply less dominant (but not to a huge degree) than the word.

35) A similar assessment can be made in respect of [the opponent’s] marks. [Its] word and device mark is dominated more by the word YELL than by the device element. ... More attention will, again, be placed on the word element which I consider will dominate the overall impression to a strong degree (although not to the point where the device is completely negligible). In respect of the YELL.COM mark, the .com aspect will be so familiar to the average consumer as simply being a domain level indicator that YELL also dominates quite strongly here.

36) I will consider firstly the visual perspective. The points of similarity are contained within the dominant and distinctive elements of the respective marks (YELL and YELP). I must bear in mind that these elements are relatively short words. The first three letters (YEL) being the same, but the fourth letters being different (L/P). However, the impact of the different letter is by no means lost in the overall impression of the marks. I also note the comments of the GC in *Inter-Ikea Systems BV v OHIM* where it was stated:

“54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the

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contested mark and the letter 'k' in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.

55 Accordingly, the degree of visual similarity of the earlier word marks and the verbal element of the contested mark must be described as low.”

37) The above judgment relates to the words IDEA/IKEA. In the case before me the difference (at least between YELL and YELP) is at the end of the words rather than towards the beginning, a point highlighted by Mr Mellor. However, the point made by the GC still applies. In short words, differences in the letters, even if at the end of those (short) words, are likely to stand out more. The difference is less likely to be overlooked. I must also factor in the further visual differences created by the device elements of the respective word and device marks and the additional wording in YELL.COM. Even though YELL and YELP may be the dominant and distinctive element, these differences should not be ignored completely from the analysis. I come to the view, based on all these factors, that there is only a low degree of visual similarity.

38) Similar considerations apply to the aural comparison ... The shortness of the words YELL and YELP means that the difference created by the final letters and their impact on the respective pronunciations is unlikely to be lost or overlooked. The P in YELP creates an additional aspect of articulation YEL-P. The addition of “.com” in YELL.COM provides a further point of difference, although I must, of course, bear in mind my earlier assessment regarding the distinctiveness of the .com element. Overall, I consider there to be a moderate degree of aural similarity.”

15. Mr Morris then set out the well-known passage from Case T-292/01, *Pash/BASS* as to conceptual differences which may distinguish marks, continuing:

“41) Both the words YELL and YELP are known English dictionary words. I will come on to their meanings shortly. I do not consider that the additional aspects

of the marks under comparison add to, or detract from, the conceptual significances that the average consumer will perceive.”

The applicant had submitted that the conceptual significance of the word YELL in Ltd’s earlier marks was not as the dictionary word ‘Yell’ but was an abbreviation of YELLOW PAGES, because of the link between YELL and the YELLOW PAGES business demonstrated in the evidence. The Hearing Officer went on:

“42) Having assessed the evidence, I come to the view that some consumers (the minority) may not appreciate the link with YELLOW PAGES, particularly those who do not know of the longstanding history of the business. However, I accept that it is likely that the average consumer (both businesses and the public) will be aware of and will appreciate the link. ... the evidence paints a compelling picture of the link between YELLOW PAGES and YELL/YELL.COM. This is clearly intentional ... even if the average consumer perceives the link and that he or she understands that the website providing business information at YELL.COM is the online equivalent of the paper based YELLOW PAGES, and even if he or she assumes that the YELLOW PAGES name played a part in the genesis of the YELL name (the borrowing of the first four letters of YELLOW), it is another thing altogether for the average consumer to set aside the concept that would ordinarily underpin the word YELL. ... I must be satisfied that the use made by Ltd will have resulted in the primary meaning (in the context of the services) of the word YELL being YELLOW PAGES. I do not consider this to be the case. The average consumer may be aware of the link and may be aware of the likely genesis, but he or she is still likely to immediately recognize the word for what it is (an English dictionary word) and this is how it will be stored away for future recall. ...

43) The conceptual comparison must, in view of the above analysis, be based on the words YELL and YELP in accordance with their normal meanings.

...

45) The assessment must be made from the perspective of the average consumer. ... It is the immediate grasp of the average consumer that it is

important. It must also be borne in mind that the average consumer will not be armed with a dictionary. It is true, though, that both the word YELL and YELP relate to noises or utterances. In my view, yell will be perceived as someone, usually a person, shouting – they will normally be yelling at someone or something. Yelp, on the other hand, is the noise itself. It will most commonly be perceived as the noise that a dog or other animal will make when in pain. A yelp will not necessarily be loud, there is no reason why an animal cannot yelp quietly. Bearing all this in mind, whilst there is a degree of similarity on a certain level of generality, the words are still distinct and different English words. I consider there to be a moderate, neither high nor low, degree of conceptual similarity.”

16. The Hearing Officer next found that the earlier marks possessed a reasonable degree of inherent distinctiveness and, at [47], that the evidence also “paints a compelling picture that the earlier marks are entitled to an enhanced degree of protection” due to the use made of them so that both of the opponent’s marks should be regarded as highly distinctive.
17. At [48], Mr Morris considered the applicant’s submission that such distinctiveness did not mean that confusion was more likely, or that the concept of imperfect recollection plays less of a role. He did not accept this submission, saying:

“To do otherwise would be to penalize the well-known mark and to count against it its reputation rather than to provide it with enhanced protection. ... Whilst there is, of course, interdependency in the various factors, this cannot equate to ignoring what is stated by the CJEU regarding distinctiveness and its relationship with the likelihood of confusion.”
18. Having referred to the interdependency principle, Mr Morris went on at [50]:

“As stated, the services are identical and the earlier marks highly distinctive. The marks have a degree of similarity but I have assessed the various aspects of similarity to be low to moderate. I must bear in mind the concept of imperfect recollection. I come to the view that the average consumer will be

well able to differentiate and distinguish between the marks. The marks are not highly similar and are of such a nature that a normal, reasonably observant and circumspect person will be able to differentiate between them. The visual and aural differences outweigh the similarities to a large extent. In terms of concept, a meaning is not stored away in the abstract. The concepts underpinning the marks will be stored away as YELP and YELL respectively. Imperfect recollection is borne in mind, but I do not consider this factor, in the circumstances of this case, to be so acute for the marks to be misremembered or miss-recalled as each other. I think that at most, all the similarity (together with the other factors) achieves is for the YELL marks to be brought to mind. Such an association would not, though, be of such a nature that the average consumer would believe that the same or related economic undertaking is responsible for both. Neither would there be any reason for an average consumer who has perceived the difference between YELL and YELP to nevertheless believe that the marks (or the undertakings responsible for them) are connected.

51) In reaching the above conclusion I have borne in mind the principle of initial interest confusion which Arnold J. confirmed as an appropriate form of confusion in *Och-Ziff Management Europe Ltd v. OCH Capital LLP* [2010] EWHC 2599 (CH). However, whether initial interest confusion is likely to arise must be based on the particular facts and circumstances of the case. I did not find the examples given by Mr Mellor particularly convincing. He referred to the potential for a person to mistype on a computer (whilst entering a URL) the word YELP as YELL and, also, the potential for a person seeing an entry for YELP in the results generated by a search engine, mistaking it for YELL and clicking on it and then simply using the YELP service to find the required business information because they had arrived at a business information service even though it was not the one they had intended. In terms of the mistyping point, this is not an appropriate form of confusion as it is not the use of Inc's mark that is causing this but merely a typing mistake which, in any event, I do not consider likely to happen. In terms of the search engine argument, I consider the differences between the words themselves to be

sufficient to prevent such an occurrence but, more fundamentally, this is not appropriate in the analysis before me because the mark put forward for registration is not the mark that is causing the claimed initial interest confusion. Based on the marks under comparison, I see no potential for initial interest confusion which places [the opponent] in any better position. There is no likelihood of confusion.

52) When reaching the above finding, I have not ignored the parties' arguments about confusion-free parallel trade. It is [the applicant which] argues that the lack of confusion is symptomatic of the marks not being likely to be confused. As this is my finding anyway then the argument takes [the applicant] no further forward. Whilst the absence of confusion could be said to vindicate the finding I have reached, I would have had some hesitation in relying on the evidence to any significant extent on the basis of the relatively new business operated by [the applicant] in the UK (although I accept that the statistics provided demonstrate that a not insignificant amount of people have used [the applicant's] service in the UK) and that instances of confusion may not always come to light even if confusion has arisen. In summary, I take some comfort from the evidence but have placed no real weight on it."

19. The opposition therefore failed across the board and Mr Morris awarded costs to the applicant.

**The application to adduce fresh evidence**

20. As I have said above, the opponent indicated in its Grounds of Appeal that it would seek permission to adduce fresh evidence on the appeal. The hearing before Mr Morris took place on 18 March 2011. The evidence upon which it wished to rely consisted of an article from The Independent newspaper of 21 April 2011. The article, which discussed how to book a holiday or a flight, contained the following passage:

"... the quest to find the best ... flight can involve a juggling act between the price comparison sites, airline homepages and your calendar as you frantically date-hop for the best deal. Reviews aren't just posted on the website

TripAdvisor. Google a hotel, a resort, even a town and a wealth of options spring up: Booking.com, Hotels.com, even the Yellow Pages' 21<sup>st</sup>-century innovation, Yelp, has its tuppence to add."

This, the opponent wish to argue, showed that the journalist had been confused into the belief that the Yelp website was in some way connected with Yellow Pages, possibly because she thought that "Yelp" was a contraction of the words "Yellow Pages." Mr Mellor QC said in his skeleton argument: "The relevant part of the article speaks for itself. The journalist from the Independent plainly thought that YELP was the on-line version of YELLOW PAGES."

21. I consider that the application to adduce this evidence on the appeal was made in an unsatisfactory manner. It appears from counsel's submissions that the article came to the attention of someone within the opponent's organisation soon after the hearing in front of Mr Morris but before he had delivered his decision. Mr Mellor QC told me that his understanding was that the view was taken (he did not say by whom) that the hearing was over and the argument closed and it was not appropriate to provide the article to the Hearing Officer. I find that explanation inadequate. In addition, Mr Mellor QC could not explain why the opponent did not file a witness statement setting out in full the circumstances in which the article came to its attention, and giving a clear explanation as to why it was not felt appropriate, necessary or indeed desirable to send it to the Hearing Officer.
22. The procedure to be adopted when seeking permission to adduce on an appeal is well established, as is the basis upon which such an application may be granted: see *Du Pont trade mark* [2004] F.S.R. 15. It is therefore surprising that the opponent did not take the appropriate steps, given that the opponent is a large organisation and had instructed both specialist solicitors and counsel in this matter. This was a matter which I dealt with in my own decision BL O/092/11, *Jessica*, on 2 March 2011, in which I commented at [10] that the provision of written submissions explaining the basis of an application to adduce fresh evidence is no substitute for a witness statement explaining why the evidence was filed late and the significance of the evidence. The reason why it is generally appropriate to produce a witness statement

is in particular so as to be able to satisfy the Court as to the first of the requirements in *Ladd v Marshall* [1954] 1 W.L.R. 1498 as to the unavailability of the new evidence at first instance.

23. This is of course an unusual case, in that the evidence did not exist at the date of the hearing before Mr Morris. However it became available shortly afterwards and well before he had handed down his decision. In the circumstances, I find it difficult to understand why the opponent would not have wished to provide the evidence to the Hearing Officer, assuming that it considered it to be helpful to its case for the reasons submitted to me. At the very least, the opponent should have invited the Hearing Officer to take the evidence into account, if necessary giving the applicant an appropriate opportunity to comment upon it. It is not satisfactory that I was not given a proper explanation as to what the opponent's view was at the time, nor as to why the decision was taken not to put the evidence before the Hearing Officer. It is still less satisfactory that the evidence was not put before the Hearing Officer.
24. In my judgment, I should treat this evidence as if it had been available for the 'hearing' below. I can see no reason to treat the evidence as if (in effect) it had not come to the opponent's attention until after the relevant time, that is to say until after Mr Morris had made his decision.
25. In the circumstances, it is my view that the first of the *Ladd v Marshall* requirements is not met here.
26. The second of those requirements is that the new evidence would probably have an important influence on the result of the case. Again, it does not appear to me that this requirement is met. I do not feel it proper to rely upon the submissions made by Mr Ward at the hearing before me as to the possible explanation for any confusion on the part of the journalist who wrote the article. They were not based upon any evidence before me.
27. However, in my view, it is extremely difficult to tell from the newspaper article whether the writer was confused or not: the possibility cannot be excluded but it is

not, in my view, certain. On the other hand, it is certainly impossible to tell from the article whether any confusion from which the writer may have suffered arose by reason of the comparison of the Yelp combination trade mark with the opponent's earlier marks, that is to say, those marks relevant to this opposition, or for some other reason. Certainly, the article refers to 'Yellow Pages', and I accept that the Hearing Officer held (at [42] of his decision) that the average consumer may be aware of the link between YELL and Yellow Pages. Whether or not that was the nature of the author's thinking, it must be recalled that Yellow Pages is not the earlier mark relied upon, and I note that the opponent's own contention was that her confusion was between "Yelp" and "Yellow Pages", not between "Yelp" and "Yell" or "Yell.com." Mr Mellor QC argued that the link which the Hearing Officer had found to have been established in the minds of some members of the public between Yellow Pages and Yell suggested that this would reinforce a likelihood of confusion of confusion between YELL and YELP. I cannot accept that submission. One cannot tell or infer from the article whether the journalist had any knowledge of the use of "YELL" or any permutations of that name as a mark. Perhaps if the opponent had approached the journalist, it might have proved possible to clarify these points, but it does not appear to me that the newspaper article alone would have been likely to have had an important influence on the Hearing Officer's decision below. Equally, it does not appear to me that it would be likely to have an important influence on any assessment of the likelihood of confusion between the parties' relevant marks which I might see fit to carry out on appeal.

28. For those reasons, I refuse the application to adduce the article as fresh evidence on this appeal.

**The substantive points on the appeal**

29. The opponent sought to persuade me that the Hearing Officer had fallen into error in his assessment of the likelihood of confusion, by over-analysing the similarities between the parties' marks by reference to their visual, aural and conceptual similarities and then failing to consider the overall impression of the marks when

reaching his conclusion as to likelihood of confusion. Mr Mellor QC reminded me that the global appreciation of the likelihood of confusion is based on the overall impression given by the marks, since, as the CJEU said in Case C-342/97 *Lloyd Schuhfabrik*, at §25-6, the average consumer normally perceives a mark as a whole and is unlikely to see the conflicting marks side by side. He criticised the Hearing Officer, who had concluded that visual similarity was low and aural and conceptual similarity were moderate, for having "analysed too far" and gone beyond what the CJEU suggests that the average consumer does when considering a trade mark. This point was broadly the basis of Grounds (1) to (3) of the Grounds of Appeal. I return to the point in [39ff] below.

30. Before looking at the opponent's various criticisms of the Hearing Officer's assessment of the similarities of the marks, I think it worth recording that none of the opponent's earlier marks consisted of the word "YELL" alone, nor was the opposition based upon section 5(4) on the basis of any earlier unregistered rights in the word YELL, although the opponent's case was that its marks had acquired a substantial reputation prior to the relevant date. That point is of some significance, it seems to me, in considering the criticisms made on this appeal of the Hearing Officer's decision. The opponent had a slight tendency to treat the earlier marks as if they simply consisted of the word YELL (especially when considering the distinctive nature of and acquired distinctiveness of the earlier marks)<sup>1</sup> and to treat the mark applied for as simply consisting of the word YELP. That is not the appropriate approach, in my view and I note that §9-093 of Kerly's Law of Trade Marks and Trade Names (15<sup>th</sup> ed) states: "It is not appropriate, however, either to concentrate on the similarities to the exclusion of the differences between the marks or, where there is a composite mark comprising both graphic and word elements, to systematically regard the word elements as dominant." *Shaker* is cited as authority for that last proposition. It is therefore significant in this case that the Hearing Officer had found that the device element of the applicant's mark was not negligible but was, on the contrary, a further or subsidiary dominant element of the mark.

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<sup>1</sup> It did the same below in §4-5 of its submissions in Reply.

*Visual similarity*

31. Ground (4) of the Grounds of Appeal related to the Hearing Officer's assessment of the visual similarity between the marks. The first point raised by the opponent was that the Hearing Officer was wrong to conclude that the device element of the applicant's mark was *a* dominant (albeit not *the* dominant) element of the mark. It does not seem to me that this Ground is based upon any error of principle or any material error. The opponent is in effect asking me to substitute my own view of the impact of the device in the applicant's mark for the Hearing Officer's view, inviting me to disagree with his view because it does so. This does not seem to me to be a step which I could properly take on an appeal of this nature. The Hearing Officer was plainly entitled to make the findings set out in [33-34] of his decision; there is no error identified in his approach to the analysis of what is the dominant element of the mark. On the contrary, it appears to me that Mr Morris was right in his approach to the application of *Shaker*, when considering an element of the mark (the device) which he thought was not negligible. The opponent's arguments boil down to the submission that the device plays a negligible role in the mark. The Hearing Officer did not agree. I cannot review that decision, even if I disagreed with it, which I do not.
32. The second point raised in relation to the Hearing Officer's assessment of the visual similarity of the marks is more significant, as it is suggested that the Hearing Officer erred in his application of the law. It will be seen that in [36-37] of the decision, the Hearing Officer set out some comments of the General Court in *Inter-Ikea Systems*, and appeared to apply them to the facts of this case. The opponent submitted that the conclusion reached by the Court at the end of paragraph 54 of *Inter-Ikea*, which was purportedly based upon the Court's own earlier decision in *Ruiz-Picasso*, is wrong. I agree. This is a matter upon which I have previously commented in my own decision BL O/387/11, *Boo Boo trade mark*, in which I said at [11]:
- "Inter-Ikea suggested that Picasso had ruled that for short word marks "even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them." It is certainly surprising that guidance of this type should be expressed in such absolute*

terms, as cases must be assessed on their particular facts and I accept that the decision in *Picasso* did not purport to lay down a rule in the terms indicated in *Inter-Ikea*. In paragraph 54 of the judgment in *Picasso* the Court had said:

“As regards visual and phonetic similarity, the applicants rightly point out that the signs at issue each consist of three syllables, contain the same vowels in corresponding positions and in the same order, and, apart from the letters ‘ss’ and ‘r’ respectively, also contain the same consonants, which moreover occur in corresponding positions. Finally, the fact that the first two syllables and the final letters are identical is of particular importance. On the other hand, the pronunciation of the double consonant ‘ss’ is quite different from that of the consonant ‘r’. It follows that the two signs are visually and phonetically similar, but the degree of similarity in the latter respect is low.”

That paragraph does not make a ruling in the terms reflected in the *Inter-IKEA* decision; it merely compared the signs at issue in that case. How or why the Court in *Inter-IKEA* summarised paragraph 54 of *Picasso* in such a way is unclear, but what is clear is that it was mistaken when it suggested that the Court had already made a finding in the terms set out at the end of paragraph 54 of the later decision. In the circumstances, it is difficult to read the later case as actively seeking to make such a ruling itself and it appears to me that the passage in that case must be treated with a great deal of caution.”

Mr Purvis QC, also sitting as the Appointed Person, similarly criticised *Inter-Ikea* in his decision BL O/277/12, *Ella trade mark*.

33. The fact that the Hearing Officer in this case referred to *Inter-Ikea* was therefore a matter of some concern to me, but it does not of itself indicate that his assessment of the level of visual similarity between the parties' respective marks was necessarily wrong. Had the Hearing Officer simply said that because of the guidance of the General Court he could not find that there was a high degree of visual similarity between the marks, plainly his decision would have been wrong. However, as is clear

from the passages which I have set out above, despite the reference to the decision that was not what he did. He did not, in particular, assess the visual similarity of the marks on the basis that there was some arbitrary rule that short marks differing in only one letter cannot have a high degree of visual similarity, let alone that they could not be found to be similar at all.

34. Instead, in [37] of his decision, Mr Morris noted that the "point" made by the General Court applied and then summarised it in his own terms: "in short words, differences in the letters, even if at the end of those (short) words, are likely to stand out more. The difference is less likely to be overlooked." That appears to me a perfectly reasonable point to make and does not reflect the mistake made by the General Court. The Hearing Officer plainly considered that it was right in assessing visual similarity to take into account the shortness of the mark. In my judgment there is no error in that approach, since a difference of one letter in a mark which is only 4 letters long is clearly more significant than a single letter difference in a longer mark. Ultimately, whether one describes a coincidence of three out of four letters as giving rise to a 'high degree of visual similarity' or simply a 'reasonable degree of visual similarity' seems to me (as Mr Purvis QC put it in *Ella*) to be a matter of semantics. What matters is that the Hearing Officer recognized the nature of the similarity (3 identical letters in the same order) and placed it properly in context (only 3/4 of the total number of letters). In the circumstances, I do not consider that the error of principle inherent in reliance upon the General Court's erroneous decision – if indeed Mr Morris relied upon the decision in any relevant way - was material to his decision.
35. Furthermore, and most importantly in this case, the Hearing Officer went on to say that he was factoring in the further visual differences between the marks, consisting in particular of the device elements of the applicant's mark and the CTM and the additional wording in the UK Mark, Yell.com. He had, of course, already rejected the opponent's argument that the device element of the applicant's mark was negligible and had instead decided that the device element of the applicant's mark was a

dominant element of it, though “less dominant (but not to a huge degree)” than the word.

36. It appears to me that it was on the basis of this combination of factors that the Hearing Officer decided that there was only a low degree of visual similarity between the parties' marks. In those circumstances, whilst I was initially concerned to see that the Hearing Officer had cited *Inter-Ikea*, I do not consider that this led him into an error of principle or a material error. I reject Ground of Appeal (4).

*Aural similarity*

37. Ground of Appeal (5) complained that the Hearing Officer's errors in the assessment of visual similarity fed into his assessment of aural similarity. The opponent submitted that the Hearing Officer had given too much weight to the difference in the last letter of each word, especially as the 'p' in Yelp would not be emphasised but is a “regressive” sound. However, in my view, these submissions do not disclose any error of principal or approach, but amount to a complaint about the Hearing Officer's subjective assessment of similarity. In the circumstances, and as I have not found that the Hearing Officer erred in relation to visual similarity, this Ground also fails.

*The average consumer*

38. Ground of Appeal (6) stated that the Hearing Officer had credited the average consumer with adopting too high a level of care and attention given the nature of the services on offer. I do not accept that criticism of the decision, as it seems to me that in [27] the Hearing Officer said that the degree and care of attention would not be any higher than the norm, as the service would ordinarily be free and would not be likely to represent a considered choice. On the other hand, he said that the consumer would wish to know that the service provided to him was reliable, so that on balance a normal degree of care and attention would be used. That seems to me an unimpeachable conclusion based on logical considerations. Ground (6) also fails.

*Conceptual similarity*

39. I must now revert to the opponent's argument that the Hearing Officer also went wrong in his assessment of the level of conceptual similarity between the marks. He had (as set out above) referred to *Pash/Bass* on "conceptual dissonance." He went on at [41-43] to conclude that each of the words YELL and YELP had a normal meaning which would be known to the average consumer in the UK. He considered those meanings by reference to dictionary definitions, as the opponent had invited him to do. His view was that both words related to "noises or utterances."
40. The Hearing Officer does not appear to have considered that the device element of the applicant's mark would have affected the analysis of conceptual similarity, perhaps because the device does not have a clear meaning. The device part of the mark is apparently called the "Burst" by the applicant which considers that it indicates a "burst of activity" or calls to mind an exclamation mark or a popping sound. For myself, I think it looks more like a stylised flower. In any event, it is not a device which has a clear meaning of its own.
41. All of the Hearing Officer's analysis up to that stage therefore seems to me to be unimpeachable and, indeed, it was not criticised. The opponent's complaint is that he nevertheless found that there was a distinction to be drawn between the 2 types of noise or utterance, such that the similarity was not high (nor low) but only moderate. That, submits the opponent, was wrong, because the 2 conceptual meanings are extremely close, and the mistake arose from the Hearing Officer having analysed the words in far too much detail, in a manner which would not be done by the average consumer.
42. I have some sympathy for this complaint, because I think it would not have been surprising had the Hearing Officer concluded that there was a high or at least a reasonably high degree of conceptual similarity between the word elements of the two marks. However, he did conclude that there was a *moderate* degree of conceptual similarity between them and the distinction between that finding and a

finding that they were reasonably highly similar may again be seen as a matter of semantics.

43. The opponent submitted in addition that the Hearing Officer went wrong in [50] of the decision because he did not give sufficient consideration to the impact of imperfect recollection on the average consumer, given the level of similarity (particularly conceptual similarity) between the marks. It is tempting to reach that conclusion, but I do not find it possible to do so, as in the middle of [50] itself Mr Morris carefully discussed the impact of imperfect recollection. He held that at most the similarity would bring the YELL marks to mind. It is absolutely clear, therefore, that he took this aspect of the global appreciation of the likelihood of confusion into account.
44. For these reasons, it appears to me that the Hearing Officer's approach was correct. I cannot say that his conclusion was plainly wrong, as I would have done had he said that the marks were not conceptually similar at all or that they had only a low level of similarity. In the circumstances, it would not, in my view, be appropriate for me to say that he had reached a conclusion which is plainly wrong. Despite the concerns set out above, therefore, I reject Grounds (1) to (3).

*Global assessment of the likelihood of confusion*

45. Ground (7) raised various issues in relation to the global assessment of the likelihood of confusion. In addition to the matters which I have already discussed, the main point raised by the opponent (Ground (7)(b)) was that the Hearing Officer failed to give proper weight to the finding which he had made that the earlier marks were not only inherently distinctive, but had achieved an enhanced degree of protection from the substantial amount of use made of them over a number of years. He had concluded at [47] that there was compelling evidence that both marks should be regarded as highly distinctive. It was immediately after that passage in his decision that Mr Morris moved on to set out his conclusions under section 5 (2)(b). In [50] he referred specifically to the highly distinctive nature of the earlier marks and he also

held that all of the factors which he had taken into consideration suggested that the YELL marks might be brought to mind by the applicant's mark. In those circumstances, it does not seem to me that the opponent can point to any error of principle or material error in the Hearing Officer's analysis of the likelihood of confusion. Without having succeeded on the various points which I dealt with above, it does not seem to me that this point has independent force.

46. Ground (7)(c) complains somewhat cryptically that the Hearing Officer failed to consider how confusion might arise. This point was expanded in Ground (8) in two ways. The first point was that the Hearing Officer would have taken into account the possibility that the average consumer typing 'YEL' into a search engine might find the applicant's site. The evidence for this point was extremely scanty and it seems to me that the comments made on it by the Hearing Officer in [51] of his decision were absolutely correct. This is not an appealable point. The second point was that the Hearing Officer had failed to take sufficiently into account the possibility that the average consumer might perceive Yelp as a new online incarnation of Yellow Pages, as, it was suggested, the journalist who wrote the Independent article had done. This point was not pursued with any vigour before me and appears to me to have no independent strength in the light of the Hearing Officer's view that the Yelp mark might bring the Yell marks to mind. Ground (8) too fails.

*Taking comfort from the lack of evidence of confusion*

47. The last substantive point, raised in Ground (7)(d) and Ground 11 related to the Hearing Officer's comment in [52] of his decision that he had not ignored the parties' comments about confusion-free parallel trade. The applicant had argued that the lack of evidence of confusion during a period of parallel trading which postdated the relevant date was indicative of there being no likelihood of confusion. The Hearing Officer did not accept that argument because it was a relatively new business and instances of confusion do not always come to light. That was plainly correct. However the opponent submitted that the Hearing Officer had gone wrong in adding that he took some comfort from the evidence to the extent that it suggested that

there had been no instances of confusion despite such parallel trade since January 2009. I did not find the authorities which Mr Mellor cited on this point particularly helpful to me, but I accept that there is something of a rule of thumb to the effect that if the evidence establishes that both marks have been used side-by-side and there is no evidence that any confusion has arisen, that is something which the tribunal may take into account. However, the impact (if any) of that evidence will depend upon the particular facts of the case. For example it may not be the kind of business in which evidence of confusion is likely to come to the proprietor's notice or may relate to a limited range of goods/services within a wider specification. Mr Mellor QC submitted that [52] did not disclose an error of principle but that if I came to reconsider whether there was a likelihood of confusion, I ought take a different view to the Hearing Officer. As, for the reasons set out above, I do not think it appropriate for me to reconsider the merits, I need discuss this matter no further.

48. For all these reasons, the appeal is dismissed.
49. Costs should follow the event, and I order the opponent to pay the applicant the sum of £1500 in respect of its costs of the appeal in addition to the sum ordered to be paid by the Hearing Officer. Both sums are to be paid within 14 days of the date hereof.

Amanda Michaels  
The Appointed Person

11 January 2013

Mr Henry Ward (instructed by Messrs Bird & Bird LLP) appeared on behalf of the applicant/respondent

Mr James Mellor QC (instructed by Messrs Bristows) appeared on behalf of the opponent/appellant.