

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1517572
BY SAFEWAY STORES PLC TO REGISTER A TRADE MARK IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 43091
BY HACHETTE FILIPACCHI PRESSE**

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TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application No 1517572
by Safeway Stores Plc to register a mark in Class 5**

10 **and**

**IN THE MATTER OF Opposition thereto under
No 43091 by Hachette Filipacchi Presse**

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BACKGROUND

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On 30 October 1992, Safeway Stores Plc applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark ELLE in Class 5. The application was advertised, under the proviso to Section 18(1) and Section 12(2) of the Act, in respect of the following specification of goods:-

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sanitary pads; sanitary tampons; sanitary towels; panty liners, all included in Class 5

On 11 September 1998 Hachette Filipacchi Presse filed Notice of Opposition. The Grounds of Opposition are in summary:

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1. under Section 17(1) because the applicants cannot claim to be the proprietor of the trade mark in suit
2. under Section 11 because of the opponents use of and reputation in the trade mark ELLE on a wide range of womens products by and with the consent of the opponent
3. under Section 12(1) and 12(3) because of the opponent's earlier registration under No 1422808 and application No 1498363.

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The details of the opponent's registration and application referred to above are as follows:-

No	Mark	Class	Journal	Specification
5 1422808	ELLE	21	6002/7474	Domestic utensils and containers; combs, sponges and brushes, all being toilet accessories; porcelain and earthenware; all included in Class 21
10 1498363	ELLE	03	6141/11119	Soaps; perfumery, cosmetics, skin care lotions, eyecare lotions, haircare products, all included in Class 3

15 The applicants in their counterstatement deny the grounds of opposition, not least because of their claim to honest concurrent use of the trade mark in suit under the provisions of Section 12(2).

20 Both sides filed evidence in these proceedings and the matter came to be heard on 22 January 1999 when the applicants were represented by Mr Christopher Morcom of Queens Counsel instructed by their trade mark Agents W P Thompson Co. The opponents were represented by Mr Colin Birss of Counsel instructed by Field Fisher Waterhouse, their solicitors.

25 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

30 **DECISION**

35 These opposition proceedings which relate to the trade mark ELLE are in tandem with opposition proceedings No 42214 between the same applicants and opponents involving the trade mark PRESTO ELLE. Virtually the same evidence has been filed in these proceedings as in opposition proceedings No 42214. I therefore adopt the summary of the evidence I set out in my decision in those proceedings for these proceedings.

40 There is also contained in a Statutory Declaration dated 6 June 1996 by Mr Nicholas Peter Rose, a partner in the firm of Field Fisher Waterhouse, who act on behalf of the opponents, his comments about the risk of confusion and deception as between the applicant's trade mark ELLE and the opponent's trade mark. In particular he believes that the risk of confusion between the applicant's and the opponent's respective ELLE trade marks is greater in these proceedings than in opposition proceedings No 42214 where the respective trade marks were ELLE (the opponents' trade mark) and PRESTO ELLE (the applicant's trade mark).

45 The only additional points of relevance in these proceedings is the evidence of use of the applicant's trade mark which pre-dates the date of application in this case.

With all this in mind I go on to consider the grounds of opposition in this case.

5 The first two, under Section 17(1) and Section 11 are the same as those in the parallel proceedings. And for the reasons set out in my decision in respect of opposition No 42214, I find that the opponents case is not made out under either head.

10 In relation to the proprietorship of the trade mark ELLE in respect of the goods covered by this application there has been put forward no additional evidence in these proceedings to show that the applicant is not the proprietor of the trade mark in accordance with criteria laid down in AL BASSAM [1995] RPC 511. I am therefore satisfied that at the date of the application the applicant was the proprietor and user of the trade mark ELLE for the goods covered by the specification set out in the application. The opposition under Section 17(1) is therefore dismissed.

15 Insofar as the Section 11 objection is concerned, again, no additional evidence has been entered in these proceedings to show that the opponent's use of the ELLE trade mark extends much beyond their core activity of magazines. That being so there is, in my view, no additional likelihood of confusion and deception occurring in this case even when the respective trade marks are identical. In the circumstances I hold that use by the applicants of
20 their ELLE trade mark is not likely to cause deception and confusion and the opposition based upon Section 11 is therefore also dismissed.

I go on finally to consider the ground of opposition based upon Section 12(1) and 12(3).
These state:

25 12 (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- 30 a. the same goods
- b. the same description of goods, or
- 35 c. services or a description of services which are associated with those goods or goods of that description.

(2)

40 (3) Where separate applications are made by different persons to be registered as proprietors respectively of marks that are identical or nearly resemble each other, in respect of:-

- 45 a. the same goods
- b. the same description of goods, or

- c. goods and services or descriptions of goods and services which are associated with each other,

5 the Registrar may refuse to register any of them until their rights have been determined by the Court, or have settled by agreement in a manner approved by him or on an appeal (which may be brought either to the Board of Trade or to the Court at the option of the appellant) by the Board or the Court, as the case may be.

10 The reference to a near resemblance in Section 12(1) is clarified by Section 68(2B) of the Act.

The established test for objections under the provisions of Section 12(1) is set down in SMITH HAYDEN & CO'S APPLICATION [1946] 63 RPC 101. Adapted to the matter in hand it may be expressed as follows:

15 Assuming user by the opponent of their trade marks consisting of the word ELLE in a normal and fair manner for any of the goods covered by the registration, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of parties if the applicants use their trade mark ELLE normally and fairly in respect of any goods covered by their proposed registration.

20 In seeking to determine the matter I take account of the standard judicial test for the comparison of trade marks, that of Parker J in PIANOTIST CO LTD 23 RPC 77 where he said:

25 "You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a
30 normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or
35 rather you must refuse the registration in that case."

In this case there was no dispute that the respective trade marks were identical and therefore I need only consider the respective goods. It was accepted that these were not the same but Mr Birss argued that they were of the same description. In that connection I was referred to
40 JELLINEK (1946) 63 RPC 59 where Romer J set out the matters to be taken into account in deciding whether goods are goods of the same description namely:

- (a) the nature and composition of the goods;
- 45 (b) the respective uses of the articles;
- (c) the trade channels through which the commodities are bought and sold.

In considering registration No 1422808 Mr Birss submitted that the combs, sponges and brushes, all being toilet accessories' were goods of the same description as the applicants goods. They, together with the applicant's sanitary towels and tampons could all be described
5 as 'bathroom hygiene products'. In my view the nature and composition of the respective goods in issue are different Sanitary towels and tampons being made of absorbent material, are completely different in nature and composition from a comb and a brush, and even a sponge. Their purposes are also clearly different. And even if the channels of trade are the same - all would be for sale in most supermarkets and chemist shops - the products are so dissimilar in
10 my view that no one would associate one with the other. In the circumstances I reject Mr Birss' view that because they are all 'bathroom hygiene products' they are goods of the same description. They are not. Therefore registration No 1422808 does not contain goods which are either the same or similar to the goods covered by the application for registration.

15 In relation to application No 1498363 Mr Birss submitted that the goods covered by the application were also of the same description as those of the opponent's application and were covered by the term 'bathroom hygiene products' I disagree. The nature and purpose of the respective goods are again different and in this case the channels of trade could be very different. The goods of this application are neither the same nor of the same description as
20 those covered by the opponent's application. The opposition based upon Section 12(1) is therefore dismissed and I hold that the provisions of Section 12(3) do not apply. In all of the circumstances the opposition having failed on all grounds I do not need to consider whether the applicant comes within the provisions of Section 12(2).

25 The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay to them the sum of **£1000**.

30 **Dated this 18TH day of March 1999**

35 **M KNIGHT**
for the Registrar
the Comptroller-General