

O-307-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2303269
IN THE NAME OF SAEED AKBAR
TO REGISTER THE TRADE MARK ELEGANCE HOME
IN CLASSES 20 & 24**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 91442 IN THE NAME OF
ELÉGANCE ROLF OFFERGELT GMBH**

Trade Marks Act 1994

**IN THE MATTER OF Application No. 2303269
in the name of Saeed Akbar
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**IN THE MATTER OF Opposition thereto under No. 91442
in the name of Elégance Rolf Offergelt GmbH**

BACKGROUND

1. On 20 June 2002, Saeed Akbar applied to register the trade mark ELEGANCE HOME in Classes 20 and 24 in relation to the following specifications of goods:

Class 20: Pillows; cushions; sleeping bags; mattresses; bolsters; bedding other than bed linen; cots, playpens; curtain tie-backs; curtain hooks, curtain rings; curtain rails, curtain rods, curtain poles, curtain runners, curtain tracks, curtain rollers, and supports therefor; indoor blinds, not of textile; bead and bamboo curtains; table mats and coasters of plastic, cork or reed or raffia.

Class 24: Textiles and textile goods; bed linen; sheets, valances, pillowcases, bedspreads, eiderdowns, coverlets, quilts, duvets, duvet covers, blankets, bed canopies; sleeping bag sheet liners; cushion covers; loose furniture coverings, throws; upholstery fabrics; dust covers; dust sheets; curtains, curtain linings, curtain holders of textile; pelmets of textile; lace curtains; blinds of textile material; wall-hangings of textile; plastic curtains; shower curtains; bath mats, covers for toilet seat lids; bath linen; towels, bath towels, beach towels, tea towels, face flannels, face towels; hand towels; table cloths; table mats and coasters of textile; napkins; handkerchiefs; banners, bunting, flags; textile piece goods; textiles to be made up into the aforesaid.

2. On 29 January 2003, Elégance Rolf Offergelt GmbH filed notice of opposition to the application under Sections 3(1)(a), 3(1)(b), 3(3)(b), 5(2)(b), 5(3) and 5(4)(a) of the Act. The opponents failed to file evidence in support of the opposition, and following an interlocutory hearing it was decided that, in the exercise of the Registrar's discretion, the proceedings should be allowed to proceed under the ground based on 5(2)(b) alone. That ground reads as follows:

Under Section 5(2)(b) because the mark applied for and the opponents' earlier marks relied upon are similar, and the goods for which registration is sought are identical to those covered by the opponents' earlier marks.

3. The opponents rely on seven earlier marks, details of which are shown as an annex to this decision.

4. The applicant filed a counterstatement in which he denies the grounds on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Both sides filed evidence in these proceedings. The matter came to be heard on 5 July 2005, when the applicant was represented by Dr Banford of T M Gregory & Co, his trade mark attorneys. The opponents were represented by Ms Rebecca Finn of Hepworth Lawrence Bryer and Bizley, their trade mark attorneys.

APPLICANT'S EVIDENCE

7. This consists of two Witness Statements. The first is dated 10 November 2004, and comes from Saeed Akbar, Managing Director of SHF (Luton) Ltd, trading as Southern Home Furnishings.

8. Mr Akbar says that his business imports and distributes linens, including bed linens, table linens, curtains, bath linen, cushion covers, pillows and the like. He says that this trade began under the mark ELEGANCE, changing in February 2002 to ELEGANCE HOMES, under which he has sold duvet sets, towels, kitchen towels, bed sheets, curtains and cushion covers. Mr Akbar lists various department stores that he says have sold his goods, confirming that sales have been throughout the UK, with some 750,000 items to the value of , 3,000,000 being sold, although does not say to what date.

9. The second Witness Statement is dated 9 November 2004, and comes from Timothy Mark Gregory, a trade mark attorney and the principal of T M Gregory & Co, the applicant's representatives.

10. Mr Gregory recounts Mr Akbar contacting him concerning the possibility of registering several trade marks, initially the word ELEGANCE, which Mr Gregory advised would not be considered acceptable, and subsequently, ELEGANCE HOME. He recounts the filing of the application to register the latter as a trade mark, and the results of the ex-parte examination. Mr Gregory draws attention to the accent above the letter Æ in the opponent's mark, Miss Elégance, a copy of the details held on the WIPO database being shown as exhibit TMG1.

OPPONENT'S EVIDENCE IN REPLY

11. This consists of a Witness Statement dated 16 May 2005, from Kieron Peter Mark Taylor, a trade mark attorney with Hepworth Lawrence Bryer and Bizley.

12. Mr Taylor's Statement consists primarily of submissions on the relative merits of the case. Whilst I do not consider it to be necessary or appropriate to summarise these submissions, I will take them fully into account in my determination of this case. Mr Taylor does refer to a number of exhibits which I have summarised below.

13. Exhibit KPMT01 consists of the results of Internet searches, Mr Taylor noting that there are no hits when a search is done for the name ELEGANCE HOME in conjunction with the names of the stores given in the applicant's Witness Statement. Exhibit KPMT02 consists of a dictionary definition for the word SIGNIFICANT, from which Mr Taylor concludes that it is not correct to assert that the opponents' earlier marks contain significant matter in addition to the word ELEGANCE.

14. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

15. The opposition is founded on Section 5(2)(b) of the Act, which reads as follows:

A5.- (2) A trade mark shall not be registered if because -

(a) YYYYYYYY.

(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,

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

16. An earlier trade mark is defined in Section 6 of the Act as follows:

A6.- (1) In this Act an earlier trade mark® means B

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,®

17. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co.*

GmbH v. Klijsen Handel B.V. paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

18. In any analysis it is inevitable that reference will be made to the elements of which a mark is composed, and rightly so, for the case law requires consideration to be given to the distinctiveness and dominance of the component parts. However, it must be remembered that the consumer does not embark on an analysis of trade marks and it is the marks as a whole that must be compared.

19. The opponents rely on seven earlier trade marks, all incorporating the word *Elégance*. Six of these also have an *E* monogram as a substantial element, three of which have other non trade mark matter that is in any event *deminimis*. The seventh earlier mark is for the words *Miss Elégance*.

20. The word *Elégance* is the French equivalent of the English word *Elegance*. I do not consider that the accent above the second letter *E* in the opponents' mark moves it away from being seen as the word *Elegance* even by non-French speaking persons. *Elegance* is an ordinary English word with a meaning that I consider will be well known to English speaking persons. It is defined by Collins English dictionary as: *dignified grace in appearance, movement or behaviour, good taste in design, style arrangement, etc, something elegant, a refinement.* The word is clearly a laudatory epithet for goods such as textiles, home

furnishings, clothing, handbags and jewellery where appearance is of importance, which is presumably why Mr Gregory advised the applicants that the word was probably insufficiently distinctive and therefore not registrable for his particular goods. The fact that registration No.1500217, contains a disclaimer, inter alia, to the exclusive rights in the word *Elégance* appears to support this view, and as this is the only element in common between this earlier mark and the opposed mark, it cannot support an objection under Section 5(2) *Paco* [2000] RPC 451. For goods such as perfumery, printed publications, and most services, this laudatory meaning has no relevance so the word *Elégance* or *Elegance* would be considered to possess a distinctive character. This means that for goods identical or similar to those of the application the *Elégance* element of the opponents' earlier marks would be considered to be devoid of distinctive character. There is no evidence of the opponents having made use of their earlier marks, and I am therefore not in a position to say whether the marks have acquired a reputation, or become any more distinctive by nurture.

21. The opponents' earlier marks all contain, amongst other things, the word *Elégance*, which, if it is not identical to, is visually as close to the word *Elegance* as it is possible to be without being that word, so if only to this extent there must be some visual similarity. But of course the opponents' earlier marks are not just the word *Elégance*. In all but one instance the mark includes a monogram of varying degrees of prominence, and in one case the word is preceded by the title *AMiss*. In most marks the word is at least equal in dominance to the other elements (either by virtue of positioning or relative size), but even so, is not the distinctive component in relation to the same or similar goods. There is also the fact that the applicant's mark also contains the word *AHOME*. This is an ordinary descriptive word that of itself cannot be capable of individualising *Ahome* furnishings, so bearing in mind my earlier comments, if the applicant's mark is distinctive, it must be by virtue of the combination of elements. Accordingly, whilst there is some visual similarity, this does not extend to what would be regarded as the distinctiveness of the marks.

22. In composite marks that have a textual element, it is generally accepted that when referring to the mark in speech, the consumer will not embark on a description of the graphical elements but will use the words, distinctive or otherwise, as the descriptor. This being the case, the opponents' marks will most likely be referred to by use of the word *Elégance*. The consumer may overlook or ignore the accent in the opponents' marks and simply say the word as it sounds in English. Alternatively, they may see the accent, conclude that it is a French word and enunciate it as they believe it would sound in that language, but even if they do, the word will still sound very similar to the English word *Elegance*. The applicant's mark also has the word *AHOME* which may be a descriptive word, but it nonetheless has an effect on the aural similarity of the respective marks, but less so in respect of the goods of interest to the applicant, which could be described as *Elégance AHOME* furnishings.

23. Insofar as both the opponents' and the applicant's marks consist of, or contain essentially the same word, there must be a degree of conceptual similarity, although I would say less so in respect of the mark *AMiss Elégance*. The use of the accent may influence the consumer into recalling the opponents' mark as a French word. The word *AHOME* in the applicant's mark is a reference to the nature of the goods for which it is used, but even so, it moves the idea away from *elegance* in general, to one linked specifically to the home.

24. Five of the opponents' earlier marks cover textile goods that are identical to those for which the applicant seeks registration, a further one covers retail services that I consider to be a similar service. Textiles can range from the cheap that will be selected by colour or aesthetic appeal and with minimal attention to the brand, to the expensive or coordinated where the purchaser will be well informed, brand conscious, and circumspect in all aspects of the selection. Clearly there will be a greater potential for confusion in the former, rather than the latter case.

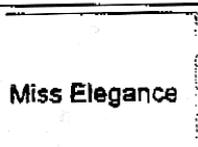
25. There is nothing in the wording of any of the respective specifications that would separate them in the market or course of trade. Accordingly, I must notionally assume that the applicant and the opponents operate in the same sector, and share the same channels of trade, from manufacture to retail. I see no reason why the consumer of the opponents' goods/services should be any different to those that would buy the applicant's goods.

26. Adopting the global approach advocated I find that use of the mark applied for in a trade in respect of the goods for which the applicant seeks registration, would not cause the public to wrongly believe that the goods are those of the opponents or come from some economically linked undertaking. Consequently there is no likelihood of confusion and the opposition under Section 5(2)(b) fails accordingly.

27. The opposition having failed, the applicant is entitled to costs. I order the opponents to pay the applicant the sum of £1,250 as a contribution towards his costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of November 2005

**Mike Foley
for the Registrar
the Comptroller-General**

	Mark	Classes	Date	Journal
1500 217	Elegance  The Sign of Exclusivity	14, 16, 18, 24, 25	08.05.92	5994/6140
M 596 447		3, 16, 24, 25	09.05.97	Madrid- International
M 596 448		3, 16, 24, 25	09.05.97	Madrid- International
M 690 881		3, 16, 24, 26	03.03.98	Madrid- International
M 709 702	 Miss Elegance	3, 14, 16, 18, 24, 25, 26	27.02.99	Madrid- International
2 269 585		35	09.05.01	6409/21825
1 500 215		14, 18, 25	08.05.92	5994/6140