

O/390/18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 195 219:



IN

THE NAME OF ELLA ENTERTAINMENT LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO BY HACHETTE FILIPACCHI
PRESSE

Background and pleadings

1. Ella Entertainment Ltd (the applicant) applied to register the trade mark No 3

195 219:  in the UK on 16th November 2016. It was accepted and published in the Trade Marks Journal on 2nd December 2016 in respect of the following services in Class 41: *TV entertainment services*.

2. Hachette Filipacchi Presse (the opponent) oppose the trade mark on the basis of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst others, its earlier UK Trade Mark No 20 199 901 ELLE, registered for numerous goods and services, including:

Class 41:

Entertainment services.

3. Under Section 5(2)(b), the opponent argues that the respective services are identical and that the marks are similar. Specifically, it argues that the presence of the device in the contested trade mark does not avoid confusion. This is because it has no obvious relationship with ELLA. As such, the trade mark will be (verbally) referred to as ELLA which is confusingly similar to the earlier ELLE.
4. Under Section 5(3), the opponent argues that the earlier trade marks enjoy a significant reputation, the nature of which is in respect of magazines in Class 16 and associated entertainment services. It argues that use of the contested trade mark would take unfair advantage as a result of image transfer as is feasible that similar brand values applies to its activities. Unfair advantage would result.
5. The applicant filed a counterstatement denying the claims made. No request for proof of use of the earlier trade marks was made. As a result, the earlier

trade mark and the contested trade mark must be compared against the full specifications as registered.

6. Both sides filed evidence. This will be summarised to the extent that it is considered necessary.
7. A Hearing took place on 5th June 2018, with the opponent represented by Mr Julius Stobbs of Stobbs. The applicant's CEO, Mr Yuel Tekle, made submissions on its behalf.

Evidence

Opponent's evidence

8. This is a witness statement, dated 30th August 2017, from Mr Fabienne Sultan, the Director of the Intellectual Property Department of the opponent. He explains that the origins of the ELLE mark go back to 1945, with the international expansion in 1985, begun in the UK. The magazine in the UK has a reach of 714 000 readers monthly and a notable digital presence. By this, Mr Sultan describes how ELLE was the first UK women's magazine to reach over 4 000 000 Facebook users.
9. Mr Sultan provides details of awards won by ELLE in the UK. These are chronologically older examples, the most recent being from 2010.
10. According to Mr Sultan, ELLE UK has its own You Tube channel with numerous videos, interviews and behind the scenes footage on ELLE cover shoots. Mr Sultan claims that ELLE has become so synonymous with fashion and the media that it organizes its own ELLE events in the UK such as the ELLE STYLE AWARDS. This is described as an annual fashion event where awards are granted to exceptional people and outstanding projects in fashion, art, culture and show business.

11. Mr Sultan describes ELLE's partnership with LONDON FASHION WEEK where it hosts an event named FASHIONABLY LATE FRIDAY. Further ELLE has teamed up with L'Oreal to create an event celebrating new talent, also in the context of London Fashion Week.

12. Mr Sultan ends his statement by providing details of how the ELLE trade mark has been licensed to other products such as mobile phone covers, stationery, perfume, jewellery, cars, facials etc. He concludes by claiming that ELLE has acquired a substantial reputation and is synonymous with fashion and media, being widely present in print, digital, social media, advertising and through its own well-established ELLE events in the field of entertainment.

Applicant's evidence

13. This is a witness statement, dated 23rd January 2018, from Mr Yuel Tekle. Mr Tekle is the CEO of the applicant. Mr Tekle explains that the word ELLA comes from his native language (East African) and means "one" (as in unite). The applicant is involved in activities such as video and audio production and distribution of music. The applicant also provides videos on demand which can be viewed online. It is noted from the evidence, that the applicant has a presence on You Tube and also sells its services via iTunes, Amazon and Googleplay. Mr Tekle expresses surprise at the opposition. He claims that the respective trade marks are different and in respect of different services: magazine publishing versus music and moving image publishing.

DECISION

Section 5(2)(b)

14. Section 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, 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

15. 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”.

16. 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 uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

17. The earlier services include *entertainment services* in Class 41. The later services are: *TV entertainment services* (in the same class). The earlier term is broader and can include those of the later trade mark. They are clearly identical.

Comparison of marks

18. 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.”

19. 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.

20. The respective trade marks are shown below:

ELLE	
Earlier trade mark	Contested trade mark

21. The earlier trade mark is a word only mark. The later trade mark includes a device of a horse. It is considered to be visually dominant. It is also a distinctive element. The verbal element ELLA is also distinctive. There is also a further element in the later trade mark: TV. This appears underneath ELLA and is extremely small. It is considered to be de minimus within the mark.

22. Visually, though the horse is dominant, ELLA is clearly visible within. This element is visually highly similar to the earlier ELLE (single letter difference). The impact of the horse is notable, however the marks are considered to be visually similar overall. This is pitched as being a medium degree.

23. Aurally, the earlier trade mark is comprised of one syllable. ELLA in the later trade mark will be two, though the entirety of the earlier trade mark coincides with the first element of the later. It is considered unlikely that TV will also be articulated as it is extremely small within the trade mark. However in the event it is, it would increase the length of the later trade mark to four syllables when spoken. Even if this were to occur, there is still a degree of aural similarity. This is pitched as low where TV is also articulated and low to medium where it is not.

24. Conceptually, each of the trade marks are female names. There was a suggestion from the opponent in its skeleton argument that each are derivatives of Helen, but no evidence was filed on this point. Importantly, there is no striking conceptual difference between them. Indeed, they are similar conceptually to the extent that they are both names and similar sounding ones. For those for whom neither of the trade marks have a meaning, the conceptual impact is neutral.

Average consumer and the purchasing act

25. 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*.

26. 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.”

27. The relevant services are *entertainment services*. This includes that provided via the medium of television. The relevant public is therefore likely to be the public at large. The nature of the purchase may well be carried out aurally (when purchasing a subscription to a particular TV channel for example) though I do not discount that this may also be a visual purchase. The level of attention one would expect to be displayed would be medium; choosing the correct, for example, TV channel could be linked to particular desired programs or notable events.

Distinctive character of the earlier trade mark

28. 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).”

29. The opponent claims it enjoys an enhanced degree of distinctiveness in ELLE due to its use made of the mark. It is accepted that this is the case in respect of its trade in magazines. However, I am not persuaded that it extends beyond this. In any case, it is considered that ELLE is entirely meaningless in respect of all of the goods and services for which the earlier trade mark is registered, including entertainment services, which have been found to be identical to the contested services. It has, inherently, at least an average degree of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

30. 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.

31. The respective services are identical. This is important as the interdependency principle is in full operation and so can offset a lesser degree of similarity between the marks. The earlier trade mark is distinctive to at least an average degree and the degree of attention one would expect to be displayed during the purchasing process is pitched as being medium. The marks have been found to be visually and aurally similar, to a medium degree in respect of the former and to a medium (or low to medium in the event TV is articulated) degree as regards the latter. Conceptually, it is possible that there is a degree of similarity to the extent that each mark is a name and a similar sounding one at that. There is no clear conceptual gap. That said, the horse device is visually dominant and it will not go unnoticed. It is considered highly unlikely that the relevant consumer (in this case the public at large) will mistake one trade mark for the other. There is considered to be no likelihood of direct confusion.

32. However that is not the end of the matter. I bear in mind the following guidance:

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

33. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

34. It has already been noted that ELLE and ELLA are similar sounding names. The aural similarity remains even if TV in the contested trade mark is also articulated (which is considered to be unlikely). ELLE and ELLA are also visually similar and are both distinctive elements. Further, it is noted that ELLA stands apart from the horse device in the contested trade mark and has no obvious relationship to it. It has an independent role within the trade mark. Bearing in mind all of the aforesaid, it is considered likely that ELLE and ELLA will be imperfectly recalled for one another. Despite a striking device in the contested trade mark, it is not considered to be enough to avoid a finding that the relevant consumer will believe the identical services to have emanated from the same source. There is therefore a likelihood of indirect confusion.

Final Remarks

35. As the opposition is successful in its entirety based upon this ground, there is no need to consider the remaining earlier trade marks as they do not materially improve the opponent's position. The same is true for the remaining ground relied upon (Section 5(3)). Whilst it is accepted that the opponent's enjoy a significant reputation in respect of magazines, I am not persuaded that the reach of the reputation goes beyond this. I cannot see how this ground places the opponent in any better position and so there is no need to consider it.

COSTS

36. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £2000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and statement of grounds - £500

Preparation and Filing of Evidence - £750

Preparation for Hearing - £750

TOTAL - £2000

37. I therefore order Ella Entertainment Ltd to pay Hachette Filipacchi Presse the sum of £2000. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 26th day of June 2018

Louise White

For the Registrar