

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2233285  
BY EMME ASSOCIATES, INC  
TO REGISTER THE TRADE MARK:**



**IN CLASS 25**

**AND**

**THE OPPOSITION THERETO  
UNDER No 51785  
BY MAGLIEFICIO EMMEBIVI DI CESARE BELLÙ SPA  
BASED UPON THE EARLIER TRADE MARK:**

**EMMEBIVI**

**Trade Marks Act 1994**  
**in the matter of application no 2233285**  
**by Emme Associates, Inc**  
**to register the trade mark:**



**in class 25**  
**and the opposition thereto under no 51785**  
**by Maglieificio Emmebivi Di Cesare Bellù SPA**

## **BACKGROUND**

1) On 22 May 2000 Emme Associates, Inc (EAI) applied to register the above trade mark. The application was published in the "Trade Marks Journal" on 30 August 2000 with the following specification:

*articles of clothing; footwear; headgear*

The above goods are in class 25 of the International Classification of Goods and Services.

2) On 29 November 2000 Maglieificio Emmebivi Di Cesare Bellù SPA (MEDCB) of Italy filed a notice of opposition to this application.

3) MEDCB is the owner of Community trade mark registration no 1254614 of the trade mark **EMMEBIVI** which is registered for *clothing, including hosiery; footwear, headgear*. These goods are in class 25 of the International Classification of Goods and Services. The application for the registration was filed on 26 July 1999 and registered on 1 September 2000.

4) MEDCB states that EAI's trade mark would be seen as the word EMME, which it claims is similar to EMMEBIVI. As the respective goods are identical there is a likelihood of confusion and registration of EAI's trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

5) MEDCB states that it has used the trade mark EMMEBIVI in the United Kingdom since January 1999 for clothing, in particular ladies' underwear. It had acquired common-law rights by the date of the filing of EAI's application. MEDCB states that it would be entitled to prevent use of EAI's trade mark, at least for underwear, by means of an action for passing-off. Consequently, registration of the EAI's trade mark would be contrary to section 5(4)(a) of the Act.

6) MEDCB states that it requested EAI to restrict its specification of goods to exclude knitwear, hosiery, corsetry, underwear, nightwear (pyjamas, nightshirts and nightdresses), stockings, tights and socks for women. However, EAI has refused either to withdraw or restrict its specification.

7) MEDCB requests that the application is refused and seeks an award of costs.

8) EAI filed a counterstatement. It accepts that the goods of MEDCB's registration are identical to those of its application. It denies the other grounds of the opposition.

9) EAI requests that the opposition is dismissed and also seeks an award of costs.

10) Both sides filed evidence.

11) After the completion of the evidence rounds I advised the parties that I believed a decision could be made without a hearing. However, the parties were advised that they retained their right to a hearing. Neither party requested a hearing so I will make a decision after a careful study of the papers. EAI filed written submissions in relation to the case and I take these into account in reaching my decision.

## **EVIDENCE**

12) Both sides filed evidence. I have read the evidence carefully. A lot of it represents submissions and counter-submissions rather than evidence of fact. I have come to the conclusion that much of it does not affect my deliberations. Consequently, I will not give a summary of the evidence here but will refer to the evidence when appropriate in the body of the decision.

## **DECISION**

### **LIKELIHOOD OF CONFUSION – SECTION 5(2)(b)**

13) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

14) Community trade mark registration no 1254614 is an earlier trade mark within the meaning of the Act.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

## Comparison of goods

16) EAI has accepted that the goods encompassed by the specifications of the respective trade marks are identical. I need say no more about this matter.

## Comparison of trade marks

17) The trade marks to be compared are:

### Earlier registration:

**EMMEBIVI**

### Application:



18) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). 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* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 BV* page 84, paragraph 27).

19) EAI have referred to its application as an EMME mark and I consider, that despite the stylisation, that is how it will be seen. From the evidence of EAI it seems clear that that is how it is promoted. The objective reality supports the subjective perception.

20) Linda Istead in her first evidence for MEDCB states:

“A commonly occurring difficulty amongst many clients, both existing and new, was the correct pronunciation of EMMEBIVI.”

and

“Frequently, clients would misremember the exact name but would usually recall the first part of it. Le Bourget’s sales agents and I often encountered clients who would refer, for example, to the “Italian underwear called Em.... something”.”

21) Mr Lutkin in his evidence for EAI comments on the possible derivation of EMMEBIVI and how Italians would pronounce the word. I am concerned with the average consumer in the United Kingdom who is most unlikely to be aware of the derivation of the trade mark nor of how it is pronounced by an Italian. Mr Lutkin opines that the trade mark might be pronounced by an English speaker as em-ee-bee-vee or as three syllables em-bee-vee. He states that Emme is a well-know feminine forename or contraction of Emily or Melissa. It might be well known to Mr Lutkin but it is not to me and he has not substantiated the claim with any evidence other than his own knowledge and his family circumstances; his late

mother-in-law being called Emily but known as Emme. Mr Bellù, in his evidence in reply for MEDCB states that the English dictionaries which he has consulted have no reference to EMME. However, he does not advise which dictionaries he has consulted.

22) Mr Bellù, again in his evidence in reply for MEDCB, states how EMMEBIVI was derived. However, as indicated above, I do not see that this is relevant to the perception of the average consumer.

23) Ms Istead's evidence about the difficulties in pronouncing the EMMEBIVI has not been countered with contradictory evidence. This does not surprise me. It is certainly not a trade mark that trips off the tongue readily. It is one that strikes me as being quite alien to the average consumer in the United Kingdom. Consequently, it I consider it as being potentially particularly prone to imperfect recollection; something which Ms Istead's evidence suggests.

24) I cannot accept the claims, in the absence of evidence, of Mr Lutkin that EMME is a well-known female forename, whether by contraction or not. I am of the view that neither trade mark would have any conceptual association for the average consumer.

25) Mr Lutkin claims EMMEBIVI might be pronounced as three syllables. This seems somewhat unlikely to me. Be that as it may I have to consider all the possible pronunciations. I am happy to accept Mr Lutkin's claim that MEDCB's trade mark will be pronounced em-ee-bee-vee. Equally I can imagine that it might be pronounced em-e-bee-vee. Clearly there is no received pronunciation for the word. I can envisage EAI's trade mark being pronounced as em-ee or em-e. It could be the case that the second m in each of the trade marks will also be clearly pronounced. As this will be the case for both trade marks nothing turns upon this. In the absence of a definitive and obvious pronunciation of the two trade marks I am of the view that their pronunciation will vary according to the way the consumer speaks. So the pronunciation could vary from regional accent to regional accent and again to those who do not speak with a regional accent. The pronunciation could vary from consumer to consumer but "emme" in EMME and in EMMEBIVI will be pronounced in the same way by individual consumers. So if a consumer pronounces EMME em-ee he/she will also pronounce the beginning of MEDCB's trade mark em-ee. Equally if a consumer pronounces the first two syllables of EMMEBIVI em-e he/she will also pronounce EMME as em-e. There will be a consistent inconsistency based on the socio-linguistic background of the consumer.

26) I need to consider the trade mark as a whole though, the public do not normally dissect or analyse trade marks. In consideration of the respective signs it is necessary to take into account the well known premise of *Tripcastroid* 42 RPC 264 at page 279 that in assessing similarity the beginnings of words are normally more important than the ends. This decision reflects the way people speak and hear and so is as relevant under the new act as under the old one. It is also the position that the Community trade mark office follows, for instance in decision no 1126/2000 – Official Journal 10/2000 at page 1506. The force of the two first syllables of MEDCB's trade mark – especially if they are pronounced em-ee or em-mee – will, in my view lessen the impact of the final syllable. It also strikes me that in pronunciation a natural division will occur between the first two and the last two syllables.

27) EAI's trade mark is in a stylised form, the lettering does not appear to be in a standard font. There is, therefore, a visual difference between the trade marks in relation to the way they are presented. I keep in mind, however, that with word marks the main source of visual recognition is the letters themselves rather than the form of those letters. It is the letters that

act as the hook for recognition and recall. In considering the visual similarities between the two trade marks there is, of course, also the matter of the four extra letters at the end of MEDCB's trade mark.

28) In considering the similarity of the respective trade marks it seems to me that imperfect recollection is an important factor. Ms Istead's description of the problems customers have had in recalling MEDCB's trade mark accurately is, to me, not unsurprising owing to the nature of the trade mark. Nor does it surprise me that customers latch on to the beginning of the trade mark. Taking all factors into account I consider that the respective trade marks are similar, if to a limited degree.

29) If I had accepted EAI's claim that EMME would be seen as a female forename I consider that the similarity of the respective trade marks would have been greater. The EMME element of MEDCB's trade mark would also have been likely to be identified as a female forename and a conceptual bridge formed between the two trade marks. It could also lead to BIVI being seen as surname. The average consumer might then expect that EMME BIVI and EMME were part of the same economic concern. Consequently, my not accepting the argument of EAI on this point is to its advantage.

## **Conclusion**

30) Both sets of evidence include comments on the likelihood of confusion. This is a question for me to decide; as Millett LJ held in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 "In the end the question of confusing similarity was one for the judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses."

31) Mr Aronson in his evidence for EAI states that he is the husband of Melissa Aronson. He states that she is universally known as Emme in her professional capacity as a "super-model". He exhibits printouts from Emme related websites. Mr Aronson claims that her fame is not confined to the United States of America. In support of this claim he exhibits various e-mails from the United Kingdom. Mr Aronson states that his wife has an international reputation under her professional name Emme.

32) All the e-mails that are exhibited come from 2001 and 2002 and so after the date of application, as such they are of very limited value. The information in the website printouts and the e-mails does not show that the average consumer in the United Kingdom would be aware of who Ms Aronson is and that she is known by the name Emme. They tell me nothing about the average consumer of clothing, who is the world and his wife. The evidence does not show me that the average United Kingdom consumer on seeing the word Emme for clothing would identify it with Ms Aronson. Consequently, I do not consider that Mr Aronson's assertions as to the fame of his wife have a bearing upon my deliberations. I note that there is no indication that the publications that have their covers reproduced on the website printouts are available in the United Kingdom. In Ms Istead's second declaration – evidence in reply – she comments that before being involved in this case she had never heard of Emme. Ms Istead is only one person, but she is someone in the clothing industry and so might be considered to be more aware of the names of models. However, I do not place any great weight on Ms Istead's ignorance; as I do not place any weight on my complete ignorance, prior to dealing with this case, of who Ms Aronson is and how she is referred to.

33) Mr Aronson comments on the coexistence of the two trade marks in the United States. He also comments upon their being registrations for EMME and EMMEBIVI in Italy in different ownerships. Mr Aronson's evidence tells me primarily about what is on trade mark registers. I refer to the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence. @

The state of the Italian trade mark register tells me nothing about the position in the marketplace in Italy, let alone whether there is likely to be a likelihood of confusion in the United Kingdom. I disregard the state of the Italian register evidence.

34) EAI might be selling goods under its trade mark in the United States but there is no indication as to what MEDCB has been doing in the United States. There is no indication that the products of MEDCB have been sold in the United States concurrently with those of EAI and in the same sort of outlets. I also note that the clothes sold under EAI's trade mark in the United States are outerclothing while the evidence of MEDCB relates primarily to underclothing – of course that evidence is not directed at the position in the United States and so I do not know what the position is there. Ms Aronson might be identified in the United States with the name EMME which could change the perception of the consumer. Consequently, the use of EAI's trade mark in the United States on clothing for women does not affect my deliberations as to whether there is a likelihood of confusion in the United Kingdom.

35) In considering if there is a likelihood of confusion I have to take into account various factors. There is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*).

36) The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). MEDCB's trade mark does not allude or describe the goods. I cannot see that it has anything other than a high degree of inherent distinctiveness. (Distinctiveness does not reflect on the ease of recall of a trade mark. A trade mark can be highly distinctive and yet prone to imperfect recollection owing to difficulties in recalling it, as in this case.) The use that has been shown of MEDCB's trade mark is at best of a limited extent and certainly, in my view, does not give the basis for claiming a reputation in the *Sabel* sense in respect of any goods. Consequently, the evidence of use of the trade mark by MEDCB does not effect my decision.

37) The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective goods are

identical and so the effects of the differences in the trade marks is lessened. In this case the identity of the goods, in my view, mitigates the limited degree of similarity of the trade marks.

38) I also take into account the respective goods. The specifications encompass all clothing, footwear and headgear and so everything from a pair of socks to formal evening dress. The purchasing decision for the former goods is likely to be far less careful and educated than for the latter. However, despite the growth of brand consciousness there are still people, like myself, who purchase clothes for their fitness for the job, their price and their look rather than the brand they carry. Such persons are likely to only take a cursory look at the trade mark. Finally I take into account that in the initial selection of items of clothing by the public it is a visual act (see *React Trade Mark* [2000] RPC 285).

**39) Having balanced all the factors and the facts in this case I come to the conclusion that there is a likelihood of confusion and that the application should be refused in its entirety.**

#### **PASSING-OFF – SECTION 5(4)(a)**

40) Section 5(4)(a) of the Act states:

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

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

41) The registration of MEDCB covers all of the goods for which any use has been shown by it. The sign used is no closer to the trade mark of EAI than MEDCB’s registered trade mark. I cannot see, therefore, that MEDCB could do any better under this ground of opposition than under section 5(2)(b). I, therefore, will say no more about it.

#### **COSTS**

**42) As Maglieificio Emmebivi Di Cesare Bellù SPA has been successful in these proceedings it is entitled to a contribution to its costs. I order Emme Associates, Inc to pay Maglieificio Emmebivi Di Cesare Bellù SPA the sum of £1200. This sum is 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 19 day of December 2002**

**D.W. Landau  
For the Registrar  
the Comptroller-General**