

O-784-19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3310127
FOR THE FOLLOWING TRADE MARK:**



IN THE NAME OF ELLEY LTD

IN CLASSES 3, 4, 24, 25, 35 & 44

**AND OPPOSITION THERETO UNDER NO. 413604
BY HACHETTE FILIPACCHI PRESSE**

Background and pleadings

1) On 11 May 2018, Elley Ltd (“the applicant”) applied to register the trade mark shown on the front page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 1 June 2018. The application covers the following goods and services:

Class 3: Skin care preparations; make-up; moisturisers; body cleaning and beauty care preparations; cosmetics and cosmetic preparations; cosmetic kits; compacts containing make-up; sunscreen creams; hair treatment preparations; soaps and gels; perfumery and fragrances; nail polish; eyelashes; deodorants and antiperspirants; dentifrices and mouthwashes.

Class 4: Candles; wicks; perfumed candles; tapers; bees wax.

Class 24: Textiles and substitutes for textile goods; bed and table covers; household textile articles; textile piece goods; travellers' rugs; textile goods for use as bedding; textiles for making articles of clothing; duvets; quilts; covers for pillows, cushions or duvets; household linen; linen cloth; bed linen; bath linen; table linen; table cloths; curtains of textile or plastic; pillow shams; pillow cases; sheets; towels; eiderdowns; covers for eiderdowns; mattress covers; napery; napkins; serviettes; table mats (not of paper); face towels; face flannels of textile; textile tissues; traced cloth for embroidery; tapestry (wall hangings) of textile; furniture coverings.

Class 25: Clothing; footwear; headgear.

Class 35: Advertising, marketing and sales promotions; online ordering services; retail services connected with the sale of skin care preparations, make-up, moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts containing make-up, sunscreen creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes, candles, wicks, perfumed candles, tapers, bees wax,

textiles and substitutes for textile goods, bed and table covers, household textile articles, textile piece goods, travellers' rugs, textile goods for use as bedding, textiles for making articles of clothing, duvets, quilts, covers for pillows, cushions or duvets, household linen, linen cloth, bed linen, bath linen, table linen, table cloths, curtains of textile or plastic, pillow shams, pillow cases, sheets, towels, eiderdowns, covers for eiderdowns, mattress covers, napery, napkins, serviettes, table mats (not of paper), face towels, face flannels of textile, textile tissues, traced cloth for embroidery, tapestry (wall hangings) of textile, furniture coverings, clothing, footwear, headgear; consultancy, information and advisory services relating to all the aforesaid services.

Class 44: Hygienic and beauty care for human beings or animals; beauty salon services; beauty therapy services; clinics; spa services; hairdressing; salon services; information, consultancy and advisory services to all the aforesaid services.

2) Hachette Filipacchi Presse (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon four of its earlier European Union (formerly Community) trade marks (“EUTMs”). Pertinent details of the EUTMs for the section 5(2)(b) claims are as follows. The opponent claims that the applied for mark and these earlier marks are similar, they cover identical/similar goods and services and therefore there is a likelihood of confusion:

Mark: 

EUTM no: 3566734

Date of Filing: 30 October 2003

Date of entry in register: 24 August 2007

Goods relied upon: Class 24 – *Bed¹ and table covers, and in particular household linens.* Class 25² – *Clothing in general, in particular underclothing, lingerie items, night clothing, trousers, knickers, shorts, pants, jumpsuits, shirts, undershirts, tee-shirt, pullovers, sweaters, knitwear, vests, jackets, raincoats, anoraks, coats, overcoats, pelerines, skirts, dresses, overalls, cover-ups, fur clothing, scarves, shawls, sashes, sports clothing, gloves, robes, suspenders, belts, neckties, footwear, boots, slippers, sandals, sports footwear, except for stockings, socks and tights.*

Mark: 

EUTM no: 3475365

Date of Filing: 30 October 2003

Date of entry in register: 11 October 2005

Goods relied upon: Class 35 - *Advertising, in particular by means of advertorials, for others, by means of co-branding operations, by means of the sale and/or rental of display stands, placards and printed and/or electronic promotional media, for the promotion of miscellaneous goods and services, in particular in the fields of fashion (fashion articles and fashion accessories, styling, fashion shows), beauty and hygiene (cosmetics, soaps, perfumery preparations, hygiene preparations, beauty care, body care and body massage, relaxation and thalassotherapy); mail order sale of miscellaneous goods, in particular in the following fields: fashion (clothing, fashion articles and fashion accessories), leather goods and luggage, beauty and hygiene preparations (cosmetics, soaps, perfumery preparations, hygiene preparations, essential oils, toiletries), childcare, fitting out of interiors and exteriors (table linen and tableware, household linen, decorative objects, furniture.*

¹ The opposition initially relied upon class 24 fabrics but reliance on these goods was subsequently withdrawn (the opponent's submissions of 25 June 2019 refers).

² The opponent initially relied upon class 25 *hats, caps, berets, visors* but in the witness statement of Mariette Colineau, reliance on these goods was withdrawn.

Mark: ELLE

EUTM no: 8174071³

Date of Filing: 20 February 2009

Date of entry in register: 3 April 2013

Goods relied upon: Class 4 – *candles*.

Mark: ELLE

EUTM⁴ no: 546813

Date of designation of the EU: 25 January 2005

Date protection granted in EU: 20 December 2006

Goods relied upon: Class 3 - *cosmetics products; perfumery*.

3) With regard to the section 5(3) claim, the opponent relies upon its earlier EUTM no. 3475365 in respect of class 16 *printed matter, newspapers and periodicals, books, catalogues, prospectuses, albums, atlases, bookbinding material*, and class 41 *publishing of texts, illustrations, books, journals, newspapers, periodicals, magazines and publications of any type or form, including electronic and digital publications; entertainment services* which the opponent claims to have “developed a massive reputation”⁵ under its ELLE mark. The opponent argues that the applicant will benefit from its investment in advertising, leading to advantage. Further, it argues that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier mark. The opponent also claims that the later use will be out of its control and that poor-quality goods will cause detriment to its valuable reputation and business. It claims that use of the later mark will dilute the distinctive character and reputation of its marks. Finally, the opponent claims that there is no due cause for adoption of the opposed mark.

³ Seniority claimed from UK trade mark registration no. 696860

⁴ International registration designating the European Union.

⁵ Para. 7 of the counterstatement

4) The applicant filed a counterstatement denying the claims made. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

5) The opponent is professionally represented by Stobbs IP. The applicant was initially represented but this was withdrawn prior to the opponent's evidence in chief being filed. For the rest of the proceedings the applicant is unrepresented. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is based on careful consideration of the papers filed.

Evidence

6) The opponent's evidence consists of two witness statements, one from Mariette Colineau and accompanying exhibits and another from Casey Joly, also with numerous exhibits. Ms Joly's witness statement and exhibits are translations of the exhibits filed by Ms Colineau. Therefore, I shall not review Ms Joly's witness statement.

7) Ms Colineau is the opponent's legal counsel and in charge of the trade mark department. She has worked for the opponent for 15 years.

8) Ms Colineau states that the "origins of the ELLE mark go back to 1945, with an international expansion begun in 1985, in the UK"⁶. She states that "ELLE has become a global fashion media brand, present all around the world with 45 editions of the ELLE magazine, 41 ELLE websites, 42 Facebook accounts, 37 Twitter accounts, 37 Instagram accounts, 23 You Tube Channels, 22 Pinterest accounts, 24 mobile apps and 19 tablet apps. In 2014, the ELLE mark reached 21 million readers."⁷

⁶ Para. 4 of the witness statement

⁷ Ditto

9) Ms Colineau states in the UK “the ELLE magazine dates back to 1985, with a reach of 714 000 readers monthly (Source TGI GB 2016) and 1 092 000 pages viewed of the ELLE UK web site. ELLE UK was the first UK women’s magazine to reach over 4 000 000 Facebook users.”⁸

10) The evidence demonstrates that the opponent licenses its ELLE brand to third parties for them to sell ELLE branded products. Ms Colineau provides the names and extracts for each of the licensees and then categorises the various goods and services which it is required to show use. The evidence has been usefully presented to address each of the earlier goods and services that it is required to provide proof of use for. Therefore, rather than summarise the goods and services specific evidence here, it is more convenient to summarise it when determining whether the opponent has demonstrated use for the goods and services that it relies upon.

Proof of use

11) The earlier marks qualify as an acceptable basis to oppose the application as defined in section 6 of the Act. Since all of the earlier marks are more than 5 years old at the date of publication of the application, and the applicant has requested proof of use, section 6A of the Act is applicable:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

⁸ Para. 5

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.”

Proof of use case-law

12) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale

and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

13) Since the earlier trade marks being relied upon mark are EUTMs, I also take into account the Court of Justice of the European Union (“CJEU”) comments in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, whereby it stated that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the

European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

14) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open

the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

15) The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

16) Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

Relevant period

17) The relevant period for proof of use is the five-year period ending on the date of publication of the application in the UK, namely 2 June 2013 to 1 June 2018. Under section 100 of the Act the onus is on the opponent to show genuine use of its mark during this period in respect of the services relied upon.

18) I begin by setting out the goods and services for which the opponent is required to demonstrate genuine use in relation to its section 5(2)(b) claim:

Class 3 - Cosmetics products; perfumery.

Class 4 – Candles.

Class 24 – Bed and table covers, and in particular household linens.

Class 25 – Clothing in general, in particular underclothing, lingerie items, night clothing, trousers, knickers, shorts, pants, jumpsuits, shirts, undershirts, tee-shirt, pullovers, sweaters, knitwear, vests, jackets, raincoats, anoraks, coats, overcoats, pelerines, skirts, dresses, overalls, cover-ups, fur clothing, scarves, shawls, sashes, sports clothing, gloves, robes, suspenders, belts, neckties, footwear, boots, slippers, sandals, sports footwear, except for stockings, socks and tights.

Class 35 - Advertising, in particular by means of advertorials, for others, by means of co-branding operations, by means of the sale and/or rental of display stands, placards and printed and/or electronic promotional media, for the promotion of miscellaneous goods and services, in particular in the fields of fashion (fashion articles and fashion accessories, styling, fashion shows), beauty and hygiene (cosmetics, soaps, perfumery preparations, hygiene preparations, beauty care, body care and body massage, relaxation and thalassotherapy); mail order sale of miscellaneous goods, in particular in the

following fields: fashion (clothing, fashion articles and fashion accessories), leather goods and luggage, beauty and hygiene preparations (cosmetics, soaps, perfumery preparations, hygiene preparations, essential oils, toiletries), childcare, fitting out of interiors and exteriors (table linen and tableware, household linen, decorative objects, furniture.

Acceptable variant use?

19) Before I determine whether the opponent has demonstrated sufficient use of its earlier mark for the goods and services that it relies upon, I firstly confirm that the mark

is consistently used as registered, i.e. **ELLE**, or ELLE word which is clearly an acceptable variant⁹.

Sufficient use?

20) Proven use of a mark which fails to establish *that “the commercial exploitation of the mark is real”* because the use would not be *“viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark”* is therefore not genuine use.

21) An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹⁰

22) As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as *“warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”*.

⁹ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v OHIM* T-415/09

23) As previously stated, the evidence filed was specific to the goods and services which the opponent seeks to rely upon. Therefore, I shall deal with each group in turn. Before doing so, I shall make the general observation that the evidence demonstrates that it licences its ELLE mark to third parties. It is not in dispute that use of a trade mark by a third party, with the owner's consent is acceptable¹¹.

Cosmetic products

24) Ms Colineau states that the licensee to use the opponent's ELLE mark for cosmetics is a company called MAESA. The licence was effective from 24 April 2013 and valid until 31 December 2018¹². The territorial scope of the licence includes France and many other European countries, but not the UK.

25) In terms of advertising its cosmetics products under its ELLE mark, Ms Colineau submits 11 extracts from its ELLE magazine dated between 2014 and 2017 which show the mark on various items of makeup.

26) In terms of turnover, for the period September 2014 to January 2017 the opponent claims, through its licensors, made sales totalling €1,080,805.32. To evidence this, Ms Colineau submits a table of sales which includes the following figures:

Category	Quantity sold	Sales
Lips	89,054	€395,416.32
Nails	29,612	€84,406.71
Foundation	45,988	€230,372.94
Eyes	62,835	€222,649.52

27) It is clear from the sales made and advertising material that the opponent has consented to use of its mark (through third parties) to a significant extent. Therefore, it demonstrated use on, and therefore may rely upon, cosmetic products.

¹¹ Section 6A(3)(a)

¹² Extracts from the licence agreement have been filed as exhibit 2 with a translation submitted by Casey Joly.

Perfumery

28) The opponent's licensee for its ELLE trade mark on perfumery products is PB LICENCE (GOUP BERDOUES). The licence was effective from 10 March 2014 and valid until 31 December 2019. Extracts of the licence have been filed as exhibit 6. The licence demonstrates that it covers the UK and France. To demonstrate the advertisement of perfume products, Ms Colineau submits¹³ 11 extracts from its UK edition of its ELLE magazine dated between 2015 and 2016 showing the mark on bottles of perfume.

29) Ms Colineau goes on to state that in June 2015 the ELLE perfume for kids was recognised among the Best Fragrances for kids and awarded an "OSCAR 2015". This is evidenced with a press clipping dated June 2015 from the COSMETIQUEMAG¹⁴. In terms of sales of perfume products for kids Ms Colineau submits a sales report which shows that sales for 2015 and 2016 were in excess of €1.5m per annum. The majority of these sales have been made in France.

30) I find that the opponent has demonstrated sufficient use of the mark for perfumery and may rely upon these goods.

Candles

31) Ms Colineau has not provided any details of a licence agreement, nor has she provided turnover figures. However, in order to demonstrate use, she has submitted: i) nine invoices¹⁵ to French-based entities listing ELLE perfumed candles dated between 2015 and 2017. They show sales of 601 candles totalling a few thousand euros, ii) two advertisements for candles dated 2016 and 2017 from its website ellepromo.fr¹⁶ which shows the mark on a candle (the candle being advertised in

¹³ Exhibit 7

¹⁴ Exhibit 8

¹⁵ Exhibit 15

¹⁶ The website is owned by the opponent as demonstrated by the Whois domain name report filed at exhibit 12

euros), and iii) an invoice¹⁷ dated 29 May 2017 which is addressed to a company in the UK for a single “ELLE SO CHIC PERFUMED CANDLE SET” costing €6.50.

32) Whilst the use listed above is not significant, I do not consider it to be sham or token. Instead I find it to be real commercial use of the mark in France which, by extension, I consider to be sufficient to constitute genuine use of its earlier EUTMs. Accordingly, the opponent has demonstrated genuine use and may rely upon candles.

Bed and table covers, and in particular household linens

33) Exhibit 16 to the witness statement is a further redacted licence agreement between the opponent and Merison Groep B.V. effective on 1 January 2015 until 31 December 2019 covering the European Union. Ms Colineau claims that the licence is for “bed and table covers, and in particular household linens”, but I could not see any reference to bed covers in the licence.

34) Ms Colineau states that the licence authorises use of the mark for two categories, these being a) “Tabletop”, which covers table textile, tablecloth, placemat, runner and napkins, b) “Textiles” which covers kitchen textile, apron, oven glove, double oven glove, potholder and tea towel. To evidence use of the mark on these goods Ms Colineau has submitted its 2016 ELLE special tableware catalogue¹⁸. The goods in the catalogue include, inter alia, placemats, napkins, tea towels, double oven gloves, aprons, placemats, kitchen textile, aprons and tea towels. In terms of sales Ms Colineau submits a table of European Union sales which show that 1,162 articles of “tabletop” goods were sold totalling €6,668. It is noted that these were sold in Croatia, France, Netherlands and Slovenia. With regard to “Textiles” goods in the same territories, it sold 386 articles totalling €2,853. Taking all of the evidence into account, I find that the opponent has sufficiently used its mark, and may rely upon: “bed covers, and in particular household linens”.

¹⁷ Exhibit 13

¹⁸ Exhibit 18

Cushion covers

35) The licensee for cushion covers is Linum AB, and the licence with them was effective from January 2011 until 31 December 2013. To evidence use of the mark on cushion covers, Ms Colineau submits the opponent's winter catalogue for 2012/2013¹⁹ which includes ELLE cushions.

36) For the relevant period, Ms Colineau submits one four-page invoice²⁰ from "the French affiliate of the Licensee to a French-based entity on 31/07/2013"²¹ for 304 articles. 175 of these relate to cushions. The total sales from this invoice amount to just a few hundred euros. I do not consider one sale for 175 "cushions", rather than cushion covers, for a few hundred euros at the beginning of the relevant period to be sufficient. Whilst I do not consider it to be sham or token, it is not aimed at creating and maintaining a market share for cushion covers. This view is supported by the licence ceasing to have effect at the end of December 2013. I find that the opponent may not rely upon cushion covers.

Clothing, footwear, headgear

37) There is no evidence of use for headgear and therefore the opponent may not rely upon these goods.

38) Ms Colineau states that the opponent has granted a licence to use its mark for clothing to Kamani Design, effective since 1 January 2010 until 1 December 2018. Extracts of the licence have been filed as exhibit 22. The licence covers the United Kingdom and covers various "sportswear apparel for women"²², which include sports tops, sports bottoms, technical sports underwear and technical sports swimwear. To demonstrate the use, Ms Colineau submits numerous advertisements placed in its ELLE magazine 2015 and 2016²³. Further evidence of use are extracts from the

¹⁹ Exhibit 20

²⁰ Exhibit 21

²¹ Paragraph 31 of the witness statement

²² Part B, Category 1 to the licence agreement

²³ Exhibit 23

opponent's website, which show the mark ELLE being used on women's sportswear²⁴. It is noted that the mark is used solely on women's sportswear. In terms of turnover, UK sales for the year 2015 amounted to £3,434,381 which generated £188,896.39 of royalties. These sales were made through UK retailers such as TK MAXX, M&M Direct, Next, etc.

39) It is clear that the opponent has used its ELLE mark in relation to clothing and sportswear but it is equally clear that the use is limited to women's clothing and footwear. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

40) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

²⁴ Exhibit 24

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

41) Taking the guidance above into account, I find a fair specification to be *women's clothing; women's sportswear*.

42) The opponent's licensee for footwear was a company called Dresco who had a licence from 1 January 2013 until 31 December 2016. The licence covers the European Union, including the UK²⁵.

²⁵ Extracts of the licence agreement have been filed under exhibit 26

43) Exhibit 27 to the witness statement comprises of the ELLE Spring/Summer 2015 catalogue. It includes numerous pictures of women's footwear. The opponent has not provided sales figures for its footwear, but it has submitted 14 invoices dated between 2014 and 2016, many to UK customers, demonstrating sales of footwear.

44) Applying the principles set out in *Euro Gida* and *Property Renaissance*, I find a fair specification to be *women's footwear*.

Advertising

45) Ms Colineau states that given ELLE's media power and influence, it "provides advertising services for operators that wish to have their products or brands promoted in the ELLE magazine."²⁶ Exhibit 29 to the witness statement consists of extracts from various ELLE magazines dated between 2013 and 2017 which advertise third party goods, including NOKIA, ASOS, River Island, H&M, etc. Ms Colineau provides further examples of the ELLE publication containing third party advertisements covering a wide range of goods, including well-known brands such as Clarins, Tiffany, Pandora and Intersport.

46) Whilst no turnover figures have been provided, it is clear that the magazines include third party advertisements and that it is service that the opponent provides. Accordingly, the opponent may rely upon *advertising*.

Mail order

47) Mail order is the buying of goods or services for them to be delivered via the post or delivery agencies. Ms Colineau claims that mail orders are carried out via its website. To evidence this, Ms Colineau states that "Exhibit 13, which is an invoice to a UK-based entity refers to its Order #200000105 and the order Dated of 23/05/2017." Further, the invoices filed under exhibit 15 are to French-based entities and include the references "Commande" which is French for "Order" and "Date de commande" which is translated as meaning "Date of the Order". Also, Ms Colineau relies upon

²⁶ Para. 39

orders made in 2015 through the opponent's website which it claims it sold £29,280 worth of goods. I consider this to be sufficient use and the opponent may rely upon its mail order services.

48) Taking all of the above into account, I find that the opponent has demonstrated use for, and may rely upon, the following goods and services:

Class 3 - Cosmetics products; perfumery.

Class 4 – Candles.

Class 24 – Table covers, and in particular household linens.

Class 25 – Women's clothing; women's sportswear; women's footwear

Class 35 - Advertising, in particular by means of advertorials, for others, by means of co-branding operations, by means of the sale and/or rental of display stands, placards and printed and/or electronic promotional media, for the promotion of miscellaneous goods and services, in particular in the fields of fashion (fashion articles and fashion accessories, styling, fashion shows), beauty and hygiene (cosmetics, soaps, perfumery preparations, hygiene preparations, beauty care, body care and body massage, relaxation and thalassotherapy); mail order sale of miscellaneous goods, in particular in the following fields: fashion (clothing, fashion articles and fashion accessories), leather goods and luggage, beauty and hygiene preparations (cosmetics, soaps, perfumery preparations, hygiene preparations, essential oils, toiletries), childcare, fitting out of interiors and exteriors (table linen and tableware, household linen, decorative objects, furniture.

Section 5(2)(b)

The legislation

49) 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”.

The case-law

50) 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:

(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.

Comparison of goods and services

51) The respective goods and services to be compared are:

Applicant's goods	Opponent's goods and services
<i>Class 3: Skin care preparations; make-up; moisturisers; body cleaning and beauty care preparations; cosmetics and cosmetic preparations; cosmetic kits; compacts containing</i>	<i>Class 3 - Cosmetics products; perfumery.</i> <i>Class 4 – Candles.</i>

make-up; sunscreen creams; hair treatment preparations; soaps and gels; perfumery and fragrances; nail polish; eyelashes; deodorants and antiperspirants; dentifrices and mouthwashes.

Class 4: Candles; wicks; perfumed candles; tapers; bees wax.

Class 24: Textiles and substitutes for textile goods; bed and table covers; household textile articles; textile piece goods; travellers' rugs; textile goods for use as bedding; textiles for making articles of clothing; duvets; quilts; covers for pillows, cushions or duvets; household linen; linen cloth; bed linen; bath linen; table linen; table cloths; curtains of textile or plastic; pillow shams; pillow cases; sheets; towels; eiderdowns; covers for eiderdowns; mattress covers; napery; napkins; serviettes; table mats (not of paper); face towels; face flannels of textile; textile tissues; traced cloth for embroidery; tapestry (wall hangings) of textile; furniture coverings.

Class 25: Clothing; footwear; headgear.

Class 35: Advertising, marketing and sales promotions; online ordering services; retail services connected with the sale of skin care preparations, make-up, moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts containing make-up, sunscreen

Class 24 – Table covers, and in particular household linens.

Class 25 – Women's clothing; women's sportswear; women's footwear

Class 35 - Advertising, in particular by means of advertorials, for others, by means of co-branding operations, by means of the sale and/or rental of display stands, placards and printed and/or electronic promotional media, for the promotion of miscellaneous goods and services, in particular in the fields of fashion (fashion articles and fashion accessories, styling, fashion shows), beauty and hygiene (cosmetics, soaps, perfumery preparations, hygiene preparations, beauty care, body care and body massage, relaxation and thalassotherapy); mail order sale of miscellaneous goods, in particular in the following fields: fashion (clothing, fashion articles and fashion accessories), leather goods and luggage, beauty and hygiene preparations (cosmetics, soaps,

<p><i>creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes, candles, wicks, perfumed candles, tapers, bees wax, textiles and substitutes for textile goods, bed and table covers, household textile articles, textile piece goods, travellers' rugs, textile goods for use as bedding, textiles for making articles of clothing, duvets, quilts, covers for pillows, cushions or duvets, household linen, linen cloth, bed linen, bath linen, table linen, table cloths, curtains of textile or plastic, pillow shams, pillow cases, sheets, towels, eiderdowns, covers for eiderdowns, mattress covers, napery, napkins, serviettes, table mats (not of paper), face towels, face flannels of textile, textile tissues, traced cloth for embroidery, tapestry (wall hangings) of textile, furniture coverings, clothing, footwear, headgear; consultancy, information and advisory services relating to all the aforesaid services.</i></p> <p><i>Class 44: Hygienic and beauty care for human beings or animals; beauty salon services; beauty therapy services; clinics; spa services; hairdressing; salon services; information, consultancy and advisory services to all the aforesaid services.</i></p>	<p><i>perfumery preparations, hygiene preparations, essential oils, toiletries), childcare, fitting out of interiors and exteriors (table linen and tableware, household linen, decorative objects, furniture.</i></p>
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52) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

53) In the judgment of the CJEU 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”.

54) 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.

Class 3

55) Both lists of goods include the identical term *perfumery*. Applying the principle set out in *Meric*, I also consider the applied for *fragrances* to be identical to *perfumery*. I consider the applied for *cosmetics and cosmetic preparations* to be identical to the earlier *cosmetics products*.

56) Applying the principle set out in *Meric*, I find the applied for *make-up, Skin care preparations, compacts containing make-up and cosmetic kits* to be identical to the earlier *cosmetics products*.

57) *Cosmetics* are preparations applied to the body, especially the face, to improve its appearance. Accordingly, I find the applied for *nail polish* to fall within the scope of the earlier *cosmetics products*.

58) With regard to the applied for *moisturisers; body cleaning and beauty care preparations; sunscreen creams; hair treatment preparations; soaps and gels; eyelashes*, these are all goods which used to improve, protect or preserve one's appearance. Therefore, whilst the physical nature of the goods differs, the users are the same as are the intended purpose and method of use. The goods are also sold in close proximity to one another in supermarkets and department stores. Accordingly, I find that there is at least a medium degree of similarity.

59) I consider the applied for *deodorants and antiperspirants* to be similar to the earlier *perfumery* to a medium degree. Whilst the nature of the goods differs, they coincide with producers, are sold to the same relevant public and share distribution channels.

60) I now turn to *dentifrices and mouthwashes* which are essentially items which are used to clean teeth and/or the consumer's mouth. Whilst some dentifrices contain whitening particles to improve one's smile and have a cosmetic impact, the purpose is to clean teeth. The users and trade channels may overlap but only on a superficial level. They are not in competition with one another. I find that the goods are not similar.

Class 4

61) Both lists of goods include the identical term *candles*. Applying the principle set out in *Meric*, I also consider *perfumed candles* to be identical to the earlier *candles*. *Tapers* are slender candles and so they are covered by, and therefore identical to, the opponent's *candles*.

62) In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

63) *Wicks* are defined as “a piece of string in the centre of a candle, or a similar part of a light, that supplies fuel to a flame”²⁷. *Wicks* clearly form part of a candle and therefore they share the same producer, via the same distributors and are complementary. However, they differ in nature. I find them to be similar to a medium degree.

64) *Bees wax* is wax secreted by bees to make honeycombs and used to make candles. The opponent argues that candles and beeswax are highly similar since they are “complementary from one another – i.e. in order to be able to make and use a candle, one must use a wick and would commonly use bees wax”. In my view, purchasers of beeswax are likely to be either businesses who make candles or enthusiasts who wish to make their own candles. It is a relatively specialist which is not likely to be sold in close proximity to candles. Taking all of the relevant factors into consideration, including the guidance provided in *Les Éditions Albert René v OHIM*²⁸, I find that if they are similar at all then it is only to a low degree.

²⁷ Online Cambridge University dictionary

²⁸ Paragraph 62 above refers.

Class 24

65) Both lists of goods include the identical term *table covers*.

66) I consider the applied for *furniture coverings* to be identical to the earlier *table covers* since both are covers and a table is an item of furniture.

67) The Collins English dictionary defines the term household linen as “items made of cloth, such as tablecloths, sheets and pillowcases, that are used in the home”. Based on this definition, and applying the principle set out in *Meric*, I find the following to be included and therefore identical to household linen: *Textiles and substitutes for textile goods; bed covers; household textile articles; textile piece goods; textile goods for use as bedding; household linen; duvets; quilts; linen cloth; bed linen; bath linen; table linen; table cloths; pillow shams; pillow cases; napery; napkins; face towels; face flannels of textile; covers for pillows, cushions or duvets; sheets; towels; eiderdowns; covers for eiderdowns; mattress covers*.

68) With regard to the remaining goods, they are all household items which are likely to be sold in the same establishments as table covers and household linens. They are not in competition or complementary and their nature does differ. Therefore, I find all of the following goods to be similar to a low degree: *travellers' rugs; textiles for making articles of clothing; curtains of textile or plastic; serviettes; table mats (not of paper); textile tissues; traced cloth for embroidery; tapestry (wall hangings) of textile*.

Class 25

69) Applying the *Meric* principle, the applied for *clothing* and *footwear* include the earlier *women's clothing* and *women's footwear* respectively. Therefore, they are identical.

70) In relation to *headgear*, I begin by noting that collinsdictionary.com defines "clothing" as: "things people wear". That definition accords with my own understanding of the word and, more importantly will, I am satisfied, accord with that of the average consumer. As headgear goods are to be worn, they too are to be regarded as identical

on the *Meric* principle. However even if that were not the case, given the obvious similarities in, at least, the users, nature, intended purpose, method of use and trade channels, if not identical, these goods are similar to the opponent's "Women's clothing" to a high degree.

Class 35

71) The applied for *advertising, marketing and sales promotions* are self-evidently identical to the earlier broad *advertising* services.

72) The earlier mark includes the term *mail order sale* of various goods. I take the earlier mail order sale services to be a retail type service. Accordingly, I find the aforementioned earlier services to be highly similar to the following services since they have the same intended purpose, are in competition with one another.

retail services connected with the sale of skin care preparations, make-up, moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts containing make-up, sunscreen creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes, candles, wicks, perfumed candles, tapers, bees wax, textiles and substitutes for textile goods, bed and table covers, household textile articles, textile piece goods, travellers' rugs, textile goods for use as bedding, textiles for making articles of clothing, duvets, quilts, covers for pillows, cushions or duvets, household linen, linen cloth, bed linen, bath linen, table linen, table cloths, curtains of textile or plastic, pillow shams, pillow cases, sheets, towels, eiderdowns, covers for eiderdowns, mattress covers, napery, napkins, serviettes, table mats (not of paper), face towels, face flannels of textile, textile tissues, traced cloth for embroidery, tapestry (wall hangings) of textile, furniture coverings, clothing, footwear, headgear; consultancy, information and advisory services relating to all the aforesaid services.

Online ordering services

73) The above term strikes me as inherently vague in terms of what it is intended to cover. In *Chartered Institute of Patent Attorneys v Registrar of Trade Marks*, Case C307/10 the CJEU stated:

“Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.”

74) In *Advance Magazine Publishers, Inc. v OHIM*, Case T-229/12, the GC held that ‘accessories’ is a vague term. The OHIM Board of Appeal therefore erred in law in comparing it with ‘*umbrellas*’. It therefore appears that where a term is not sufficiently precise to identify the characteristics of the goods/services at issue, that term cannot be the subject of a finding that it covers goods/services which are similar to other goods/services.

75) I consider the term “online ordering services” to lack the necessary clarity and precision. In order for the term to be clear and precise it would require the goods which are to be ordered to be listed. Accordingly, I shall proceed on the basis that the applicant intended the online ordering services to be akin to mail order services and for the same reasons listed above I find them to be highly similar.

Class 44

76) The opponent claims that its earlier class 3 cosmetics products and perfumery are “very similar” to the applied for class 44 services. It relies upon the UK IPO decision in *Kiko SRL v Be Connected International General Trading L.L.C.* O-351-14 which states at paragraph 30 that:

“**Class 44:** *Health care services; manicure and pedicure services; beauty salons; make-up services; beauty consultancy; cosmetics consultancy*”

services, hygienic and beauty care for human beings; all the above services related to nails.

30) The services are all of the type to be offered in beauty salons. This is so even for health care services [related to nails] as a beautician will take care of the health of one's nails as well as applying nail varnish etc. In comparison to the cosmetic goods of the earlier mark, there is a similarity in purpose (they are all for the purpose of beautification), have similar trade channels in some contexts (beauty products are often sold in beauty salons and some shops will offer beauty services within), they are offered to the same end users. There is also a degree of competition as someone may purchase a particular product to use at home or, alternatively, use the services to gain the same result. The inherent nature is, of course, different. Nevertheless, I still consider there to be a reasonable degree of similarity."

77) I am not bound by previous decisions of the UK IPO. However, I do agree with the hearing officer's assessment and agree that the respective goods and services are similar to, at best, a medium degree.

78) To summarise, I have found all of the applied for goods and services to be either identical or similar (to varying degrees) except for *dentifrices and mouthwashes*.

Comparison of marks

79) 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 CJEU 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.”

80) 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.

81) The respective trade marks are shown below:

Applicant's mark	Opponent's mark
	

82) The opponent's mark is a word only mark and so its overall impression therefore resides solely in this element.

83) The applicant's mark is a combination of a word and a device. The applicant describes the devices as being “a dominant intricate butterfly design under which the name ELLEY appears below”²⁹. In my view, given the size and prominence of the device, its impact in the overall impression of the mark is notable. The verbal element ELLEY is equally dominant and also contributes to the distinctive character of the mark as a whole.

²⁹ Paragraph 4 of the counterstatement

84) Visually, the respective marks are similar to the extent that they share the common element ELLE. They differ insofar that the applicant's mark ends with the letter Y, includes a device and the font of the lettering differs. Since the device is a notable element of the applicant's mark, together with the letter Y at the end of the word, I consider the marks to be visually similar to a below medium degree, but not low.

85) Aurally, the device in the applicant's mark will not be verbalised. The opponent argues that it would be pronounced as either "EL-EE" or "EL-AY". I consider it most likely to be pronounced as two syllables, these being "EL-EE". The opponent argues that its mark may also be pronounced as two syllables, namely "EL-EE". I disagree. In my view, it would be pronounced as one syllable, i.e. "ELL" (the E at the end of ELLE being silent). In view of this, I find that the marks are aurally similar to a medium degree.

86) Conceptually, the applicant states that ELLEY is a girl's forename which I take to imply ELLE as not being a girl's forename and therefore there is no conceptual similarity. If this is what the applicant is arguing, then I disagree. Both ELLE and ELLEY are girl's forenames. Therefore, they are conceptually similar to the extent that they are both girl's names and are similar sounding. They are conceptually similar to at least a medium degree.

Average consumer and the purchasing act

87) 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.

88) 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.”

89) The goods and services in question are broad, ranging from, inter alia, cosmetics to advertising, from linen to mail order. Generally speaking, the goods are all items which are likely to be purchased by the general public predominantly following a visual inspection of the goods or, to a lesser degree, an aural recommendation.

90) The only goods or services which are more likely to be purchased by professionals are advertising, marketing and sales promotions services which would be sought by businesses looking to promote their goods or services. Those seeking such services are likely to pay a higher than average degree of care and attention. Further, they would also be sought following a visual inspection of websites, brochures, etc, though I do not discount aural recommendations.

Distinctive character of the earlier trade mark

91) 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).”

92) The opponent has not filed any evidence aimed at supporting any enhanced distinctive character, nor has it claimed such use. Therefore, it does not have an enhanced level of distinctive character by virtue of the use made of the mark.

93) From an inherent perspective, the earlier mark consists of the word ELLE (in a relatively non-distinct font). The mark is neither directly descriptive or allusive of the goods and services in question and, therefore, the opponent argues that it is inherently “very strong and very distinctive”³⁰. Inherent distinctiveness can vary from being high for invented words to marks which are allusive or suggestive of the goods or services in question. In this instance, the earlier mark is a well-known girl’s name which is not descriptive or allusive of the goods in question. However, it is not an invented word and so I find that the earlier mark has at least a medium degree of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

94) Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. It is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and

³⁰ Opponent’s written submissions

vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

95) Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

96) To determine whether there is a likelihood of direct or indirect confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I have set out above.

97) I have found that the respective goods either identical or similar to varying degrees. I also concluded that the respective marks are visually similar to a below medium degree but not low, aurally similar to a medium degree and conceptually similar to at least a medium degree. I have also found that the earlier mark is inherently distinctive to at least a medium degree. I have also concluded that the goods will be purchased following a visual inspection of the goods (though I do not discount aural considerations) whereby members of the public will pay a medium degree of attention and for some of the services they will be professionals who pay a higher degree of attention.

98) I must assess the marks taking into account all of the relevant factors. With this in mind, I do not consider that the average consumer will mistake one mark for another and so there is no likelihood of direct confusion. However, I do consider the indirect likelihood of confusion position to be different. 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.

99) I also bear in mind the guidance in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, whereby 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. Mr Mellor Q.C. pointed out that it is not sufficient that a mark merely calls to mind another mark, this is mere association.

100) Taking all of the factor listed above into account, and in particular imperfect recollection and the interdependency principle, given the similarity between the marks, I find that this will result in a consumer mistaking one mark for the other, i.e. there will be direct confusion. Even if I am wrong about there being direct confusion and the differences between the marks, in particular the applicant’s device, were sufficient to avoid direct confusion, there is still, in my view, a likelihood of indirect confusion. The average consumer is likely to consider the applicant’s trade mark to be another brand owned by the opponent, i.e. there is a likelihood of indirect confusion. However, I do not consider this to be the case in respect of goods and services which I have found there to be a medium or lower degree of similarity. For these goods I do not consider there to be either direct or indirect confusion and so the opposition under section 5(2)(b) fails.

SECTION 5(2)(b) OUTCOME

101) The section 5(2)(b) claim succeeds against the following goods and services

Class 3: Skin care preparations; make-up; moisturisers; body cleaning and beauty care preparations; cosmetics and cosmetic preparations; cosmetic kits; compacts containing make-up; sunscreen creams; hair treatment preparations; soaps and gels; perfumery and fragrances; nail polish; eyelashes; deodorants and antiperspirants.

Class 4: Candles; perfumed candles; tapers.

Class 24: Textiles and substitutes for textile goods; bed and table covers; household textile articles; textile piece goods; textile goods for use as bedding; duvets; quilts; covers for pillows, cushions or duvets; household linen; linen cloth; bed linen; bath linen; table linen; table cloths; pillow shams; pillow cases; napery; napkins; face towels; face flannels of textile; sheets; towels; eiderdowns; covers for eiderdowns; mattress covers; furniture coverings.

Class 25: Clothing; footwear; headgear.

Class 35: Advertising, marketing and sales promotions; online ordering services; retail services connected with the sale of skin care preparations, make-up, moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts containing make-up, sunscreen creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes, candles, wicks, perfumed candles, tapers, bees wax, textiles and substitutes for textile goods, bed and table covers, household textile articles, textile piece goods, travellers' rugs, textile goods for use as bedding, textiles for making articles of clothing, duvets, quilts, covers for pillows, cushions or duvets, household linen, linen cloth, bed linen, bath linen, table linen, table cloths, curtains of textile or plastic, pillow shams, pillow cases, sheets, towels, eiderdowns, covers for eiderdowns, mattress covers, napery, napkins, serviettes, table mats (not of paper), face towels, face flannels of textile, textile tissues, traced cloth for embroidery, tapestry (wall hangings) of textile, furniture coverings, clothing, footwear, headgear; consultancy, information and advisory services relating to all the aforesaid services.

102) The section 5(2)(b) claim fails against

Class 3: Dentifrices and mouthwashes.

Class 4: Wicks; beeswax.

Class 24: Travellers' rugs; textiles for making articles of clothing; curtains of textile or plastic; serviettes; table mats (not of paper); textile tissues; traced cloth for embroidery; tapestry (wall hangings) of textile.

Class 44: Hygienic and beauty care for human beings or animals; beauty salon services; beauty therapy services; clinics; spa services; hairdressing; salon services; information, consultancy and advisory services to all the aforesaid services.

Section 5(3)

103) Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

104) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

105) I begin by reminding myself that the mark the opponent claims to have reputation

for is **ELLE** in respect of the following goods and services: class 16 *printed matter, newspapers and periodicals, books, catalogues, prospectuses, albums, atlases, bookbinding material*, and class 41 *publishing of texts, illustrations, books, journals, newspapers, periodicals, magazines and publications of any type or form, including electronic and digital publications; entertainment services*.

106) I shall only decide the section 5(3) claim in relation to the goods and services that the section 5(2)(b) claim failed. These are:

Class 3: Dentifrices and mouthwashes.

Class 4: Wicks; beeswax.

Class 24: Travellers' rugs; textiles for making articles of clothing; curtains of textile or plastic; serviettes; table mats (not of paper); textile tissues; traced cloth for embroidery; tapestry (wall hangings) of textile.

Class 44: Hygienic and beauty care for human beings or animals; beauty salon services; beauty therapy services; clinics; spa services; hairdressing; salon services; information, consultancy and advisory services to all the aforesaid services.

Reputation

107) In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

108) The requisite reputation of an EU mark requires that the opponent's mark is known by a significant part of the public concerned by the products or services covered

by that mark in a substantial part of the territory of the Community³¹. As I have already acknowledged, the opponent's turnover in the EU is reasonably significant being in the tens of millions of euros a year and relates to use in a number of member states. Further, the opponent has stated that its monthly readership is around 714,000. Therefore, I have little hesitation in finding that the opponent has the requisite reputation in the EU for magazines, which are covered by the broader term printed matter. The opponent argues that its reputation "has also expanded to include entertainment, which continues to be an area of intense recognition for the brand, as demonstrated by the extensive online following that the Opponent attracts under the ELLE mark, through its online content and social media channels. The Opponent's reputation in respect of fashion is extensive and positive, and is most extensive with regards to the provision of content by way of publishing magazines and online content."

109) The opponent goes on to state that "the Opponent has built a massive reputation in respect of the ELLE mark in the field of publications, publishing services, and entertainment, and that the mark is extremely well known in the United Kingdom."

110) As previously stated the evidence clearly demonstrates that the opponent has a reputation for magazines. Having a significant reputation for magazines does not automatically result in the opponent also having a reputation for publishing services. Publishing services is the act of preparing issuing books, journals, magazines and other material for sale. The opponent clearly publishes its own material, but I do not consider it to have a reputation for publishing third party material. If the ELLE magazine was one of other publications being issued by the same entity, then it would be that entity who is the publisher and them that would have a reputation for such services. However, if I am wrong about this I shall proceed on the basis that the opponent does have a reputation for such services.

111) There is no evidence filed in relation to entertainment services and certainly nothing to persuade me that the opponent has a reputation for those services.

³¹ *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, para 30

112) To summarise, the opponent has the requisite reputation for magazines. I shall also proceed on the basis that it has a reputation for publishing services, but as already stated it may not rely upon entertainment services.

The Link

113) My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

114) I have already concluded that the respective marks are visually similar to a below medium degree but not low, aurally similar to a medium degree and conceptually similar to at least a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

115) The opponent's mark has a reputation for magazines and publishing services. The applicant's mark covers goods and services covered by classes 3, 4, 24 and 44 (see paragraph 106 for a full list). I do not find any of the respective goods and services to be similar. More specifically, it is clear that there is no point of similarity between the applied for dentifrices, mouthwashes, wicks and beeswax.

116) I also do not see any point of similarity between magazines and the applied for class 24 goods. Further, the respective nature, intended purpose and users all differ, and they are not in competition with one another, nor are they complementary, i.e. "one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."³²

³² *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

117) I do not see any similarity between the opponent's magazines and the applied for class 44 services. They are dissimilar. They clearly differ in nature since magazines are tangible items whereas services are intangible. I do not consider them to be in competition or complementary, nor do they share distribution channels.

The strength of the earlier mark's reputation

118) The opponent's ELLE magazine has 714,000 monthly readers in the UK and over 1 million of its online pages are viewed each month. Accordingly, I find that its reputation is significant.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

119) I have found that the earlier mark has at least a medium degree of inherent distinctive character. In relation to magazines, the level of distinctive character has been enhanced to being very high.

Whether there is a likelihood of confusion

120) In order for there to be a likelihood of confusion there must be some similarity between the respective goods and services and since in this case they are dissimilar, there is no likelihood of confusion.

Conclusions on link

121) It is true that there is some similarity between the marks and the opponent does have a significant reputation. However, this does not overcome the dissimilarity between the respective goods and services. Even if the earlier mark was brought to mind upon encountering the applied for mark (which I do not consider to be the case), this would be fleeting and certainly not sufficient for a mental link to be established.

122) Since the opponent has failed to establish a link, I am not required to go on to consider whether there would be, or likely to be, any damage caused.

SECTION 5(3) OUTCOME

123) The section 5(3) claim fails.

OVERALL CONCLUSION

124) Subject to appeal, the opposition partially succeeds, and the application shall be refused, in respect of the following goods and services

Class 3: Skin care preparations; make-up; moisturisers; body cleaning and beauty care preparations; cosmetics and cosmetic preparations; cosmetic kits; compacts containing make-up; sunscreen creams; hair treatment preparations; soaps and gels; perfumery and fragrances; nail polish; eyelashes; deodorants and antiperspirants.

Class 4: Candles; perfumed candles; tapers.

Class 24: Textiles and substitutes for textile goods; bed and table covers; household textile articles; textile piece goods; textile goods for use as bedding; duvets; quilts; covers for pillows, cushions or duvets; household linen; linen cloth; bed linen; bath linen; table linen; table cloths; pillow shams; pillow cases; napery; napkins; face towels; face flannels of textile; sheets; towels; eiderdowns; covers for eiderdowns; mattress covers; furniture coverings.

Class 25: Clothing; footwear; headgear.

Class 35: Advertising, marketing and sales promotions; online ordering services; retail services connected with the sale of skin care preparations, make-up, moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts containing make-up, sunscreen creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes, candles, wicks, perfumed candles, tapers, bees wax,

textiles and substitutes for textile goods, bed and table covers, household textile articles, textile piece goods, travellers' rugs, textile goods for use as bedding, textiles for making articles of clothing, duvets, quilts, covers for pillows, cushions or duvets, household linen, linen cloth, bed linen, bath linen, table linen, table cloths, curtains of textile or plastic, pillow shams, pillow cases, sheets, towels, eiderdowns, covers for eiderdowns, mattress covers, napery, napkins, serviettes, table mats (not of paper), face towels, face flannels of textile, textile tissues, traced cloth for embroidery, tapestry (wall hangings) of textile, furniture coverings, clothing, footwear, headgear; consultancy, information and advisory services relating to all the aforesaid services.

125) The section 5(2)(b) claim fails against

Class 3: Dentifrices and mouthwashes.

Class 4: Wicks; beeswax.

Class 24: Travellers' rugs; textiles for making articles of clothing; curtains of textile or plastic; serviettes; table mats (not of paper); textile tissues; traced cloth for embroidery; tapestry (wall hangings) of textile.

Class 44: Hygienic and beauty care for human beings or animals; beauty salon services; beauty therapy services; clinics; spa services; hairdressing; salon services; information, consultancy and advisory services to all the aforesaid services.

COSTS

126) The opponent has been more successful than it hasn't and so it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, and considering the opponent's partial success, I award the opponent the sum of £950. This sum is calculated as follows:

Official fee	£200
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Preparing a statement and considering the other side's statement	£150
Filing evidence	£400
Filing written submissions	£200
TOTAL	£950

127) I therefore order Elley Ltd to pay Hachette Filipacchi Presse the sum of £950. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 23th day of December 2019

MARK KING
For the Registrar,
The Comptroller-General