

O/609/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK 3621479

IN THE NAME OF SHENZHEN SHIJIDAFEI TECHNOLOGY CO., LTD

FOR THE TRADE MARK:

LOVELLE

IN CLASS 8

AND

OPPOSITION THERETO UNDER NO. 426621

BY HACHETTE FILIPACCHI PRESSE

Background and pleadings

1. SHENZHEN SHIJIDAFEI TECHNOLOGY CO., LTD (“the applicant”) applied to register the trade mark shown on the cover page on this decision in the UK on 6 April 2021.
2. The application was accepted and published in the Trade Marks Journal on 4 June 2021 in respect of the following goods:

Class 8: *Scissors; Tweezers; Table cutlery [knives, forks and spoons]; Hand tools, hand-operated; Vegetable knives; Trowels [gardening]; Blade sharpening instruments; Cuticle tweezers; Cuticle nippers; Hair-removing tweezers; Pedicure sets; Garden tools, hand-operated; Nail files; Razors, electric or non-electric; Nail files, electric; Nail buffers, electric or non-electric; Fingernail polishers, electric or non-electric; Hair clippers for personal use, electric and non-electric; Nail clippers, electric or non-electric; Manicure sets; Depilation appliances, electric and non-electric; Manicure sets, electric; Pizza cutters, non-electric; Eyelash curlers; Ceramic knives; Emery boards; Table knives, forks and spoons for babies; Vegetable peelers [hand tools]; Wine bottle foil cutters, hand-operated; Fruit segmenters; Kitchen mandolines; Wick trimmers [scissors]; Can openers, non-electric; Tin openers, non-electric; Penknives; Artificial eyelash tweezers.*

3. On 03 September 2021, HACHETTE FILIPACCHI PRESSE (“the opponent”) opposed the application on the basis of Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) relying on the trade marks and specifications set out in the table below:

UK00810546813 (“the first earlier mark”)

ELLE

Filing date: 25 January 2005

Registration date: 25 December 2006

Priority date: 20 January 1989

Priority date: 30 March 1989

Relying on:

Class 3: *Cosmetic and beauty preparations, perfumery.*

Class 21: *Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; articles for cleaning purposes; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.*

UK00910170132 (“the second earlier mark”)

ELLE

Filing date: 02 August 2011

Registration date: 26 February 2013

Relying on:

Class 8: *Hand tools and implements (hand-operated); Cutlery; Forks and spoons; Side arms; Manicure sets, electric; Nail files (electric or non-electric); Fingernail polishers (electric or non-electric); Nail clippers (electric or non-electric); Clippers; Pizza cutters (non-electric); Hair curling implements; Forks; Curling tongs; Sharpening instruments; Cheese slicers (non-electric); Nutcrackers; Pedicure sets; Tongs; Hair removing tweezers; Manicure sets; Silver plate (knives, forks and spoons); Scissors; Choppers; Eyelash curlers; Razors, electric or non-electric; Depilation appliances, electric and non-electric; Hair clippers, electric and non-electric; Razor blades; Shaving cases; Razor cases; Beard trimmers, Non-electric can openers, Hair trimmers, Vegetable slicers, Nail nippers.*

UK00001282347 (“the third earlier mark”)

E L L E

Filing date: 01 October 1986

Registration date: 19 May 1989

Relying on:

Class 41: *publishing*

UK00903475365 (“the fourth earlier mark”)

ELLE

Filing date: 30 October 2003

Registration date: 11 October 2005

Relying on:

Class 16: *printed matter, periodicals.*

Class 41: *publishing of texts, illustrations, books, journals, newspapers, periodicals, magazines and publications of any type or form, including electronic and digital publications.*

4. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with existing EUTMs and protected international (EU) trade mark designations. As a result of the opponent's first and fourth earlier marks being registered as EUTMs and the second earlier mark being registered as a protected international (EU) trade mark designation at the end of the Implementation Period, comparable UK trade marks were automatically created. These comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing date.

5. Under Section 5(2)(b), the opponent relies on the first and second earlier mark. It claims that the applicant's goods are identical or similar to the goods covered by the earlier marks and that the marks are similar, leading to a likelihood of confusion.

6. Under Section 5(3), the opponent relies on the third and fourth earlier marks. It states that the earlier marks have acquired a reputation in relation to publications and magazines and that use of the applicant's mark would, without due cause, take unfair advantage or be detrimental to the distinctive character or repute of the earlier marks.

7. Given their filing dates, the opponent's marks qualify as earlier marks in accordance with Section 6 of the Act. All earlier marks had completed their registration procedure more than five years before the date the application was filed and are subject to the proof of use provisions contained in Section 6A of the Act.

8. The applicant filed a counterstatement denying the grounds of opposition and requesting the opponent to provide proof of use of the earlier marks.

9. Only the opponent filed evidence during the evidence rounds. I shall refer to the evidence to the extent that I consider necessary.

10. The applicant is represented by Isabelle Bertaux and the opponent by Stobbs. Neither party requested a hearing, but the opponent filed submissions in lieu. This decision is taken following a careful consideration of the papers.

11. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

THE EVIDENCE

12. The opponent filed evidence in the form of two witness statements of Mariette Colineau and Andrew Carver.

13. Ms Colineau is the legal manager of the opponent's company. Her witness statement is dated 27 December 2021 and is accompanied by 31 exhibits (MC1-MC31).

14. Mr Carver is a chartered trade mark attorney at Stobbs, the firm representing the opponent in these proceedings. Mr Carver's witness statement is dated 4 January 2022 and is accompanied by 5 exhibits (AC1-AC5).

DECISION

Proof of use

Relevant statutory provision: Section 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), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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.”

15. As the first, the second and the fourth earlier mark are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

16. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Bundervsvereinigung 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].”

18. The relevant period in which proof of use must be shown is the five-year period ending with the date of the application for registration, namely 7 April 2016 - 6 April 2021.

19. Since the first, second and fourth earlier mark are UK comparable marks, the practice set out in Tribunal Practice Notice (“TPN”) 2/2020 applies. This states that where use and reputation fall to be considered at any time before IP Completion Day (31 December 2020), I am to take into account use in the EU of the corresponding EUTM or International Registration designating the EU until IP Completion Day - see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraph 36.

Evidence

20. The opponent’s main business activities concern the publication and distribution of ELLE magazine. The reputation of the magazine is not, in my view, in doubt (I will return to this point below). However, for the purpose of its claim under Section 5(2)(b),

the opponent relies on goods other than magazines, namely goods in classes 3, 21 and 8; these are the goods on which I will focus, so far as the proof of use is concerned. The evidence shows that the opponent has licensed other companies to produce and distribute various goods which exploit the 'ELLE' brand. Ms Colineau gave the following evidence:

- (a) Between September 2014 and January 2017, a total of 227,489 of make-up products were sold by one of the opponent's licensees in France under the brand ELLE, equating to EUR 1,080,805.32 (with a total royalty of EUR 108,080.53). However, most of these sales occurred prior to the relevant period (7 April 2016 - 6 April 2021) and from August 2016 to January 2017 there are no sales. The goods sold between April 2016 and January 2017 are as follows: EUR 31,854.88 (April 2016) EUR 700.43 (May 2016) and EUR 421.86 (June 2016) for a total of EUR 32,977.17;¹
- (b) In the first quarter of 2017, a total of EUR 121,602.12 worth of perfumes for children were sold by one of the opponent's licensees in France and EUR 84,129.55 in other permitted territories including the UK, however, there is no breakdown of how sales were split between the EU and other non-EU countries;
- (c) Between 1 September 2018 and 31 December 2018, a total of EUR 249,837 worth of ELLE branded perfumes and body lotions were sold by one of the opponent's licensees in Germany and the UK. Other figures are given for various periods between 1 January 2019 -31 December 2020 although it is not easy to quantify them because they include non-EU countries;
- (d) Various electrical personal care products including electrical hair accessories (hair dryers and hair straighteners), electrical manicure and pedicure products (nail dryers and manicure/pedicure sets), electrical hair removal products (lady shavers and facial hair removers) were sold by one of the opponent's licensees in various EU countries. Sales of these products were as follow:

¹ There is a value of EUR -21,492.61 but it is not clear what the – symbol means

- second quarter of 2019: 199,116 units sold with a wholesale price of EUR 908,356;
- third quarter of 2019: 206,652 units sold with a wholesale price of EUR 839,393;
- fourth quarter of 2019: 275,796 units sold with a wholesale price of EUR 1,295,474;
- first quarter of 2020: 88,464 units sold with a wholesale price of EUR 331,618;
- second quarter of 2020: 63,444 units sold with a wholesale price of EUR 188,703;
- third quarter of 2020: 366,468 units sold with a wholesale price of EUR 1,632,615;
- fourth quarter of 2020: 341,910 units sold with a wholesale price of EUR 1,615,903

(e) sales reports (supported by invoices) evidencing sales of goods including brushes, scissors, nail clippers, files, mirrors, tweezers, eye lashes curlers and combs by one of the opponent's licensees are provided. The total number of units sold in the UK during the second, third and fourth quarter of 2016 is 133,665;

(f) copies of pages from 2016/2017 catalogues showing use of the brand ELLE in relation to cutlery, kitchen/tableware products are provided. Goods include storage tins, containers, storage mugs, cups, plates, bowls, cutlery, glassware and kitchen utensils. Sales reports show that the sales of these types of goods by one of the opponent's licensees in 2017 in Croatia, Nederland and Slovenia were as follows:

- first quarter of 2017: 18,448 units sold with a wholesale price of EUR 57,637;
- second quarter of 2017: 31,772 units sold with a wholesale price of EUR 103,355;
- third quarter of 2017: 596 units sold with a wholesale price of EUR 2,322;

- fourth quarter of 2017: 19,338 units sold with a wholesale price of EUR 70,124.

21. This evidence is supported by copies of license agreements and invoices, extracts from catalogues, examples of marketing material and images of goods offered for sale in shops and on the Internet, all of which clearly show use of the mark ELLE.

22. Although the opponent has not used the earlier marks in relation to the registered goods in classes 3, 8 and 21, it has, as a trade mark owner, the ability to license others to use its marks for some or all of the goods for which the marks are registered, which is what it has done. Use of the mark by the opponent's licensees is therefore use by consent and, as such, it counts toward genuine use.

23. Taking all of the evidence before me into account, including the sale figures, the extent or geographical spread of the use shown and the marketing material, I am satisfied that there has been genuine use of the first and second earlier marks during the relevant period in the relevant territories. As the specifications of both marks cover goods that are not shown within the evidence, I must consider what would be a fair degree of protection. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

“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.”

24. 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].

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.”

25. I shall begin with the class 3 goods. I am satisfied that the use shown is sufficient for the opponent to rely on *perfumery*. As regards the term *cosmetic and beauty preparations*, the mark has been used in relation to a variety of make-up products. In my view, the average consumer would view *make-up* as an independent subcategory of goods within the broader term *cosmetic and beauty preparations*.

26. As regards the relied-on goods in class 21, there is no use in relation to *articles for cleaning purposes; sponges and unworked or semi worked glass*. However, there is clearly use in relation to *household or kitchen utensils and containers (not of precious metal or coated therewith); combs; glassware, porcelain and earthenware not included in other classes*. The opponent can therefore rely on these goods.

27. Moving to the specification in class 8, there is no use in relation to *Hand tools and implements (hand-operated); Side arms; Pizza cutters (non-electric); Sharpening instruments; Cheese slicers (non-electric); Nutcrackers; Razors, electric or non-electric; Razor blades; Shaving cases; Razor cases; Beard trimmers, Non-electric can openers*.

28. However, I am satisfied that there has been genuine use for the following goods: *Cutlery; Forks and spoons; Manicure sets, electric; Nail files (electric or non-electric); Fingernail polishers (electric or non-electric); Nail clippers (electric or non-electric); Clippers; Hair curling implements; Forks; Curling tongs; Pedicure sets; Tongs; Hair removing tweezers; Manicure sets; Silver plate (knives, forks and spoons); Scissors; Choppers; Eyelash curlers; Depilation appliances, electric and non-electric; Hair clippers, electric and non-electric; Hair trimmers, Vegetable slicers, Nail nippers*. These are the goods upon which the opponent can rely.

Section 5(2)(b)

29. Section 5(2)(b) of the Act is as follows:

“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”.

30. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

31. 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

32. The goods to be compared are as follows:

The applicant's goods	The opponent's goods
<p>Class 8: Scissors; Tweezers; Table cutlery [knives, forks and spoons]; Hand tools, hand-operated; Vegetable knives; Trowels [gardening]; Blade sharpening instruments; Cuticle tweezers; Cuticle nippers; Hair-removing tweezers; Pedicure sets; Garden tools, hand-operated; Nail files; Razors, electric or non-electric; Nail files, electric; Nail buffers, electric or non-electric; Fingernail polishers, electric or non-electric; Hair clippers for personal use, electric and non-electric; Nail clippers, electric or non-electric; Manicure sets; Depilation appliances, electric and non-electric; Manicure sets, electric; Pizza cutters, non-electric; Eyelash curlers; Ceramic knives; Emery boards; Table knives, forks and spoons for babies; Vegetable peelers [hand tools]; Wine bottle foil cutters, hand-operated; Fruit segmenters; Kitchen mandolines; Wick trimmers [scissors]; Can openers, non-electric; Tin openers, non-electric; Penknives; Artificial eyelash tweezers.</p>	<p>Class 3: make-up, perfumery.</p> <p>Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); combs; glassware, porcelain and earthenware not included in other classes.</p> <p>Class 8: Cutlery; Forks and spoons; Manicure sets, electric; Nail files (electric or non-electric); Fingernail polishers (electric or non-electric); Nail clippers (electric or non-electric); Clippers; Hair curling implements; Forks; Curling tongs; Pedicure sets; Tongs; Hair removing tweezers; Manicure sets; Silver plate (knives, forks and spoons); Scissors; Choppers; Eyelash curlers; Depilation appliances, electric and non-electric; Hair clippers, electric and non-electric; Hair trimmers, Vegetable slicers, Nail nippers</p>

33. Some of the contested goods, i.e. *Manicure sets, electric*, are identical to the goods on which the opposition is based. For reasons of procedural economy, I will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed on the basis that the contested goods are identical to those

covered by the earlier trade marks. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

Average consumer

34. 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.

35. 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.”

36. The average consumer of the competing goods in class 8 is a member of the general public.

37. The average consumer is likely to obtain the goods through self-selection from a shelf, catalogue or online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may be an aural aspect to the selection process, such as word-of-mouth recommendation or discussions with retail staff. When selecting the goods, the average consumer will pay attention to factors such as compatibility of the products with their skin or quality and safety of the tools. These factors suggest that the average consumer is likely to pay a medium degree of attention when selecting the products.

Comparison of marks

38. 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.”

39. 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. The respective marks are shown below:

The applicant's mark	The opponent's earlier mark
LOVELLE	ELLE

40. Although the opponent relies on two earlier marks under Section 5(2)(b), the second earlier mark represents the opponent's best case because the goods covered by the first earlier mark are less similar to those covered by the applicant's mark. Further, the second earlier mark is a word-only mark, whilst the first earlier mark has a degree of stylisation which makes it less similar to the mark in suit. Hence, it is hard

to see how the opposition based on the first earlier mark can succeed if the one based on the second earlier mark fails. I will therefore focus on the second earlier mark.

Overall impression

41. In its counterstatement, the applicant states:

“In either the Applicant’s trademark or the Opponent’s trademark, there is no dominant element. In fact, for a finding that there is a dominant element within a sign, the sign should have a component which visually stand out (e.g. by means of size or colour), which is not the case here.”

42. Both marks consist of a single word presented in standard capital letters. I agree with the applicant that the overall impression of each mark resides in their single element.

Visual similarity

43. In its submissions in lieu, the opponent states that even if the applicant was right to assert that consumers generally pay more attention to the beginning of marks than the end, the *“identical aspects of the marks are greater than the differences”*. The opponent also referred to the General Court’s case T-569/11 as an example of where coincidence in the ending of a mark *“has been considered more significant in consumer recognition”*. Further, relying on the principle set out in *Medion v Thompson*, the opponent states that the average consumer will view the applicant’s mark LOVELLE as a conjoining of the words ‘LOVE’ and ‘ELLE’. Finally, the opponent referred to my previous decision BL-O-109/19 in which I found that the mark ‘Proaura’ would be appreciated as composed of the words ‘Pro’ and ‘aura’, albeit conjoined. According to the opponent, the marks are visually similar to a medium degree.

44. In its counterstatement, the applicant states that *“the opponent cannot take a monopoly on the letters “ELLE” and prevent from using these letters in another fancy, invented and distinctive word as the Applicant’s trademark “LOVELLE”*.

45. Whilst the opponent stressed that the applicant accepted that the marks “*are somewhat a little bit similar, only to the extent that they use the same common letters “ELLE”*”, I consider the applicant’s statement to be nothing more than an admission that there are four identical letters in the respective words. However, the applicant also states that overall, the marks are visually different.

46. I agree with the applicant that the mark LOVELLE will be perceived as an invented word and that the average consumer will not identify the element ELLE in LOVELLE as having an independent role. The most that can be said is that the average consumer is likely to appreciate that the mark LOVELLE incorporates the dictionary word LOVE, because that word is one of the most common words in the English language and is clearly identifiable at the beginning of mark.

47. In my view, the letters -LLE in the applicant’s mark are likely to be perceived merely as the end of an invented word incorporating the word LOVE rather than as part of the word ELLE. This is because (a) the letters ELLE are unlikely to be perceived as a separate element since they do not clearly stand out; (b) the mark LOVELLE does not lend itself to be perceived as the words LOVE and ELLE conjoined, because there is only one ‘E’ and (b) the word ELLE is a word of French origin meaning ‘she’ and it is unlikely to be recognised by the average consumer in the UK. But even if the average consumer is familiar with the word ELLE (being it a French word or a female name), it is unlikely that that word would be immediately brought to mind by the mark LOVELLE, given the points I made at (a) and (b). Consequently, if the average consumer was to identify any known words within the mark, it would be the word ‘LOVE’ which is more clearly identifiable and is placed at the beginning of the mark. It follows that the first letter E in LOVELLE will be perceived as the last letter of the word LOVE, rather than the first letter of the word ELLE, with the result that consumers will still see the mark as made up of two elements, namely the word LOVE and the ending -LLE but will not see ELLE as a separate word.

48. As regards the other two cases that the opponent mentioned, no analogy can be made with them as they concern marks that are completely different from the ones at hand. In the GC’s decision the Court found that there was a likelihood of confusion between the signs ‘gitana’ and ‘kitana’, however, in that case the marks differed only

in their first letter. In my previous decision, I found that the mark 'Proaura' lends itself to be broken down in the two elements 'Pro' and 'aura' because they are two well-known dictionary words, however, I have already explained why I am not persuaded that the mark LOVELLE will be perceived as the two words LOVE and ELLE.

49. Visually, although the four letters -E, L, L, E of the two marks in question are certainly identical, that identity is counteracted by the additional three letters L, O, V of the applicant's mark which make it much longer than the opponent's mark (seven and four letters respectively).

50. Additionally, the fact that the differentiating letters are placed at the beginning of the marks further reduces the impact of any similarity created by the shared letters - E, L, L, E. In my view, the marks are visually similar to a low degree.

Aural similarity

51. The opponent states that when the mark LOVELLE is spoken there is a natural break between the letters LOVE and ELLE, and ELLE becomes the dominant component. However, the opponent does not put forward any argument regarding why ELLE is the dominant component of LOVELLE when the mark is articulated. Although I note the opponent's submissions under the conceptual comparison that "*LOVE is an ordinary English word of merely laudatory and descriptive quality, and thus the distinctive element of the mark remains ELLE*", I reject the submission for the reasons given above, namely (1) that the mark LOVELLE will be perceived as an invented word adding the ending -LLE to the word LOVE; (2) that UK consumers are unlikely to recognise the word ELLE within LOVELLE. Further, consumers generally pay greater attention to the beginning of a mark than to the end. In my view, the marks are aurally similar to a low degree.

Conceptual similarity

52. Conceptually, the point that LOVELLE is merely a conjoining of the words LOVE and ELLE is insisted on in the opponent's argument about the conceptual comparison.

The opponent states that the applicant accepts that the word ELLE *“is fairly broadly understood in the UK to mean ‘she’”*. This is not what the applicant said. The applicant said:

“The Opponent’s trademark is however composed by the verbal element “ELLE” which means “SHE” in French and could be understood by a part of the public who understands this common word in French.

Therefore,

- for the part of the public which could see a semantic content behind the earlier marks, it will be considered that no same or analogous semantic content can be found between the trademarks at issue as the Applicant’s sign has not the same meaning;

-or the part of the public, which could not see a semantic content behind the earlier marks, it will be considered that, since no sign has a meaning for the public in the relevant territory, a conceptual comparison is not possible so that the conceptual aspect does not influence the assessment of the similarity of the signs.

As conclusion, the Applicant’s Trademark and the Opponent’s Trademarks are visually and phonetically not similar and have no conceptual aspect in common for a part of the public and the conceptual comparison is not relevant for the other part of the public.”

53. The applicant’s point is that the word ELLE is common in French (and that people in the UK who speak French could understand it), not that it is commonly known in the UK.

54. The opponent further states:

26. The Opponent submits that LOVELLE is not “fanciful, inventive or distinctive” and is merely a conjoining of the words LOVE and ELLE. Furthermore, the Opponent submits that LOVE is an ordinary English word of merely laudatory and descriptive quality, and thus the distinctive element of the mark remains ELLE.

The Opponent argues that the letters ELLE are not meaningless and would be widely understood to mean “she” or at least bring to mind associations of femininity; and will undoubtedly be instantly recognisable throughout the UK as a famous lifestyle brand and magazine for women, by virtue of its extensive use, goodwill and reputation.

27. The Applicant presents two scenarios to compare conceptual similarity – one where the consumer recognises the French word ELLE to mean ‘she’ and the other where ELLE is a meaningless word. The Applicant argues no same or analogous semantic content can be found in either situation – a conclusion which flies in the face of reason, as ELLE remains consistent regardless whether perceived as “ELLE – the lifestyle brand” or “she” or even merely as a combination of letters suggestive of femininity.
28. The Opponent highlights the principle recognised by the Court of Justice in *Medion v Thomson*³ and subsequent case law, that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two signs - one of which has a distinctive significance which independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

The Opponent respectfully submits there is conjoining of LOVE with ELLE merely conflates the concepts of endorsement and linking with the goodwill and repute of the brand, ELLE.

29. The Opponent respectfully submits that the logic presented in the Applicant’s comparison of conceptual similarity is both confused and flawed. In summary, the Opponent disputes the arguments made by the Applicant.

The Opponent argues that ELLE is the dominant element of both marks leading to a finding of high similarity - aurally, visually, and conceptually.

This is especially heightened because of the high level of recognition of ELLE as a brand name among the general public in the UK, who are the average consumer of the goods at hand.

It is evident, as the Applicant admits, that ELLE has a meaning which would be clearly understood to be a common French word by a high proportion of the relevant population. If there is any understandable semantic content, full or partial, then there is clearly a **medium to high level of conceptual similarity**.

Even if ‘ELLE’ was not understood as a word, ELLE would at least be recognised as a household name and a popular fashion, personal hygiene and homeware brand. In this event, this would also lead to a finding of a degree of **medium conceptual similarity** between the marks.

55. First, I reject the opponent’s submission that *“it is evidence as the applicant admits that ELLE has a meaning which would be clearly understood to be a common French word by a high proportion of the relevant population.”* As I have said, the applicant did not make such admission and there is no evidence that most UK consumers speak French or understand the meaning of the word ELLE in French.

56. Second, I have already said that the principle set out in *Medion* does not apply to the present case. LOVELLE is not a composite mark consisting of two signs, one of which has a distinctive significance independent of the significance of the whole. This

is not simply because it is a single word. Rather, this is a case of a single sign into which the letters ELLE have been subsumed to form a new word in such a way that the independent distinctive role of the earlier mark is removed in the applicant's mark. Consequently, the letters ELLE are an inseparable part of the word LOVELLE and will not be perceived separately. This means that whatever is the meaning that consumers will attribute to the earlier mark ELLE, it does not belong to the applicant's mark. The only concept which the mark LOVELLE will convey is that of an invented word which incorporates the word LOVE and adds the ending -LLE to it.

57. Insofar as the applicant's mark will convey the concept of LOVE, that concept has no counterpart in the opponent's mark. The earlier mark ELLE could be perceived either as the French pronoun 'she' (although there is no evidence of it), or as the name of a magazine (although the association with the ELLE magazines is unlikely to be brought to mind in the context of the goods at issue) or as a girl's name. The marks are conceptually different.

Distinctive character of earlier mark

58. 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).”

59. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

60. The applicant states that *“the distinctiveness of the earlier mark must be seen as average”*. The opponent states that *“the extensive reputation acquired by the ELLE brand may even mean that the level of distinctiveness is higher than average”*. Whilst the opponent might have a reputation in relation to magazines, these goods are not relied upon under Section 5(2)(b), so I am not even sure that the opponent can rely on that reputation for the purpose of its objection under Section 5(2)(b). The goods in relation to which the first and the second marks - which are the only marks relied upon under Section 5(2)(b) - have been used are not goods in relation to which the opponent has acquired a reputation (and nor are they closely similar to such goods). A similar point was addressed by Ian Purvis, QC sitting as the Appointed Person in BL-O- 16-10, where he stated:

“It seems to me that any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used. Particularly with marks which are not fanciful or invented words, the “trigger” which creates an association in the mind of the public between a mark and its proprietor is not simply familiarity with the mark, but familiarity with the mark in a particular context. Here the public have become used to seeing the word DOVE as a trade mark in the particular context of soap, deodorants, shampoos etc. – what Mr Malinicz calls “fast moving consumer products” - not

in the context of perfumes. Inherently, therefore, they are much less likely to see a connection with the DOVE mark when they see a similar mark being used as the name of a perfume than when they see it being used as the name of (for example) a bar of soap”.

61. In this case although the opponent has used the second earlier mark in relation to, *inter alia*, identical goods in class 8, the level of use shown is not sufficient to have enhanced the distinctive character of the mark in the context of these goods.

62. As regards the use shown in relation to magazines, given the different nature of magazines compared to the relevant goods in class 8, any enhanced distinctiveness the mark ELLE might have acquired as a result of use in relation to magazines, is not going to increase the likelihood of confusion in relation to the relevant goods in class 8.

63. From an inherent perspective, the earlier mark consists of the word ELLE. The mark is neither directly descriptive nor allusive of the goods, nor is it an invented word so, it has a medium degree of distinctiveness.

Likelihood of confusion

64. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

65. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

66. Earlier in this decision I have found that the competing marks are visually and aurally similar to a low degree and conceptually different. The goods are identical. The average consumer is a member of the general public who will select the goods visually with a medium degree of attention, although I do not discount aural considerations.

67. The opponent argues that there is a likelihood of both direct and indirect confusion.

68. Taking all of the factors listed above into account, in particular the differences between the marks, I am satisfied that they maintain the necessary distance so that there is no likelihood of direct confusion although the goods at issue are identical. Even allowing for the principle of imperfect recollection, the differences between the marks are too striking to result in consumers mistaking one mark for the other especially given that the identical letters -ELLE are placed at the end of the applicant’s mark. There is no likelihood of direct confusion,

69. As regards indirect confusion, the opponent submits that *“the mark LOVE-ELLE triggers an association in the mind of the average consumer, who will remember the brand ELLE; and creates an overall impression that ELLE loves or endorses particular items, or it is provided from ELLE with love. The “LOVE/LOV” element clearly fall squarely into the reasoning of the Proaura case”*.

70. The opponent also produced, in its submissions in lieu, the following table referring to previous UKIPO decisions as examples of cases in which there has been found to be a likelihood of indirect confusion *“where an additional non-distinctive/low in distinctiveness element has been added to the mark”*:

Case Ref	Earlier Mark	Refused Applied for Mark
O/336/21	KICK	WOOLKICK
O/071/20	SUGAR ZERO	ZERO
O/049/20	BAY	GAMERSBAY
O/286/16	CHOO	DEAR CHOO
O/393/12	LICK	BIG LICKS
O/284/12	RUSH	PURE RUSH
O/055/11	BOSS	MOST BOSS

71. First, if the opponent wished to rely on these decisions, it should have filed them as evidence during the evidence rounds. Second, it is implicit that the opponent bases the analogy with the cases listed in the tables on the argument that the average consumer will recognise the element ELLE as playing an independent distinctive role within the mark LOVELLE, an argument which I have already rejected. Consequently, the analogy which the opponent seeks to draw between this case and the previous UKIPO decisions is not a good one because in the former the earlier mark has no distinctive significance independent of the significance of the whole, whereas in the cases listed in the table the Hearing Officer must have found that the earlier mark retained an independent role and was not subsumed to form a new whole even when conjoined with another sign.

72. Even allowing for the earlier mark to benefit from enhanced distinctive character (which is not the case here), in my view, the average consumer is unlikely to consider the applicant's mark to be another brand owned by the opponent. This is because the marks at issue produce a significantly different overall impression and, in the applicant's mark the letters ELLE cannot be disassociated from the word LOVELLE they form part of. Consequently, there is not common shared independent element that could justify a finding of indirect confusion.

73. There is no likelihood of confusion. The opposition under Section 5(2)(b) fails.

Section 5(3)

74. Section 5(3) 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”.

75. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

76. 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* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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 Saloman*, 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* and *Environmental Manufacturing, paragraph 34*.

(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 of 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*).

Reputation

77. 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.”

78. The opponent's case under Section 5(3) is as follows:

“The opponent's earlier marks have established a reputation as a young, trendy and glamorous brand with respect to a broad variety of consumers products,

ranging from apparel to personal care items to homewares. The opponent's arguments include that it would be unfair for the applicant to take advantage of or benefit from its hard-earned reputation, as consumers may purchase goods or services from the applicant on the basis of the reputation of the earlier marks brought to mind. Furthermore, the opponent argued, if the quality of the goods provided by the applicant are poor, the use of the subject application could result in detriment to the distinctive character or repute of the opponent's earlier marks, which would likely result in a change in economic behaviour of the average consumer"

79. Under this ground the opponent relies on the third and the fourth earlier mark and claims reputation in relation to various publishing services in class 41 and printed matter and periodicals in class 16.

80. The relevant date to assess whether the opponent has a reputation is the filing date of the contested application, namely 06 April 2021.

81. The evidence shows that the opponent has extensively used the earlier marks in relation to a magazine called ELLE. Originally founded in France in 1945, the ELLE magazine was launched in the UK in 1985. The magazine has been published under licence from the opponent by National Magazine Company Limited. Circulation figures for various 6-month period in 2015, 2016, 2017, 2018 and 2019 show that the ELLE magazine had a monthly distribution of over 150k printed copies whilst readership figures ranged between over 700k (2015) to over 1 million readers per month (2019). These are very significant figures as shown by the comparison with other well-known magazines published by the opponent's competitors.²

82. The figures relating to the online/digital publishing also show a significant level of use with 4.6 million visitors to the ELLE website in 2020 alone.

² MC3

83. The opponent's licensee also operates various social media pages dedicated to ELLE magazine as well as other ELLE derived publications, including ELLE DECORATION, with over 7 million UK followers.

84. The opponent referred, in its submissions in lieu, to other UKIPO decisions in which the opponent has been found to have a reputation in relation to the same goods and services relied upon in these proceedings. I do not find this surprising, but even based only on the material filed in these proceedings, there is plenty of evidence which supports the opponent's claim to reputation.

85. I am therefore satisfied that the earlier marks had a substantial reputation in the UK at the relevant date. A reputation in the UK also constitutes a reputation in the EU (which is relevant in relation to the fourth earlier mark). The reputation of the earlier marks was primarily in relation to periodicals in class 16. However, it also extended to the closely related publishing services in class 41.

Link

86. As noted above, 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.

Although the third and fourth earlier marks present a degree of stylisation, it is minimal, and does not make any material difference compared to my previous assessment of the similarity between the applicant's mark and the word mark ELLE. The marks are visually and aurally similar to a low degree, and conceptually different.

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.

The applicant's goods in class 8 and the opponent's services in class 41 and goods in class 16 have nothing in common. The users, uses, nature, purpose and methods of use of the goods and services are different, the trade channels do not coincide, and the goods and services are neither complementary nor in competition. The competing goods and services are therefore dissimilar. Although Mr Carver filed evidence of articles by third party publishers of magazines about homeware products this does not support a finding that the goods and services are similar.

The strength of the earlier mark's reputation.

I have concluded that the opponent's evidence establishes that the earlier marks had a substantial reputation in the UK at the relevant date.

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

The earlier mark has a medium degree of distinctive character. However, the evidence shows that it had acquired a highly distinctive character through use by the relevant date in relation to relevant the goods/services in classes 16 and 41.

Whether there is a likelihood of confusion.

Earlier in this decision, I found that there is no likelihood of confusion between the applicant's mark LOVELLE and the earlier word-only mark ELLE, even where identical goods are involved. The position for the opponent is even worse in relation to the third and fourth earlier mark because the goods and services relied upon under these marks are dissimilar, and it is trite law that some similarity of goods and services is essential for a finding of likelihood of confusion.³

87. The opponent argues that, even if there is no confusion, the reputation of the earlier mark is such that average consumers will make a link between the marks. This is on the basis that the dominant element of the applicant's mark aurally, visually and

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

conceptually is ELLE. I have already rejected that submission under Section 5(2)(b). For the same reasons, I reject the submission again in the context of the opponent's claim under Section 5(3).

88. While the reputation of the earlier mark is a factor in favour of establishing a link between the marks in the average consumer's mind, the distance between the marks and the goods and services is so great that makes it unlikely that the public will make any link between the marks. Although, for the purposes of Section 5(3), there is no requirement that a likelihood of confusion be established nor that the goods and services be similar, these factors must be taken into account in establishing a link.

89. Having considered all of the above, my conclusion is that notwithstanding the strength of the reputation of the earlier marks, the coincidence of the letters E-L-L-E in the mark LOVELLE is not capable of creating any link between the marks in the mind of the consumers. In the absence of a link, there can be no damage.

90. The ground based on Section 5(3) is also rejected.

OUTCOME

91. The opposition fails under both grounds and the contested mark will proceed to registration.

COSTS

92. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the applicant the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing and filing a TM8 and counterstatement:	£300
Considering the other party's evidence:	£500
Total	£800

93. I therefore order HACHETTE FILIPACCHI PRESSE to pay SHENZHEN SHIJIDAFEI TECHNOLOGY CO., LTD the sum of £800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 19th day of July 2022

**Teresa Perks
For the Registrar**