

O-141-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2505808

BY

ELLA SHOES LIMITED

TO REGISTER THE TRADE MARK:

ELLA

IN CLASS 25

AND

THE OPPOSITION THERETO

UNDER NO 98970

BY

HACHETTE FILIPACCHI PRESSE

Trade Marks Act 1994

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1) On 6 January 2009 Ella Shoes Limited (ESL) filed an application for the registration of the trade mark **ELLA** (the trade mark). The trade mark was published in the *Trade Marks Journal*, for opposition purposes, on 20 February 2009 with the following specification:

footwear.

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 20 April 2009 Hachette Filipacchi Presse (Hachette) filed a notice of opposition to the registration of the trade mark. Hachette relies upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

3) Section 5(2)(b) of the Act states:

“(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.”

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 Community trade mark or international trade mark (EC) in the European Community) 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.”

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

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

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

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

4) In relation to section 5(2)(b) of the Act Hachette relies upon the following trade mark registrations:

International registration no 546813 of the trade mark ELLE. The request for protection in the United Kingdom was made on 17 December 2004. The registration was published for opposition purposes on 15 April 2005. There being no opposition to the granting of protection, the trade mark was protected from 16 July 2005. It is protected in respect of the following goods:

textiles and textile goods not included in other classes; bed and table covers, textile fabrics, blankets, eiderdowns, sheets, eiderdown cases, pillow cases,

table linen, tablecloths, household linen, toilet and bathroom linen, linen made of toweling and beach towels of toweling, handkerchiefs, napkins for removing make-up, mosquito nets;

clothing, particularly trousers, knickerbockers, shorts, undershorts, combinations, shirts, chemisettes, T-shirts, pullovers, sweaters, knitwear, vests, jackets, raincoats, anoraks, coats, overcoats, pelerines, skirts, dresses, blouses, tracksuits, clothing of fur, scarves, shawls, sashes for wear, sports clothing, gloves, dressing gowns, suspenders, belts, neckties, shoes, boots, slippers, sandals, shoes for sports, hats, caps, berets, cap peaks, with the exception of socks, stockings and tights;

lace and embroidery, ribbons and braids including bows for the hair, headbands, scrunchies, bows, chignon frames, elastic hair bands; buttons, hooks and eyelets, pins and needles including hair pins and grips, hair slides (hair clips), forks, hair picks, pins and needles used for keeping hair in place and hair styling (hair curlers and hair curling papers); artificial flowers and plants.

The above goods are in classes 24, 25 and 26 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

United Kingdom registration no 1576959 of the trade mark ELLE. The application for registration was made on 2 July 1994 and the registration procedure was completed on 12 April 1996. Consequently, the registration is subject to proof of genuine use¹ for the period from 21 February 2004 to 20 February 2009. ESL has required proof of use of the trade mark in respect of all of the goods for which it is registered, namely:

shoes; all included in class 25.

United Kingdom registration no 1072225 of the trade mark ELLE. The application for registration was made on 20 December 1976. The registration is subject to proof of genuine use for the period from 21 February 2004 to 20 February 2009. ESL has required proof of use of the trade mark in respect of all of the goods for which it is registered, namely:

outer clothing for women, but not including stockings, body stockings, tights or swimwear. CANCELLED IN RESPECT OF : Socks.

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

5) In relation to section 5(3) of the Act Hachette relies upon the three trade mark registrations in paragraph 4 and upon United Kingdom registration no 1145485 of the trade mark:

ELLE

The application for registration was made on 11 December 1980. The registration is subject to proof of genuine use for the period from 21 February 2004 to 20 February 2009. ESL has required proof of use of the trade mark in respect of all of the goods for which it is registered, namely:

periodical publications relating to women.

The above goods are in class 16 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

6) Hachette claims to have a reputation in respect of all of the goods for which its trade marks are registered. It claims to have used the trade marks for all of the goods for which the trade marks, which are subject to the proof of use requirement, are registered.

7) Under section 5(4)(a) of the Act Hachette claims to have used the trade mark ELLE in the United Kingdom from 1985. It claims that the trade mark has been used in relation to all of the goods of the international registration and magazines.

8) Hachette states that it has used the trade mark ELLE in the United Kingdom in relation to magazines on a massive scale since its launch on the United Kingdom market in 1985. It claims that the magazine has acquired a substantial goodwill and reputation. Hachette states that for many years it has sold merchandise in the United Kingdom under the trade mark ELLE. Hachette states that the merchandise includes clothing and footwear which has been sold through its magazine, mail order, retail shops and from its website, which was launched in 1995. Hachette claims that there is a strong association and economic link between footwear and a fashion magazine. It claims that this association and link is emphasised (sic) by the fact that fashion magazines often sell fashion goods, such as clothing, footwear and accessories, under the same trade mark used by the magazine to “maximise the commercial opportunities under the trade mark”. Hachette claims that unfair advantage will occur as a result of the feeding on the fame of the earlier trade mark to increase the “marketability” of ESL’s footwear provided under the trade mark ELLA. Hachette also claims that use of the trade mark ELLA would tarnish the reputation of the earlier trade mark or

dilute the distinctiveness of the trade mark. Hachette states that it will provide evidence that the trade mark ELLE has a substantial goodwill and reputation as a result of continuous sales throughout the United Kingdom of magazines, clothing, footwear and fashion accessories. Hachette claims that the use of ELLA on footwear constitutes a misrepresentation which is likely to damage its business. Consequently, use of the trade mark is liable to be prevented under the law of passing-off. Hachette claims that the trade mark ELLE has achieved such a high recognition in the United Kingdom in relation to magazines, footwear, clothing and fashion accessories that it is a well-known trade mark under the provisions of section 6(1)(c) of the Act. Hachette states that ELLE has been recognised as a well-known trade mark by the courts, including the High Court. It claims that owing to the close similarity of the trade marks ELLE and ELLA, the registration of the trade mark would be contrary to sections 5(2) and 5(3) of the Act.

9) ESL filed a counterstatement. It requires proof of use of all of the earlier trade mark registrations upon which Hachette relies in respect of all of the goods. However, the international registration is not subject to the proof of use requirement.

10) ESL accepts that footwear is identical to shoes, boots, slippers, sandals, shoes for sport of the international registration and shoes in registration no 1578959. ESL denies that outer clothing for women, as per registration no 1072225, covers footwear. ESL puts Hachette to proof as to its claims to reputation. It denies that registration of its trade mark would be contrary to sections 5(2)(b), 5(3) and 5(4)(a) of the Act. ESL denies that there is a strong association and economic link between footwear and fashion magazines. It denies that ELLE is a well-known trade mark. ESL denies that the trade mark and the trade marks of Hachette are similar. It states, inter alia, that ELLE is the French for she, while ELLA is a girl's name. Consequently, the perception of the two trade marks will be different. If ELLE is also considered to be a girl's name, then the similarity must be considered on the basis of the consumer's ability to distinguish between two different names. ESL states that Hachette is known in the publishing sector, in particular for women's magazines. It is ESL's opinion that Hachette is not well-known in relation to clothing, footwear or other fashion goods and does not have a reputation in respect of these goods in the United Kingdom. A search of the elleuk.com website for clothing and footwear returned no hits. ESL states that the only ELLE branded products that it found were 16 items of jewellery. ESL states that it has used the trade mark in the United Kingdom in relation to footwear for women since 2002, when it was incorporated. The approximate turnover for goods sold under the ELLA trade mark in the United Kingdom since 2002 is around £12 million. ESL states that during this time it has not become aware of any instances of confusion with any products sold under the ELLE trade mark. ESL claims that it is highly unusual for a magazine to sell goods such as clothing or footwear under the same trade mark as that of the magazine. ESL requests that the opposition is rejected.

11) Both parties filed evidence.

12) A hearing was held on 6 April 2011. ESL was represented by Mr Guy Tritton of counsel, instructed by Dummett Copp LLP. Hachette was represented by Ms Madeleine Heal of counsel, instructed by Keltie.

EVIDENCE FOR HACHETTE

Witness statement of Fabienne Sultan of 10 December 2009

13) Ms Sultan is the head of the intellectual property department of Hachette. Ms Sultan exhibits a copy of a witness statement which she made in relation to another opposition on 22 January 2004.

14) Ms Sultan states that the fame of the trade mark ELLE was recognised in a substantial part of the European Union by a decision of the Opposition Division of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) dated 27 April 2007 under no B 841870. She states that the reputation was recognised by the 1st Chamber of the Board of Appeal in a decision dated 11 November 2009. An uncertified partial translation of the decision of the board of appeal is exhibited. The reputation is recognised as being for a magazine. There is reference to ELLE being a well-known trade mark in the magazine sector in France and a considerable part of the European Union. There is no reference to the position in the United Kingdom. The decision of the Opposition Division relates to the reputation of the magazine ELLE in “French territory but, to a lesser extent, also in the rest of European Community”.

15) Ms Sultan states that in 2006 the United Kingdom edition of the ELLE magazine received the ACE Silver Circulation Excellence and Endeavour by a Major Magazine in 2006. In 2008 the magazine received five awards: PPA Best Designed Front Cover [MD&JA], PPA Best New Design/Redesign [MD&JA], PPA Art Director of the Year, PPA Customer Direct Marketing Team Award, PPA Customer Direct Off-Page Promotion Award. Ms Sultan states that in 2009 the magazine won the PPA Designer of the Year award.

16) Ms Sultan states that the magazine organises fashion competitions and style awards regularly in conjunction with major advertisers and operators in the fashion field such as H&M.

17) Exhibited at FS1 to Ms Sultan’s statement is a large amount of material.

- At 2.01 there are newsstand circulation figures for the ELLE magazine in “England” for the years 1999 to 2007. At the lowest the figures are 184,000 (2003 and 2007) and at the highest 218,000 (2000). There are also subscription figures for “England”. At the lowest the figure is 3,000 (2003) and at the highest 15,000 (2007).

- At 2.02 a circulation figure of 195,114 is given for July to December 2008, with a readership figure of 791,000 for October 2007 to September 2008. Details of ELLE DECORATION are also given. This is described as a style magazine for the home. For July to December 2008 a circulation figure of 62,027 is given and a readership figure for January to December 2007, of 201,000.
- At 2.03 there is a certificate of circulation from ABC given for 1 July 2003 to 31 December 2003. The figures combine the United Kingdom with the Republic of Ireland. 2.04 consists of figures relating to the export of the United Kingdom edition of ELLE for 2008. 2.05 consists of figures relating to the export of the French edition of ELLE. 2.07 consists of figures for readership of magazines for women from 1996 to 2009. The highest readership figure is 938,000 for 1996 and the lowest 695,000 for July 2005 to June 2006.
- 2.09 is described as being the market share for clothing. However, there is no explanation as to what the figures relate and the percentage figures appear to relate to drops in sales. The figures relate to magazines for women rather than clothing undertakings per se. The rubric describing the figures:

“Including – Display, Advertorial, Excluding Review Ads”

indicates that the figures do not relate to sales of clothing but to the advertising of clothing and accessories.

- At 2.10 are copies of pages from ELLE magazine for December 2006 and October 2006, the latter is promoted as celebrating the 21st birthday of the magazine.
- At 2.11 are copies of pages from a publication from 1996 which has listed what the publication considers the 300 most powerful brands in Europe, ELLE appears at 224.
- At 2.12 are lists of ELLE websites. The site for the United Kingdom is identified as elleuk.com. There were 371,000 and 399,000 unique visitors for November and December 2008 respectively for the United Kingdom site.
- At 2.13 is a list of what are described as “Websites dedicated to ELLE collections”.
- A copy of material from a convention held on 20 June 2000 is exhibited, this is included in and dealt with in relation to Ms Sultan’s witness statement of 22 January 2004.

- At 3.01.01 is a copy of a United Kingdom store check report from November 2006. Photographs of the Designer Room in Ashford, the ELLE outlet store in Ashford, TK Maxx in Ashford, the Designer Room in Braintree, ELLE outlet store in Braintree, Boundary Mills in Romford and TK Maxx in Romford are shown in the report. They show the outsides and insides of stores, use of the ELLE trade mark can be seen in relation to a variety of clothing for women.
- 3.01.02 appears to be material from a presentation headed “2006 retail operations – UK”. Two licensees, L-Wear and CWF, are listed who have a presence in House of Fraser stores, John Lewis stores, Beatties, Army & Navy, Binns and Rackhams. The exhibit includes pictures of ELLE stores in Croydon, Birmingham and Norwich and a concession in Alders. Women’s clothing can be seen in the photographs.
- 3.2 is a list of licence agreements as of 1 March 2009. The ones that specifically identify the United Kingdom are HFP UK Ltd (for a car), Kamani Design Ltd (for women’s technical sportswear and sports accessories), The License Factory Ltd for umbrellas and luggage and Zap Ltd (for bed linen and towels).
- 3.3 consists of copies of advertisements from ELLE (French edition) from 2003 advertising various clothing products. This material is also included in the first statement of Ms Sultan, with which copies of orders are also included; this is referred to below.
- 3.4 consists of material that is included with the first statement of Ms Sultan and is dealt with below.
- 3.5 consists of a Prêt-à-porter accessories brochure under the ELLE name. The brochure has been produced by Hachett’s licensing department in France and appears to be aimed at businesses eg it gives circulation figures and countries where there are stores.
- 3.6 – 3.8 consists of a copy of exhibits FS14 and FS18 to the first statement of Ms Sultan, which is dealt with below.
- 3.9 is a catalogue for ELLE women’s shoes for spring/summer 2008. The end of the catalogue shows that it was produced by JB Martin in France. Various countries to which exports are made are listed, the United Kingdom is not one of them.
- 3.10.1, 3.10.2 and 3.10.3 consist of catalogues for ELLE children’s wear for fall/winter 2008, spring/summer 2009 and fall/winter 2009/2010. The catalogues are multi-lingual. The first catalogue includes a telephone

number in the United Kingdom for details of the nearest stockist of ELLE products. There are no similar details in the other two catalogues.

- 3.11 is an ELLE beachwear catalogue for spring/summer 2009. It is multi-lingual, there is no reference to the United Kingdom in the catalogue.
- 3.12 consists of copies of ELLE underwear and nightwear catalogues from 2003 to 2009. They are in English and French. The licensee are identified as Nelson IA Ltd of Nelson, Lancashire or Canat SA. (The catalogue for spring/summer 2008 is only in English.)
- The list of material identifies at 3.13 a list of agents' networks, this list is not in the evidence.
- At 3.14 is a picture of an ELLE girl's shoe. There is no indication as to where or when the shoe was sold.
- At 3.15 and 3.16 are figures relating to the advertising contributions of licensees. There is no indication as to specific figures relating to the United Kingdom.
- 3.17 is described as being copies of a selection of advertisements for ELLE Collection from 2004-2005. The September, October 2004, April and June 2005 editions of ELLE have advertisements for ELLE Prime Stores, which show, inter alia, clothing and shoes for women and girls, and a variety of ELLE products. The September 2005 issue has advertisements for ELLE which show women wearing ordinary clothing and sports clothing. The October and November 2005 issues have advertisements for ELLE which show women wearing ordinary clothing, underwear and sports clothing.
- 3.18 consists of press articles:
 - i. From *Metro* (for Glasgow) of 28 April 2005, a reference to the ELLE store in Glasgow.
 - ii. Undated printout from newwoman.co.uk showing an ELLE skirt.
 - iii. Undated printout from primamagazine.co.uk showing an ELLE bathing suit.
 - iv. Undated page from happymagazine.co.uk showing an ELLE SPORT visor.
 - v. Unattributed page from a publication of 13 June 2005. On the side of the page the reader is advised that the model is, inter alia, wearing a yellow top costing £26 from ELLE.
 - vi. Undated and unattributed page showing ELLE cropped trousers.
 - vii. Undated and unattributed page showing a vest from ELLE at £22.
 - viii. Undated and unattributed page showing a £16 vest from ELLE.

- ix. Undated and unattributed page which relates to ELLE clothing for summer 2005 and refers to kaftans, tops, shrugs and skirts.
 - x. Pages from undated *Daily Express* magazine showing camisole, shrug, dress, top, shorts, skirt, belt and cape by ELLE.
 - xi. Undated page from moremagazine.co.uk showing bikini from ELLE Sport.
 - xii. *Star* of 14 March 2005 showing cropped trousers by ELLE.
 - xiii. Undated and unattributed page showing ELLE swimsuit and bikini.
- 3.19 is a booklet for a meeting of ELLE sales and marketing in Europe on 15 April 2008. Included in the booklet is a statement that in relation to websites the next step is for ELLE to extend to Spain, the United Kingdom and Germany.
 - 3.20 consists of press coverage for ELLE style awards for 2004 - 2009. References to these awards for 2004 appear, inter alia, in ELLE magazine, *Fashion Monitor*, *Marketing*, *Daily Mirror*, *Daily Telegraph*, *Belfast Telegraph*, *Evening Standard*, *The Independent Magazine*, *Daily Record*, *South Wales Echo*, *Aberdeen Press & Journal* and *The Sun*. The other references to the awards are from ELLE magazine.
 - At 3.21.3 is material relating to a fashion competition run by ELLE and Esmod International, all of the material is in French.
 - It is stated that the documents exhibited at 3.22.1 to 3.23.10 are decisions and judgments relating to proceedings involving Hachette and its trade mark ELLE. Exhibit 3.22.1 is a decision of 11 November 2009 of a Board of Appeal OHIM. An uncertified translation of one page of the decision is given, this relates to ELLE being a well-known trade mark in France and "a considerable part of the European Union". 3.22.2 consists of an untranslated judgment of 7 November 2003 of a court in Spain. 3.22.3 consists of an untranslated judgment of the Court of Appeal of Paris of 11 September 1996. 3.22.4 consists of an untranslated judgment of 7 October 1992 of a court in Paris. 3.22.5 consists of an untranslated judgment of the Court of Appeal of Paris of 16 February 2000. 3.22.6 consists of a document that appears to be in Greek. 3.22.7 consists of an untranslated document in Portuguese. 3.22.8 consists of an untranslated document in Portuguese. 3.22.9 consists of an untranslated document in Czech. 3.22.10 consists of a decision and an uncertified translation thereof of a decision of the Romanian Office for Inventions and Trademarks of 12 October 2004. 3.22.11 consists of an uncertified translation of a decision of the National Bureau of Standards of Taiwan, no date is given and the original is not adduced. 3.22.12 consists of an untranslated decision of a decision from Costa Rica of 9 January 2009. 3.23.1 consists of a decision in French of the Opposition Division of OHIM of 27 April 2007 with a partial uncertified translation. The decision states that ELLE has a reputation for magazines in France and "to a lesser extent, also in the rest

of European Community”. 3.23.2 is the same document as exhibited at 3.22.1. 3.23.3 consists of a decision of the Patent Office of Poland of 22 April 2008 with an uncertified translation. 3.23.4 consists of two decisions under the Trade Marks Act 1938 of the Patent Office of the United Kingdom of 18 March 1999. 3.23.5 consists of an untranslated Italian judgment of 25 May 2005. 3.23.6 consists of an uncertified French translation of an Italian judgment of 23 March 2001. 3.23.7 consists of a judgment of a Dutch court of 24 May 2006 with an uncertified translation. 3.23.8 consists of an uncertified translation of a judgment of a Dutch court of 29 April 1993, the judgment has not been adduced. 3.23.9 consists of a judgment of a Dutch court of 15 December 2006 with a partial free translation in French. 3.23.10 consists of a judgment under the Trade Marks Act 1938 of the High Court of 27 October 1999. It is an appeal from the decisions adduced at 3.23.4.

Witness statement of Fabienne Sultan of 22 January 2004

18) This is a witness statement that Ms Sultan made in relation to an opposition filed by Hachette against an application made by Saprotex International (Proprietary) Limited. At the time of making the statement Ms Sultan was the deputy director of the intellectual property department of Hachette.

19) ELLE magazine was first published in France in November 1945 on a weekly basis. The French edition of the magazine was distributed and continues to be distributed in over 90 countries, including the United Kingdom, on a regular basis. Exhibited at FS2 are export sales sheets. The latest sales sheet is for December 2002 during which month 76,068 copies of the magazine were supplied to the United Kingdom, 40,011 of these were sold. At exhibit FS3 is a copy of an article from *Retail Newsagent* of 14 November 2003 which advises of the availability of “ELLE (FRENCH)”.

20) A local edition of ELLE magazine for the United Kingdom was produced in 1985. Ms Sultan states that the magazine is made to appeal to women. She states that it is primarily a fashion and lifestyle magazine with a strong focus on women’s issues, fashion goods, such as women’s clothing, shoes and fashion accessories, beauty and lifestyle themes. Ms Sultan states that the magazine is principally directed to and read by a “wide audience of all ages, urban-based, educated, career-orientated, upmarket women with significant disposable income”. Ms Sultan exhibits at FS4 a copy of Hachette’s 1998/1999 brochure entitled “ELLE THE BRAND BUSINESS 98/99”. The brochure includes references to .fr and .com ELLE websites. Pictures of ELLE branded clothing and shop are shown. In the merchandising section of the brochure there is reference to 100 licences worldwide and 250 different licensed products. Pages in the brochure relate to merchandising in the United Kingdom by DB Actif, from summer 1996, for clothing for women, Carlton/Hartstone, from spring 1997, for bags and luggage, Zeon, from spring 1998, for watches. The exhibit also

includes the copy of a price list for ELLE Active for spring/summer 1997 and a copy of a page from *Health & Fitness Magazine* for February 1999 which relates to ELLE branded gym clothing for women.

21) Ms Sultan gives worldwide sales figures for 1996 for the ELLE magazine, all editions. She does not give any figures specific to the United Kingdom.

22) Ms Sultan states that the United Kingdom edition of the ELLE magazine has had an average monthly circulation in recent years of 200,912. Exhibited at FS6 are the results of the audit of distribution of the United Kingdom edition of ELLE for 1996 – 2003. The figures show a circulation of 200,192 for the period 1 January 2003 to 30 June 2003. The figure for 1 January 1996 to 30 June 1996 was 191,243. All the figures after this period are over 200,000. Exhibited at FS7 are copies of press articles in relation to the eighteenth anniversary of the United Kingdom edition.

23. Ms Sultan states that the United Kingdom edition of ELLE has regularly offered for sale ELLE branded clothing, footwear and headgear through a market section featured in the magazine. Exhibited at FS8 are computerised lists of offers for sale through the United Kingdom edition of ELLE magazine. The list begins on 1 November 1985 and ends on 1 June 1995, it includes items of clothing and footwear.

24) Ms Sultan states that sales of products have been ordered from the French edition of ELLE magazine by readers in the United Kingdom. She exhibits at FS9 copies of advertisements with the corresponding orders placed by United Kingdom customers. Certain of the products appear to be being sold by reference to other trade marks, the magazine simply offering the products to its readers. These include boots by Aigle, a jumper by Armor Lux, shoes by Repetto and trousers by René Derby. Other products can be seen bearing ELLE as a trade mark eg t-shirts.

25) Ms Sultan states that sales through mail order in “more recent years” has been organised through United Kingdom mail order catalogues such as Freemans, Littlewoods Home Shopping, Grattan and Texplant. Exhibited at FS10 are extracts of advertisements of ELLE branded clothing under licence as featured in the United Kingdom mail order catalogues and the computerised printout of the audited sales by UK licensee Actif Group PLC for the year 2001, totalling £1,121,501.74. The extracts include some in German. The goods shown in the catalogues, in English, are all for females and are: sweatshirts, t-shirts, trousers, bras, briefs, jackets, sweaters, dresses, tops, jeans, cardigans, swimsuits and sweat pants. Turnover for the year 2002 is shown as having been £609,229.34.

26) Ms Sultan states that in November 1995 Hachette launched its website, elle.com, which can be accessed from the United Kingdom. She states that the

website features ELLE branded clothing, footwear and headgear which is advertised for sale with a possibility of purchasing the goods electronically. FS11 shows printouts from the website elle.com, elleshop.com and ellemag.com; where prices appear they are in French francs or dollars. The elle.com website bears the rubric "2003 Hachette Filipacchi Media U.S.". Exhibited at FS12 is material given at a convention for ELLE Creation on 20 June 2000. The convention included presentations made by licensees: DBA, Charmant, Fashion Line, CWF and Zoom. These licensees supply day wear, sportswear, nightwear, underwear, swimwear, eyewear, children's wear.

27) Ms Sultan states that ELLE branded goods are also the subject of a wide scale merchandising programme in the United Kingdom which was launched in 1996 following the appointment of London based Actif Group PLC as exclusive licensee for ELLE active wear in March 1996. Exhibited at FS13 is a copy of *European Licensing Guide 2003*.

28) Actif Group handles retail activity under the ELLE name in the United Kingdom. As well as mail order catalogues the network of sales includes department stores such as Debenhams, John Lewis and Bentalls and concessions in House of Fraser and a shop in Harrods. ELLE branded clothing, footwear and headgear is also commercialised through nine ELLE boutiques at the following locations: Bluewater, Gateshead, Leeds, Milton Keynes, Southampton, Trafford, Reading and Sheffield. Exhibited at FS14 are a number of catalogues:

- Autumn/winter 1998 for active wear, sportswear, swimwear, sleepwear and underwear.
- Spring/summer 2000 for sportswear and swimwear.
- Spring/summer 2000 for underwear and nightwear.
- Spring/summer 2001 for underwear and nightwear.
- Spring/summer 2001 for day wear.
- Spring/summer 2001 for sportswear.
- Autumn/winter 2000/2001 for active wear, sportswear, underwear and nightwear.
- Autumn/winter 2000/2001 for underwear and nightwear.
- Autumn/winter 2000/2001 for sportswear and swimwear.
- Spring/summer 2004 for sportswear.
- Spring/summer 2004 for nightwear.
- Spring/summer 2004 for sportswear (this also includes swimwear).

All of the clothing shown is for women.

29) ELLE stores have also been opened at factory outlets at Bicester, Braintree, Bridgend, Castleford, Cheshire, Oaks Street and Whiteley.

30) Ms Sultan states that she has been told that retail sales by Actif Group for 2001 in the United Kingdom were as follows:

ELLE boutiques	£3,948,024
Factory Outlets	£3,548,126
Concessions	£5,915,714

31) Ms Sultan states that wholesale figures made by Actif Group in the United Kingdom in 2001 amounted to £5,240,641.

32) Ms Sultan states that Actif Group also exports ELLE branded active wear to several countries and has participated in trade and consumer exhibitions in the United Kingdom. Exhibited at FS15 is a computerised printout of exports of Actif Group for the year ending 2001. Total sales of clothing amounted to 7,607,342 wholesale; it is presumed that this figure is in pounds sterling. Ms Sultan states that the advertising expenditure of Actif Group in 2001/2002 was £15,000.

33) Ms Sultan states that the other exclusive licensees for clothing, footwear and headgear are CWF, ID Line, Nelson and Canat. She states that CWF, the exclusive licensee for children's clothing in the United Kingdom, sells its ELLE branded clothing through Actif Group's sales network and independent retailers. Ms Sultan states that sales of ELLE branded children's clothing in 2001 totalled some €4,429,730. Exhibited at FS16 is a computerised printout of the sales made by CWF for the first and second quarters of 2003 and copies of CWF catalogues for spring/summer 2001 and autumn/winter 2002. All of the clothing is for female children. The sales for the first and second quarters of 2003 were €1,375,246.29 and €539,632.54 respectively.

34) In relation to the commercialisation of the ELLE underwear collection in the United Kingdom by the exclusive licensee, Nelson, exhibited at FS17 is a catalogue for spring/summer 2004 for underwear for women and a computerised printout of the sales for the first, second and third quarters of 2003. Units of underwear exported to the United Kingdom were 12,528, 1,476 and 10,807 for the first three quarters of 2003 respectively.

35) Included in exhibit FS18 are catalogues for shoes for women and girls for fall/winter 2003, spring/summer 2003, spring/summer 2002, autumn/winter 2001 and autumn/winter 2002. The sole contact details given on the catalogues is ID Line, with an address in France. Also included in the exhibit is a computerised printout of sales made in the United Kingdom by the exclusive licensee ID Line for the period 1 January 2002 to 31 December 2002. 3,760 pairs of shoes for women were supplied to the United Kingdom and 3228 pairs of shoes for children. Also included in the exhibit are figure for sales of shoes for women in 2001, which amounted to 34,640 pairs.

36) Exhibited at FS19 are copies of knitting patterns which appeared in the United Kingdom edition of ELLE between 1986 and 1993. Exhibited at FS20 are copies of knitting patterns which appeared in the French edition of ELLE between 1975 and 1993.

EVIDENCE FOR ESL

37) This consists of a witness statement, dated 10 September 2010, made by John Smith. Mr Smith is the owner of ESL.

38) ESL has used the trade mark ELLA in relation to footwear for women and girls in the United Kingdom since 1 June 2002, when ESL began trading. ESL has sold ELLA footwear to the Netherlands, Spain, Denmark, Cyprus and Ireland, although the majority of products are sold in the United Kingdom. ESL only sells footwear for women and girls and all products are sold under the ELLA trade mark. The name ELLA was chosen as the trade mark because this was the name of his daughter. ELLA footwear is sold wholesale to retailers. The retailers are predominantly independent retail outlets or small chains of retail outlets.

39) Exhibit 1 consists of a copy of an ELLA catalogue which is sent out to retailers. The catalogue is from 2007/2008. At the top of each page "Ella Shoes" is printed. A variety of shoes for women and girls are shown. On pages 12, 13, 16 and 17 ELLA can be seen written upon the insole of the shoes.

40) Exhibit 2 consists of a number of photographs:

- A shoe box bearing the name ELLA SHOES.
- The insole of a woman's shoe bearing the name ELLASHOES.
- A shoe box bearing the name ELLA SHOES.
- The old company sign outside the office in Romford, bearing the name ELLA SHOES.
- Boots bearing the italicised name ELLA on the heels.
- The new company sign outside the office in Romford, bearing the italicised name ELLA with SHOES appearing to the right in smaller print in upper case.
- A shoe box bearing the italicised name ELLA.

The plain text version of ELLA has gradually been replaced, since 2006, by "the new "curly" stylised version of the ELLA trade mark".

41) Exhibit 3 consists of a printout from Companies House and the certificate of incorporation. These show that the company was incorporated on 3 May 2002.

42) ESL has a website which can be found at ellashoes.co.uk and ellashoes.com. ESL has owned the websites since March 2003 and the website

has been live at these domain names since November 2007. Printouts from WHOIS are to be found at exhibit 4 in relation to these domain names. At exhibit 5 are pages from archive.org which show the domain name ellashoes.com was live on 23 November 2007. Exhibit 6 consists of printouts from ellashoes.com and ellashoes.co.uk downloaded on 8 September 2010. Page 1 shows italicised ELLA. Page 2 shows the banner ELLA italicised, underneath of which SHOES LTD appears. The page welcomes the visitor to the "Ella Shoes Website" and advises that the footwear is only available through wholesale. On pages 10 and 11 of the exhibit ELLA italicised can be seen on the outside sole of a boot.

43) Exhibit 7 consists of a sample of invoices from 20 June 2003 and 5 July 2010. The invoices show goods sent to the following locations:

Chatham, West Thurrock, Orpington, Peckham, Bolton, Walsall, Stratford, East Ham, London, Croydon, Eltham, Hounslow, Braintree, Colchester, Hayes, Gosport, South Ockendon, Sittingbourne, Brighton, Kingston-upon-Thames, Bexley Heath, Bude, Sidcup, Rogiet, Liverpool, Bognor Regis, Nottingham, Manchester, Paisley, Birmingham, Daventry, Windsor, Swansea, Dereham, Sittingbourne, Cheltenham, Sunderland, Nottingham, Herne Bay, Dagenham, Dalston, Warrington, Harlow, Nantwich, Burnley, West Wickham, Corby, Trowbridge, Daventry, Gorleston, South Woodham Ferriers, Sheerness, West Wickham, Swanley, Navestock, Bishops Stortford and Tilbury.

44) ELLA footwear is promoted at various trade exhibitions. ESL has attended the following shows:

The London Shoe Show 23-25 March 2003.
Footwear UK 10-12 August 2003.
Blackpool Shoe Fayre 9-12 January 2004.
Footwear UK 15-17 February 2004.
Footwear UK 8-10 August 2004.
Blackpool Shoe Fayre 14-17 January 2005.
Footwear UK 20-22 February 2005.
Footwear London 3-5 April 2005.
Footwear UK 7-9 August 2005.
Footwear London 2-4 October 2005.
Blackpool Shoe Fayre 13-16 January 2006.
Moda Footwear 13-21 February 2006.
Footwear London 2-4 April 2006.
Moda Footwear 6-8 August 2006.
Moda Footwear 18-20 February 2007.
Moda Footwear 12-14 August 2007.
Moda Footwear 17-19 February 2008.
Moda Footwear 10-12 August 2008.
GDS International Shoe Fair 12-14 September 2008.
Moda Footwear February 2009.

Pure London August 2009.
Moda Footwear 9-11 August 2009.
Pure London February 2010.
Moda Footwear 21-23 February 2010.
Pure London 1-3 August 2010.
Moda Footwear 8-10 August 2010.

45) Exhibit 9 includes a page downloaded from the Moda website. The exhibition is described as:

“The largest gathering of footwear brands seen anywhere in the UK can once again be found at Moda Footwear.”

Included in the exhibit is a press release, dated 4 June 2010, from the organisers of the exhibition which states that the February exhibition played host to over 1,400 brands and attracted over 12,000 visitors. 86% of visitors were buyers and 95% of visitors had some or sole buying responsibility. Mr Smith notes that “the ELLE trade mark is not listed on any of the Exhibitor Lists or found on any of the Exhibition Plans included in Exhibit 9”.

46) Turnover of goods sold under the ELLA trade mark is as follows:

June 2002 to May 2003	£215,154
June 2003 to May 2004	£1,599,012
June 2004 to May 2005	£2,315,254
June 2005 to May 2006	£2,063,959
June 2006 to May 2007	£2,348,667
June 2007 to May 2008	£3,172,510
June 2008 to May 2009	£2,678,662
June 2009 to May 2010	£3,940,782

The turnover figures relate to sales of between 3.4 and 3.6 million pairs of shoes. The sales correspond to retail values of approximately £73.3 million in the United Kingdom and the European Union. The figures from June 2002 to May 2005 relate to sales in the United Kingdom only. At Exhibit 10 are copies of the profit and loss account for ESL for the periods ending 31 May 2003, 31 May 2005 (which also includes the figures for 2004), 31 May 2006, 31 May 2007, 31 May 2009 (which also includes the figures for 2008) and 31 May 2010.

47) Mr Smith states that “[a]lthough the vast majority of our sales are made into the United Kingdom, in recent years we have made some sales into the rest of Europe”. The total sales to other European Union countries was as follows:

2006	£323,001
2007	£541,845
2008	£448,400

2009 £1,138,816
2010 £1,111,372

Sales in respect of the United Kingdom only from June 2005 onwards were as follows:

June 2005 to May 2006	£1,740,958
June 2006 to May 2007	£1,806,822
June 2007 to May 2008	£2,724,110
June 2008 to May 2009	£1,539,806
June 2009 to May 2010	£2,829,410

Mr Smith states that the sales in the United Kingdom only amounted approximately to 3 million pairs of shoes, boots or sandals which would equate to about £59 million in terms of retail value.

48) Mr Smith states that he is not aware of any instances of confusion having occurred between the ELLA and ELLE trade marks since ESL began selling footwear in 2002.

PRELIMINARY MATTERS

49) At the hearing Ms Heal agreed that Hachette was in no better position in relation to section 5(4)(a) of the Act than it was in relation to section 5(2)(b) of the Act. If it fails in relation to the latter, it will fail in relation to the former; consequently, it is not necessary to consider the grounds under section 5(4)(a) of the Act.

50) Mr Tritton accepted that Hachette had a reputation in relation to the trade mark ELLE for magazines and shoes. There was no dispute that the trade mark the subject of registration no 1145485 had been used in the material period for proof of use purposes. As the international registration covers the goods of the two class 25 registrations of Hachette, it was agreed that in relation to section 5(2)(b) of the Act the matter could be considered solely in relation to the international registration.

51) Ms Heal agreed that the claim to a well-known trade mark added nothing to the case.

52) Ms Heal attacked the witness statement of Mr Smith. She considered that the statements made by Mr Smith could not be accepted. She considered that the attack could be made within the exceptions given by Mr Richard Arnold QC, sitting as the appointed person, in *Tripp Limited v Pan World Brands Limited* BL O/161/07:

“33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phillips* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence."

53) Ms Heal prayed in aid paragraphs from a letter from Kelties dated 30 December 2010. The letter makes submissions in response to the written submissions of Dummett Copp LLP and the witness statement of Mr Smith. The paragraphs in question read as follows:

“12) The Applicant claims that ELLA has been used as a trade mark in relation to footwear for women and girls in the UK since 1 June 2002. However, there is no evidence of use since June 2002. The earliest of the invoices at Exhibit 7 is dated 2003. Moreover, the invoices do not bear the trade mark ELLA. They bear the company name at the top of the invoice but do not refer to ELLA in the purchase details. However, the purchase order descriptions on the invoices refer to the other trade marks, e.g. POM POM, MAXI G, MILLY G, MONET, CASSIE, PARMA, FRANKIE, MONA etc. It is further noted that the domain names www.ellashoes.co.uk and www.ellashoes.com were registered in 2003 but that a website was not live under the domains until November 2007. Moreover, the evidence at Exhibit 5 from the *Internet Archive/Wayback Machine* promotes shoes under different trade marks, such as BOBBI, BOSSI, GRANGE, JIMMY, KIMA and LIVIA (see page 6 of the exhibit) but not ELLA.

13) Further, the documents at Exhibit 8 consisting of invoices, exhibition plans and exhibitor lists do not show how the mark was displayed at the exhibitions. There is no evidence that the Applicant's goods were promoted under the trade mark ELLA at the exhibitions it attended and the evidence merely confirms that Ella Shoes Ltd was a registrant of booths at the exhibitions. Although the Applicant claims that it spent approximately £48,500 on marketing and advertising during the 6 year period from June 2002 to December 2008, there is no evidence of advertisements bearing the ELLA trade mark.

14) We note that the catalogue at Exhibit 1 is a recent catalogue dated 2007/2008. The photographs at Exhibit 2 are not dated and so cannot constitute evidence of use dating back to 2002.

15) We note that the catalogue at Exhibit 1 is a recent catalogue dated 2007/2008. The photographs at Exhibit 2 are not dated and so cannot constitute evidence of use dating back to 2002.

16) We submit, therefore, that the Applicant has not supported its claim to use of ELLA as a trade mark dating back to 2002. Indeed, the earliest evidence of use of ELLA as a trade mark dates back to November 2007.”

54) This is a commentary upon the evidence, it is difficult to see that it is a challenge to the evidence. Commenting and challenging are different matters, the commenting on the evidence asks the tribunal to consider what the effects of the evidence are, not the veracity of the evidence. It is also to be noted that Ms Heal adopted a different approach to what was submitted in the letter. She submitted that there was no evidence that the catalogue was for 2007/2008 and no evidence that the trade mark of ESL had been used prior to 6 January 2009,

the date of application. Something that was not only not foreshadowed in the letter of 30 December 2010 but is contrary to the position adopted in it.

55) In his evidence Mr Smith states:

“3) Ella Shoes has used the ELLA trade mark in relation to footwear for women and girls in the UK since 1st June 2002 when the company commenced trading....Ella Shoes only sells footwear for women and girls and all products are sold under the ELLA trade mark....”

Ms Heal challenged the validity of the statement. The letter of 30 December 2010 does not state that Mr Smith's statement is false. Either the statement is true or it is not, there are no two ways about it. If Hachette wanted to challenge Mr Smith's statement it should have used the vehicles readily available to it: cross-examination, disclosure and/or counter-evidence. Ms Heal stated that she was not challenging the veracity of Mr Smith. It is impossible to see that she was doing anything else. As stated above, Mr Smith's statement is either true or not and to ask the tribunal to disregard it is, de facto, for the tribunal to treat it as being false. The underlying argument of Ms Heal is very serious, that Mr Smith lied; this must be a matter that is tested by means of the vehicles referred to above. This is not a matter of nuance or interpretation of the nature of the use of the trade mark ELLA, as for proof of genuine use in a revocation action, but a matter of stating that ELLA has not been used as a trade mark as stated by Mr Smith.

56) Ms Heal submitted that ESL had not furnished any evidence in response to the letter of 30 November 2010. As Mr Tritton commented, what could Mr Smith do? File another statement confirming the truth of his earlier statement? If the catalogue does not have a date upon it what can Mr Smith do about that? He has stated from when the catalogue emanated, a matter not challenged in the letter of 30 December 2010.

57) Ms Heal submitted that the evidence of Mr Smith was “obviously incredible”. *The Concise Oxford English Dictionary* defines incredible as being “impossible to believe”. Ms Heal was stating that Mr Smith's statement was not only impossible to believe but obviously impossible to believe. There is nothing in the details of Mr Smith's statement that is obviously incredible, or even incredible, either in individual details or in the warp and woof of the statement.

58) In the absence of any contradictions in the evidence of Mr Smith, in the absence of any contradictions that Hachette has shown through counter-evidence, in the absence of a challenge by way of cross-examination or counter-evidence, the statement of Mr Smith is accepted at face value.

59) Hachette criticises the absence of evidence of advertising of the trade mark of ESL. Mr Smith states what ESL has spent of marketing/advertising. By any

normal definition of these activities this would include attending trade exhibitions, which cost money and for which Mr Smith has furnished invoices. It will also include the cost of catalogues. Taking into account the nature of the business of ESL, which is not a retailer, the presence at trade shows and the production of catalogues would be a normal way to promote the business.

60) Ms Heal submitted that the use shown by the invoices and in the catalogues was of other trade marks eg page 1 of Exhibit 7 is for 72 pairs of Flo white. It would seem normal for a provider of shoes to identify different styles by reference to a name, they have to be defined in some fashion. So there is nothing surprising that the statements and the catalogue refer to the style of the shoe. On the same basis the shoe box at pages 10, 11 and 12 bears the name ELLA as the predominant name but also the style of shoe, MACI. It is to be noted that this is how MACI is described on the box, as a style. Ms Heal submitted that the invoices showed use of the company name and not of ELLA as a trade mark. The invoices do not need to show use of ELLA as a trade mark. They are primary evidence of the sales to a number of undertakings in a number of locations in the United Kingdom. Consequently, they give clear documentary proof of sales by ESL. The invoices need to be considered within the context of the evidence as a whole. Mr Smith states that ELLA appears on the shoes and is the trade mark used in relation to the shoes. The shoe box, if emanating after the date of application, supports this. The pictures of the shoes in the 2007/2008 catalogue show shoes where ELLA can clearly be seen on the insole of the shoes eg page 12 of Exhibit 1. The 2007/2008 catalogue also includes clearance lines, if the shoes are clearance lines they will emanate from an earlier period. On pages 16 and 17, which show clearance lines, ELLA can be seen on the Sheba, Marty, Mars, Santos, Cass, Gabby, Terra and Nina styles of the shoes. At the top of the pages of the catalogue "Ella Shoes" appears, this is not use of a company name. It is difficult to see how this is anything other than use of ELLA as a trade mark.

61) Mr Smith has supported his statement, inter alia, with invoices, copies of the profit and loss account, details of trade exhibitions and a catalogue. There are no internal contradictions in the evidence. There is nothing which even raises a question as to the probity or credibility of the evidence of Mr Smith.

62) The evidence establishes that ESL has been trading in shoes for women and girls since 1 June 2002 by reference to the trade mark ELLA. This trade has taken place across the United Kingdom and to a variety of retailers. There has been a reasonable scale of use and ESL has had a regular presence at major trade exhibitions.

63) Hachette and Ms Heal state that there has been use of ELLE in relation to shoes. They claim that there is a reputation in relation to this use, a matter that Mr Tritton accepted. So there has been use of ELLE in relation to shoes during the period when ESL has been trading in shoes for women and girls by reference

to ELLA. The use shown by Hachette for all of its clothing and footwear is for women and girls; so the same products have been supplied to the same gender since June 2002.

SECTION 5(3) OF THE ACT

64) In relation to taking unfair advantage Hachette has to establish two things, that there would be an advantage and that it would be unfair. The question of the unfair aspect was considered by Lloyd LJ in *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753:

“136. I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L'Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic C-shape of a stand mixer, the kMix would remind relevant average consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L'Oréal v Bellure*. I find the Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in *L'Oréal v Bellure*. No additional factor has been identified in this case other than intention.”

This matter was also considered by Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch):

“160. Thus something more than mere advantage is required. It must be an unfair advantage. Lloyd LJ seems to state that an advantage is rendered unfair if it is intended. He also leaves open the possibility that unintended advantage may have a sufficient quality of unfairness about it to qualify.”

In *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07 the Court of Justice of the European Union (CJEU) stated:

“37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the

use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.....”

65) Hachette has put nothing forward in relation to the issue of unfairness. Unlike in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* there has been no evidence of a decision to “live dangerously”. Mr Smith states that he chose the name ELLA as it is the name of his daughter. Hachette has put in nothing to challenge this; it could have, for instance, shown that this was not the name of his daughter. Ms Heal submitted that ESL would have known of the trade mark ELLE and its reputation and so known that the use of ELLA was unfair. Such an argument is contingent on the finding that use of the trade mark ELLA would take advantage of the trade mark ELLE and so a finding of unfairness would be predicated on the finding of taking advantage and so effectively nullifying the unfairness element of the advantage. The argument is rejected.

66) ESL has been using the trade mark ELLA since June 2002 so this is not a quia timet action. Consequently, the qualification of paragraph 37 of *Intel* by paragraph 38 does not come into play. 2.25 million ELLA shoes have been sold in the United Kingdom. If Hachette wishes to rely upon the provisions of section 5(3) of the Act it must supply evidence to support its claim under this head. It has singularly failed so to do. It has put forward no evidence in relation to the claim of unfairness, it has put forward no evidence in relation to the claims of taking advantage or being detrimental to, the distinctive character or the repute of the earlier trade mark. In the absence of any substantiating evidence to the claim under section 5(3) of the Act, the grounds of opposition under section 5(3) of the Act are dismissed.

SECTION 5(2)(B) OF THE ACT – LIKELIHOOD OF CONFUSION

Average consumer, nature of purchasing decision and standard for likelihood of confusion

66) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”ⁱⁱⁱ. The goods under consideration, footwear, are purchased by the public at large. Footwear covers a variety of

goods eg shoes and socks. In shops, shoes and the like will normally be tried on. However, these goods are often bought from websites and catalogues, where they obviously cannot be tried on. They are goods that are normally purchased by the eye, whether that be in retail premises or a website. They can be of low cost and high cost. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

It is necessary to take into all aspects of the market and all types of goods. Consequently, it is necessary to take into account articles of footwear that could be of low cost and bought without a good deal of attention. The lesser the degree of attention, the greater the effects of imperfect recollection.

67) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

In this case visual similarity will be of more importance than aural similarity.

Comparison of goods

68) ESL accepts that identical goods are involved.

Comparison of trade marks

69) The trade marks to be compared are **ELLE** and **ELLA**.

70) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various detailsⁱⁱⁱ. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{iv}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^v. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{vi}.

71) Various submissions were made about the conceptual significance of the respective trade marks. Ms Heal submitted that ELLA would be seen as the Castellano or Italian for she. ELLA is a common female forename in the United Kingdom. It is difficult to understand why the average consumer in the United Kingdom would perceive a common female forename as being the third person singular feminine pronoun in other languages. Applying similar logic the average United Kingdom consumer would see 'once' as being the Castellano for eleven or the acronym for Organización Nacional de Ciegos Españoles (the Spanish equivalent of the RNIB). Ms Heal submitted that ELLE would be seen by the average consumer as the French for she. There is no evidence as to this. However, in its counterstatement ESL stated that "ELLE is the French word for 'she', while ELLA is a girl's name. The perception of the two marks by the consumer will be different". The response by ESL must be viewed as accepting the argument that ELLE will be seen as the French for she. ESL also referred to ELLE being a female forename in the following terms:

"If, on the other hand, ELLE is considered to be a girl's name..."

This is not an acceptance that ELLE will be seen as a female forename and Hachette has not argued that it will so be seen. There is no evidence that ELLE will be seen as a female forename and it is certainly not a subject of judicial knowledge. If it is a female forename it is certainly not one in common use. ELLE, as advocated by Hachette and accepted by ESL, will be seen as she in French and ELLA will be seen as a female forename. **The respective trade marks are conceptually dissonant.**

72) Ms Heal argued that ELLE might be pronounced ELLIE as well as the letter L. Such an argument is contrary to standard English orthography and is dismissed. If, as argued by Ms Heal, and accepted by ESL, ELLE is known as the French for she it will be pronounced as L. The interpretation of normal English orthography would also lead to this conclusion eg gazelle, Belle, Belle Vue (Manchester) and quenelle. ELLE consists of one syllable. ELLA consists of two syllables. The first syllable of ELLA will be pronounced in the same fashion as ELLE. However, the doubling of the syllabic length gives rise to a good deal of difference aurally. Consequently, aural similarity is limited.

73) Visually the difference between the two trade marks is the last vowel. Consequently, three out of the four letter are the same. In *Inter-Ikea Systems BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-112/06* the GC held:

“54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the contested mark and the letter ‘k’ in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.”

Taking into account the shortness of the trade marks, as per the above judgment, although there is visual similarity it cannot be held that there is a high degree of visual similarity.

Conclusion

74) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{vii}. In this case the respective goods are identical.

75) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{viii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{ix}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish

those goods from those of other undertakings^x. ELLE is allusive for shoes for females, however, balanced against this is the reputation that Mr Tritton accepted. Consequently, it must be held that ELLE for footwear has a high degree of distinctiveness.

76) There is the conceptual dissonance of the respective trade marks to be considered. In *Phillips-Van Heusen Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-292/01*:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game ‘Pasch’ is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

It is Hachette’s own argument that ELLE will be seen as the French for she by the average consumer. ELLA will be immediately seen by the average consumer as the female forename, so the effects of conceptual difference come into play, in this case conceptual dissonance. It is to be noted that conceptual difference does not always trump visual and aural similarities as per the judgment of the GC in *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-460/07*:

“66 Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

In this case there is a clear conceptual dissonance which will mean that the average consumer will have different conceptual hooks with which to attach the

trade marks. Clear conceptual hooks that will militate against imperfect recollection. The phonetic similarity is limited and the visual similarity not of the highest level. Visual similarity is of greater importance than aural similarity, as decided above, however, when confronted with the trade marks visually the average consumer will also have dissonant meanings before him or her, so allowing for distinguishing of the trade marks.

77) There is a tranche of case law to the effect that lack of confusion in the market place is often indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

However, in this case there has been extensive use by ESL of its trade mark. It has promoted it regularly at major trade exhibitions. It has sold a good number of shoes. There is nothing exclusive about where the licensees of Hachette have sold ELLE shoes. They have been sold in mail order catalogues, they have been sold at discount shopping villages, in department chain stores. There has been no clear demarcation line between the goods. The trade mark appearing on the shoes has been ELLA, not with added matter. Consequently, the concurrent use over a lengthy period of time is not something that can be ignored. It is something that has to be taken into consideration. Mr Smith states that he is not aware of any instances of confusion. There has been no challenge to this. Hachette has provided no instances of confusion. After so many years of use it could be expected that some evidence would have presented itself eg the return of faulty goods or complaints about the goods. Hachette has provided nothing.

78) There is not a likelihood of confusion and the opposition is dismissed in its entirety.

COSTS

79) Ms Heal submitted that if Hachette were successful, the denial of reputation by ESL should be taken into account. It is to be noted that Hachette claimed reputation in relation to all of the goods of the international registration and also a goodwill in relation to all of them. So its claim in relation to these matters included mosquito nets, lace, chignon frames, artificial flowers. There is nothing in the evidence to suggest any use in relation to such goods, let alone a reputation for the purposes of section 5(3) of the Act. Consequently, the claims

of Hachette were clearly outwith the use that had been made of its trade mark. The evidence of Hachette was not specifically tailored to the facts of this case. A large part of the evidence was adduced from earlier proceedings. The exhibits adduced specifically to these proceedings seem to have been adduced without any concern for their relevance. A number of decisions and judgments were adduced. A number were without translation; a couple were translated, into French. None of the translations were certified and none of the decisions or judgments had any clear relevance to this case. Taking into account the volume of the evidence and its nature, it is considered appropriate to make an award at the top of the scale.

80) Costs are awarded to ESL on the following basis:

Preparing a statement and considering the statement of Hachette:	£600
Preparing evidence and considering the evidence of Hachette:	£2,000
Preparing for and attending the hearing:	£1,000
Total	£3,600

Hachette Filipacchi Presse is to pay Ella Shoes Limited the sum of £3,600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27 day of April 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

“(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

(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 Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

"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."

ⁱⁱ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

ⁱⁱⁱ *Sabel BV v Puma AG* Case C-251/95.

^{iv} *Sabel BV v Puma AG* Case C-251/95.

^v *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{vi} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{vii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{viii} *Sabel BV v Puma AG* Case C-251/95.

^{ix} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^x *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.