O-492-16

TRADE MARKS ACT 1994

TRADE MARK APPLICATION NO. 3017428

ALLURE

IN CLASS 9

BY

ADVANCE MAGAZINE PUBLISHERS INC.

AND

THE OPPOSITION THERETO

UNDER NO. 401389

BY EDIZIONI ESAV S.R.L.

Background and pleadings

1. Advance Magazine Publishers Inc. ("the applicant") applied for the trade mark ALLURE[1] on 27 September 2011 for *phone applications (phone apps); software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones*, in Class 9.

2. The application was published on 27 September 2013 and was subsequently opposed by Edizioni Esav S.r.l.("the opponent"). The opponent bases its opposition, under sections 5(2)(a) and (b) of the Trade Marks Act 1994 ("the Act"), on the following EU trade mark:

8943813

Class 38: *Telecommunications; broadcasting; communication handling; information about telecommunication.*

Class 41: *Photography services; arranging and conducting of training courses, refresher courses, demonstrations, symposiums, conventions, exhibitions, workshops, artistic management.*

Filing date: 10 March 2010; completion of registration procedure: 9 May 2013.

3. The claim under section 5(2)(b) is that the parties' marks are identical or similar, and the goods and services are similar, the combination of which will lead to a likelihood of confusion between the marks.

[1] Converted from a European UnionTrade Mark.

4. The applicant filed a counterstatement in which it denies that the marks are identical, admits that the marks are similar, but denies that the goods and services are similar. Further, the applicant maintains that the proceedings constitute an abuse of process in view of previous proceedings between the parties[2]. The applicant requests that the opposition is dismissed.

5. Both parties are professionally represented. The applicant filed evidence and the opponent filed written submissions and evidence in reply. Neither of the parties opted to be heard, and both filed written submissions in lieu of a hearing. I make this decision after carefully considering all of the papers filed.

Applicant's evidence

6. This comes from Mr Ian Bartlett, who is the applicant's trade mark attorney with the firm Beck Greener. He states that he has represented the applicant for ten years, has a good knowledge of its business and that the facts in his witness statement come either from his own knowledge or are from the applicant's documents.

7. Mr Bartlett begins by explaining that the previous proceedings referred to in the counterstatement resulted in a partial revocation of the applicant's registration 1414193 ALLURE to *women's interest magazines*, and a refusal of the present opponent's application to protect its trade mark IR 1108825, except for *photographs*. In the previous proceedings, evidence for the applicant was given by Pamela Raynor. A copy of her second witness statement is adduced for the present proceedings at exhibit IB-2. I adopt here the summary of that evidence from the previous decision:

> "26. Ms Raynor's second witness statement is in response to the criticisms and opinions given by Mr Pissimiglia. She accepts that the number of ALLURE copies sold in the UK has not been on the same scale as its UK

[2] Decision BL O/053/14

specific titles, but she submits that the number is, nevertheless, significant and has been in the region of 4,000 to 9,500 copies per year since 2006. Sales are approximately £200,000. Ms Raynor states:

> "7. There is a suggestion made by Mr. Pissimiglia in his statement that we do not make a profit out of our UK retail sales of ALLURE. Such a suggestion would be wrong. It is not our policy to give out profit figures. However, I understand from Mr Joe. Bertolino, who is Advance's Head of Circulation for ALLURE magazine that UK retail sales of ALLURE are profitable. The cost of the additional print run to satisfy this demand is proportionately small as are the distribution costs in view of the existing distribution channels which I explained in my earlier statement, are used. I should emphasise that ALLURE is sold to UK retailers such as W.H. Smith and Easons ... [i]f the magazine did not sell they would not carry it but would make room on their shelves for other titles."

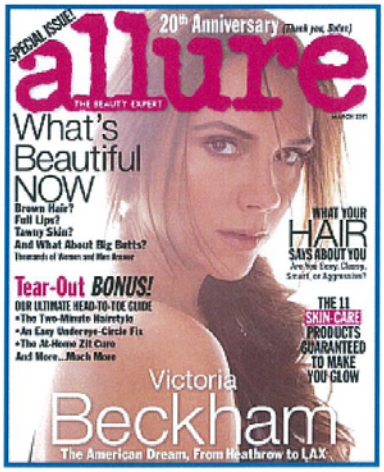
27. Ms Raynor points out that much of the advertising in ALLURE is for brands which are "international". She refers to exhibit PR1, the full copy of ALLURE from September 2011, which carries advertisements for e.g. Estée Lauder, Calvin Klein, DKNY, Clinique, Olay, Chanel, Fendi, Neutrogena, Dior, L'Oréal, Givenchy, Revlon and Lancôme. Ms Raynor believe that advertisers in ALLURE are well aware that the magazine has international readership. She refers to another of Advance's magazines, TATLER, which she states is also a showcase for international luxury goods: the UK edition of the magazines is sold internationally, particularly in English speaking and Commonwealth countries. Ms Raynor states that Mr Pissimiglia is wrong to assert that the circulation of ALLURE outside of the US is irrelevant to the advertising income which Advance derives from ALLURE. She states that international brand owners have internationally coordinated campaigns and will ensure that their advertising has correspondingly international relevance. As regards US v UK content, Ms Raynor says that at one extreme, a 'what's on' guide to New York will be different to a similar magazine for London.

However, she says that Advance's ALLURE magazine is at the other end of the spectrum because it concerns women's beauty, provides news concerning beauty products and treatments, many of which are available internationally.

28. In relation to publicity for ALLURE, Ms Raynor exhibits at PR19 a copy of a February 2011 press release by Comag, on the occasion of the 20th Anniversary edition of ALLURE, to UK retailers:

28 February 2011

COMAG PRESS RELEASE



ALLURE

Publisher: Condé Nast U.S.

Frequency: Monthly

On Sale: 9 March 2011

Price: £4.40

20th ANNIVERSARY ISSUE

Describing itself as 'the' magazine for today's woman, ALLURE features serious advice on how to look fabulous and feel fantastic! With quality editorial and superb production in every issue, ALLURE is essential reading for the sophisticated woman interested in health, beauty and fashion.

To celebrate its 20th anniversary the March edition will be a special issue and the beautiful Victoria Beckham spices up the cover. Inside, 'Posh' talks about how her journey from Heathrow to LAX was more than just an airline flight.

As well as looking back at two decades of fashion and beauty, the March issue of ALLURE will unveil the biggest trends for 2011. The 'What's Beautiful Now' section highlights the sometimes surprising results from a national beauty survey, with both men and women giving their opinions on everything from full lips to big butts.

Featuring the hottest makeup colours for spring, the cult beauty products of the year as well as new ways to make your skin look radiant, the March issue brings readers all the top beauty advice from the U.S., written by experts.

Retailers are advised to display ALLURE prominently alongside VOGUE USA, ELLE USA and MARIE CLAIRE USA.

29. Exhibit PR20 shows listings on W.H. Smith's website and on Mag-Deals UK website:

Ms Raynor states that although the prints are recent, she believes that they are typical of the kind of third-party promotion which ALLURE has received in the UK for many years.

30. In relation to the ALLURE book, Ms Raynor exhibits details of royalty figures at Exhibit PR22. This, she says, proves that the book was sold in the UK during the relevant periods. I see from the figures that they relate to a combined total for the UK and Ireland, and that between 51 copies were sold from July to December 2007; 59 from July to December 2008; 14 were sold from July to December 2009, 15 from July to December 2010, and 12 from July to December 2011.

31. Ms Raynor states that Advance offers two ALLURE apps; the first of these was launched in April 2011 and is a preview of the digital version of the magazine available on the iPad. The second app was launched in September 2011, which is the ALLURE Best of Beauty iShopper. Ms Raynor states that between April 2011 and March 2012 there were 184 UK subscribers to the

app and that there were 49 UK annual subscribers to the digital version of the magazine up to November 2011. Since November 2011, there have been more than 300 further UK subscribers. This is in addition to the purchase of one-off editions of the digital magazine which for the UK has been over 1000 since the magazine was launched."

8. Mr Bartlett states that the applicant is one of the world's largest and best known publishing businesses, publishing VOGUE, TATLER and GQ, as well as ALLURE. Mr Bartlett points out that the applicant's registration 1414193 ALLURE is registered for *women's interest magazines* in Class 16, and that the present opposition is directed at the applicant's goods in class 9, *phone applications (phone apps); software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones*. He draws attention to Ms Raynor's evidence as showing that the applicant first launched two such apps in April and September 2011. Further, he states that the applicant has for some years provided digital versions of its magazines for viewing on tablets and devices, via its apps. An example from the Apple iTunes online store is shown in Exhibit IB3. He states that it has become extremely common for newspaper and magazine publishers to provide digital versions of their publications via apps, and that the applicant is no exception.

9. At Exhibit IB4, Mr Bartlett provides a copy of a decision of the European Union Intellectual Property Office's cancellation division[3]. This concerned the applicant's invalidity claim against the opponent's registration which it relies upon as the earlier mark in the present opposition proceedings. The result, delivered on 10 June 2015, was a reduction in the scope of the registered services to those set out in paragraph 2, above. The present proceedings were suspended pending the outcome of the EUIPO proceedings. Mr Bartlett observes that, despite the restriction, the opponent has continued with the present opposition.

10. The opponent filed evidence in reply, in the form of a witness statement by Geoffrey Smith, who is the opponent's trade mark attorney (with the firm HGF Limited). He notes that the opponent's earlier mark predates any use by the

[3] No. 8306 C.

applicant of ALLURE for apps and that the applicant's use of its mark for podcasts had stopped by the time the opponent filed its earlier mark.

11. Mr Smith exhibits at GES1 and GES2 copies of decisions by the EUIPO Opposition Division[4] and the EUIPO Fourth Board of Appeal in relation to another dispute between the parties[5]. The basis of that opposition to the applicant's mark ALLURE was the same registration which is relied upon as the earlier mark in the present opposition. The Fourth Board of Appeal refused the applicant's mark for *phone applications (phone apps)* and allowed the mark to be registered for *software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones*. The goods in that case were exactly the same as in the present opposition. I will refer to the Board of Appeal's findings as and when necessary in this decision.

Decision

12. In its counterstatement, the applicant denies that the mark are identical but admits that they are similar. I agree that the marks are not identical because the earlier mark is clearly comprised of dots which make up the letters. In *LTJ Diffusion SA v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") stated:

> "54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

[4] B2085705
[5] R 2469/2015-4

13. The dots are not so insignificant that they may go unnoticed by the average consumer. The section 5(2)(a) ground is therefore unsustainable and the remainder of this decision will address the ground of objection under section 5(2)(b) of the Act.

14. Section 5(2)(b) of the Act states that:

> "(2) A trade mark shall not be registered if because –
>
> (a) ….
>
> (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."

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. where the CJEU stated, at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

17. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

> "82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking…".

18. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

19. In *Avnet Incorporated v Isoact Limited,* [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

20. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. The parties' respective specifications are shown below:

Earlier mark	**Application**
Class 38: *Telecommunications; broadcasting; communication handling; information about telecommunication.* Class 41: *Photography services; arranging and conducting of training courses, refresher courses,*	*Class 9: Phone applications (phone apps); software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones.*

demonstrations, symposiums, conventions, exhibitions, workshops, artistic management.	

22. The opponent has not made any submissions or explained why it considers any of its class 41 services to be similar to the applicant's class 9 goods. I cannot see any similarities, applying the authorities cited above. Consequently, I find that there is no similarity between them.

23. In its decision referred to above, the EUIPO Fourth Board of Appeal said this about the comparison between the applicant's goods and the opponent's class 38 services:

> "28. *Phone applications* is a broad category which encompasses almost all types of software, including telecommunications applications. These goods and services are similar given their complementary character, and although their nature is different their purpose and distribution channels are the same (12/11/2008, T-242/07, Q2web, EU:T:2008:488, §24-26).
>
> 29. However, contrary to what was found by the Opposition Division the contested 'software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones', which is specific software with the purpose of making newspapers available to mobile phone users, is dissimilar to any of the respondent's [the opponent's] goods and services. The appellant's goods have a clear target market, i.e. readers of those newspapers. Those are different from the purpose and the target market of telecommunications services."

24. The Board of Appeal went on to say that the purpose of software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones is access, whilst the purpose of telecommunications services is communication.

25. In my view, the applicant's software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones is not similar to any of the opponent's class 38 services. They are not of the same nature. The purpose of the applicant's software is access and viewing of magazines on mobile phones, whereas the purpose of telecommunication is communication over distance via technology. These are different. The goods and services are not complementary, are not in competition and do not share meaningful similarities in terms of methods of use. As found by the Board of Appeal, the channels of trade for apps are different to that for telecommunication providers. It is not enough that apps are downloaded via broadband; this fact alone would not lead consumers to suppose that the provider of broadband is linked to or responsible for an app for accessing and viewing magazines.

26. The Board of Appeal found that phone applications (phone apps) is a broad category which encompasses almost all types of software, including telecommunications applications. I agree. It is common to use a mobile phone to send SMS and MMS messages, using a telecommunications provider (such as Vodafone). However, messaging in ways comparable to texting (and voice communication) can also take place via apps such as Facebook, Instagram, Snapchat and WhatsApp. The purpose of these apps is therefore the same as a telecommunication service, and they may be said to be in competition with the more traditional method of using a telecommunication service for voice or text communication. Methods of use are very similar: typing messages or using the voice to communicate. I find that the broad term *phone applications (phone apps)* is similar to a medium degree to the opponent's telecommunications services.

Average consumer and the purchasing act

27. 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.

28. 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."

29. The average consumer for mobile phone apps, and for software for viewing magazines on mobile phones is the general public, who will pay no more than a normal level of attention to the selection of the goods. In relation to the opponent's services, telecommunications is a wide term ranging from mobile phone telecommunications, in which case the consumer is the general public, to high level corporate or business telecommunications services. Photography services, training courses, exhibitions and artistic management may be aimed both at the business user and at the general public. A reasonable degree of attention will be paid to the selection of the opponent's services, depending on the cost and the reason for selection; e.g. photography for a wedding, a fixed mobile phone contract, a business exhibition, or a contract for artistic management. The selection of the applicant's goods will be visual. The opponent's services are also likely to be primarily selected after visual inspection of their details, although I do not ignore the potential for an aural aspect to the purchase, such as verbal recommendation.

Comparison of marks

30. The respective marks are:

Earlier mark	Application
	ALLURE

31. The applicant admits that the marks are similar. Both consist of the single word allure/ALLURE. Despite the dots in the earlier mark, it is clearly the word allure. The marks are highly similar visually, and identical aurally and conceptually.

Distinctive character of the earlier mark

32. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV*[6] 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 *WindsurfingChiemsee* 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

[6] Case C-342/97.

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)."

33. The opponent has not filed any evidence of use of its mark, so I only have the inherent position to consider. Allure means attractiveness or appeal; someone might be said to have allure. It is not a word which naturally lends itself to denoting a characteristic of services. It is more likely to be used in relation to a person. The mark has a reasonable degree of inherent distinctive character for the services of the opponent's registration.

Likelihood of confusion

34. In its written submissions in lieu of a hearing, the applicant says:

"33. Without prejudice to the submissions above the following two successive fall back specifications are proposed such that if the Tribunal considers there to be any relevant similarity in relation to the term 'Phone applications (phone apps)' the following nevertheless should be allowed:

i. Phone applications (phone apps) ***for use in downloading, and/or digitally viewing a magazine and for use in connection with health and beauty****; software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones.*

And if not:

ii. Phone applications (phone apps) ***for use in downloading, and/or digitally viewing a magazine****; software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones.*

35. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). However, where there is no similarity between the goods or services, neither identity between the marks nor a good degree of distinctive character in its earlier mark will help the opponent's case. The CJEU said in *Waterford Wedgwood plc v OHIM* Case C-398/07:

> "35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood."

36. Consequently, the section 5(2)(b) ground **fails** in respect of *software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones.*

37. In relation to the rest of the applicant's goods, *phone applications (phone apps)*, I find that there is a likelihood of confusion on account of the combination of a high level of similarity between the marks, a reasonable level of distinctive character for the earlier mark, a medium degree of similarity between the goods and services,

and, at its lowest level, no more than a normal level of attention on the part of the general public.

38. That is not the end of the matter though, because I must consider whether the applicant's non-binding fall-back specifications alter the outcome. I consider that they do. The limitations have the effect of mirroring the other goods in the application which I found were not similar (as did the EUIPO Board of Appeal). Consequently, the application may proceed to registration for:

Phone applications (phone apps) for use in downloading, and/or digitally viewing a magazine; software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones.

Abuse of process

39. The applicant claims that the opposition is an abuse of process and should be dismissed summarily. It bases this claim on the previous UK proceedings, referred to above (BL O/053/14). In those proceedings, the applicant was the opponent, relying on ALLURE, registered for 'women's interest magazines', in Class 16. The abuse of process argument appears to be that the applicant's goods in class 9 are the 'app' equivalent to its class 16 magazines; and that the class 9 and class 16 goods are inextricably linked, which makes the attack on the class 9 goods an abuse of process.

40. The opponent refutes the claim. It submits that the applicant's class 9 goods were not at issue in the previous UK proceedings:

> "14. The use of the trademark ALLURE for women's interest magazines (i.e. printed magazines) and owning such a registration for such class 16 goods does not legally entitle the Applicant to expand its registration of the same trade mark in other sectors such as the class 9 goods covered by its Application. This would violate earlier legitimate rights of the Opponent.

15. This Opposition does not amount to a re-litigation of the subject matter of Decision O-053-14 as the Applicant's class 9 and class 16 goods are distinct and different products. Any attempt to maintain that there is no difference between the respective class 9 and class 16 goods is clearly mistaken.

16. Moreover, reference is made to the scope of the following term appearing in the Applicant's specification, namely, *"Phone applications (phone apps)"*. This term includes no limitation as to any particular purpose of or the particular nature of such apps yet the Applicant argues that there is no difference between this broad term and *"women's interest magazines"*. The Applicant's contention is groundless. In any event even if the term *"Phone applications (phone apps)"* were qualified there still remains an intrinsic and unavoidable difference between all the Applicant's class 9 goods and *"women's interest magazines".*"

41. I agree with the opponent. It does not seem to be to be an abuse of process to oppose a mark for different goods, in a different class, to that previously litigated. The applicant's argument would mean registration by way of a "creeping equity". There is no abuse of process in the opponent objecting to that. I therefore reject the applicant's claim that the opposition should be dismissed on this basis.

Outcome

42. The application may be registered for the following specification:

Phone applications (phone apps) for use in downloading, and/or digitally viewing a magazine; software for accessing, downloading, and/or digitally viewing a magazine on mobile telephones.

Costs

43. Since both sides have achieved a measure of success, each should bear its own costs.

Dated this 25th day of October 2016

Judi Pike
For the Registrar,
the Comptroller-General