

O-388-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3208438
BY PRINCE HOLLY YAN LLC TO REGISTER:**

Ella Moon

AS A TRADE MARK IN CLASSES 18 & 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 409155 BY SEVEN FOR ALL MANKIND INTERNATIONAL GMBH**

BACKGROUND & PLEADINGS

1. On 24 January 2017 (claiming an International Convention priority date of 2 August 2016 from an earlier filing in Trinidad And Tobago), Prince Holly Yan LLC (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods:

Class 18 - Purses, and handbags, all-purpose carrying bags, tote bags, traveling bags, shoulder bags, clutch purses, backpacks, athletic bags, wallets, coin purses and cosmetic bags sold empty.

Class 25 - Clothing, footwear, and headgear, namely, blouses, shirts, t-shirts, sweatshirts, pants, denim jeans, slacks, shorts, skirts, tunics, tank tops, dresses, sweaters, scarves, jackets and coats, raincoats, fashion headbands and hats, belts, sleepwear, lingerie, socks, gloves, and hosiery.

The application was published for opposition purposes on 3 February 2017.

2. The application has been opposed in full by Seven for all Mankind International GmbH (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the European Union Trade Mark (“EUTM”) and International Registration designating the European Union (“IREU”) shown below:

EUTM no. 11611233 for the trade mark **ELLA MOSS** which was applied for on 27 February 2013 and registered on 14 August 2013. The opponent indicates it relies upon all the goods in its registration i.e.

Class 18

Backpacks; book bags; sports bags; wallets; handbags; purses; tote bags; umbrellas; briefcase-type portfolios; toiletry bags sold empty; cosmetic bags sold empty; shaving kit bags, sold empty; attache cases; briefcases; satchels; duffel bags; luggage; garment bags for travel; billfolds; tie cases; key cases; diaper bags; belts; covers for electronic devices.

IREU no. 863530 for the trade mark **ELLA MOSS** which designated the EU on 10 August 2005 and which was granted protection on 5 December 2006. Once again, the opponent indicates it relies upon all the goods in its registration i.e.

Class 25 - Clothing namely, T-shirts, tank tops sweatshirts, shorts, jeans, jackets, skirts, blouses, shoes, hats, swimwear, dresses.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings, the opponent is represented by Bear & Wolf LLP (“B&W”) and the applicant by Cooley (UK) LLP. Although only the opponent filed evidence, both parties filed written submissions during the evidence rounds. Whilst neither party asked to be heard, both filed written submissions in lieu of attendance at a hearing. I will refer to these submissions, as necessary, later in this decision,

DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“5 (2) A trade mark shall not be registered if because –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

6. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is relying upon the two trade mark registrations shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As the IREU had been protected for more than five years at the date the application was published, it is subject to the proof of use provisions contained in section 6A of the Act. In its counterstatement, the applicant asked the opponent to make good its claim that this trade mark had been used in relation to all the goods for which it is registered and upon which the opponent relies. Given the interplay between the dates on which the opponent’s EUTM was registered and the application for registration published, the EUTM is not subject to proof of use. Consequently, the opponent is entitled to rely upon it without having to demonstrate genuine use.

The opponent’s evidence

8. This consists of a witness statement from Mark Heritage, a partner at B&W, accompanied by Schedules 1 to 10; I note that schedules 5, 7 and 8 are subject to a

Confidentiality Order and the information contained in them has been withheld from public inspection. For the avoidance of doubt, I confirm I have read all these documents.

My approach to the proceedings

9. It is at this point in my decision I would normally provide a summary of the evidence filed and then go on and assess if it established genuine use of the earlier IREU being relied upon and, if so, what constituted a fair specification based upon the use shown. However, for reasons which will shortly become clear, I shall, instead, proceed on the basis most favourable to the opponent i.e. that its evidence establishes that: (i) it has made genuine use of its ELLA MOSS trade mark in relation to all the goods in its class 25 registration, (ii) the competing goods at issue are identical and, (iii) its trade mark is entitled to benefit from an enhanced distinctive character in the United Kingdom in relation to all the goods upon which it relies in these proceedings.

Section 5(2)(b) – case law

10. The following principles are gleaned from the decisions of the courts of the European Union 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 greater 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.

The average consumer and the nature of the purchasing act

11. Although I am proceeding on the basis that the competing goods are identical, it is still necessary for me to determine who the average consumer is for the goods at issue; I must then determine the way these goods are likely to be selected by the average consumer in the course of trade. 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.”

12. The average consumer of all the goods at issue is a member of the general public. As a member of the general public will, for the most part, self-select the goods from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or

catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten.

13. As to the degree of care the average consumer will display when selecting the goods at issue, the cost of such goods can vary considerably. However, as the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items, the average consumer can, in my view, be expected to pay a normal degree of attention to their selection. As the cost and/or importance of the item increases, so too is likely to be the degree of care paid to its selection.


Comparison of trade marks

14. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

15. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give

due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
ELLA MOSS	

16. In reaching the conclusions which follow, I have taken into account (but do not intend to record here), all the competing submissions on this aspect of the case.

17. The opponent's trade mark consists of the words "ELLA" and "MOSS" presented in block capital letters; that is the overall impression it will convey with its distinctives lying in the totality created.

18. The applicant's trade mark consists of the words "Ella" and "Moon" presented in title case in a bold cursive script. Although the stylisation makes a modest contribution, the overall impression conveyed and the trade mark's distinctiveness lies, overwhelmingly, in the totality created.

19. I will now compare the competing trade marks with the above conclusions in mind.

20. Both parties' trade marks consist of the word "ELLA"/"Ella" followed by a four letter word which begins with the letters "MO"/"Mo" and which end with the letters "SS"/"on". Although the stylisation in which the applicant's trade mark is presented introduces an additional point of visual difference between the competing trade marks, as the degree of stylisation present is modest, it assists the applicant to only a limited extent. Considered overall, there is a fairly high degree of visual similarity between the competing trade marks.

21. Of course, the stylisation present in the applicant's trade mark has no impact on how it will be pronounced. In its submissions filed in lieu of a hearing, the applicant states:

"14. In addition, the differences between the MOSS and MOON element are sufficient to distinguish the marks aurally as the applicant's mark is pronounced softly owing to the double vowel elongating the MOON element. On the contrary, the pronunciation of the opponent's mark is much harder given the double "SS" ending of MOSS."

22. In its submissions filed during the evidence rounds, the opponent states:

"12(c) Neither is it the case (nor understood) that (or how) the alleged slight difference in pronunciation between "oon" and "oss" allegedly offsets the overall phonetic similarity of the marks."

23. Both trade marks consist of three syllables i.e. EL-LA MOSS and El-la Moon; the first two syllables are identical. Whilst I agree that the way the third syllable in each trade mark is pronounced will differ in the manner the applicant suggests, considered overall, the competing trade marks remain aurally similar to a fairly high degree.

24. Finally, the conceptual comparison. In its Notice of opposition, the opponent commented on this aspect of the comparison in the following terms:

"Conceptually, [the competing trade marks] either have no meaning or - if they do - they would both be seen as the name of a woman; in the latter case, they are clearly similar."

25. In its submissions filed in lieu of a hearing, the applicant states:

"15. Conceptually, the applicant submits that the relevant consumer would struggle to understand the marks as anything other than full names and although the marks shares the common ELLA element, it has been established that when

the average consumer perceives a full name it is usually the surname that plays a more distinctive role because the first names are rather common...”

26. In its submissions filed during the evidence rounds, the opponent states:

“12(d) When examining conceptual similarity, the applicant appears to assume, and proceed on the basis, that the [competing trade marks] are automatically and only perceived as names. However, which mark it is alleged will be so perceived is not clear. Neither, per the opponent’s original statement of grounds, does ELLA MOSS (or ELLA MOON, for that matter) carry any particular conceptual meaning. True, ELLA is typically a first name, but MOSS is also typically perceived to mean a flora, and MOON typically perceived to mean the moon in the sky. Both ELLA MOSS and ELLA MOON could be “full names”, but will not automatically be seen as such by the average consumer.”

27. It is, of course, true that the words MOSS and MOON have the meanings to which the opponent refers. However, in my experience, and, more importantly, I am satisfied that of the average consumer, they will also be well-known as surnames. When such words follow a word which the average consumer will recognise as a common female forename i.e. ELLA/Ella, I think it far more likely than not that the resulting combinations will be seen as feminine full names. While the competing trade marks are conceptually similar to that limited extent, it is, in my view, inescapable that they will also be considered to refer to different individuals.

Likelihood of confusion

28. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the

average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

29. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

30. In its submissions filled in lieu of a hearing, the opponent states:

“18...Consumers encountering the application will be likely to assume that the contested goods originate with or emanate from the opponent, and/or that the opponent and the applicant are in some way associated or linked economically (such as through a licensing relationship, or similar). At the very least, those encountering the application will have the ELLA MOSS marks and the opponent called to mind by reason of the application, and therefore will tend to associate in their mind the respective marks and their respective owners and their respective undertakings.”

31. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, commented upon the difference between direct and indirect confusion in the following terms:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark

is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

32. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

33. I begin by reminding myself of my approach to the proceedings (paragraph 9 refers). To that I add my conclusions regarding: (i) the average consumer, who I determined is a member of the general public who, whilst not forgetting aural considerations, is most likely to select the goods at issue by visual means, paying a normal degree of attention during that process and, (ii) that the competing trade marks are visually and aurally similar to a fairly high degree and conceptually similar to the limited extent they are both feminine full names, albeit which share the same forename.

34. However, even proceeding on the basis most favourable to the opponent, I see absolutely no reason why an average consumer paying even a low (let alone) normal degree of attention during the selection process (but who will, in my experience, be well used to distinguishing between different combinations of common forenames and surnames), would directly confuse the competing trade marks. Similarly, I think the average consumer is far more likely to assume the identical goods at issue come from competing undertakings (perhaps in which individuals named ELLA MOSS and Ella Moon are, or may have been, the controlling minds); there is no likelihood of indirect confusion. Insofar as the opponent refers to the applicant's trade mark calling the opponent's trade mark to mind, that is mere association, not confusion.

Overall conclusion

35. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

36. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the applicant on the following basis:

Reviewing the Notice of Opposition and preparing a counterstatement:	£300
Considering the opponent’s evidence:	£700
Written submissions:	£400
Total:	£1400

37. I order Seven for all Mankind International GmbH to pay to Prince Holly Yan LLC the sum of **£1400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of June 2018

C J BOWEN
For the Registrar