

O-914-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3527351

BY TOMBANY KOULOUFOUA

TO REGISTER:



AND:



AS A SERIES OF TWO TRADE MARKS IN CLASSES 9 & 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 423196 BY

MADAME MARIE ROUSSELET

BACKGROUND & PLEADINGS

1. On 27 August 2020, Tombany Kouloufoua (“the applicant”) applied to register the series of two trade marks shown on the cover page of this decision for the goods and services in classes 9 and 41 shown in paragraph 10 below.

2. On 12 February 2021, the application was opposed in full by Madame Marie Rousselet (“the opponent”). Although the opposition was originally based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), in her written submissions dated 28 June 2021, the opponent indicated that she “now relies on section 5(2)(b) only.” The trade mark being relied upon is shown below (the services being relied upon are shown in paragraph 10 below):

UK no. 3575945:



Filed on 7 January 2021 (claiming a priority date of 17 July 2020 from an earlier filing in France) and entered in the register on 28 May 2021.

3. In her Notice of opposition, the opponent states:

“The opposed mark contains the identical words ENTRE ELLES which are the dominant and distinctive element of the earlier right. The opposed mark includes a small image of 4 “girls” above the words ENTRE ELLES and with a highly stylised microphone separating the words. The additional matter does not detract from the impact of the clear words ENTRE ELLES. The words

mean “between them” in French. However the words are highly distinctive to an English speaker in respect of the goods/services, despite a percentage of the UK population speaking French.

Furthermore the goods and services applied for are identical to, and if not identical, then are similar to the services of the earlier right...”.

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

5. In these proceedings, the opponent is represented by ip21 Limited and the applicant by Lewis Silkin LLP. Although neither party filed evidence, both filed written submissions during the evidence rounds. At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. Neither party requested a hearing nor did they elect to file written submissions in lieu. I will bear the submissions filed in mind, referring to them to the extent that I consider it appropriate to do so.

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

7. The opposition is now only based upon section 5(2)(b) of the Act. This reads as follows:

“5 (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.

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

8. In these proceedings the opponent is relying upon the trade mark shown in paragraph 2. Although that trade mark has a filing date which is later than the application being opposed, it qualifies as an earlier trade mark under the provisions of section 6 of the Act by virtue of its priority claim. Given the interplay between the date on which the opponent’s trade mark was entered in the register and the application date of the trade mark being opposed, the earlier trade mark being relied upon is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent can rely upon all the services claimed without having to demonstrate that the trade mark has been used in relation to such services.

Case law

9. 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.

(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.

Comparison of goods and services

10. The comparison is as follows:

Opponent's services	Applicant's goods and services
Class 35 - Presentation of companies on the Internet and other media; Presentation of companies and their goods and services on the Internet; Copywriting for advertising and promotional purposes; Subscription to an information media package; Business advisory and information services; Information services relating to businesses; Providing information about commercial business and commercial information via the global computer network; Dissemination of advertising matter online; Preparation of audio and/or visual displays for businesses; Arranging of commercial and business contacts; Banner advertising; Business management assistance; Consultancy	Class 9 – Podcasts; Downloadable podcasts. Class 41 - Creation [writing] of educational content for podcasts; Creation [writing] of podcasts.

regarding advertising communication strategies; Dissemination of advertising via online communications networks; Dissemination of advertising for others via an on-line communications network on the internet; Rental of advertising space on the internet; Rental of advertising space on the internet; Rental of advertising time on communication media; Providing advertising space in periodicals, newspapers and magazines; Promoting the goods and services of others via computer and communication networks; Online advertising on a computer network; Advertising through all public communication means; Advertising and marketing services provided via communications channels; all the aforesaid services mainly in the field of female entrepreneurship.

Class 41 - Publication of electronic magazines; electronic and online publication of periodicals; Writing of texts, other than publicity texts; Preparation of texts for publication; Services for the publication of newsletters; Services for the publication of newsletters; online literary and film review services; Education services relating to therapeutic treatments; Personal development training;

<p>coaching [training] in personal development and well-being; Interviewing of contemporary figures for educational purposes; Interviewing of contemporary figures for entertainment purposes; Arranging of lectures; Organisation of seminars; Publication and edition of books; writing texts for publication, namely writing books; all the aforesaid services mainly in the field of female entrepreneurship.</p>	
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11. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

14. 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.”

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...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”.

16. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

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

18. I begin by noting that the opponent’s specifications in classes 35 and 41 contain the following limitation “all the aforesaid services mainly in the field of female entrepreneurship.” However, as the use of the word “mainly” does not limit the services to only those in the field identified, I must consider the matter on the basis that the services are, in effect, unrestricted.

19. In her submissions, the opponent argues:

“28. The goods and services covered by the Applicant’s Mark can be summarised as podcasts (as a product) and the writing of podcasts (as a service).

29. The Class 35 services of the Opponent’s Mark can be summarised as advertising and marketing services provided online including the ‘preparation of audio and/or visual displays for businesses’. Podcasts fall into the category of an ‘audio and/or visual display’ and are therefore encompassed within the Opponent’s broad term ‘preparation of audio and/or visual displays for businesses’.

30. The Class 41 services of the Opponent’s Mark can be summarised as electronic and online publication of texts, newsletters, magazines and periodicals as well as the preparation and writing of texts for publication. Again, the Applicant’s ‘podcasts’ and ‘creation [writing] of podcasts’ fall within the broad terms of the Opponent’s Class 41 specification. The nature and method by which the services are rendered are the same – online. The users of the services are the same – the general public. And the services are

complimentary – a podcast may be accompanied or could itself be described as an online publication, and the Opponent’s writing services (of text for publication) are complimentary to the Applicant’s writing of podcasts for publication.

31. We submit that the goods and services applied for are identical to the services covered by the Opponent’s Mark, or are highly similar.”

20. In her submissions, the applicant argues (by reference to the Trade Marks Registry’s Cross-Search list¹), that her goods in class 9 are not similar to the services relied upon by the opponent. While I note the applicant’s submissions regarding the Cross-Search list, in reaching a conclusion in inter-partes proceedings, I must consider the matter on the basis of the relevant case law mentioned above and the submissions of the parties.

Class 9

21. I note that collinsdictionary.com defines podcast as:

“1. an audio file similar to a radio broadcast, which can be downloaded and listened to on a computer, mp3 player, mobile phone, etc.”

22. That is my understanding of the term and will, I am satisfied, accord with that of the average consumer. As the items in class 9 are goods and those relied upon in class 35 are services, the nature will be different as will the method of use. The intended purpose of a podcast will, in my view, differ to the “core” meaning of the terms included in the opponent’s specification in class 35 and, insofar as the opponent’s argument in relation to the services in class 35 it has identified is concerned, as production and writing of podcasts is proper to class 41, they cannot, in my view, be encompassed by the term the opponent identifies in class 35. In

¹ The Cross-Search list is used by The Trade Marks Registry as a starting point when conducting an ex-officio search on relative grounds during the examination phase of an application.

addition, while the users of the applicant's goods are more likely to be members of the general public, it appears to me that the users of the opponent's services in class 35 are much more likely to be businesses. The trade channels through which one might acquire a podcast appear to me to be different to those through which a business would acquire the opponent's services in class 35. Finally, as far as I can tell, there is no meaningful competitive relationship between the goods and services nor is there a complementary relationship in play (at least not in the sense outlined in the case law). Considered overall, I am not persuaded there is any meaningful degree of similarity between any of the opponent's services in class 35 and the applicant's goods in class 9.

23. Turning to the opponent's services in class 41, once again the nature of the goods and services will differ. While the users of the vast majority of the opponent's services are, once again, more likely to be business users, the users of "education services relating to therapeutic treatments", "personal development training" and "coaching [training] in personal development and well-being" will be both businesses and members of the general public. In relation to those services directed primarily at businesses, the intended purpose, method of use and trade channels are likely to differ and there appears to be no meaningful competitive or complementary relationship in play.

24. However, in relation to the opponent's educational, training and coaching services, a user of such services would not, in my view, be surprised to find that a provider of such services also produces a podcast in support. In those circumstances, there is likely to be an overlap in, at least, the users, the intended purpose, as well as there being a complementary relationship in the sense outlined in the case law. Considered overall, there is, in my view, a between low and medium degree of similarity between the applicant's goods and the opponent's educational, training and coaching services. I shall, however, return to the issue of similarity between the applicant's goods in class 9 and the opponent's services when I consider the likelihood of confusion later in this decision.

Class 41

25. In her submissions, the applicant states that:

“24. The respective services in class 41 are similar to one another to a small degree.”

26. I disagree. As the term “writing of texts, other than publicity texts” in the opponent’s specification in this class is broad enough to include writing of texts for podcasts, the applicant’s writing of podcasts (including writing of educational content for podcasts), is to be regarded as identical to the opponent’s named services on the principles outlined in *Meric*.

The average consumer and the nature of the purchasing act

27. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which these goods and services 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.”

28. As I mentioned earlier, the average consumer of the applicant’s goods in class 9 is most likely to be a member of the general public, whereas the average consumer of the opponent’s educational, training and coaching services in class 41 is either a

member of the general public or a business user. The average consumer of the opponent's "writing of texts, other than publicity texts" in class 41 and the applicant's services in class 41 is most likely to be a business user. Absent any submissions to assist me, I shall proceed on the basis that as is so often the case, the goods and services at issue are most likely to be selected visually following, for example, a review of materials on-line. As a consequence, visual considerations are likely to dominate the selection process, although not to the extent that aural considerations in the form of, for example, word-of-mouth recommendations can be discounted.

29. As to the degree of care these consumers will display when selecting the goods and services at issue, given the obvious importance to either an individual or a business to select the most appropriate training provider or for a business to identify the most appropriate undertaking to write content for, inter alia, a podcast, I would expect such consumers to pay a fairly high degree of attention. Considered in the context I have described, I think one can expect at least a medium degree of attention to be paid to the selection of the applicant's goods in class 9.



Comparison of trade marks

30. 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 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."

31. 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.

32. Although the application is said to consist of a series of two trade marks, as far as I can tell, the two trade marks appear to be identical. Proceeding on that basis, the trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
	

My approach to the comparison

33. In her written submissions, the applicant states:

“7. Each of the marks contains the words ENTRE ELLES which can be translated as the descriptive words “between them”. The words are clearly seen in the applicant’s mark whereas in the opponent’s marks, the stylisation of the word elements obscures the words so that the word elements could be seen as the meaningless elements ENTR and LLES.” (my emphasis)

34. As the applicant’s admits that the opponent’s trade mark may be construed as containing the words “ENTRE ELLES” and as that clearly represents the opponent’s best case, that is the basis upon which I shall proceed, only returning to consider the alternative position if it is necessary for me to do so.

Overall impression

The opponent's trade mark

35. Proceeding on the basis indicated above, the applicant accepts that the first character in the opponent's trade mark (i.e. that which is followed by the letters "N-T-R") may be construed as a letter "E", as may the interlocking devices presented one above the other in the colours white and black (which appear in the yellow rectangular device). As consequence, the opponent's trade mark may be construed as containing the stylised words "ENTRE ELLES". Given their size and positioning, these words will make an important contribution to the overall impression conveyed. Despite its central positioning, the yellow rectangular device will make at best a modest contribution to the overall impression.

36. The opponent's trade mark also contains a component which consists of the letters "W-E-B-Z-I-N" all of which are presented in block capital letters in the colour purple. These letters are followed by a further character also presented in purple. In her submissions, the opponent states:

"17. The Opponent's Mark contains the word 'WEBZINE' which is a juxtaposition of the words 'web' and 'magazine' and is commonly used to describe a magazine which is accessible via the internet. As such, this element of the Opponent's Mark is descriptive of the services registered and is not capable of performing a distinctive function within the mark... Due to its descriptive nature and its insignificant positioning and presentation in the Opponent's Mark, it is unlikely to be recalled by the average consumer and it is unlikely a consumer will pronounce this word when referring to the Opponent's Mark and services."

37. As her submissions above indicate, the applicant accepts that the two devices appearing in the yellow device may be construed as the letter "E". Proceeding on that basis, it follows that the device which appears after the purple letter "N" may also be construed as a letter "E" and, as a consequence, the totality would, as the

opponent submits, be construed as the word “WEBZINE.” I note that collinsdictionary.com defines “webzine” in the manner the opponent suggests.

38. However, even if the average consumer was unfamiliar with that meaning, for the reasons the opponent suggests, I think it highly likely that that is the initial impression they would reach on seeing the word for the first time. Given its size and positioning within the trade mark as a whole, any impact this word may have on the overall impression conveyed will be very limited and is in any case likely to be descriptive/non-distinctive in nature. Considered overall, it is the components that the applicant accepts may be understood as the stylised words “ENTRE ELLES” that will make by far the greatest contribution to both the overall impression conveyed and the trade mark’s distinctiveness.

The applicant’s trade mark

39. This consists of a number of components. The first, is the device of four stylised female characters presented in the various colours shown. Given the size and positioning of the device, it will make an important contribution to the overall impression conveyed. Below this device there appears the second component i.e. a smaller device presented in the colour red, which I am satisfied the average consumer will construe as a stylised device of a microphone. Despite its relative size in relation to the device which appears above it, its central positioning results in it making a not insignificant contribution to the overall impression.

40. The third and fourth components consist of words which are presented either side of the device of a microphone. The first word, “Entre”, is presented in title case in a black slightly stylised but unremarkable font. The second word contains the letters “e-l-l-e-S” presented in red in a stylised bold cursive script with the letters “e-l-l-e” presented in lower case and the final letter “S” presented in what appears to be upper case and in which the tail of the letter “S” has a flourish. Notwithstanding their stylisation, it is the words themselves that will make an important contribution to the overall impression conveyed. The final component consists of a horizontal red line which radiates from the centre of the device of a microphone and serves as an underlining for the words which appear above it. Even if noticed by the average

consumer, it will have little or no impact on the overall impression conveyed. Considered overall, the first component and the combination of the third and fourth components will make a roughly equal contribution to the overall impression conveyed and it is in those components the bulk of the trade mark's distinctiveness lie.

Visual similarity

41. The competing trade marks contain components which may be construed as "ENTRE ELLES"/"Entre elleS". There are, however, various differences between them, most importantly in my view, the device of four female characters in the applicant's trade mark and, to a lesser extent, the stylisation of the words themselves. Weighing the various similarities and differences, there is what I regard as a between low and medium degree of visual similarity between the competing trade marks.

Conceptual similarity

42. The yellow device component in the opponent's trade mark is unlikely to create any concept in the average consumer's mind. The component which will be construed as the word "WEBZINE" will convey a purely descriptive conceptual message. In her submissions, the opponent argues that the device in the applicant's trade mark depicts "four ladies who appear to be chatting in front of a microphone." That, I think, is a fair assessment of the concept likely to be conveyed by the device.

43. The parties agree that if construed as words in the French language the words "ENTRE ELLES" translate as "between them." However, while the opponent argues that the number of average consumers who will recognise this meaning is "small", the applicant argues (by reference to guidance contained in the UK Manual of Trade Mark Practice²), that the words "are common words that the average UK consumer

² The UK Manual of Trade Mark Practice is used as a guide by The Trade Marks Registry when determining if a trade mark is, inter alia, distinctive during the examination phase of an application.

would be able to recognise and interpret.” I accept that as French is routinely taught in schools in the UK, many average consumers are likely to have a basic understanding of the language and many may recognise this meaning. For those consumers the words “ENTRE ELLES” are likely to create a unit having the meaning the parties suggest and to that extent are conceptually identical.

44. While for the not-insignificant number of average consumers in the UK who are non-French speakers, the combination of the words are unlikely to convey any concept, given, in particular, its visual similarity to the English language word “ENTER”, the word “ENTRE” may evoke the concept of entering. Considered overall, for UK consumers familiar with French there is at least a medium degree of conceptual similarity and for non-French speakers, a between low and medium degree of conceptual similarity (the latter resulting from the concept likely to be evoked by the sharing of words which may be construed as relating to entering).

Aural similarity

45. It is well-established that when a trade mark consists of a combination of words and figurative components it is by the word components the trade mark is most likely to be referred to. I agree with the opponent that the word in her trade mark which will be treated by the average consumer as the word “WEBZINE” is, given its positioning and descriptive/non-distinctive nature, unlikely to be verbalised when her trade mark is referred to. As a UK consumer familiar with French is most likely to verbalise the words “ENTRE ELLES” in the competing trade marks in line with standard French pronunciation, it will result in aural identity, as it is likely to for a non-French speaker who is, in my view, most likely to verbalise the words as “EN-TRAY-ELS”.

Distinctive character of the earlier trade mark

46. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade 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 trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

47. As the opponent has filed no evidence of any use she may have made of her earlier trade mark, I have only its inherent characteristics to consider. In her submission, the applicant states:

“19. The Collins Dictionary translates the word ENTRE as “between” or “among” and the word ELLES as “they” or “them”...the terms would be readily translated by the average English consumer to the descriptive term “between them”. The word elements of the trade marks have, therefore, at best a low level of distinctive character and would probably be seen as a descriptive phrase in relation to the goods and services in question.” (my emphasis)

48. As I mentioned earlier, as the average consumer is likely to treat the word which will be construed as “WEBZINE” as descriptive/non-distinctive, it adds nothing to the trade mark’s distinctiveness. For non-French speaking average consumers, other than a possible reference to entering, the words “ENTRE ELLES” are unlikely to have any meaning and will be neither descriptive of nor non-distinctive for the services being relied upon. As a consequence, those words and the opponent’s trade mark as a whole are distinctive to a fairly high degree. However, even for those average UK consumers familiar with French and for whom the words may form a unit meaning “between them”, the applicant appears to accept the words have some distinctive character. However, I see no obvious reason why, as the applicant suggests, the combination of words would “probably be seen as a descriptive phrase in relation to the goods and services in question”, nor do I regard the words as being obviously non-distinctive. For such consumers, the words are inherently distinctive to at least a medium degree as is the opponent’s trade mark as a whole.

Likelihood of confusion

49. 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 services and vice versa. As I mentioned above, 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 and services, 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.

50. 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/services down to the responsible undertakings being the same or related.

51. Earlier in this decision I concluded that:

- the applicant's goods in class 9 are similar to named services in the opponent's specification in class 41 to a between low and medium degree;
- the applicant's services in class 41 are to be regarded as identical to named services in the opponent's specification in the same class;
- the average consumer of the goods and services at issue is either a member of the general public or a business user;
- whilst not ignoring aural considerations, such average consumers are likely to select the goods and services at issue by predominantly visual means whilst paying at least a medium degree of attention during that process;

- my comparison of the trade marks is based upon the applicant's admission that the opponent's trade mark may be construed as containing the words "ENTRE ELLES";
- the competing trade marks are visually similar to a between low and medium degree;
- the competing trade marks are conceptually similarity to at least a between low and medium degree;
- the competing trade marks are aurally identical;
- the earlier trade mark is inherently distinctive to at least a medium degree.

52. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained the difference between direct and indirect confusion. He stated:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

53. I begin by noting that the decision in *LA Sugar* only represents examples of when indirect confusion may be relevant (see in this respect the decision of the Court of Appeal in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 at [12]). I also note that 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 trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

54. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said

in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

55. In other words, simply considering the level of distinctive character possessed by the earlier trade mark is not enough. It is important to ask “in what does the distinctive character of the earlier trade mark lie?”. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

56. As I mentioned earlier, in her written submissions, the applicant makes a number of references to what she regards as the descriptive nature of the words “ENTRE ELLES”, including the following:

“33. The identity of the word elements in the respective marks does not automatically lead to an assumption of indirect confusion. The word elements are not distinctive and so could be seen as a description of the content of the podcasts or webzines of the respective parties rather than as an indicator of origin.”

57. I note that in *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier

mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

58. As the applicant accepts that the opponent’s trade mark may be construed as containing the words “ENTRE ELLES” and as the applicant’s submissions on the distinctiveness of the words “ENTRE ELLES” are predicated upon them being read and understood by the average consumer as meaning “between them”, it is there I shall begin. Despite my earlier findings, I shall consider the likelihood of direct confusion on the basis most favourable to the opponent i.e. that the competing goods and services are identical, the average consumer will pay a low degree of attention during the selection process (making him/her more prone to the effects of imperfect recollection) and the words which will be construed as “ENTRE ELLES” are highly distinctive. However, even proceeding on that basis, having concluded that the visual aspect of the comparison is the most important and as the visual differences between the competing trade marks (in particular the presence of the device of four stylised female characters) is most unlikely to go unnoticed by the average consumer, the likelihood of direct confusion is, in my view, remote.

59. That leaves indirect confusion to be considered. When approached from the perspective of a UK consumer who is familiar with French, the presence in the competing trade marks of the words “ENTRE ELLES” results in aural identity and at least a medium degree of conceptual similarity. I must, of course, also factor in the between low and medium degree of visual similarity, the identity/between low and medium degree of similarity in the goods and services at issue and the at least medium degree of inherent distinctiveness the earlier trade mark enjoys.

60. Having done so, despite my earlier findings, I shall proceed on the basis that the applicant’s goods in class 9 are only similar to the opponent’s services to a very low degree and the words “ENTRE ELLES” in the opponent’s trade mark have, to use the applicant’s words “at best a low level of distinctive character”. However, even

proceeding on that basis, having factored in the guidance in *L'Oréal*, I am satisfied that even an average consumer paying a high degree of attention is, given the presence of the words "ENTRE ELLES" in both trade marks, likely to conclude that the applicant's trade mark is, for example, a variant/updated version of the trade mark being used by the opponent or by an undertaking linked to the opponent. As that is likely to result in indirect confusion, the opposition succeeds.

61. When considered in relation to those average UK consumers who are non-French speakers, for the reasons mentioned earlier, I reach the same conclusion in relation to direct confusion. Notwithstanding the lower degree of conceptual similarity, the degree of visual similarity, aural identity and the fairly high degree of distinctiveness the earlier trade mark enjoys, combine to lead to the same conclusion in relation to indirect confusion.

Overall conclusion

62. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

63. As the opponent has been successful, she is entitled to a contribution towards her costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice 2 of 2016. I remind myself that the original opposition was also based upon sections 5(3) and 5(4)(a) of the Act (which attracted a filing fee of £200). However, as the opponent elected to abandon her grounds of opposition based upon sections 5(3) and 5(4)(a) and as an opposition based upon section 5(2)(b) of the Act only attracts an official fee of £100, I award costs to the opponent on the following basis:

Filing the Notice of opposition and reviewing the counterstatement:	£200
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Official fee:	£100
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Written submissions: £200

Total: £500

64. I order Tombany Kouloufoua to pay to Madame Marie Rousselet the sum of **£500**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of December 2021

C J BOWEN
For the Registrar