BL O/0181/26

TRADE MARKS ACT 1994

IN THE MATTER of

UK Trade Mark Application No. 3753130 for the series of three trademarks ELLISSElliss and elliss in class 25 by Elliss Studio Ltd (the "**Respondent"**)
and

UK Trade Mark Application No. 3760944 for ELISS in class 25 by Elliss Studio Ltd
AND IN THE MATTER of

Oppositions thereto by Ellesse International SpA (the "**Appellant"**)

DECISION

INTRODUCTION

1. This is an appeal from the decision of Hearing Officer Ms. Judi Pike acting for the Registrar of Trade Marks (the **"Decision"**) dated 21 November 2023.

2. The Decision relates to two Oppositions brought by the Appellant in respect of the following trade mark applications (collectively the **"Respondent's Marks"**):
    a. application no. 3753130, for the series of marks ELLISS, Elliss and elliss for *clothing* in class 25, and
    b. application no. 3760944 for ELLISS for *shoes; clothes; headgear; headwear* in class 25.

3. The Appellant opposed both applications under section 5(2)(b) TMA, relying

upon: (i) UK trade mark no. 1279236 for ellesse, and (ii) UK trade mark no. 900069260 for ELLESSE (the **"Earlier Marks"**). The earlier marks were both registered in respect of goods that included *inter alia* articles of clothing, footwear and headgear in class 25.

4. The Appellant's oppositions failed in their entirety; the Hearing Officer concluding that there was no likelihood of direct or indirect confusion.

STANDARD OF APPEAL

5. The approach I should adopt on this appeal was summarized by Mr. Daniel Alexander KC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* [2017] RPC (17) 655 (AP), at [14]-[56] and subsequently approved and applied by Joanna Smith J in *Axogen v Aviv* [2022] EWHC 95 (Ch) as follows:

> "24. Although I was referred to numerous cases on the subject …, the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
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> i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
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> ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);
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> iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);
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> iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum

and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], REEF at [28] and Fine & Country at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], Actavis Group at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (Shanks at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], Fage at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

6. This appeal includes considerations of criticisms of the Hearing Officer's evaluative decisions. I therefore also bear in mind the guidance given by the

Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 (albeit I understand this guidance to be consistent with the decision in *Axogen*), where Lords Briggs and Kitchin explained at [49]-[50]:

> "… on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.
> On the other hand, it is equally clear that, for the decision to be "wrong" under CPR 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."

7. Finally, I note that disagreements about the precise "weight" to be given to a factor has been consistently rejected as a proper ground of appeal (see Ian Purvis KC, sitting as the Appointed Person in BL-0-106-20 *GREYBOX).*

GROUNDS OF APPEAL

8. There were eight distinct grounds of appeal. I will refer to them, as the Appellant did, by reference to the paragraph numbers in which they appear in the Grounds of Appeal document, that is to say as grounds 6(a) – 6(h).

Ground 6(a): *failure to properly account for high level of distinctiveness of the Earlier Marks*

9. The Hearing Officer found that the evidence established that Earlier Marks had acquired an enhanced degree of distinctive character through use (in addition to their high degree of inherent distinctive character). Under this ground the Appellant criticized the Hearing Officer's subsequent failure to refer to that evidence expressly when considering the likelihood of confusion.

10. The Hearing Officer addressed the likelihood of confusion at paragraph 42 of the

Decision. The central section of that paragraph states as follows (emphasis added):

> However, as I said earlier in this decision, the oppositions fail. This is because, despite the goods being identical and the earlier marks being highly distinctive, the balance of the other factors in the global assessment which I have considered throughout this decision means that there is no likelihood of confusion.

11. It is therefore clear that the Hearing Officer did have well in mind her finding that the Earlier Marks had acquired an enhanced degree of distinctive character. There was at this stage of her Decision, no need for her to refer to evidence which she had relied upon to reach that finding, as that evidence was set out in detail earlier in her Decision.

12. I therefore reject this ground of appeal.

Ground 6(b): *impermissible partitioning of the marks in issue*

13. Ground 6(b) is directed to the following finding by the Hearing Officer:

> 34. The earlier marks consist of seven letters and the applicant's marks consist of six letters. Both marks start with ELL and both have SS following the middle vowel. The middle vowels are I/E or i/e which look very different. The earlier marks also have a final E/e which is absent from the contested marks. The earlier marks have three letter Es and the later mark has only one. The earlier marks have a sort of symmetry in that there is an E at the beginning, middle and end of the mark. There is nothing symmetrical about the contested marks. Balancing the similarities and differences, the marks have a low to medium degree of visual similarity.

14. The Appellant submits that this finding is based on an artificial, and therefore impermissible, dissection of the marks. It submits that had the Hearing Officer directed herself properly she would have concluded that the marks had a high level of visual similarity.

15. In my view the fact that the Hearing Officer compared the visual similarities and differences of the marks cannot in and of itself lead to the conclusion that

she has taken an impermissible approach. The Hearing Officer was required (as she directed herself in the previous paragraph of her Decision, paragraph 33) to make her comparison taking into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. To do this it was, in my view, inevitable that she would have to set out the sort of analysis she did in paragraph 34 of the Decision. There is therefore no error of principle in her approach.

16. In the absence of the identification of a distinct error of principle, the question I therefore have to decide is whether the Hearing Officer's decision was one which no reasonable Hearing Officer could have reached. There is considerable force in the submission that the visual comparison of marks does not reveal a low-medium degree of similarity. However, I do not believe that this submission is so clearly established as to be one that no reasonable Hearing Officer could reach. I therefore, with some hesitation, dismiss this ground of appeal.

Grounds 6(c) and 6(d)*: erroneous analysis of conceptual similarity*

17. These grounds relate to the Hearing Officer's findings at paragraphs 36-38 of the Decision. These state:

> 36. I bear in mind that sometimes invented words can be evocative. The earlier marks start with 'elle' which is a French word meaning 'she'. In combination with the 'sse' ending, the earlier marks have a French look about them. However, there is still no meaning overall, even if consumers know what 'elle' means.
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> 37. Ms Solomon's given name is ELLISS. She says that this spelling is unique as a given name, but that ELLIS is common as a name. It is certainly common as a surname and I have heard it used as a forename. In my view, the additional S at the end will not prevent consumers from perceiving it as a name, and likely a variation on the more conventional spelling with one S. This is why they are likely to verbalise it as they would if it was the common name ELLIS.

> 38. There is therefore a degree of conceptual difference between the marks; although names do not have meanings as such, there is nevertheless a difference in conceptual impression between an invented word and a known name. The very purpose of names is to distinguish people. However, I bear in mind that not everyone will see the contested marks as names and will see them as invented words. For this group of consumers, the parties' marks are conceptually neutral.

18. The Appellant's primary submission is that the Hearing Officer did not consider conceptual similarity from the perspective of the notional average consumer at all.

19. That submission is, in my view, clearly incorrect. At paragraph 27 of the Decision the Hearing Officer recorded that the average consumer was a member of the general public who exhibited a medium degree of attention. The Hearing Officer then referred to the well-known decisions in *Sabel BV v. Puma AG* and Case C-591/12P, *Bimbo SA v OHIM*, both of which make clear that the visual, aural and conceptual comparisons are to be made by reference to the notional average consumer. Given this there is no basis to conclude that the Hearing Officer did not have clearly in mind that she was to assess conceptual similarity from the perspective of the notional average consumer. Of more note is the Appellant's submission that she failed in any event to complete that analysis properly. The Appellant submits that the two groups of consumers referred to at [38] of the Decision are entirely nebulous, as the Decision does not explain which group is in the majority, or of significant enough size to influence an assessment of how the notional average consumer would perceive the marks conceptually. In my view there is force in this criticism. However, the difficulty with the Appellant's submission is that, even if accepted, it does not assist its case in relation to likelihood of confusion. The relevant part of the Decision is found in paragraph 44:

> The French feel of ELLESSE, the symmetry of the three letter Es and the impression that ELLISS is a name will further remove the potential for confusion. However, even if the marks are entirely conceptually neutral (with no evocation of being a French word or of a name), they are far enough away visually, even for identical goods and for highly distinctive earlier marks, to avoid one being mistaken for the other. The average consumer will not pay so little attention in looking at the goods bearing the marks that they will make the sort of mistake which leads

to direct confusion.

20. The Hearing Officer has therefore considered both potential groups of consumer and then found that neither would be confused.

21. To overcome this problem the Appellant submits that the Hearing Officer's finding in relation to confusion in the case of conceptual neutrality has been coloured by her finding of conceptual dissimilarity. There is in my view no analytical basis for such a finding and nor did the Appellant able to suggest one.

22. Overall, whilst the Hearing Officer's analysis of conceptual similarity might have been more completely and clearly worded, there is no adequate basis in my view to interfere with her findings of a likelihood of confusion as a result of this analysis. I therefore dismiss these grounds of appeal.

Grounds 6(e) and 6(f): *erroneous analysis of the nature of the purchasing process*

23. The heart of these grounds is the submission that the Hearing Officer erred in finding that the average consumer would pay a medium degree of attention to "*quality, material, fit, suitability and aesthetics*".

24. The Appellant submitted that the Hearing Officer concluded correctly that there would be a number of avenues through which products sold under the parties' marks could be purchased, namely "*displays in shops, or from catalogues and websites*". However, it submitted that the Hearing Officer failed to take adequate note of the differences in opportunity of examination between online shops (where no physical examination could be made) and physical shops (where it could). On this basis it submitted that the Hearing Officer ought to have found that a low level of attentiveness would be exhibited in relation to online purchases.

25. I reject this submission. It is undoubtedly correct that the purchasing process is different online and in shops. It is also undoubtedly correct that some aspects of a products characteristics can only be examined physically. If the purchasing

process was dominated by a detailed examination of the surface feel of a product, then there would, in my view, be force in the Appellant's submission. However, the Hearing Officer found (and this was not materially challenged) that the purchase decision was made primary visually (see Decision paragraph 27). I therefore find that there was no error of principle in the Hearing Officer's approach.

26. As I have found there to be no error of principle in the Hearing Officer's approach the remaining question is whether I should interfere with her evaluative decision. In my view I have no proper basis to do so as her decision fell within the range of decisions a reasonable Hearing Officer could have reached.

27. The Appellant also submitted that the Hearing Officer, having found that there would be an aural dimension to the purchase process, failed to take into account adequately the aural aspect of the purchasing process when considering the likelihood of confusion.

28. The Hearing Officer addressed the aural dimension of the purchase process at paragraph 28 as follows:

> Therefore, whilst I do not discount an aural dimension to the selection process, it is the visual selection which is the most important consideration.

29. At paragraph 35 she addressed the aural comparison and found as follows:

> Various submissions have been made as to how the earlier marks would be pronounced, such as enunciating the final 'e', so that the marks sound like el-ess-ee or el-ess-ay, or without the final 'e': el-ess. My view is that the average UK consumer will pronounce it without articulating the final 'e', as in 'finesse'. The emphasis will be on the middle vowel: el-ess'. For reasons I will come to, the average UK consumer is likely to pronounce the contested marks as two syllables, with the emphasis on the first vowel: e-liss. The middle vowels sound more similar than they look. Taking this into account with the different vowel/syllable emphasis in speech, they are similar aurally to a medium degree. However, if the emphasis is on the second vowel (the 'i'), this results in an above-medium degree of aural similarity.

30. In that context I do not think the Hearing Officer unreasonably ignored the aural dimension in her summary findings on the likelihood of confusion at paragraph 44. That paragraph expressly refers to the relative significance of the aural comparison as follows:

> The applicant has disputed the opponent's submission that the beginnings of words tend to have more visual and aural impact than the ends, but this is set out in case law in El Corte Inglés, SA v OHIM.16 Nevertheless, it is a rule of thumb and each case must be considered on its own facts. It also does not trump the requirement, set out in the authorities cited earlier in this decision, that it is the marks as wholes which must be assessed in deciding whether there is a likelihood of confusion. The visual differences between the parties' marks is [sic] important because the consumer will see the marks during purchase, paying the normal degree of attention, even if there is also an aural element to selection.

31. There is therefore no basis to find that the Hearing Officer did not have the aural comparison firmly in mind when assessing the likelihood of confusion. The significance she gave to that comparison is a matter for her evaluative judgment (i.e. a matter of weight that lies within her discretion). There is in my view no basis for me to find that her weighing of the aural vs visual and conceptual factors results in a finding that no reasonable Hearing Officer could have reached.

32. For these reasons I dismiss this aspect of this ground of appeal.

Ground 6(g): *insufficient weight given to evidence of visual similarity*

33. The heart of this ground is that the Hearing Officer failed to give any weight to the result of online searches. These were said to show that when searching third party retail websites by reference to the Earlier Marks, consumers would be presented with search results sold under the marks applied for.

34. The Appellant submitted that such evidence should be given weight as it demonstrated the risk of actual confusion *"due to the high level of visual similarity between the Applicant's Marks and the Earlier Marks"*. This submission was not made on the basis of an ad-words type argument. It was instead made the basis

that the fact the marks would appear alongside (or at least near) each other would, because of their similarity, give rise to a likelihood of confusion. This ground of appeal is therefore primarily parasitic on the arguments raised under ground 6b. This is made plain by the Appellant's skeleton which states:

> However, that was to misunderstand the relevance of such evidence, which plainly demonstrated the risk of actual confusion due to the high level of visual similarity between the Opposed Marks and the Earlier Marks. The Hearing Officer failed to appreciate such high level of similarity because her process of analysing the marks in issue gave undue weight to the minor differences between them.

Given my earlier finding in relation to ground 6b, I can see no error in the Hearing Officer's evaluation of this evidence which would allow me to interfere with it. I therefore dismiss this ground of appeal.

Ground 6(h): *failure to globally assess likelihood of confusion*

35. Ground 6(h) was an omnibus ground advanced on the basis that given the other grounds there was a reasoned basis for finding that the Hearing Officer's global assessment of the likelihood of confusion was incorrect. As I have dismissed the other grounds this ground also fails.

CONCLUSION

36. For the reasons set out above, I dismiss this appeal. No costs pro-forma was provided to the Hearing Officer by the Respondent (who ably appeared in person, as she did here). The Hearing Officer therefore made no order as to costs. I will therefore make no order as to costs.

GEOFFREY PRITCHARD KC
The Appointed Person
9 July 2025

Addendum

This judgment was finalised on 9 July 2025 as stated above. Due to an administrative error that falls only to me, and for which I apologise, it was not circulated to the parties until 4 March 2026.

Geoffrey Pritchard KC