

O-190-11

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2505006
IN THE NAME OF YELP! INC
IN RESPECT OF THE TRADE MARK:**



AND

OPPOSITION (NO 99222) BY YELL LIMITED

TRADE MARKS ACT 1994

In the matter of trade mark application 2505006 in the name of Yelp! Inc and opposition thereto (no 99222) by Yell Limited

THE BACKGROUND AND THE PLEADINGS

1) Yelp! Inc (“Inc”) applied for application 2505006 on 17 December 2008. The application is for a series of four trade marks, all of which, together with the services for which registration is sought, are set out below:



Class 35: Providing business information, namely, compilations, rankings, ratings, reviews, referrals and recommendations relating to business organizations, service providers, and other resources using a global computer network; promoting the goods and services of others via a global computer network, through search engine results and reporting, and by providing hypertext links to the websites of others; providing marketing and promotional consumer information, suggestions and recommendations in a wide variety of fields; compilation, management and maintenance of computer databases in the field of consumer products and services.

Class 38: Providing access to an online interactive website for obtaining and providing users comments concerning business organizations, service providers and other resources; electronic bulletin board, chat room, blog, messaging and web page sharing services.

Class 41: Publishing services all relating to information, namely, compilations, rankings, ratings, reviews, referrals and recommendations relating to business organizations, service providers, and other resources.

Class 42: Hosting an online interactive website obtaining users comments concerning business organizations, service providers, and other resources; providing temporary use of non-downloadable software enabling users to post ratings, reviews, referrals and recommendations relating to business organizations, service providers, and other resources on a website; computer services, namely, providing website content, links and web pages containing content of interest to computer users based on predefined criteria of such users and like-minded individuals; computer services, namely enabling clients to comment on and refine information for website content, links and web pages.

Class 45: Online social networking services; personal services, namely provision of information and advice relating to personal preferences, opinions, likes and dislikes.

2) Yell Limited (“Ltd”) opposes the registration of Inc’s application. The opposition is against all of the marks and all of the services sought to be registered. There is

only one ground of opposition, namely, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under this ground Ltd relies on a number of earlier marks, however, at the hearing that subsequently took place before me, the following two marks were identified by Ltd as representing its best case:

- i) Community trade mark (“CTM”) application 2172682 filed on 10 April 2001 in classes 9, 16, 35, 36, 37, 38, 39, 41 & 42 for the mark:



- ii) UK registration 2451074 filed on 28 March 2007 in classes 9, 16, 35, 36, 37, 38, 39, 41 & 42 for the mark:

YELL.COM

Yell.com

The registration procedure for the above mark was completed on 4 January 2008.

3) As the above marks are put forward as best cases my decision will, accordingly, focus upon them. The proof of use provisions¹ contained in section 6A of the Act do not apply to either of the above marks. The CTM is not yet registered, so, if a decision in Ltd’s favour is made solely on the basis of this mark then such decision will be provisional, dependent on the successful registration of that mark.

4) Inc filed a counterstatement denying the grounds of opposition. Both sides filed evidence. The matter then came to be heard before where Ltd were represented by Mr James Mellor QC, instructed by Bristows, and where Inc were represented by Mr Henry Ward, of Counsel, instructed by Bird & Bird LLP.

THE EVIDENCE

5) During the evidence rounds both parties filed written submission in support of their respective positions. I will not summarise the submissions here, but they are all borne in mind, as are the submissions made by Counsel at the hearing. In terms of the factual evidence, this consists of:

¹ As contained in section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force on 5th May 2004.

Ltd's evidence - witness statement of John Hayward

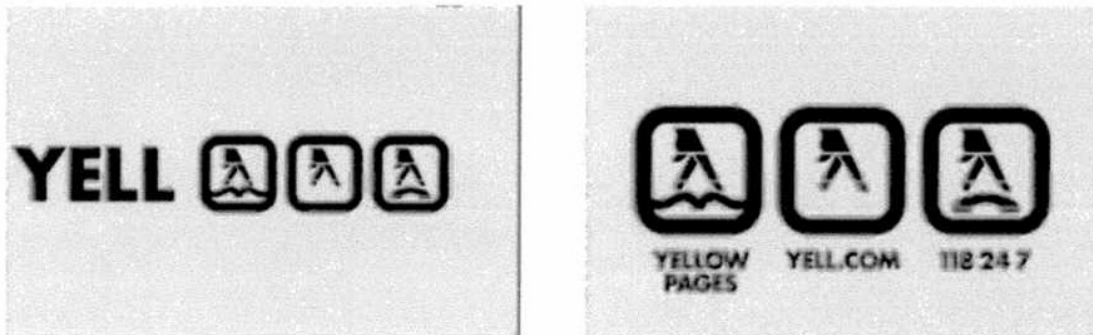
6) Mr Hayward worked for Ltd from 1990 until February 2009. During the majority of this time he was involved in the promotion of Ltd's business. He held a number of positions including Head of Consumer Communications and Head of Marketing Communications. Mr Hayward no longer works for Ltd. He confirms, however, that his evidence comes from his own knowledge or from the records of Ltd to which he was given access.

7) Mr Hayward explains that Ltd always aim for quality advertising and attempts to make its products as famous as possible, so delivering value to its advertising customers. Much of Mr Hayward's evidence details various (and numerous) advertising campaigns that Ltd has run over the years. Significant sums of money are spent on such activities. To highlight this, Mr Hayward states that for the campaigns detailed in his evidence (which date between 1998 and 2010) expenditure was over £83 million. This sum covers, primarily, the media costs involved and not the creative development costs and agency fees; the actual advertising expenditure would, therefore, have been higher.

8) I do not intend to summarise the specific campaigns one by one. I have, though, gone through all of the evidence in detail. It is clear that the campaigns are numerous, high profile and have crossed a number of media forms (Internet, TV, radio, newspaper). What is also clear from the evidence is that there are three main aspects of Ltd's business. It provides business directories in paper form under the sign YELLOW PAGES, it provides a telephone based equivalent under the sign TALKING PAGES and 118 247 and it also provides an Internet based equivalent under the sign YELL.COM. All of these signs are often used in conjunction with a device mark commonly depicting a pair of walking fingers. The scanned image below is taken from one of the exhibits (JEH14) to Mr Hayward's witness statement. It demonstrates a typical form of use of these three business strands:



9) Mr Hayward explains that British Telecommunications (“BT”) previously owned the business but sold it in 2001 to the company that became Ltd. It is further explained that prior to the sale the three business strands were promoted as stand-alone products, but Ltd subsequently began to promote them under the umbrella brand of YELL. Mr Hayward states that the brand draws on the heritage of YELLOW PAGES. To give a feel for the use of the umbrella branding, the following scanned image comes from Exhibit 20 of Mr Hayward’s evidence. The image is taken from a television advertisement run between 2005 and 2006:



10) I will come back to Mr Hayward’s evidence when I come to deal with the substantive issues.

Ltd’s evidence - witness statement of Christian Wells

11) Mr Wells is Head of Legal and Compliance at Ltd. He sets out the history of Ltd’s business, much of which mirrors the evidence already given by Mr Hayward. He makes no specific comment about the use of YELL as an umbrella brand; his evidence focuses more on YELL.COM. He gives some statistics to demonstrate that YELL.COM is well-known. For example, in March 2008 8.5 million unique UK visitors reached the website. YELL.COM has around 2.3 million business listings from around 211,000 advertisers (both as of 20 September 2009). Ltd’s revenue has ranged between £36 and £164 million between the years 2005 and 2009. Ltd has also received a number of industry awards which Mr Wells details.

Inc’s evidence - witness statement of Miriam Warren

12) Ms Warren is Inc’s Head of European Community Management. She explains that Inc was set up in the US in July 2004 and has since then expanded to other countries including the UK in January 2009. It owns a large number of domain names which redirect to www.yelp.com. The service provided on the website is said to be local search, review and social networking which offers users a forum to post their views about local businesses. Users can search for, and read reviews about, local businesses and can communicate with each other. Some pages from the website are provided in Exhibit MRW-2 illustrating such use. It is clear that users can browse for businesses under particular categories

or search for names or types of businesses. The relevant locality can also be entered. Inc also produces a weekly newsletter. The London edition was launched on 24 March 2009 and is currently sent to 23,263 users in London.

13) Businesses can use the website to provide a detailed business description, to provide up-to date information and to announce special offers etc. This is all free. Some enhanced services can be paid for e.g. sponsored advertising at the top of a search result and the use of video etc. The enhanced services are not currently offered in the UK. The businesses on YELP receive weekly emails about page views etc. Inc has a *Twitter* profile and has recently introduced mechanisms for linking its website with other social networking websites such as *Facebook*.

14) In terms of the UK service, this is operated at yelp.co.uk. As stated above, this was launched in January 2009. A press-release preceded the launch. It is stated that over 100,000 people from the UK visited yelp.com in the month before the yelp.co.uk website was launched. Ms Warren states that this prior awareness helped to get Inc established in the UK. Some usage statistics are provided including:

- From mid-April 2009 to the end of 2009 there were some 3,789,533 unique visitors.
- For 2009 as a whole there were 26,463 registered UK users, 44,353 reviews written and 1,908 profiles claimed by businesses.
- For January 2010 to 8 July 2010 there were 4,466,035 unique visitors, 31,737 newly registered UK users, 63,977 reviews written by UK users and 4,068 profiles claimed by businesses.
- £281,600 was spent on promotion in 2009 and £291,000 from January to May 2010.

15) Ms Warren states that YELP is not a contraction of YELLOW PAGES (as claimed by Ltd) but a name that rhymes with help. It is said to reflect a burst of activity and is short and memorable. The device is said to re-enforce this burst of activity message.

16) Inc runs events called Elite Events for its users. 17 were run between 2009 and 2010 which an average of 50 users attended. Inc has also sponsored a number of community events, the details of which show the applied for mark. Inc does not advertise its services directly with advertising companies and relies instead on raising its profile through local communities and event planners.

17) Ms Warren states that no confusion has arisen since Inc started its UK business. I note her comments that:

- One of the community managers indicated that people refer to Yell in discussion but only because they are asking whether Yelp is like Yell.
- Feedback records for Inc have been researched, no confusion has ever been noted.

Inc's evidence - witness statement of Lawrence Donaker

18) Mr Donaker is Inc's Chief Operating Officer. His evidence relates to a meeting that took place in the US between Inc and the company responsible for the YELLOWBOOK trade mark in the US, Yell Group. The suggestion is that this is the US arm of Ltd. The meeting discussed the possibility of the two businesses working together. Mr Donaker explains that there was never a suggestion from Yell Group that there would be any form of confusion. Emails that followed up the meeting are exhibited – there is no mention of any potential for confusion.

DECISION

The legislation and the case-law

19) Section 5(2)(b) of the Act reads:

“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.”

20) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

21) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective services are similar, other factors are relevant including:

The nature of the average consumer of the services in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

The initial parameters of my decision

22) I will, in the first instance, make an assessment and decision on the basis of the class 35 services of the parties which cover the provision of business information (which I take to include the type of services offered by the parties). This approach enables me to deal with a scenario where Ltd is put in its strongest possible position because I will be dealing with identical services in an area where Ltd's reputation will be the strongest. If Ltd cannot succeed in such a scenario then it is unlikely to succeed in respect of any other conflict of services. On the other hand, if Ltd are successful here then I will come back to consider the other services in dispute.

The average consumer

23) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on the particular goods or services in question (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

24) Both parties' evidence provides information as to the nature of the services in class 35 in terms of providing business information. Members of the public are able to search for information about businesses on the parties' respective websites (Inc's also providing user generated reviews). Businesses place their details on the respective websites. This appears to be a paid for service in

respect of Ltd's business but a free service in respect of Inc's service (at least in respect of their non-enhanced services which are, in any event, the only ones currently offered in the UK). The fact that businesses do not have to pay to have a profile or listing on Inc's website does not make that business any less of a consumer than the businesses that use Ltd's service.

25) In view of all this, I consider there to be two distinct average consumers to consider. These are: i) members of the general public who are looking for information about businesses, and ii) businesses who are looking to get information about themselves to the attention of the public. If there is a likelihood of confusion in respect of one or the other of these average consumers then this is sufficient for a successful finding².

26) In terms of the degree of care and attention that such consumers will display when availing themselves of the service, it is likely that the business user will display a greater degree of care and consideration than a member of the general public. A business user will be looking at the most appropriate and best means of getting information about the business to the attention of the public. Issues of cost, reputation (of the service provider) and visibility will come into play. I consider that a slightly higher degree of care and attention than the norm will be displayed.

27) In terms of a member of the public wishing to avail themselves of such a service, I do not consider that the degree of care and attention will be any higher than the norm given that the service will ordinarily be free and it is not likely to represent a particularly considered choice. That said, the reliability and accuracy of the information together with a desire to use a service provider likely to generate a wide range of results when searching for information on businesses means that the degree of care and attention is unlikely to be materially less than the norm. A normal degree of care and attention by a reasonably observant and circumspect member of the public will be displayed.

Comparison of services

28) As stated earlier, I will consider the position from the perspective of the class 35 services relating to the provision of business information. Inc's relevant term reads:

"Providing business information, namely, compilations, rankings, ratings, reviews, referrals and recommendations relating to business organizations, service providers, and other resources using a global computer network"

² See, for example, case T-256/04, *Mundipharma AG v OHIM*.



29) Ltd's relevant terms (in respect of both earlier marks identified earlier) includes:

“...provision, of business and commercial information....”.

30) Inc's term falls within the ambit of Ltd's term. They are worded in almost identical ways albeit Inc's term names the manner in which the services are provided. The services are considered identical.

Comparison of marks

31) Inc's application is for a series of four marks. I will make the comparison on the basis of the mark in which both the word and the device element are depicted in black. Mr Ward stated that whether the device element is in black, red or some other colour it is still important. As such, there was no suggestion that there was any material difference between any of the applied for marks which would make a difference to the comparison. I agree. In any event, colour in the applied for mark cannot act as a distinguishing feature from the earlier mark, the earlier mark also being in black and white³. For ease of reference, the competing marks are depicted below:

Inc's mark	Ltd's mark
 The logo for Yelp, featuring the word "yelp" in a lowercase, sans-serif font, followed by a stylized six-pointed starburst icon.	 The logo for Yell, featuring a large, bold, square outline icon to the left of the word "YELL" in a bold, uppercase, sans-serif font. Below this, the text "YELL.COM" is written in a smaller, uppercase, sans-serif font, and "Yell.com" is written in a bold, lowercase, sans-serif font.

32) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

³ See *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, O-246-08, and *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

33) Mr Mellor was keen to stress the importance of the overall impression of the marks and that, in his view, the marks under comparison would be dominated by the words YELP and YELL to such an extent that the other elements would play very little or, indeed, no part at all in the overall impression made on the average consumer. Mr Ward, on the other hand, stressed that the other elements in the respective marks played a role in their overall impressions and that, therefore, they should not be ignored from the analysis. In *Shaker di L. Laudato & Co. Sas* the CJEU stated:

“39 On the basis of those considerations, the Court of First Instance, in the context of the analysis of the signs at issue, firstly held that the mark for which registration was sought contained a dominant element comprising the representation of a round dish decorated with lemons. It then inferred, in paragraphs 62 to 64 of the judgment under appeal, that it was not necessary to examine the phonetic or conceptual features of the other elements of that mark. It finally concluded, in paragraph 66 of the judgment, that the dominance of the figurative representation of a round dish decorated with lemons in comparison with the other components of the mark prevented any likelihood of confusion arising from the visual, phonetic or conceptual similarities between the words ‘limonchelo’ and ‘limoncello’ which appear in the marks at issue.

40 However, in so doing, the Court of First Instance did not carry out a global assessment of the likelihood of confusion of the marks at issue.

41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42 As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

34) In view of the above guidance, it would only be possible to make the comparison solely on the basis of the words YELL/YELP if I were satisfied that the additional aspects of the respective marks were negligible. I am far from satisfied that that is the case. Nevertheless, I agree with Mr Mellor that the words YELL and YELP constitute the dominant and distinctive elements of the

respective marks. In terms of Inc's mark, whilst it also has a device element which is distinctive in its own right, this element plays a subordinate role in its overall impression on account of its positioning, its slightly lower contribution to the visual aspect of the mark (than YELP) and that it plays no role in its aural and conceptual aspects. I agree with Mr Mellor that, in this case, the rule of thumb that words speak louder than devices applies. Although the device element is not the dominant and distinctive element it still, though, constitutes a dominant element of the mark, it is simply less dominant (but not to a huge degree) than the word.

35) A similar assessment can be made in respect of Ltd's marks. Ltd's word and device mark is dominated more by the word YELL than by the device element. Although the device is positioned first, it does not stand out as a particularly distinctive device. More attention will, again, be placed on the word element which I consider will dominate the overall impression to a strong degree (although not to the point where the device is completely negligible). In respect of the YELL.COM mark, the .com aspect will be so familiar to the average consumer as simply being a domain level indicator that YELL also dominates quite strongly here.

36) I will consider firstly the visual perspective. The points of similarity are contained within the dominant and distinctive elements of the respective marks (YELL and YELP). I must bear in mind that these elements are relatively short words. The first three letters (YEL) being the same, but the fourth letters being different (L/P). However, the impact of the different letter is by no means lost in the overall impression of the marks. I also note the comments of the GC in *Inter-Ikea Systems BV v OHIM* where it was stated:

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

55 Accordingly, the degree of visual similarity of the earlier word marks and the verbal element of the contested mark must be described as low."

37) The above judgment relates to the words IDEA/IKEA. In the case before me the difference (at least between YELL and YELP) is at the end of the words rather than towards the beginning, a point highlighted by Mr Mellor. However, the point made by the GC still applies. In short words, differences in the letters, even if at the end of those (short) words, are likely to stand out more. The difference is less likely to be overlooked. I must also factor in the further visual differences

created by the device elements of the respective word and device marks and the additional wording in YELL.COM. Even though YELL and YELP may be the dominant and distinctive element, these differences should not be ignored completely from the analysis. I come to the view, based on all these factors, that there is only a low degree of visual similarity.

38) Similar considerations apply to the aural comparison, albeit the device elements play no role in the likely pronunciations. The shortness of the words YELL and YELP means that the difference created by the final letters and their impact on the respective pronunciations is unlikely to be lost or overlooked. The P in YELP creates an additional aspect of articulation YEL-P. The addition of “.com” in YELL.COM provides a further point of difference, although I must, of course, bear in mind my earlier assessment regarding the distinctiveness of the .com element. Overall, I consider there to be a moderate degree of aural similarity.

39) When considering the issue of conceptual similarity, the following explanation from *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] helpfully sets out the position:

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

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

40) The above is a judgment of the GC, the CJEU has made similar findings on a number of occasions⁴. For a conceptual meaning to be relevant it must be one

⁴ See, for example, Case 361/04P (*Picaro/Picasso*).

capable of immediate grasp. A conceptual difference occurs when one mark has a meaning which is not shared by the other. I should, though, be careful not to assume too readily the degree of knowledge that the average consumer may or may not possess⁵.

41) Both the words YELL and YELP are known English dictionary words. I will come on to their meanings shortly. I do not consider that the additional aspects of the marks under comparison add to, or detract from, the conceptual significances that the average consumer will perceive. However, I must deal with the submission made by Mr Ward where he argued that the conceptual significance of the word YELL in Ltd's earlier marks was not of the known English dictionary word but was, instead, as a word designating or being short for YELLOW PAGES. This submission is based on the link between YELL and the YELLOW PAGES business. Mr Ward highlighted the continual and strong link demonstrated in Ltd's evidence between them. As stated earlier, I have considered the evidence in detail and I earlier described YELL.COM as the online equivalent of YELLOW PAGES. I also note that Mr Hayward, on behalf of Ltd, stated that YELL draws on the heritage of YELLOW PAGES. The use made by Ltd is a relevant consideration to bear in mind when deciding upon the concept that the average consumer will perceive⁶.

42) Having assessed the evidence, I come to the view that some consumers (the minority) may not appreciate the link with YELLOW PAGES, particularly those who do not know of the longstanding history of the business. However, I accept that it is likely that the average consumer (both businesses and the public) will be aware of and will appreciate the link. Although, as pointed out by Mr Mellor, there are three separate strands to the business, I think Mr Ward is right when he submitted that the evidence paints a compelling picture of the link between YELLOW PAGES and YELL/YELL.COM. This is clearly intentional given Mr Hayward's comments about drawing on the heritage of the YELLOW PAGES brand. That being said, even if the average consumer perceives the link and that he or she understands that the website providing business information at YELL.COM is the online equivalent of the paper based YELLOW PAGES, and even if he or she assumes that the YELLOW PAGES name played a part in the genesis of the YELL name (the borrowing of the first four letters of YELLOW), it is another thing altogether for the average consumer to set aside the concept that would ordinarily underpin the word YELL. Mr Ward stated that it was not about displacing the primary meaning of the word YELL because the primary meaning, when the mark is considered against the services in question, has always been

⁵ See, for example, the decision of Anna Carboni (sitting as the Appointed Person) in *Chorkee* (BL O-048-08).

⁶ By way of analogy, in a case involving the device of an alligator (BL O-333/10) Mr Hobbs QC (sitting as the Appointed Person) agreed with the hearing officer's view that the device in question was inextricably linked to the word LACOSTE so that that word would be applied to the picture both mentally and vocally.

based on the way in which the YELL business arose and the way in which it is promoted. Whatever way one looks at it, I must be satisfied that the use made by Ltd will have resulted in the primary meaning (in the context of the services) of the word YELL being YELLOW PAGES. I do not consider this to be the case. The average consumer may be aware of the link and may be aware of the likely genesis, but he or she is still likely to immediately recognize the word for what it is (an English dictionary word) and this is how it will be stored away for future recall. In any event, I agree with Mr Mellor that any danger of what Mr Ward submitted occurring will have been countered, to a large extent, by the advertising and promotion that has taken place, on numerous occasions, which emphasises the word YELL as the word itself (see Exhibits JEH4, JEH6, JEH7, JEH8, JEH9, JEH23, JEH25, JEH26, JEH46, JEH47, JEH48, JEH49, JEH51 & JEH52). In these Exhibits YELL/YELL.COM is used, for example, as part of a sentence or phrase e.g. "Don't search, just Yell.com"

43) The conceptual comparison must, in view of the above analysis, be based on the words YELL and YELP in accordance with their normal meanings. In its written submissions Ltd provided a number of definitions from a number of dictionaries. I summarise them below:

YELP

Cambridge Dictionaries Online: *Verb* "to make a sudden, short, high sound, usually when in pain".

The Oxford English Dictionary: *Verb* "to utter a yelp or yelps; said of dogs and related animals, and certain birds", "to complain, whine", "to utter with a loud cry; to express by yelping or in a yelping tone", "to bring into some condition by yelping" *noun* "a cry characteristic of dogs and some other animals, resembling a bark but distinguished from it by being sharp and shrill".

YELL

Cambridge Dictionaries Online: *verb* "to shout something or make a loud noise, usually when you are angry, in pain or excited.

The Oxford English Dictionary: *verb* "to utter a loud or stringent cry, esp. from some strong and sudden emotion, as rage, horror or agony", "of certain birds or beats: To emit a loud cry, either as their natural utterance or when hurt of from rage", "applied to loud singing or chanting", "to urge on by yelling", "to utter with a yell". *Noun*, "an act of yelling; a sharp loud outcry, such as described s.v. YELL", "of animals", "an outcry in writing e.g. in a newspaper", "a cry consisting of a set of words or syllables shouted on certain occasions, as by American college students", *slang* "something or someone extremely amusing; a joke, a "scream".

44) Ltd's summary of the above concepts was that YELP related to the making of a sound, usually when in pain and YELL was a loud noise or sound. The submission was, therefore, that both words describe a sound or noise, sometimes made when a person or animal is in pain.

45) The assessment must be made from the perspective of the average consumer. There is unlikely to be any difference in perception between the two different average consumers identified earlier. It is the immediate grasp of the average consumer that it is important. It must also be borne in mind that the average consumer will not be armed with a dictionary. It is true, though, that both the word YELL and YELP relate to noises or utterances. In my view, yell will be perceived as someone, usually a person, shouting – they will normally be yelling at someone or something. Yelp, on the other hand, is the noise itself. It will most commonly be perceived as the noise that a dog or other animal will make when in pain. A yelp will not necessarily be loud, there is no reason why an animal cannot yelp quietly. Bearing all this in mind, whilst there is a degree of similarity on a certain level of generality, the words are still distinct and different English words. I consider there to be a moderate, neither high nor low, degree of conceptual similarity.

Distinctiveness of the earlier mark

46) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent point of view the earlier mark possesses a reasonable degree of distinctiveness. The word YELL is a common English word. It could be argued that it has a slight degree of suggestiveness in respect of the service (one may “yell” for information) but this does little, in my view, to reduce its capacity to distinguish Ltd's services from those of others.

47) The evidence filed also paints a compelling picture that the earlier marks are entitled to an enhanced degree of protection. The YELL.COM mark has been used both as the domain name of Ltd's business but also promoted as a trade mark in its own right. The word and device mark has also been used, however, I note from the evidence that the square device often contains the “walking fingers” logo. It is clear, though, that part of a mark can gain distinctiveness through the use of another⁷. I have little hesitation in concluding that both marks should be regarded as highly distinctive.

48) I should mention here the submission of Mr Ward, who picked up the submissions made in writing by Inc's representatives, that despite such heavy promotion, this did not mean that confusion was more likely. The first argument was based on the heavy link between YELL and the YELLOW PAGES branding.

⁷ See case C-353/03 *Société des produits Nestlé SA v Mars UK Ltd*.

I have already dismissed this argument when it came to conceptual meaning – the same point remains - even if the average consumer was aware of such a link I do not see how this can possibly effect the distinctiveness of the earlier marks or disentitle Ltd to the enhanced protection that the case-law suggests. The written submissions also suggest that because of the fame and the clear imagery used by Ltd in its marketing, the concept of imperfect recollection plays less of a role. I do not accept this submission. To do otherwise would be to penalize the well-known mark and to count against it its reputation rather than to provide it with enhanced protection. The written submissions suggest that I have a flexible approach in the application of the case-law. Whilst there is, of course, interdependency in the various factors, this cannot equate to ignoring what is stated by the CJEU regarding distinctiveness and its relationship with the likelihood of confusion.

Conclusions under section 5(2)(b)

49) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

50) The business average consumer is less likely to be confused than a member of the general public because the business consumer displays a greater degree of care and attention when availing themselves of the service. I will consider, therefore, the position from the perspective of the general public average consumer. As stated, the services are identical and the earlier marks highly distinctive. The marks have a degree of similarity but I have assessed the various aspects of similarity to be low to moderate. I must bear in mind the concept of imperfect recollection. I come to the view that the average consumer will be well able to differentiate and distinguish between the marks. The marks are not highly similar and are of such a nature that a normal, reasonably observant and circumspect person will be able to differentiate between them. The visual and aural differences outweigh the similarities to a large extent. In terms of concept, a meaning is not stored away in the abstract. The concepts underpinning the marks will be stored away as YELP and YELL respectively. Imperfect recollection is borne in mind, but I do not consider this factor, in the circumstances of this case, to be so acute for the marks to be misremembered or miss-recalled as each other. I think that at most, all the similarity (together with the other factors) achieves is for the YELL marks to be brought to mind. Such an association would not, though, be of such a nature that the average consumer would believe that the same or related economic undertaking is responsible for both. Neither would there be any reason for an average consumer who has perceived the difference

between YELL and YELP to nevertheless believe that the marks (or the undertakings responsible for them) are connected.

51) In reaching the above conclusion I have borne in mind the principle of initial interest confusion which Arnold J. confirmed as an appropriate form of confusion in *Och-Ziff Management Europe Ltd v. OCH Capital LLP* [2010] EWHC 2599 (CH). However, whether initial interest confusion is likely to arise must be based on the particular facts and circumstances of the case. I did not find the examples given by Mr Mellor particularly convincing. He referred to the potential for a person to mistype on a computer (whilst entering a URL) the word YELP as YELL and, also, the potential for a person seeing an entry for YELP in the results generated by a search engine, mistaking it for YELL and clicking on it and then simply using the YELP service to find the required business information because they had arrived at a business information service even though it was not the one they had intended. In terms of the mistyping point, this is not an appropriate form of confusion as it is not the use of Inc's mark that is causing this but merely a typing mistake which, in any event, I do not consider likely to happen. In terms of the search engine argument, I consider the differences between the words themselves to be sufficient to prevent such an occurrence but, more fundamentally, this is not appropriate in the analysis before me because the mark put forward for registration is not the mark that is causing the claimed initial interest confusion. Based on the marks under comparison, I see not potential for initial interest confusion which places Ltd in any better position. There is no likelihood of confusion.

52) When reaching the above finding, I have not ignored the parties' arguments about confusion-free parallel trade. It is Inc who argues that the lack of confusion is symptomatic of the marks not being likely to be confused. As this is my finding anyway then the argument takes Inc no further forward. Whilst the absence of confusion could be said to vindicate the finding I have reached, I would have had some hesitation in relying on the evidence to any significant extent on the basis of the relatively new business operated by Inc in the UK (although I accept that the statistics provided demonstrate that a not insignificant amount of people have used Inc's service in the UK) and that instances of confusion may not always come to light even if confusion has arisen. In summary, I take some comfort from the evidence but have placed no real weight on it. I should also say that I have borne in mind the other services claimed to be in conflict and have also borne in mind the other marks Ltd pleaded – neither circumstance is considered to put Ltd in any better position.

COSTS

53) Inc has been successful and is entitled to a contribution towards its costs⁸. I hereby order Yell Limited to pay Yelp! Inc the sum of £2300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement - £500

Considering Ltd's evidence and filing its own evidence - £1000

Attending the hearing - £800

54) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 6 day of June 2011

**Oliver Morris
For the Registrar,
The Comptroller-General**

⁸ Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.