

BL O/0488/26

TRADE MARKS ACT 1994

TRADE MARK APPLICATION
NO. UK00003941396

DECONOVO

IN THE NAME OF
HANGZHOU MUJIA NETWORK TECHNOLOGY CO., LTD

AND

OPPOSITION NO. OP000444181
BY
WACOAL EMEA LTD
AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY
WACOAL EMEA LTD
AGAINST DECISION BL O/0579/25
DATED 27th JUNE 2025

*Ms Ashton Chantrielle of Counsel instructed by Mathys & Squire LLP appeared for Wacoal EMEA Ltd.
Hangzhou Mujia Network Technology Co., Ltd was not represented and took no part in the Appeal*

APPEAL DECISION

Introduction & Background

1. This is an appeal by Wacoal Emea Ltd from a decision of James Hopkins, sitting as a Hearing Officer acting for the Registrar of Trade Marks dated 27th June 2025.
2. On 30 August 2023 Hangzhou Mujia Network Technology Co., Ltd (“the Applicant”) applied to register the trade mark DECONOVO under No. UK0000394139 for various goods including, in class 25,

“Bathing suits; leggings [leg warmers]; scarves; trousers; caps being headwear; clothing; dressing gowns; hosiery; shoes; bathing trunks; headscarves; neck tube scarves; sweaters; underwear; bath slippers; clothing for gymnastics; coats; footwear; hats; rash guards; sandals; shawls; skirts; slippers; yoga tops; yoga pants; yoga shirts; yoga socks; yoga shoes; bath robes”
3. Wacoal EMEA Ltd (“the Opponent”) opposed the registration of the applicant’s mark in class 25 on 17 November 2023. Under section 5 (2)(b) the Trade Marks Act 1994 (“the Act”) the Opponent relied on its

UK trade mark registration number 910943066, DECO (“the opponent’s mark”). The Opponent’s mark was filed on 6 June 2012 and became registered on 5 September 2014. It was registered for

“lingerie; hosiery; beachwear; swimwear”

in class 25, all of which goods are relied upon under this ground.

4. The Opponent also opposed under S. 5 (4) (a) of the Act. The Opponent claimed that it had significant goodwill in its business in relation to which it used the sign DECO (“the opponent’s sign”) throughout the UK since 2012. The Opponent’s sign was said to have been used in respect of lingerie; hosiery; beachwear; swimwear; sports bras. The Opponent argued that use of the applicant’s mark in respect of the applied-for goods in class 25 would constitute passing off.
5. The applicant filed a counterstatement, denying the grounds of opposition. It also required the Opponent to provide proof of use of its registered mark.
6. Both parties were professionally represented, the opponent by Mathys & Squire LLP and the applicant by Charlie, Liu (*sic*). Only the Opponent filed evidence. No hearing was requested and only the Opponent filed written submissions in lieu.

The Hearing Officer’s Decision

7. Under S. 5 (2) (b):
 - 1) Regarding the proof of use of the Opponent’s Mark, having considered the evidence the Hearing Officer found that the Opponent could rely only upon “lingerie and women’s swimwear” for the purposes of the opposition.
 - 2) Comparing those goods with those of the Application the Hearing Officer found there to be a range at all levels from identity to low similarity.
 - 3) Moving to the comparison of marks, the Hearing Officer found:
 - i) The marks were visually similar to a medium degree;
 - ii) They were aurally similar to a medium degree;
 - iii) They were conceptually neutral.
 - 4) Even considering the principles of imperfect recollection and interdependency, there was no likelihood of direct or indirect confusion, even in relation to identical goods.

The Opposition therefore failed on this ground.

8. Under S. 5 (4) (a), referring to his findings under S. 5 (2) (b) above the Hearing Officer found, for the same reasons, that there was no likelihood of deception and thus this ground failed also.
9. The Opposition was therefore dismissed in full, with costs of £300 to the Applicant.

The Appeal

10. An Appeal was filed on Form TM55 by the Opponent on 25 July 2025. The grounds of appeal were two in number and focussed on the assessment of aural similarity, as follows:
 - 1) The Hearing Officer erred in principle in his assessment of the aural similarities between the marks by failing to carry out an assessment of how the Application would be pronounced.
 - 2) The Hearing Officer erred in principle in his assessment of whether there was a likelihood of confusion by failing to take into account the different pronunciations of the mark and failing to consider the circumstances in which aural considerations would play a role. In particular, the Hearing Officer failed to account for the fact that the average consumer is likely to be exposed to the mark being pronounced DECO – NOVO (in two parts).
11. Although it was not stated expressly in the Grounds of Appeal it appears the appeal was directed to the Decision under both Sections 5 (2) (b) and 5 (4) (a).
12. There was no Respondent's Notice and the Respondent took no part in the Appeal.

Standard of Review

13. I understood the Opponent to be in agreement with me as to the relevant standard, which has been repeated many times albeit in various restated forms. An appeal is by way of review, not a rehearing. It is well established that before I can interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24] and re-stated by Arnold LJ in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262 at [110] where he said:

“The test on appeal

110. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: Volpi v Volpi [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2] (v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare Magmatic Ltd v PMS International Group plc [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and Actavis Group PTC EHF v ICOS Corp [2019] UKSC 15, [2019] Bus LR 1318 at [78]- [81] (Lord Hodge), and see Re Sprintroom Ltd [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt

and Rose LJJ), which was cited with approval by the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024]UKSC 8 at [49] (Lord Briggs and Lord Kitchin).”

14. In particular, in *Axogen* the court said at [24 (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]).”

15. Further guidance has also been given by the Supreme Court in *Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc* [2025] UKSC 25 at [93] to [95].

16. I bear these principles in mind.

Decision

17. Ms Chantrielle, for the Opponent, focussed on the Hearing Officer’s approach under S. 5 (2) (b). However, it was clear the appeal on S (5) (4) (a) stood or fell with that on S. 5 (2) (b), since it added nothing either way.

Ground 1 – Failure to consider how DECONOVO would be pronounced

18. For the purpose of this appeal it is convenient to look first at the Hearing Officer’s assessment of the respective marks’ overall impression at [56]:

56. The competing marks are both in word-only format and consist of the words ‘DECO’ and ‘DECONOVO’, respectively. The opponent submits that the applicant’s mark comprises two words, and the emphasis will be on the first, i.e. ‘DECO’. I disagree. As discussed in further detail below, there does not appear to be any reason which would lead the average consumer to dissect the word ‘DECONOVO’ into two words. Rather, it is my view that the average consumer would perceive the mark as one word. There being no other elements in the competing marks, I find that the overall impressions of the marks lie in the words ‘DECO’ and ‘DECONOVO’ themselves.

19. The Hearing Officer assessed the aural nature of the marks at [58]:

“58. Aurally, the opponent’s mark consists of two syllables, i.e. “DE-CO”, whereas the applicant’s mark consists of four, i.e. “DE-CO-NO-VO”. The first two syllables are identical, but the applicant’s mark has two additional syllables, rendering it twice as long as the opponent’s mark. Overall, I find that there is a medium degree of aural similarity between the competing marks.”

20. Finally, at [63], in dealing with his assessment of the likelihood of confusion, the Hearing Officer stated:

“I acknowledge that the opponent’s mark is entirely reproduced at the beginning of the applicant’s mark. Moreover, I accept that the opponent’s mark possesses a high level of distinctive character. Nevertheless, taking all the above factors into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer, paying a medium degree of attention, to distinguish between them and avoid mistaking one for the other. The applicant’s mark contains four additional letters, i.e. ‘NOVO’. Although the beginnings of trade marks tend to have more impact, that is a general rule which is not necessarily determinative.”

21. The Hearing Officer does not expressly reference the marks’ pronunciation in his analysis.

22. Ms Chantrielle submitted in her skeleton argument that “Whilst this is not strictly wrong, what the Hearing Officer failed to do was consider how the marks might actually be pronounced by members of the relevant public.” In her submission, there were two modes of pronunciation, either DECONOVO as a complete term, or DECO-NOVO, with (to the average consumer) a natural break occurring mid-mark.

23. I understood the Opponent to agree that in both marks, DECO- would be pronounced identically, the only point taken being that the Hearing Officer should have expressly considered pronunciation of the mark and in particular the possibility that the Application would be pronounced as two words, DECO NOVO.

24. We spent some considerable time at the hearing on this point and Ms Chantrielle valiantly sought to convince me of the aural separation of the two elements. However, my view, one way or the other, is immaterial unless I can be persuaded the Hearing Officer erred.

25. In this, Ms. Chantrielle has been unsuccessful. Notwithstanding the Hearing Officer did not expressly mention “pronunciation” it is clear to me, from [56] and [58] that he had it in mind, the issue of where the emphasis in DECONOVO lay having been put squarely before him. He evaluated the application as being

composed of a single unified word, without the kind of “break” postulated by the Opponent. The reasoning in [58] may be a little compressed but that is not unusual in these cases ¹.

26. Furthermore, Ms Chantrielle’s argument is essentially that more emphatic weight should have been given to the element DECO- as the first part of the application. That issue was firmly addressed by the Hearing Officer, and rejected, at [63].

27. Overall, the Hearing Officer’s reasoning is clear enough and I do not detect any error that would warrant appellate intervention.

28. Ground 1 is dismissed.

Ground 2 - failure to account for the fact that the average consumer is likely to be exposed to the mark being pronounced DECO – NOVO (in two parts) in considering likelihood of confusion.

29. At first sight Ground 2 appears to be little more than a re-stating of Ground 1. However, Ms Chantrielle submitted that there was a difference. In her skeleton she argued that *“the starting point is that the average consumer would be familiar with DECO and would be exposed to DECONOVO. Where that exposure is purely aural, for example when the average consumer is being assisted by shop staff, it is highly likely that the average consumer would be confused, whether directly or indirectly, when that mark is pronounced in two parts as DECO-NOVO.”*

30. Further, Ms. Chantrielle argued that *“The Hearing Officer’s assessment at [63] appears to consider the visual differences between the marks. For example, he states that “the additional letters in the applicant’s mark are unlikely to be overlooked” and “as a result of the additional letters, the applicant’s mark is twice as long as the opponent’s mark”. There is no mention of how the marks might sound to the average consumer, and how that might impact their view of the mark.”*

31. However, Ms. Chantrielle went on to submit before me that *“what we are saying is if the pronunciation had been considered and the circumstances in which the aural exposure had been considered - which is not part of this assessment as far as we can tell, it looks to be more of a visual comparison -- then the emphasis in DECO is more pronounced.”* With that in mind it does seem to me that, in effect, this is the same point as in Ground 1, and if there is a difference it is all but imperceptible. To her credit, Ms Chantrielle accepted it was a fine point. However, by their very nature, fine points tend to be things on which reasonable tribunals can differ, and as such they equally tend to be resistant to appeal.

32. Be that as it may, I do not accept Ms Chantrielle’s main line of attack which is that the assessment of the likelihood of confusion is biased towards a visual comparison. The references to the construction of the

¹ See Arnold LJ’s explanation in his judgment in *Extreme Networks Ltd v Extreme E Ltd* [2024] EWCA Civ 1386 at [31]

application can be understood to apply equally to the visual and aural aspects of the mark. Again, it is merely a form of compressed, but readily understood, reasoning. In any event, at [46] and [62] (from neither of which is there an appeal) the Hearing Officer noted ² that the purchasing process for the goods in issue would be primarily visual but that aural considerations had not been excluded, and his assessment of the likelihood of confusion is consistent with that.

33. It follows that Ground 2 of the appeal is dismissed.

Conclusion and Costs

34. The appeal has failed in its entirety. The Decision of the Hearing Officer stands and the Applicant's mark will proceed to registration in the UK for all the applied-for goods.

35. The Applicant took no part in the Appeal so I make no order as to costs.

36. I will make a separate formal order only if asked to do so.

Philip Harris
Appointed Person
9 June 2026

² Citing the General Court in *New Look Limited v OHIM*, Cases T-117/03 to T-119/03 and T-171/03 at [50]