

O/0449/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004082842

IN THE NAME OF LI TING

TO REGISTER THE FOLLOWING TRADE MARK:

dodo & gogo^o

IN CLASSES 14 & 26

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000450809

BY DODO S.R.L.

Background and pleadings

1. On 02 August 2024, Li Ting (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 16 August 2024 in respect of the following goods:

Class 14: Alloys of precious metal; jewellery boxes; jewellery; bracelets [jewellery]; necklaces [jewelry]; rings [jewellery]; pins [jewellery]; charms for jewellery; works of art of precious metal; wristwatches; earrings; precious stones; beads for making jewellery; jewellery findings; silver thread [jewellery]; brooches [jewellery]; key chains [split rings with trinket or decorative fob]; watches; clocks; jewellery for pets.

Class 26: Hair bands; lace trimmings; hair grips; hair barrettes; trimmings for clothing; buttons; false hair; needles; artificial flowers; heat adhesive patches for repairing textile articles; corset busks; numerals for marking linen; hair nets; hair pins; hair ornaments; buckles [clothing accessories]; zippers; haberdashery [dressmakers' articles], except thread; artificial plants, other than Christmas trees; hair curlers, electric and non-electric, other than hand implements.

2. On 15 November 2024, DODO S.R.L. (“the Opponent”)¹ opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).² The opposition is directed against all goods in class 14 of the application.³ The Opponent relies upon the following two comparable marks:

¹ At the time of filing the form TM7 the Opponent was POMELLATO S.p.A, however, on 30 June 2025 the Opponent notified the Registry that the earlier rights relied upon had been assigned to DODO S.R.L.. Following undertakings received on 17 July 2025, DODO S.R.L were substituted as the Opponent to these proceedings. This change was communicated to the Applicant in the official letter of 28 July 2025.

² At the time of filing the form TM7, the opposition was also based upon Section 5(3) and Section 5(4)(a) of the Act, however, on 14 April 2025 the Opponent requested to remove these grounds of opposition. This change was communicated to the Applicant in the official letter of 03 July 2025.

³ At the time of filing the form TM7, the opposition was directed against all goods in the applications, however, on 14 April 2025, the Opponent withdrew its opposition to the goods in class 26. This change was communicated to the Applicant in the official letter of 03 July 2025.

DoDo

UK Registration no. UK00917889892 (“the ‘892 mark”)

Filing date: 19 April 2018

Date of registration: 07 November 2019

Relying upon all its registered goods and services, as set out under paragraph 14 of this decision.



UK Registration no. UK00918193404 (“the ‘404 mark”)

Filing date: 07 February 2020

Date of registration: 16 July 2020

Relying upon all its registered goods and services in classes 9, 14 and 35, as set out in Annex A of this decision.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the Opponent’s marks were converted into comparable UK trade marks. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.⁴

⁴ See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

4. By virtue of their earlier filing dates, the above registrations both constitute earlier marks within the meaning of section 6 of the Act. As the Opponent's marks had not completed their registration process more than five years before the filing date of the application in issue, they are not subject to the use provisions contained in section 6A of the Act. In view of this, the Opponent can rely upon all of its goods and services without having to demonstrate use.
5. The Opponent submits that the marks are similar and that the goods at issue are identical or similar.
6. The Applicant filed a counterstatement within which it denies the marks are similar but accepts that the goods are similar in class 14.⁵
7. Neither party filed evidence during proceedings. Neither party requested a hearing, and neither party filed submissions in lieu. This decision is taken following careful consideration of the papers.
8. The Applicant is represented by Akos Suele, LL.M.; the Opponent is represented by Boulton Wade Tennant LLP.
9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

My Approach

10. The Opponent relies upon two earlier rights under Section 5(2)(b). I consider that the '892 mark represents the Opponent's strongest case as it consists of the stylised word "DoDo" with no additional matter. The '404 mark also contains the words

⁵ Applicant's TM8 and counterstatement, paragraph 1.

“charming jewellery since 1994” and introduces a further point of difference due to the additional device element. Further to this, I note that the goods and services covered by each mark are identical, save for two terms only.⁶ In the event that I find a likelihood of confusion in respect of the ‘892 mark, any finding of confusion in respect of the ‘404 mark will not further the Opponent’s case. On the contrary, if I find no likelihood of confusion for the ‘892 mark, it follows that the same finding will apply to the ‘404 mark in view of the additional word and device elements which render the competing marks even further removed from one another. I will, therefore, focus my assessment on the ‘892 mark only, which I consider to be the most favourable basis on the part of the Opponent. If required, I will address this point further when considering any final remarks at the conclusion of this decision.

DECISION

Section 5(2)

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

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

(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”.

12. Section 5A of the Act reads as follows:

⁶ I do not consider that the additional terms, (underlined), which are found only in class 14 of the ‘404 mark to materially affect the outcome of my decision: “[...] pill boxes [...] being made of or coated with precious metals” and “figurines, ornaments, trinkets, and works of art made of [...] brass or coated therewith”.

“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.”

13. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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 great 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 might 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

14. The goods and services for comparison are as follows:

Opponent's goods & services	Applicant's goods
<p><u>Class 9:</u> Spectacles and sunglasses; Frames for eyeglasses; Eyeglass cases and cases for contact lenses; Spectacle lenses, contact lenses, tinted or filtering lenses, accessories for telephones.</p> <p><u>Class 14:</u> Precious metals and their alloys, not included in other classes; Precious metals, unwrought or semi-wrought; Alloys of precious metal; Gold</p>	<p><u>Class 14:</u> Alloys of precious metal; jewellery boxes; jewellery; bracelets [jewellery]; necklaces [jewellery]; rings [jewellery]; pins [jewellery]; charms for jewellery; works of art of precious metal; wristwatches; earrings; precious stones; beads for making jewellery; jewellery findings; silver thread [jewellery]; brooches [jewellery]; key chains [split rings with trinket or decorative fob]; watches; clocks; jewellery for pets.</p>

unwrought or beaten; Palladium;
Platinum [metal]; Rhodium;
Ruthenium; Silver thread; Silver,
unwrought or beaten; Jet, unwrought
or semi-wrought; Gold thread; Amulets
[jewellery], paste jewellery; Jewellery;
Bracelets, bangles, brooches, badges,
pins, earrings, chains, charms,
loquets, necklaces, medallions,
pendants, finger rings, cloisonné
jewellery; Precious stones and gems;
Semi-precious stones and gems;
Diamonds; Pearls [jewellery]; Badges
of precious metal; Ingots of precious
metals; Beads for making jewellery;
Horological and chronometric
instruments, including watches, alarm
clocks, clocks, pocket watches and
other timepieces and timekeeping
instruments in this class; Watch bands
and watch straps; Clock cases; Watch
chains; Sundials; Figurines,
ornaments, trinkets, and works of art
made of or using precious metals or
coated therewith; Boxes of precious
metal; Coins; Cuff links, tie pins, tie
bars, tie clips, lapel pins, hat pins,
ornamental pins; Ornaments
[jewellery]; Ornaments for shoes;
Ornaments of precious metals or
coated therewith; Jewellery holders
and cases; Watch cases; Key rings;
Key chains; Key fobs; Medals,

<p>trophies and stands for clocks all being made of or coated with precious metals; Gemstones, pearls and precious metals, and imitations thereof, natural or artificial precious stones and natural or artificial semi-precious stones; Natural or artificial gemstones; Jewellery made with or of man-made stones, crystals and/or cubic stones.</p> <p><u>Class 35:</u> Retail services and online retail services in connection with sunglasses, eyewear, jewellery, time instruments and watches, precious metals and their alloys, tie-pins, cuff-links, key rings, precious stones, pearls [jewellery], ornaments [jewellery]; Fashion show exhibitions for commercial purposes; Organization of trade fairs for commercial or advertising purposes; Organization of fashion shows for commercial and promotional purposes.</p>	
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15. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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”.

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 that:

“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.

17. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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.

18. 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 and services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“82. ...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”.

19. The Opponent has provided submissions on how the goods and services compare. I have taken these submissions into account but will refer to them only to the extent that is necessary.

20. As noted at paragraph 6, the Applicant has admitted that its class 14 goods are similar to the Opponent’s goods, although it has not stated to what degree they may be considered similar. I will therefore proceed to make an assessment on the level of similarity for each of the goods, considering groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.⁷.

Jewellery; Beads for making jewellery.

21. The above goods are explicitly named in both the Applicant’s and the Opponent’s specifications. They are self-evidently identical.

Alloys of precious metal.

⁷ Paragraph 5

22. While expressed slightly differently, the Applicant's above goods are self-evidently identical to the Opponent's "*precious metals and their alloys, not included in other classes*".

Precious stones.

23. The Applicant's above goods are self-evidently identical to the Opponent's "*precious stones [...]*".

Silver thread [jewellery].

24. While expressed slightly differently, the Applicant's above goods are self-evidently identical to the Opponent's "*silver thread*".

Bracelets [jewellery]; brooches [jewellery]; pins [jewellery]; earrings; necklaces [jewelry].

25. While expressed slightly differently, the Applicant's above goods are self-evidently identical to the Opponent's "*bracelets, [...] brooches, [...] pins, earrings, [...] necklaces, [...]*".

Rings [jewellery].

26. The Opponent's "*[...] finger rings [...]*" are encompassed by the Applicant's above broader category. They are therefore identical on the principle outlined in *Meric*.

Charms for jewellery.

27. The Applicant's above goods fall within the Opponent's broader category "*[...] charms [...]*". They are identical on the principle outlined in *Meric*.

Jewellery boxes.

28. The Applicant's above goods fall within the Opponent's broader category "*jewellery holders and cases*". They are identical on the principle outlined in *Meric*.

Works of art of precious metal.

29. The Applicant's above goods fall within the Opponent's broader category "*figurines, ornaments, trinkets, and works of art made of or using precious metals or coated therewith*". They are identical on the principle outlined in *Meric*.

Wristwatches; watches; clocks.

30. The Applicant's above goods fall within the Opponent's broader category "*horological and chronometric instruments, including watches, alarm clocks, clocks, pocket watches and other timepieces and timekeeping instruments in this class*". They are identical on the principle outlined in *Meric*.

Key chains [split rings with trinket or decorative fob].

31. The Applicant's above goods fall within the Opponent's broader category "key chains". They are identical on the principle outlined in *Meric*.

Jewellery for pets.

32. The Applicant's above goods fall within the Opponent's broader category "jewellery". They are identical on the principle outlined in *Meric*.

Jewellery findings.

33. I understand jewellery findings to be small component parts of jewellery, such as clasps or wires. I consider the Applicant's above goods overlap in user with the Opponent's "beads for making jewellery", being members of the general public, or professionals concerned with jewellery making. There is an overlap in purpose and method of use in that the goods are both used in the manufacture of jewellery, however, jewellery findings have a functional role in connecting or holding together

jewellery, while beads are primarily decorative and incorporate a hole through which thread can be passed. The goods differ in nature as beads are made of a range of materials and selected for their aesthetic appearance, while jewellery findings are generally made of metal and are used to connect or attach parts of jewellery together. I consider that the average consumer will likely expect an undertaking responsible for beads for making jewellery to also provide jewellery findings. There is an overlap in trade channels as the goods will be sold within the same craft retailers, where they will be positioned within close proximity to one another. While the goods are used in the manufacture of jewellery, I do not consider them complementary in the way set out in caselaw as they are not indispensable to one another. The goods are not in competition, as the average consumer will not purchase beads for jewellery making in place of jewellery findings. Overall, I consider the goods to be similar to a medium degree.

Average consumer and the purchasing act

34. As the case law above indicates, it is necessary to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which the goods and services are likely to be selected by the average consumer.

35. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

36. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and



(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

37. The average consumer for the goods is a member of the general public and professionals concerned with the manufacture of jewellery, with the goods self-selected from the shelves of traditional high street retail outlets or their online equivalents. In the case of more expensive items of jewellery, the goods will likely be stored in a cabinet/behind the counter, where the consumer will need to make a request to view and/or purchase the goods. The goods will vary in price, from potentially low cost goods such as "jewellery findings" to higher cost goods such as "works of art of precious metal". Various factors are still likely to be taken into consideration during the purchasing process, such as materials used, quality, aesthetic appearance and size/fit. Given the process of selection, the marks' visual

impact is likely to play the greater role, though I do not discount the opportunity for aural recommendations made by salespeople, for example. Weighing all factors, I find that, where the average consumer is a member of the general public, they will apply a medium to high degree of attention to the purchase, dependant on the cost and/or importance of the purchase. Where the average consumer is a professional, they will pay a high degree of attention during the purchasing process due to the impact that poor quality goods could have on the reputation of their business. I bear in mind that the likelihood of confusion will be assessed from the perspective of the former (i.e. the general public), since they are the group who in general are likely to pay the lower degree of attention overall.⁸

Comparison of the marks

38. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
 <p data-bbox="422 1339 654 1377">(The '892 mark)</p>	

39. The Applicant's mark consists of two words separated by an ampersand, namely, "dodo & gogo". The '&' will be understood to mean 'AND' by the average consumer. As '&' is generally used as a connective to join two words, I consider that both 'dodo' and 'gogo' retain independent distinctive roles within the mark, rather than forming a unit. The words are presented on a curve in a black lowercase typeface. I consider that the words "dodo" and "gogo" will make an equal contribution to the overall impression of the mark, with the curved stylisation and ampersand playing a lesser role.

⁸ Case T-356/14, *CareAbout v OHMI - Florido Rodríguez (Kerashot)*, paragraph 25

40. The Opponent's '892 mark consists of the word "DoDo", presented in a black typeface, with the first O being italicised and the D letters capitalised. I consider that the word element plays the greatest role in the overall impression of the mark, with the presentation of the letters playing a lesser role.
41. Visually the marks coincide in the word "dodo", which forms the entirety of the Opponent's mark and appears at the beginning of the Applicant's mark. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. The capitalisation/italicism of the letters act as points of visual difference between the marks. Other points of visual difference are the ampersand and the word "gogo" in the Applicant's mark, which are not present in the Opponent's mark. Overall, considering the position of the identical element "dodo" in the later mark, the respective stylisation of the word in each mark notwithstanding, I consider the marks to be similar to no more than a medium degree.
42. Aurally, I consider that a significant proportion of average consumers will pronounce the "dodo" element within both marks identically as 'DOE-DOE'. This aurally identical element forms the entirety of the Opponent's mark and appears at the beginning of the Applicant's mark. The ampersand and word "gogo" in the Applicant's mark, which will be pronounced as 'AND-GO-GO', introduce a point of aural difference. The curved stylisation of the words will not impact the articulation of the Applicant's mark. Overall, taking the above into account, I consider the marks to be aurally similar to no more than a medium degree.
43. Conceptually, the Applicant's mark as a whole has no unitary meaning, as the words "dodo" and "gogo" both retain an independent distinctive significance. I consider that for a significant proportion of average consumers the word "dodo" will evoke the identical concept in both marks of the extinct bird of the same name. The capitalisation/italicism of letters within the Opponent's mark do not impact its conceptual meaning, nor does the curved stylisation in the Applicant's mark. The ampersand will be understood to mean 'AND' by the average consumer.

44. The Applicant's mark introduces a further concept in the word "gogo" which is not an ordinary dictionary word and has no obvious conceptual meaning. While I notice that 'gogo' is comprised of the repeated word 'go', which commonly conveys a concept of movement (i.e. to travel or move to another place), I bear in mind that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*. I consider that the identification of "go" within the word 'gogo' would involve an extra step of analysis. In view of this, I consider that the average consumer, who perceives the mark as a whole and does not proceed to analyse its various details,⁹ will see "gogo" as an invented word.

45. Overall, due to the identical concept attributed to the "dodo" element in each of the marks, I consider the marks are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

46. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 *Lloyd Schuhfabrik*, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

⁹ *Usinor SA v OHIM*, Case T-189/05

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

47. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.
48. The Opponent submits that their mark has enhanced distinctive character,¹⁰ however, the Opponent has not filed any evidence to support that the earlier mark’s distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.
49. The Opponent’s mark comprises the word “dodo”, which as already mentioned is an ordinary dictionary word relating to a now-extinct flightless bird. The word bears no descriptive or allusive qualities in relation to the goods and services for which it is registered. I consider that the irregular capitalisation will likely be noticed by the average consumer but that it does not add to the distinctiveness of the mark to any material degree. I consider the second letter (‘o’) being italicised will likely go unnoticed by the average consumer and does not add to the distinctiveness of the mark. I am reminded that invented words usually have the highest degree of distinctive character, whereas words which are descriptive or allusive of the goods and services relied upon normally have the lowest. Accordingly, I find the Opponent’s mark to be inherently distinctive to a medium degree.

¹⁰ Opponent’s form TM7, paragraph 15.

Likelihood of confusion

50. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

51. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

52. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the Applicant's mark and the Opponent's marks to be visually similar to no more than a medium degree.
- I have found the Applicant's mark and the Opponent's marks to be aurally similar to no more than a medium degree.
- I have found the Applicant's mark and the Opponent's marks to be conceptually similar to a medium degree.
- I have found the earlier marks to be inherently distinctive to a medium degree.
- I have identified the average consumer to be the general public or professionals concerned with the manufacture of jewellery. I have found that

the average consumer will select the goods primarily by visual means, although I do not discount an aural component.

- I have concluded that the average consumer (bearing in mind that the likelihood of confusion must be assessed from the perspective of the group who will pay the lower degree of attention) will pay a medium to high degree of attention during the purchasing process.
- I have found the parties' goods to be between identical and similar to a medium degree.

53. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I do not consider that the marks will be mistakenly recalled or misremembered for one another. Although the marks share the word 'dodo' (which is not descriptive or allusive of the goods at issue), I consider the additional elements in the Applicant's mark will not be overlooked, especially in view of the 'gogo' element retaining an independent distinctive role within the overall impression of the mark. Consequently, notwithstanding the medium inherent distinctive character of the Opponent's mark, I consider there to be no likelihood of direct confusion between the marks, even for the goods that I have found to be identical.

54. I now proceed to consider whether there exists a likelihood of indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"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”).

55. Furthermore, in *Liverpool Gin*,¹¹ Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria (O/219/16)*, where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

¹¹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

56. The Applicant's mark is a composite mark which contains an identical word element to the earlier mark, the stylisation of that word within each mark notwithstanding. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

57. I consider that the shared “dodo” element, which I found to be the dominant element in the Opponent’s mark, and which I found to have an independent distinctive significance within the Applicant’s mark (applying the principles set out in *Medion*, as considered in *Whyte and Mackay*), will lead the average consumer to perceive the Applicant’s mark as indicative of a collaboration or co-branded offering incorporating the “dodo” mark.

58. While co-branding is not one of the categories highlighted in *L.A. Sugar*, those three categories are not exhaustive; rather, they were intended to be illustrative of the general approach. This was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands LLC and others* [2021] EWCA Civ 1207. Regarding the explanation given in *L.A. Sugar* about how indirect confusion arises, Arnold LJ said:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

59. I consider that the average consumer will notice the differences between the marks, being “& gogo” at the end of the Applicant’s mark, but that when this is seen alongside the shared ‘dodo’ element, it will reinforce the impression of a collaboration between two brands. I consider the ampersand symbol is commonly used as a conjunction in collaborations between brands and is therefore likely to be

understood by the average consumer as signifying a relationship or collaboration between the Opponent and another undertaking. In addition, I consider that the fact that the shared “dodo” word element appears at the beginning of the Applicant’s mark (a position to which the average consumer tends to pay more attention) will reinforce the idea that the “dodo & gogo” mark comes from the Opponent or an economically linked undertaking.

60. Weighing all the factors, I consider that there is a likelihood of indirect confusion for all goods which are similar to at least a medium degree, due to the interdependency principle.

CONCLUSION

61. The opposition based upon 5(2)(b) has succeeded. Therefore, subject to any successful appeal against my decision, the application will be refused for all goods in class 14.

62. The Applicant’s mark will proceed to registration for all goods in class 26, which were unopposed.

COSTS

63. The Opponent has achieved a significantly greater degree of success overall, it is entitled to a contribution towards its costs. I base the costs awarded on the scale contained in TPN 1/2023. In the circumstances, I award the Opponent the sum of £450 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fee	£200
Preparing a statement and considering the other side’s statement	£250
Total:	£450

64. I therefore order Li Ting to pay DODO S.R.L. the sum of £450. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of May 2026

Emma Rees

For the Registrar

Annex A

Goods and services relied upon by the Opponent under UK00918193404 (the '404 mark)

Class 9:

Spectacles and sunglasses; Frames for eyeglasses; Eyeglass cases and cases for contact lenses; Spectacle lenses, contact lenses, tinted or filtering lenses, accessories for telephones.

Class 14:

Precious metals and their alloys, not included in other classes; Precious metals, unwrought or semi-wrought; Alloys of precious metal; Gold unwrought or beaten; Palladium; Platinum [metal]; Rhodium; Ruthenium; Silver thread; Silver, unwrought or beaten; Jet, unwrought or semi-wrought; Gold thread; Amulets [jewellery], paste jewellery; Jewellery; Bracelets, bangles, brooches, badges, pins, earrings, chains, charms, lockets, necklaces, medallions, pendants, finger rings, cloisonné jewellery; Precious stones and gems; Semi-precious stones and gems; Diamonds; Pearls [jewellery]; Badges of precious metal; Ingots of precious metals; Beads for making jewellery; Horological and chronometric instruments, including watches, alarm clocks, clocks, pocket watches and other timepieces and timekeeping instruments in this class; Watch bands and watch straps; Clock cases; Watch chains; Sundials; Figurines, ornaments, trinkets, and works of art made of or using precious metals or brass or coated therewith; Boxes of precious metal; Coins; Cuff links, tie pins, tie bars, tie clips, lapel pins, hat pins, ornamental pins; Ornaments [jewellery]; Ornaments for shoes; Ornaments of precious metals or coated therewith; Jewellery holders and cases; Watch cases; Key rings; Key chains; Key fobs; Medals, trophies, pill boxes, and stands for clocks all being made of or coated with precious metals; Gemstones, pearls and precious metals, and imitations thereof, natural or artificial precious stones and natural or artificial semi-precious stones; Natural or artificial gemstones; Jewellery made with or of man-made stones, crystals and/or cubic stones.

Class 35:

Retail services and online retail services in connection with sunglasses, eyewear, jewellery, time instruments and watches, precious metals and their alloys, tie-pins, cuff-links, key rings, precious stones, pearls [jewellery], ornaments [jewellery]; Fashion show exhibitions for commercial purposes; Organization of trade fairs for commercial or advertising purposes; Organization of fashion shows for commercial and promotional purposes.