O/0643/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. UK00003611413
BY MUNAT LTD
TO REGISTER

Logo design font : Times Name Roman

Brand tag design font, to stitch on garments: Baskerville
Measurement: 5cm x 2.2cm

Swing tag design: font for brand name Baskerville. Font for slogan: Snell roundhand
Measurments: 8cm x 5.5cm

AS A TRADE MARK IN CLASSES 25 AND 35
AND
THE OPPOSITION THERETO UNDER NO. 431699
BY BING LI

Background and pleadings

1. On 17 March 2021, Munat Ltd ("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 25 February 2022. The goods and services for which registration is sought are as follows:

> **Class 25:** *Clothing for men, women and children; Footwear for women.*
>
> **Class 35:** *Retail services connected with the sale of clothing and clothing accessories; Retail services relating to clothing; Online retail services relating to clothing.*

2. On 09 March 2022, BING LI ("the opponent") partially opposed the application. The opposition is directed against the following goods and services:

> **Class 25:** *Clothing for men, women and children; Footwear for women.*
>
> **Class 35:** *Retail services connected with the sale of clothing and clothing accessories; Retail services relating to clothing.*

3. The opposition is based on Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following trade mark:

UK registration number: 916397127[1]  Filing date: 21 February 2017

[1] The opponent's mark is a comparable trade mark. It is based on the opponent's earlier EUTM, being registration number 016397127. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM

Registration date: 07 June 2017

Seniority details: Application date: 21 December 2015; Country: UK; Application number: 00003141684

Relying on some of the registered goods, namely:

Class 18: *Bags; Shoulder bags; Evening bags; Book bags; School bags; Canvas bags; Courier bags; Messenger bags; Shopping bags; Hunting bags; Game bags; Duffel bags; Duffle bags; Camping bags; Hiking bags; Gym bags; Athletics bags; Athletic bags; Sport bags; Sports bags; Hand bags; Cosmetic bags; Work bags; Overnight bags; Barrel bags; Roll bags; Shoe bags; Key bags; Flight bags; Cloth bags; Garment bags; Clutch bags; Suit bags; Waist bags; Belt bags; Gladstone bags; Souvenir bags; Knitting bags; Roller bags; Music bags; Bags for school; Hunters' game bags; Bags for campers; Imitation leather bags; Bags for sports; Sports [Bags for -]; Travelling bags [leatherware]; Airline travel bags; Bags for clothes; Wallets; Handbags, purses and wallets; Backpacks; Luggage; Luggage trunks; Trunks [luggage]; Luggage tags; Trunks and suitcases; Suitcases with wheels; Travelling bags made of leather; Luggage label holders; Satchels; School satchels; Satchels (School -); Randsels [Japanese school satchels]; Pouches; Key pouches.*

4. The opponent claims that the respective marks consist of a letter 'M' within a circle and are highly similar, and that its *"main goods and services have clothing bags, clothing accessories and luggage"* which are similar to the goods and services for which the applicant's mark seeks registration, giving rise to a likelihood of confusion.

5. The mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the mark had not completed its registration process more than 5 years before the application date of the mark at issue, it is not subject to proof of use. Consequently, the opponent can rely upon the goods it has identified. I should also mention here that the applicant requested the opponent to show use of its earlier mark, however, as I have said, proof of use is not relevant in the present proceedings.

6. The applicant filed a defence and counterstatement, denying the claims made in the following terms:

- the applicant's logo has a letter 'M' with an arrow around it, starting from the right to the left, whereas the opponent's logo has a full circle around the letter 'M';

- as well as the logos having different designs, the goods and services between companies are different;

- the applicant's logo is included in the brand name and is visible on all social media as well as the website, whilst the opponent's logo can be seen only on the website not attached to the brand name.

7. The applicant filed evidence in-chief, and the opponent filed evidence in reply. I will not summarise the parties' evidence here, but I will refer to them where necessary in my decision. No hearing was requested, and neither party has filed written submissions in lieu of a hearing. I make this decision following a careful consideration of the papers.

EU Law

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

EVIDENCE

9. The applicant's evidence consists of the witness statement of Memunat Dele, who is the applicant's director, dated 27 December 2022.

10. The opponent's evidence consists of the witness statement of Bing Li, who is the applicant himself, dated 27 February 2022.

DECISION

Section 5(2)(b)

11. Section 5(2)(b) of the Act is as follows:

> "A trade mark shall not be registered if because-
> […]
> (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 is as follows:

> "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 principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

> (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

> "23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary."

15. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

(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.

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court (the 'CG') clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

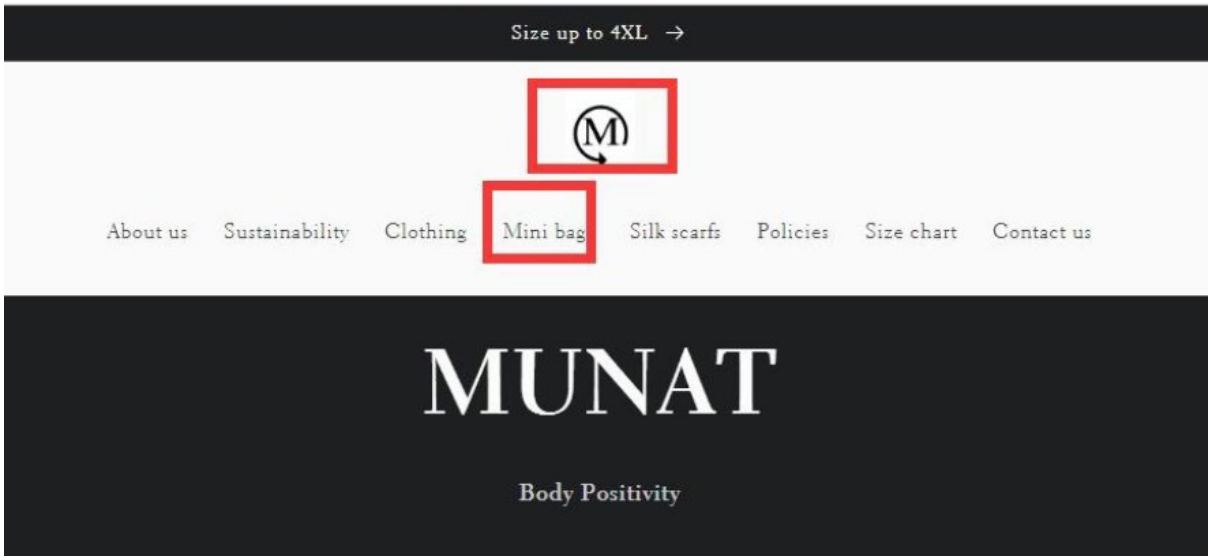
> "[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

17. The goods and services to be compared are as follows:

The applicant's goods and services	**The opponent's goods**
Class 25: *Clothing for men, women and children; Footwear for women.* **Class 35:** *Retail services connected with the sale of clothing and clothing accessories; Retail services relating to clothing.*	**Class 18:** *Bags; Shoulder bags; Evening bags; Book bags; School bags; Canvas bags; Courier bags; Messenger bags; Shopping bags; Hunting bags; Game bags; Duffel bags; Duffle bags; Camping bags; Hiking bags; Gym bags; Athletics bags; Athletic bags; Sport bags; Sports bags; Hand bags; Cosmetic bags; Work bags; Overnight bags; Barrel bags; Roll bags; Shoe bags; Key bags; Flight bags; Cloth bags; Garment bags; Clutch bags; Suit bags; Waist bags; Belt bags; Gladstone bags; Souvenir bags; Knitting*

	bags; Roller bags; Music bags; Bags for school; Hunters' game bags; Bags for campers; Imitation leather bags; Bags for sports; Sports [Bags for -]; Travelling bags [leatherware]; Airline travel bags; Bags for clothes; Wallets; Handbags, purses and wallets; Backpacks; Luggage; Luggage trunks; Trunks [luggage]; Luggage tags; Trunks and suitcases; Suitcases with wheels; Travelling bags made of leather; Luggage label holders; Satchels; School satchels; Satchels (School -); Randsels [Japanese school satchels]; Pouches; Key pouches.

18. In its witness statement the opponent argues that the applicant sells bags. It also provides a screenshot from the applicant's website (reproduced below) which shows that the goods sold include bags:



19. Although the applicant might sell bags, what I must look at is not the applicant's business, but the terms listed in the specification of the applicant's mark. Hence, the fact that the applicant sells bags is not something that I can take into account, if it is not reflected in the applicant's specification. In this connection, the only term which I consider would cover bags is *retail services connected with the sale of clothing accessories* (in class 35) because the term *clothing accessories* is, in my view, broad enough to include bags.[2]

20. The opponent's goods in Class 18 are various types of bags whereas the applicant's goods in Class 25 are clothing goods, namely clothing for men, women and children and footwear for women. The goods have a different nature and purpose since bags are essentially used to carry objects, whereas clothing and footwear have the primary function of covering, concealing, adorning and protecting the human body. It follows that the goods in question are not substitutable and are not, therefore, in competition with each other. However, the goods concerned are often produced by the same manufacturers and sold in the same sales outlets, and therefore share the same distribution channels, which constitutes a point of similarity. Further, they may be aesthetically complementary, in the sense that they share a common aesthetic function by jointly contributing to the image of the consumer concerned.[3] In my view, these goods are similar to a low degree.

21. Moving to the applicant's services in class 35, I have already concluded that the term *Retail services connected with the sale of clothing accessories* in the applicant's specification covers services connected with the sale of bags. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. Accordingly, I find that the applicant's

[2] See In Case T-569/11, at paragraph 45 in which the GC refers to bags as "clothing accessories": "Moreover, in respect of the relationship between the 'goods in leather and imitations of leather' in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the 'goods in leather and imitations of leather' include clothing accessories such as 'bags or wallets' made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image ('look') of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased".

[3] Giordano T-483/08 (GC) the GC

retail services connected with the sale of clothing accessories in class 35 are similar to a low to medium degree to the opponent's bags in class 18.

22. This leaves *retail services relating to clothing*. In *Tony Van Gulck v Wasabi Frog Ltd,* Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

> "9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

23. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM,* Case T-105/05*,* at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

> i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

24. In my view, the retail of clothing in shops will nearly always be alongside the sale of bags, as included within the opponent's specification. There will be an overlap of trade channels between the goods and services. I find the applicant's services to be complementary to the opponent's goods, in the sense that the applicant's clothing and the retail thereof is important for the use of the opponent's bags. Further, I find the intended users to overlap. Overall, whilst I find retail services for clothing to be slightly further removed than retail services for clothing accessories (which includes bags), I find that the applicant's retail services for clothing remain similar to the opponent's bags to a low degree.

Average consumer

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

26. The average consumer of the parties' goods and services in classes 18, 25 and 35 is a member of the general public. The goods are likely to be purchased relatively frequently. Their cost may vary, with cheaper items of limited quality at one end of the spectrum and more expensive fashion pieces at the other. However, the average consumer will consider factors such as style, quality, size, cost and compatibility with other items. Overall, I find that the general public would demonstrate a medium level of attention.

27. The goods will be purchased from shops or their online equivalents, where they are likely to be self-selected from rails and shelves or after viewing information on websites. In these circumstances, visual considerations would dominate. Nevertheless, as such goods may also be the subject of, for instance, word of mouth recommendations or oral requests to sales assistants, I do not discount aural considerations entirely.

Comparison of marks

28. 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. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

"....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

29. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

30. The respective marks are shown below:

The applicant's mark

Logo design font : Times Name Roman

Brand tag design font, to stitch on garments: Baskerville
Measurement: 5cm x 2.2cm

Swing tag design: font for brand name Baskerville. Font for slogan: Snell roundhand
Measurments: 8cm x 5.5cm

The opponent's mark

31. Both parties have filed website evidence showing how the respective marks are used in real life. However, I must carry out the comparison based on how the marks appear on the register. Hence, any extraneous matter that the parties might use in trade is irrelevant insofar as it not reflected in the application and the earlier mark respectively.

Overall impression

The applicant's mark

32. The applicant's mark is a complex mark. It consists of three rectangular frames incorporating various elements. The first frame is placed on the left hand-side of the mark and contains a letter 'M' surrounded by an unfinished circle broken at the bottom between the middle point and the second leg of the letter 'M' and ending with an arrow (the "M logo"). Underneath this element are the words: *"Logo design font: Times Name Roman".* The second frame is positioned in the middle of the mark between the other two frames and incorporates the word 'MUNAT' placed below the 'M' logo which is presented in a much smaller font. Underneath this element are the words *"Brand tag design font to stitch on garments: Baskerville"* and *"Measurement: 5cmx2.2.cm".* The third rectangular frame is positioned on the right hand-side of the mark; it incorporates what appears to be the silhouette of a body, the overlapping word 'MUNAT' in a larger font (on the top), and the words "*Centred for curves*" in a smaller font (on the bottom). Underneath this element are the words *"Swing tag design: font for brand name Baskerville. Font for slogan: snell roundhand" and "Measurement: 8cmx5.5cm".*

33. Whilst the various elements of the mark contribute to the overall impression, the most distinctive element of the mark is the word 'MUNAT' which will be perceived as the element denoting the commercial origin of the goods. The 'M' logo will be perceived as a stylised version of the letter 'M' standing for the first letter of the word 'MUNAT' and will have a secondary role. The words "Catered for curves" will be perceived as a slogan and the figurative element will be perceived as decorative reinforcing the message conveyed by the slogan, namely that clothing sold under the mark are shaped for curves. The very small words underneath the frames will be perceived as

part of the label design. Although these elements are in themselves less distinctive than the word ‘MUNAT’, their combined weight in the overall impression is significant.

The opponent’s mark

34. The earlier mark is composed of a letter ‘M’ presented in a standard font and placed within an uninterrupted circular border. The overall impression of the mark is dominated by the letter ‘M’ which is the only verbal element of the mark. As for the border element, I consider that this plays a minimal role.

Visual similarity

35. The opponent’s mark and the applicant’s mark coincide in the presence of a capital letter ‘M’ surrounded by a circular border. However, first, the typeface in which the letter ‘M’ in shown in both signs is different and, second, whilst the letter ‘M’ is contained within an uninterrupted circle in the opponent’s mark, it is surrounded by a broken circle ending with an arrow in the applicant’s mark. Further, bearing the composition of the applicant’s mark as a whole in mind, the relevant public will perceive the letter ‘M’ as the first letter of the element ‘MUNAT’, whilst the same public will not associate the letter ‘M’ in the opponent’s mark with any brand name or word. The signs also differ in the other elements of the applicant’s mark, including the word ‘Munat’ which features twice, the slogan and the other wording which creates the impression of three label designs, none of which has a counterpart in the earlier mark. The marks are visually similar to a very low degree.

Aural similarity

36. Aurally, since the letter ‘M’ in the applicant’s mark will be perceived as the first letter of the word ‘MUNAT’ which is likely to be seen as the most distinctive element denoting the commercial origin of the goods, the average consumer is likely to articulate the applicant’s mark simply as ‘MUNAT’ rather than as ‘M - MUNAT’. As the very small words underneath the frames will be perceived as part of label designs, they are unlikely to be articulated. The opponent’s mark can only be referred to as ‘M’.

Overall if the letter ‘M’ in the applicant’s mark is pronounced, the marks are similar to a low degree, otherwise they are aurally different.

Conceptual similarity

37. Conceptually, reference is made to the previous assertions concerning the association between the word ‘MUNAT’ and the letter ‘M’ in the applicant’s mark. Conversely, in the opponent’s mark the letter ‘M’ being the only verbal element of the mark it can only evoke and represent the idea of a letter of the alphabet, namely the letter ‘M’.

38. If the mark coincides only in the ‘generic concept’ of the specific letter of the alphabet, this fact alone is not sufficient to establish a conceptual similarity between the marks because no concept can be associated with a letter.[4] Further, in the present case there are other (relevant) concepts to be taken into account, because the letter ‘M’ in the applicant’s mark will be perceived as standing for the first letter of the word ‘MUNAT’. Further, the border around the letter ‘M’ in the applicant’s mark conveys the concept of an arrow, and the way the various elements of the applicant’s mark are arranged will convey the impression (and concept) of three label designs; none of these concepts have a counterpart in the opponent’s mark. Nevertheless, neither mark conveys any clear or specific semantic content to the public because the word ‘MUNAT’ is an invented word. Overall, I consider that (1) the fact that both marks contain a letter ‘M’ is not sufficient to establish a conceptual similarity between them because no concept can be associated with a letter and (2) there are some conceptual differences between the marks, but they are not particularly striking.

Distinctive character of earlier mark

39. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97, the CJEU stated that:

[4] See *Poloplast v OHIM — Polypipe (P),* Case T-189/09, at paragraph 83

> "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 *WindsurfingChiemsee* 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 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)."

40. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because 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 made of it.

41. The opponent's mark consists of a letter 'M' presented within a plain circle. In relation to the distinctiveness of single letters, the CJEU in C-265/09 at paras 37-39 held that:

> "37 In that regard, it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely prima facie to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities

from having to carry out an examination of their distinctive character based on the facts.

38 In relation, more particularly, to the fact that the sign at issue consists of a single letter with no graphic modifications, it should be borne in mind that registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark (Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317, paragraph 41).

39 It follows that, particularly as it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks, OHIM is required to assess whether the sign at issue is capable of distinguishing the different goods and services in the context of an examination, based on the facts, focusing on those goods or services"

42. Whilst the Court said stated that single letter marks cannot be regarded as devoid of any distinctive character merely because they are single letters, it also acknowledged that it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks. It is true that this guidance was given in the context of a case concerning a decision to refuse registration of a trade mark based on absolute grounds; however, it is equally applicable when assessing the distinctiveness of earlier marks in the context of oppositions and invalidity brought on relative grounds. Furthermore, although it is true that trade marks do not have to display any creativity or originality in order to benefit from protection, extremely simple and common signs, such as single letters of the alphabet or single numbers, tend to be less memorable and therefore relatively less distinctive.[5] That said, the letter 'M' in the opponent's mark is neither descriptive nor is it devoid of distinctive character in relation to the opponent's bags. Taking all of the above into account, I believe that the opponent's earlier mark is inherently distinctive to a low degree.

[5] BL-O-591-16

43. The opponent made no claim to enhanced distinctiveness. However, as it filed evidence of use, I will consider whether the distinctiveness of the earlier mark has been enhanced through the use made of it.

44. Mr Li states that the opponent's turnover was nearly £26,000 in 2017/2018 which increased to about half-million in 2018/2019, went up to nearly £3.3million in 2019/2020 and then to nearly £5million in 2020/2021, dropping to £4.6 million in 2021/2022. He also stated that advertising spend was about £400,000 per annum during the same period.

45. Except from two invoices which are for very tiny amounts, i.e. £ 19 and £36 respectively - one of which is after the relevant date, the relevant date being the filing date of the contested application - the figures in paragraph 44 provided by Mr Li are not supported by any corroborating evidence. In any event, I do not need to go any deeper into why the evidence filed is not sufficient to establish enhanced distinctiveness of the earlier mark in the UK for the simple reason that the turnover and advertising figures which have been provided seem to include goods sold outside the UK. In this connection, Mr Li states that his company initially used the mark in relation to a shop in Cardiff in 2010 subsequently expanding online sale "all over the UK and EU countries"; however, he did not say that the turnover and advertising figures relate specifically to the UK.

Likelihood of confusion

46. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

47. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where 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."

48. I have found the goods to be similar to a low and low to medium degree respectively. The selection of the goods will be predominantly visual and the average consumer's degree of attention when selecting the goods will be medium. I have found the marks to be visually similar to a very low degree and aurally different or, at best, similar to a low degree. Conceptually, I found that the fact that both marks contain a letter 'M' is not sufficient to establish a conceptual similarity between them because no concept can be associated with a letter. The earlier mark is inherently low in distinctive character and the evidence is insufficient to establish that its distinctiveness has been enhanced through use.

49. In the present case, the similarities between the marks are limited to the letter 'M' which is the only element of the earlier mark and an element that is subordinate to the distinctive and dominant word 'MUNAT' in the applicant's mark. The element 'MUNAT' and the other elements of the applicant's mark contribute significantly to a sufficient distance in the overall impressions given by the marks.

50. Having considered all of the relevant factors, I have no hesitation in finding that the differences between the marks are sufficient to enable the relevant public to safely distinguish between them. As a consequence, a likelihood of direct confusion between the conflicting marks can safely be ruled out.

51. I have also considered the likelihood of confusion arising through imperfect recollection of the 'M' logos in the respective marks. However, I have concluded that this is also unlikely for the following reasons.

52. First, whilst in both marks the letter 'M' is incapsulated within a circular border, the stylisation of the letter 'M' is different and the borders in the marks are different, as they consist of a simple circle (in the earlier mark) and a circular arrow (in the applicant's mark).

56. Second, the inherent distinctiveness of the shared element and of the earlier mark as a whole is low for the reasons set out above, and the general rule is that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.[6] Moreover, the element in the applicant's mark which is the common element (i.e. the 'M' presented in the form of a circular logo) is itself less distinctive than the other features of that mark (i.e. the word 'MUNAT') and there is much more to the applicant's mark than the common element. This means that the overall impressions created by the marks is very different.

57. Lastly, given that the dominant and most distinctive element of the applicant's mark is the word 'MUNAT', the reaction of the average consumer is likely to be that its absence in the earlier mark[7] means that there is no confusion - because the consumer will assume that the applicant's 'M' logo stands for the first letter of the word 'MUNAT' and that the same logo is always used in conjunction with the brand name 'MUNAT'. Consequently, if the average consumers were to notice any similarity between the

[6] *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Ltd v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) and BL-O/0368/23
[7] See *Comic Enterprises v Twentieth Century Fox* [2016] about wrong way around confusion

logos in the marks, they will put it down to mere coincidence rather than economic connection.

52. **There is no likelihood of confusion. The opposition fails.**

CONCLUSION

53. The opposition fails and, subject to any appeal, the application may proceed to registration for all of the goods and services applied for.

COSTS

54. The applicant has been successful and, in the ordinary course of these proceedings, would be entitled to a contribution towards its costs. However, the applicant is unrepresented meaning that, in order to claim its costs, it is required to file a completed costs pro-forma. The tribunal wrote to the applicant and asked it complete and return a costs pro-forma if it intended to seek an award of costs. It was advised that, if the pro-forma was not returned, no award of costs would be made. As no costs pro-forma was filed and the applicant incurred no official fees arising from this action, I make no order as to costs. Both parties are hereby ordered to bear their own costs of these proceedings.

Dated this 5th day of July 2023

Teresa Perks
For the Registrar