

O/0715/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00004097087
BY ALEXANDER EDWARD ALI SEYED KASAI TO REGISTER:**

NO PERSONA

AS A TRADE MARK IN CLASSES 25 & 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 451557 BY
MAX MARA FASHION GROUP S.R.L.**

BACKGROUND AND PLEADINGS

1. On 8 September 2024, Alexander Edward Ali Seyed Kasai (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published on 27 September 2024 and registration is sought for the following goods and services:

Class 25: Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Furs [clothing]; Layettees [clothing]; Clothing layettes; Garments for protecting clothing; Linen clothing; Headbands [clothing]; Headbands for clothing; Clothes; Gloves [clothing]; Gloves as clothing; Aprons [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Silk clothing; Leather clothing; Clothing of leather; Leather (Clothing of -); Parts of clothing, footwear and headgear; Collars [clothing]; Knitted clothing; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts [clothing]; Belts for clothing; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Visors [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Trunks being clothing; Woven clothing; Drawers [clothing]; Drawers as clothing; Sports clothing; Clothing for sports; Leisure clothing; Athletic clothing; Ties [clothing]; Muffs [clothing]; Bodies [clothing]; Tops [clothing]; Weatherproof clothing; Water-resistant clothing; Fabric belts [clothing]; Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Chaps (clothing); Thermal clothing; Cowls [clothing]; Men's clothing; Dance clothing; Mitts [clothing]; Braces for clothing; Plush clothing.

Class 41: Music concerts; Presentation of music concerts; Live music concerts; Performance of music; Music concert services; Performance of music and singing; Live music performances; Music entertainment services; Arranging of music performances; Production of music shows; Live music shows; Live musical concerts; Presentation of musical concerts; Entertainment in the nature of live performances by musical bands; Arranging of musical entertainment.

2. On 20 December 2024, the applicant's mark was partially opposed by MAX MARA FASHION GROUP S.r.l. ("the opponent"). The opposition was initially based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). However, the section 5(3) ground was withdrawn on 25 April 2025. The opposition is aimed at the class 25 goods of the applicant only. In bringing the opposition, the opponent relies on the following two earlier marks:

PERSONA

UK registration no. 1534508

Filing date 30 April 1993; registration date 27 October 1995

Relying on all goods, namely:

Class 25: Suits, dresses, jackets, blazers, coats, raincoats, skirts, trousers, jeans, shorts; shirts, sweaters, pullovers, jerseys, socks, all being knitted articles, shoes, boots, sandals; scarves, hats and caps; all included in Class 25.

("the opponent's first mark"); and

PERSONA

UK registration no. 906890479¹

Filing date 6 May 2008; registration date 5 November 2008

Relying on all goods, namely:

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas, parasols and walking sticks; Whips, harness and saddlery; Casual bags; Handbags; Wallets; Purses; Backpacks; Haversacks.

Class 25: Clothing, footwear, headgear.

("the opponent's second mark").

3. In relying on both of the above marks, the opponent gave a statement of use confirming that it has used the marks on all of the goods for which they are registered.
4. The opponent's claim is that in view of the similarity between the marks and the identity, similarity or complementarity between the goods, there exists a likelihood of confusion arising on the part of the relevant public. It is claimed that this includes a likelihood of association, through direct and indirect confusion. Lastly, it is noted that the opponent relies on an enhanced level of distinctiveness in respect of its marks. However, as I will come to discuss below, no evidence was filed to support that claim.
5. The applicant filed a counterstatement wherein he denied all of the claims against him.

¹ The opponent's second mark is a comparable mark based on an earlier EUTM. 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 existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

6. The opponent is represented by Marks & Clerk LLP and the applicant is unrepresented. Neither party filed evidence but the applicant did file submissions during the evidence rounds. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
7. 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.

PRELIMINARY ISSUES

The nature of the applicant's counterstatement

8. In considering the applicant's counterstatement, I note that there are several references to the 'UKIPO Examination Guide' and specific sections such as (but not limited to) 3.1.7 regarding the conceptual differences between trade marks and 3.2.9 which seemingly relates to differences in sales channels and target demographics and how this reduces the likelihood of confusion. It is noted that the applicant's references to the various sections include direct quotations. In short, there are no such sections in the Examination Guide published by the UK IPO.² Further, I have cross-referenced these citations with the Tribunal section of the Trade Marks Manual (also published by the UK IPO)³ and no such sections appear in that document either. On this point, I will say that whilst the quoted passages are not correctly cited, some of them do allude to correct principles that are routinely adopted in decisions issued by the Tribunal. I do not intend to go over each

² Which can be found at <https://www.gov.uk/guidance/trade-marks-manual/the-examination-guide>

³ Which can be found at <https://www.gov.uk/guidance/trade-marks-manual/tribunal-section>

reference but note, for example, that the applicant has included a passage regarding conceptual distinctions and how they can counteract visual and phonetic similarities. This does have some merit because *The Picasso Estate v OHIM*⁴ suggests that this may be the case. That being said, it is not always the case that conceptual differences overcome visual or aural similarities.⁵

9. Secondly, reference is made to a decision issued by the UK IPO under number BL O/688/22 which is put forward as an example of where there can be peaceful coexistence of trade marks. However, having considered this decision further, it is an *ex parte* decision regarding an objection of a trade mark due to its lack of distinctive character under section 3(1)(b) of the Act. It makes no reference to peaceful coexistence and is not a decision issued by this Tribunal.
10. Insofar as the counterstatement relies on such quotations and references, I consider it reasonable to conclude that it is more likely than not that it was drafted, at least in part, with the assistance of artificial intelligence. I say this because unsupported references such as those discussed at paragraph 8 above are commonly seen in submissions generated by artificial intelligence. In addition, it is a common pattern in submissions generated by artificial intelligence that they make reference to cases that do not exist or rely on incorrect cases, being the scenario discussed in the preceding paragraph.
11. For the avoidance of doubt, I do not reach the above conclusion lightly but I see no alternative reasons as to why such vague and imprecise references were made. As to how I treat such comments, I remind myself of the decision of Professor Phillip Johnson, sitting as the Appointed Person, in the case of *Pro Health* (BL O/0559/25). At paragraph 22 of that decision, Professor Johnson set out that where a Hearing Officer is aware material is fabricated, it is to be disregarded regardless of whether it is formally struck out or not. This is the approach I will take here in

⁴ Case C-361/04 P

⁵ *Nokia Oyj v OHIM*, Case T-460/07

that I will disregard any comments in the counterstatement that I deem to have been generated with the assistance of artificial intelligence. That being said, where such references do make reference to accurate principles (as discussed regarding the conceptual point above, for example), those principles remain relevant to the proceedings and will, if necessary, form part of the ordinary consideration of the case before me.

Google Searches

12. There are comments made by the applicant in his counterstatement that relate to Google searches. The applicant states that the Google searches for 'PERSONA' and 'NO PERSONA' produce entirely different results, reinforcing that the brands do not overlap in online presence, consumer perception or market positioning. In short, there is no evidence showing the results stemming from these Google searches and, without such, I am not willing to take the applicant's comments as fact. Such arguments are, therefore, of no assistance here and I will say no more about them.

Common use of 'PERSONA'

13. The applicant claims that 'PERSONA' is not exclusive to the opponent. In making this argument, he refers to multiple trade marks incorporating 'PERSONA' that are registered for goods in Class 25. The applicant claims that the existence of these brands means that 'PERSONA' is not inherently distinctive nor uniquely associated with a single brand. In principle, I accept that the presence of other marks using the same words can point to a weakening of the distinctiveness of those words. However, for such an argument to succeed, evidence of those marks present in the marketplace is required.⁶ On this point, there is no evidence before me of any of these third party brands that would assist the applicant's position. It is noted that

⁶ *Zero Industry Srl v OHIM*, Case T-400/06

reference is made to a brand called 'Persona Clothing' but, again, nothing is before me by way of evidence to suggest the presence of this brand on the marketplace or its impact on consumers.

14. This section of the applicant's counterstatement goes on to discuss co-existing brands that share core elements. In making this argument, the applicant refers to 'Coca-Cola' and 'Pepsi-Cola', 'Stone Island' and 'Island Green', 'AllSaints' and 'Saint Lauren' and 'Fred Perry and Perry Ellis'. It is claimed that all of these brands coexist despite their shared words. I do not intend to go over this point in too much detail but will explain briefly that the assessments I am required to make throughout this decision are based on the marks as they appear before me and reference to other unconnected marks are of no assistance to my decision. Further, some of the marks referred to are associated with extremely large and successful brands so I fail to see how a comparison between 'COCA-COLA' and 'PEPSI-COLA', for example, is of any relevance to a comparison between 'PERSONA' and 'NO PERSONA'. I will say no more about this point.

The applicant's submissions

15. I wish to briefly discuss the applicant's submissions wherein he stated that it is for the opponent to provide a factual basis to support its position under section 5(2)(b) of the Act and that its decision not to file evidence reinforces the argument that consumer confusion has not occurred and is unlikely to. Firstly, oppositions reliant upon section 5(2)(b) grounds do not require the filing of evidence meaning the lack of evidence in the present case is not a factor against the opponent. Secondly, whilst evidence of actual confusion may be of assistance,⁷ it is not necessary in order for oppositions reliant upon section 5(2)(b) grounds to succeed.⁸ In the present case, I do not consider the lack of evidence of actual confusion (or the absence thereof) to be a factor against the opponent.

⁷ See paragraph 80 of *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

⁸ See *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283

DECISION

Section 5(2)(b): legislation and case law

16. Section 5(2)(b) states that:

“(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.”

17. Section 5A of the Act states as follows:

“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.”

18. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in

question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

19. Given their filing dates, the opponent’s marks qualify as earlier trade marks in accordance with the above provisions. Both marks completed their registration processes more than five years prior to the filing date of the applicant’s mark. It was, therefore, open for the applicant to request proof of use for the opponent’s marks. However, he did not do so. The consequence of this is that the use provisions do not apply meaning that the opponent may rely on all of the goods for which its marks are registered.

20. 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 Pairs 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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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.

My approach

21. As set out above, the opponent relies on two earlier marks, neither of which are subject to proof of use. Those marks are both word only marks consisting solely of the word 'PERSONA'. Given the identity of the marks and the fact that the second mark includes a broader specification in respect of its class 25 goods (in that it consists of the broad term 'clothing, footwear, headgear'), I see no benefit to considering the opponent's first mark as any outcome stemming from the reliance upon that mark will either mirror, or be less advantageous to the opponent, than its second. I will, therefore, proceed to consider the opponent's second mark only and will refer to it simply as 'the opponent's mark'. For the avoidance of doubt, I will

only return to discuss the opponent's first mark if necessary at the conclusion of my decision.

Comparison of goods

22. The competing goods are as follows:

The opponent's goods	The applicant's goods
<u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas, parasols and walking sticks; Whips, harness and saddlery; Casual bags; Handbags; Wallets; Purses; Backpacks; Haversacks. <u>Class 25</u> Clothing, footwear, headgear.	<u>Class 25</u> Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Furs [clothing]; Layettees [clothing]; Clothing layettes; Garments for protecting clothing; Linen clothing; Headbands [clothing]; Headbands for clothing; Clothes; Gloves [clothing]; Gloves as clothing; Aprons [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Silk clothing; Leather clothing; Clothing of leather; Leather (Clothing of -); Parts of clothing, footwear and headgear; Collars [clothing]; Knitted clothing; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts [clothing]; Belts for clothing; Casual clothing;

	Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Viscers [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Trunks being clothing; Woven clothing; Drawers [clothing]; Drawers as clothing; Sports clothing; Clothing for sports; Leisure clothing; Athletic clothing; Ties [clothing]; Muffs [clothing]; Bodies [clothing]; Tops [clothing]; Weatherproof clothing; Water-resistant clothing; Fabric belts [clothing]; Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Chaps (clothing); Thermal clothing; Cowls [clothing]; Men's clothing; Dance clothing; Mitts [clothing]; Braces for clothing; Plush clothing.
--	---

23. When making the comparison, all relevant factors relating to the goods 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:

“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”.

24. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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.”

26. In its counterstatement, the applicant claimed that the parties' goods serve entirely different markets and appeal to distinct consumer bases. On this point, the applicant claims that the opponent is a premium designer label specialising in plus-size women's fashion, whereas his own brand is a contemporary streetwear brand targeting 18 to 30 year old males. This is noted but when considering the likelihood of confusion under section 5(2)(b), the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods based on the specifications before me, not the goods effectively provided by the parties.⁹ Therefore, given that the opponent's specification includes the term "clothing, footwear, headgear" without limitation, the point raised by the applicant is of no assistance.

27. Save for those goods specifically listed below, all of the applicant's goods are types of clothing or headgear. As such, they are identical under the principle outlined in *Meric* with the opponent's term of "clothing, footwear, headgear".

Parts of clothing, footwear and headgear; Collars [clothing]; Pockets for clothing.

28. The above goods are all parts of clothing, footwear or headgear. Whilst I do not consider them to be identical to the opponent's term of "clothing, footwear, headgear", they are similar. I say this because whilst the nature and method of use may differ, there is an overlap in end purpose, trade channels and user. Dealing with purpose first, I accept that the immediate aim is for the applicant's goods to be used to create or repair clothing whereas the opponent's goods are to be worn. However, the end purpose of the applicant's goods is that they will be worn on the person for stylistic or practical reasons, which is the same for the opponent's goods. That being said, given that this overlap is in the end purpose of the applicant's goods, I consider that it is somewhat fleeting. In terms of trade

⁹ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

channels, I am of the view that a company that produces clothing, footwear or headgear is likely to produce parts for the same and such goods will also be available via the same retail outlets. As for user, I find that members of the general public who buy clothing may also seek to buy parts to create or repair clothing. Further, in some circumstances, the goods will be competitive. This is on the basis that someone may look to create their own clothing as opposed to buying finished garments, for example. Lastly, there is a degree of complementarity between the goods in that the parts are important to the clothing goods and such a relationship between them is likely to lead consumers to believe that the goods originate from the same undertakings.¹⁰ Overall, I consider these goods to be similar to a medium degree.

Braces for clothing.

29. The above goods are not parts of clothing but are accessories. They differ in nature and method of use with the opponent's goods. As for purpose, there is some overlap as whilst the core purpose of braces is to hold items of clothing in place, they can still be worn for stylistic reasons which can be the same for general items of clothing. The above goods are likely sought from the same undertakings that produce and sell clothing items meaning that there is an overlap in trade channels. The goods overlap in user also. Lastly, while the goods are important to one another, I do not consider their relationship is such that consumers will believe that they are the responsibility of the same undertaking. They are not, therefore, complementary. Taking all of this into account, I find that these goods are similar to a medium degree.

¹⁰ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

The average consumer and the nature of the purchasing act

30. 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.

31. In *Iconix* (cited above), 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.

32. The opponent submits that the average consumer for the goods at issue is the member of the general public. I agree to some extent but note that insofar as the goods relate to parts, the consumer will also be business users such as clothing manufacturers. For the most part, the goods will be available via a range of general clothing retailers and their online equivalents. For the parts, the goods will likely be available from the producer directly, via wholesalers or from specialist garment stores. Either way, in physical stores, the goods will be displayed on shelves or racks and self-selected by the consumer. A similar approach will follow for online sales in that the consumer will select the goods having viewed images of them on a website. As a result, I find that the visual component will dominate the selection process of the goods at issue. Having said that, I do not discount an aural component playing a part as a result of advice from sales assistants or word of mouth recommendations.

33. The goods at issue cover a range of clothing, headgear and footwear items (as well as their parts) and are likely to be selected relatively frequently. In some cases, the goods (being parts) will be selected in bulk. I consider that the costs of the goods at issue will vary quite considerably from cheap clothing goods such as socks to relatively expensive items such as designer clothing, for example. In respect of the level of attention paid when selecting the goods at issue, the opponent submits that the degree of attention paid will be average. For the most part, I agree¹¹ on the basis that the average consumer will give consideration to

¹¹ Though I would, instead, categorise it as 'medium'.

factors such as materials used, style and suitability. These are ordinary factors and I consider that they will also be taken into account in circumstances where the consumer selects goods that are more expensive and/or on a less frequent basis. That being said, I do appreciate that some of the lower cost goods (such as socks, for example) may be selected with a lower degree of attention. To conclude, I find that the level of attention will either be lower (but not outright low) or medium, regardless of the identity of the consumer.

Comparison of the marks

34. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

35. 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.”

36. 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.

37. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
PERSONA	NO PERSONA

38. I have comments from both parties in respect of the similarity of the marks. Whilst I will only refer to those comments where I deem it necessary to do so, I can, for the avoidance of doubt, confirm that I have taken both parties' positions into account when making the following comparison.

Overall impression

39. The opponent's mark is a word only mark that consists of one word, being 'PERSONA'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself. The applicant's mark is also a word only mark that consists of two words, being 'NO PERSONA'. I find that neither word dominates over the other, meaning that the overall impression of this mark lies equally in both words.

Visual comparison

40. Visually, both marks include the word 'PERSONA'. The marks differ in the presence of the first word of the applicant's mark, being 'NO'. Despite the point of difference coming at the beginning of the marks,¹² I am of the view that the length of the shared word and the fact that it is the sole element of the opponent's mark are such that they result in the marks being visually similar to a high degree.

¹² Which, as per *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 is the parts of marks that tend to have more visual and aural impact.

Aural comparison

41. The opponent's mark consists of three syllables that will be pronounced as 'PER-SOW-NUH'. The applicant's mark consists of four syllables, with 'NO' being pronounced in the ordinary way and 'PERSONA' being pronounced as above. Aurally, the marks share three syllables, being the entirety of the opponent's mark, with just one point of difference coming in the one syllable, NO. In comparing the marks, I consider that the difference in just one syllable, albeit at the beginning, does not detract too much from the shared use and pronunciation of the longer element 'PERSONA' (which, again, is the sole element in the opponent's mark). Overall, I consider that the marks are aurally similar to a high degree.

Conceptual comparison

42. The opponent's mark's concept is that associated with the word 'PERSONA'. The opponent submits that this will be understood as reference to a particular type of character that a person seems to have, that is often different from their real or private character. This submission falls in line with my own understanding of the word and its dictionary definition, which is "*an assumed identity or character*".¹³ Turning to the applicant's mark, the addition of the word 'NO' before 'PERSONA' will be taken as a reference to a lack of an assumed identity or character.

43. In comparing these concepts, I find that the addition of 'NO' alters the overall meaning of the applicant's mark to the point that it reduces the impact of the shared reference to 'PERSONA'. That being said, regardless of whether the marks will be viewed as a reference to someone having a persona (the opponent's mark) or not (the applicant's mark), the shared use of the concept surrounding a persona will still be noticed. In my view, the conceptual similarity of the marks sits at a medium degree.

¹³ <https://www.collinsdictionary.com/dictionary/english/persona>

Distinctive character of the opponent's mark

44. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 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).”

45. Registered trade marks possess varying 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 marks can be enhanced through use but, as set out above, the opponent has not filed any evidence. Therefore, I only have the inherent position

to consider. On this point, I remind myself that the applicant's arguments as to the common use of 'PERSONA' and its lack of inherent distinctiveness are of no assistance in the present case.

46. The opponent's mark consists of the word 'PERSONA'. As above, this will be seen as a reference to an assumed identity or character. I have given consideration as to whether, when viewed on clothing, 'PERSONA' will be viewed as a reference to the user assuming a *new persona* when wearing the opponent's goods, thereby potentially giving it a laudatory meaning. However, I am of the view that such a connection is somewhat of a stretch and one that will not be understood by a significant proportion of consumers. As such, I do not consider that the opponent's mark has any obvious connection to the goods upon which the opponent relies. Therefore, it has no descriptive or allusive qualities. That being said, it is a dictionary word with a known meaning and will not, therefore, be viewed as remarkable from a trade mark perspective. As a result, I consider that the opponent's mark attracts a medium degree of inherent distinctive character.

Likelihood of confusion

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. 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 trade 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 trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

48. I found the goods at issue to be either identical or similar to a medium degree. For the most part, the average consumer base for the goods at issue will be members of the general public. However, for the goods that cover parts of clothing, headgear or footwear, the consumer will also include business users. Regardless, both sets of consumers will select the goods via primarily visual means (though I do not discount an aural component) whilst paying mostly a medium degree of attention. On this point, I remind myself that some goods will attract a lower (but not outright low) degree of attention. I have found the marks at issue are visually and aurally similar to a high degree and conceptually similar to a medium degree. Lastly, I concluded that the opponent's mark enjoys a medium degree of inherent distinctive character.

49. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I consider that consumers will misremember or inaccurately recall the parties' marks for one another. As above, the marks are highly similar from a visual and aural perspective and even though the conceptual similarity is not high, it is still at a level of similarity that does not detract from the other factors, especially when considering that the goods at issue are ordinary consumer products that do not attract a high degree of attention during the selection process.¹⁴ Even if my finding of conceptual similarity is found to be too generous, the shared use of 'PERSONA' (as the sole or largest element across the marks) still provides a sufficiently similar conceptual hook to remain a factor in favour of a finding of direct confusion.¹⁵ In addition, the identity/similarity of the goods at issue is another factor in favour of a finding of direct confusion when bearing in mind the principle of

¹⁴ On the contrary, it may in some circumstances, be to a lower (but not outright low) degree.

¹⁵ In any event, as I have explained above (with reference to *Nokia*), it is not always the case that any conceptual differences offset the visual and aural similarities.

interdependence and the fact that the marks are highly similar.¹⁶ Lastly, I wish to point out that whilst the point of difference between the marks comes at the beginning of the applicant's mark, it is not always the case that this avoids a likelihood of confusion. On this point, I remind myself of the case of *Bristol Global Co Ltd v EUIPO*, T-194/14 wherein the GC found that the common element of 'STONE' in the marks 'STONE' and 'AEROSTONE' was sufficient to create the necessary degree of similarity between the marks as wholes to enable the opposition before the EUIPO to succeed. Whilst an EU case, I consider that this principle applies here, especially when considering the point of difference is just two letters, whereas the point of similarity stems from a shared seven letter word. Consequently, I find that there exists a likelihood of direct confusion between the marks.

Final remarks

50. Given that I have found confusion in respect of the opponent's second mark, I do not consider it necessary to return to consider its first mark. Even if I were to do so, I find that given the identity of that mark to the opponent's second mark and the high degree of similarity between the opponent's marks' specifications, the outcome would be the same as above. As such, and for the avoidance of doubt, I consider that the findings I made above regarding confusion are equally applicable to the opponent's first mark.

CONCLUSION

51. The partial opposition succeeds in full and, subject to any successful appeal against my decision, the applicant's mark is refused registration for all of the opposed goods (being those in Class 25). It may, however, proceed to registration for the services that were not subject to this opposition, being:

¹⁶ It is acknowledged that some goods are similar to a medium degree but this is not at a low level so, in my view, does not detract from this finding.

Class 41: Music concerts; Presentation of music concerts; Live music concerts; Performance of music; Music concert services; Performance of music and singing; Live music performances; Music entertainment services; Arranging of music performances; Production of music shows; Live music shows; Live musical concerts; Presentation of musical concerts; Entertainment in the nature of live performances by musical bands; Arranging of musical entertainment.

COSTS

52. The opposition has succeeded in full meaning that the opponent is entitled to a contribution towards its costs. On this point, I remind myself of my conclusion above that the counterstatement of the applicant is more likely than not to have been drafted, at least in part, with the assistance of artificial intelligence. In considering how this issue relates to costs, I refer to the case of *Pro Health* (cited above), wherein Professor Johnson set out at paragraphs 23 and 24 of his decision that off-scale costs should be awarded where a party puts fabricated material before the Tribunal. In the present case, the opponent did not make a request for off-scale costs as it does not appear that it picked up on the fact that the counterstatement was likely generated by artificial intelligence. Further, the counterstatement was filed before the decision was issued in *Pro Health* and I consider it reasonable to conclude that the applicant was unlikely to have been aware of the risks and consequences of using artificial intelligence to draft his counterstatement. On this point, I note that Professor Johnson's comments at paragraph 28 of his decision (being where he discusses the Tribunal adopting a practice of including a warning to parties setting out the risks of using artificial intelligence in proceedings) would not have been adopted at the time of the

applicant's filing of his counterstatement.¹⁷ Therefore, whilst I remain critical of the applicant's approach in filing his counterstatement, I do not consider it necessary to make an off-scale costs award in the present case. As such, the costs awarded to the opponent are to be based upon the scale published in Tribunal Practice Notice 1/2023.

53. In the circumstances, I award the opponent the sum of £900 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the counterstatement:	£400
Written submissions in lieu of a hearing:	£400
Official fees:	£100 ¹⁸
Total:	£900

54. I hereby order Alexander Edward Ali Seyed Kasai to pay MAX MARA FASHION GROUP S.r.l. the sum of £900. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 11th day of August 2026

A COOPER
For the Registrar

¹⁷ On the basis that his decision was issued on 20 June 2025 whereas the applicant's counterstatement was filed on 27 February 2025.

¹⁸ It is noted that the opponent paid £200 in official fees but given that it dropped the section 5(3) ground prior to filing evidence, I only consider it necessary to award costs in line with what they would have been had the opposition been reliant upon section 5(2)(b) only.