BL O/1205/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3793662

BY PRYA LTD

TO REGISTER THE TRADE MARK:

PRYA

IN CLASSES 18, 25 & 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 436690

BY PYRA IP PTY LTD

Background and pleadings

1. On 30 May 2022, PRYA LTD ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 22 July 2022. Registration is sought for the following goods and services:

> Class 18: Fashion handbags.
>
> Class 25: Clothes; Clothing; Leisure clothing; Girls' Clothing; Women's clothing; Headbands [clothing].
>
> Class 42: Fashion design; Design of fashion accessories.

2. At the time of filing the Form TM7 the opponent marked this as a partial opposition however, due to the applicant amending their specification, the above noted goods and services are what remains and are all subject to these opposition proceedings. Therefore, the opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act") against all of the goods and services that remain applied for.

3. The opponent relies on the following trade mark:

UK801535021[1]

PYRA

Filing date: 27 April 2020
Registration date: 29 October 2020
Relying upon the following goods:

[1] Following the end of the transition period of the UK's withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (IR)' retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation.

Class 25: Clothing and articles of clothing, shirts, trousers, skirts, dresses, suits, underwear, coats, headbands, neckties, hosiery, socks, jackets, knitwear, mittens, pyjamas, bathrobes, scarfs, shawls, swimsuits, belts, jeans; footwear; hats, berets, caps.

4. The opponent claims that the marks are visually and aurally very similar and are likely to be misread/misspoken. Further, the marks are conceptually neutral. The opponent also states that the applicant's goods and services are identical or similar to their own.

5. The applicant filed a counterstatement denying the claims made by the opponent.

6. The applicant is represented by Harper James and the opponent is represented by Ashfords LLP.

7. Both parties filed evidence. Neither party requested a hearing but the applicant filed submissions in lieu. This decision is therefore taken following careful consideration of the papers.

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 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 opponent's evidence consists of a witness statement dated 7 February 2023 by Carl Bryan Steele, who is a solicitor and chartered trade mark attorney at Ashfords LLP, the representatives of the opponent. This has two accompanying exhibits. The purpose of this evidence is to show that class 18 and 25 goods are sold under the same brand name and also class 25 goods and class 42 services can be offered by the same brand.

10. The applicant's evidence consists of a witness statement dated 11 April 2023 by Gemma Louise Pickavant, who is a solicitor at the applicant's representative firm. This has four accompanying exhibits. There are three main points to the evidence: (i) the conceptual meaning of the earlier mark (ii) rebuttal of the evidence from the opponent regarding similarities between the class 25 goods and class 42 services (iii) rebuttal of the opponent's evidence that clothing and handbags are sold under the same brand or supplier.

DECISION

11. Section 5(2)(b) is being relied upon and is as follows:

> "5(2) 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. 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,

13. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before

the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Case law

14. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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

15. 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".

16. 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.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market* (OHIM) ('Meric'), Case T-133/05, the General Court ("the 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".

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

> "...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. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

Applicant's goods and services	**Opponent's goods**
Class 18: Fashion handbags.	
Class 25: Clothes; Clothing; Leisure clothing; Girls' Clothing; Women's clothing; Headbands [clothing].	Class 25: Clothing and articles of clothing, shirts, trousers, skirts, dresses, suits, underwear, coats, headbands, neckties, hosiery, socks, jackets, knitwear, mittens, pyjamas, bathrobes, scarfs, shawls, swimsuits, belts, jeans; footwear; hats, berets, caps.
Class 42: Fashion design; Design of fashion accessories.	

Class 18

20. Both parties have submitted evidence regarding the similarity between the applicant's class 18 goods and the opponent's class 25 goods. The opponent has submitted screenshots in Exhibit CBS1 of various websites that offer for sale both clothing and handbags under the same brand. The applicant's evidence at exhibits GLP3 and GLP4 are extracts from websites that sell one but not the other. There is well established caselaw on the subject of similarity between these goods. In *El Corte Ingles SA v OHIM*, Case T-443/05 the GC found that *Clothing, footwear and headgear* in Class 25 were similar to the clothing accessories included in *Leather and imitations of leather, and goods made of those materials and not included in other classes*. I note that in a later case, *Asos plc v OHIM,* Case T-647/11, the GC found that, for example, sports bags and briefcases could not be considered clothing accessories and were not similar to class 25 goods. The principle to be applied was summarised in *Gitana SA v OHIM,* Case T-569/11:

> "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. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of 'goods made of these materials [leather and imitations of leather] and not included in other

classes' in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; exē, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27)."[2]

21. Nevertheless, the underlying principle is the same in that goods in class 18 are similar to 'clothing' to the extent that they may combine to form a 'coordinated look'. The opponent's specification in class 25 includes 'clothing and articles of clothing'. Bearing in mind the above case law, I find that they are similar to a medium degree to the applicant's class 18 goods which are 'fashion handbags'.

Class 25

Clothes; Clothing

22. These terms from the applicant's specification are self-evidently identical to the opponent's 'clothing and articles of clothing'.

Leisure clothing; Girls' Clothing; Women's clothing

23. I find that these goods from the applicant's specification can all be said to be types of clothing and therefore fall within the wider category of 'clothing and articles of clothing'. I therefore consider them to be identical under the *Meric* principles.

Headbands [clothing]

24. This term is self-evidently identical to 'headbands' in the opponent's specification.

[2] Paragraph 45

Class 42

Fashion design

25. I note the evidence provided by the opponent in Exhibit CBS2 shows screenshots of websites that sell clothing and also offer bespoke tailoring. I agree with the applicant's assertions in their witness statement that these offerings do not necessarily fall within the average consumer's understanding of what 'fashion design' might mean. However, I will go on to apply the *Treat* criteria.

26. I consider that there is an overlap in end user with the opponent's 'Clothing and articles of clothing' and the above services from the applicant's specification as they share the same end user, most likely being the general public. There is likely to be an overlap in trade channels also as I believe that fashion designers not only offer the design services but also go on to produce and sell the clothing onto other stores or directly to the consumer. The nature differs, one is a good and the other a service, as does the purpose. I believe that fashion design is important/indispensable for the goods of clothing to be produced and it would be reasonable for the average consumer to believe these goods and services would come from the same undertaking. I therefore find them to be complementary. I therefore find these goods and services similar to a medium degree.

Design of fashion accessories

27. The above reasoning at paragraph 25 also applies here between the applicant's 'design of fashion accessories' and the opponent's 'headbands; neckties; scarfs; shawls; belts' as I believe they could all be considered as fashion accessories. I therefore find them similar to a medium degree.

Average consumer and the purchasing act

28. 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.

29. 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

30. The average consumer of the goods in classes of 18 and 25 will predominantly be the general public.

31. The selection of such goods is largely a visual process, as the average consumer will wish to physically handle the goods to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact. If the consumer is buying online then I also note they will see the marks on the websites. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in the latter circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer's mind.

32. Although the prices of individual items will vary greatly, I consider that the average consumer will pay at least a medium degree of attention (but not the highest level) during the purchase of the class 18 and 25 goods.

33. Regarding the class 42 services, business users should also be considered as well as the public, and the costs are likely to be slightly higher as well. Once again, the visual aspect of the purchase will likely dominate (not discounting any aural factors). I consider that once again, the average consumer will pay at least a medium degree of attention (but not the highest level) during the purchasing process.

Comparison of the marks

34. 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."

35. 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.

36. The respective trade marks are shown below:

Earlier Mark	Contested Mark
PYRA	PRYA

37. Both the earlier and contested marks consist of one word. There are no other elements to contribute to the overall impression which lies in the word itself.

38. Visually, both marks comprise of one word which is four letters long. Both marks contain the same letters, 'P' 'R' 'Y' and 'A' with the 'R' and 'Y' being swapped around in the earlier mark. I therefore find the marks to be visually similar to a very high degree.

39. Aurally, I agree with the applicant's submission that the opponent's mark will likely be pronounced as *pie-rah*. I note the applicant submits that their mark would be pronounced *pree-yah.* In this case, the marks share the beginning 'puh' sound and the ending "ah" sound, and both are two syllables long. In this instance, I consider the aural similarity to be medium. I also consider that the applicant's mark could be pronounced as *pry-yah* in which case the vowel sounds in the middle are closer. Therefore, in this instance I find the marks to be aurally similar to between a medium and high degree.

40. Next, I turn to the conceptual comparison. Both parties agree that the applicant's mark has no conceptual meaning. The applicant argues that the opponent's mark has the meaning 'born of flame' from Ancient Greek and this is shown on their website (which they have provided screenshots of at exhibit GLP1). I believe the comments made by Phillip Harris, as the Appointed Person in *Retail Royalty Company v Harringtons Clothing Limited* O/593/20 might be appropriate here:

> "75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trademark acknowledgement) or a

level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken...”

41. I do not believe the average consumer, upon seeing the opponent’s mark in the marketplace would necessarily assign any meaning and would rather view it as a made up word. Therefore, the marks are conceptually neutral.

Distinctive Character of the Earlier Marks

42. 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 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).”

43. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods

and/or services, ranging up 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 however, I have not been provided with any evidence so I only have the inherent position to consider.

44. As I have found the earlier mark to be an invented word with no link to the goods it is registered for, I consider that it is inherently distinctive to a high degree.

Likelihood of confusion

45. 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 and services 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services 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 he has retained in his mind.

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

- I have found the overall impressions of both marks lies in the marks themselves.
- I have found the marks to be visually similar to a high degree, aurally similar to either a medium degree or to between a medium and a high degree (depending on how the applicant's mark is pronounced) and conceptually neutral.
- I have found the opponent's mark to be inherently distinctive to a high degree.

- I have identified the average consumer for the goods and services to be a combination of members of the general public as well as business users. The purchasing process is likely to be predominantly visual.
- I have concluded that at least a medium (but not the highest) degree of attention will be paid during the purchasing process.
- I have found the goods and services to either be identical or similar to a medium degree.

47. Due to the high degree of visual similarity between the marks, including that they are made up of identical letters with only two of them being reversed in the middle of the mark, the visual purchasing process being the most dominant and bearing in mind the imperfect recollection of the average consumer, I consider there would be direct confusion between the marks. This is further supported by the levels of similarity of the goods and services in question and the lack of conceptual differences between the marks.

Conclusion

48. The opposition is successful in its entirety.

Costs

49. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I find that the opponent's own evidence was limited in value and not extensive and therefore I am awarding below the TPN guideline. I award the opponent the sum of **£600**, calculated as follows:

Official fee	£100
Preparing the Notice of opposition and considering the counterstatement	£250

Preparing evidence and considering the other side's evidence	£250
Total	**£600**

50. I therefore order PRYA LTD to pay Pyra IP Pty Ltd the sum of £600. This 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 21st day of December 2023

L Nicholas
For the Registrar