

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3199516 IN THE NAME OF YANGO INTERNATIONAL LIMITED

AND IN THE MATTER OF OPPOSITION NO. 408493 THERETO BY CONSOLIDATED ARTISTS B.V.

DECISION

Introduction

1. This is an appeal against the decision of Mr Matthew Williams, acting on behalf of the Registrar, dated 15 March 2018 (O-169-18). In his decision the Hearing Officer dismissed the opposition and ordered Consolidated Artists B.V. (*“the Opponent”*) pay to Yango International Limited (*“the Applicant”*) the sum of £450 as a contribution towards its costs.

2. On 30 November 2016 the Applicant applied to register the trade mark:

YANGO

in respect of a number of different goods and services in classes 3, 14, 16, 25, 26, 38 and 41.

3. The application was examined and accepted and subsequently published for opposition purposes in the Trade Marks Journal on 9 December 2016.

4. By a Notice of Opposition dated 9 February 2017 the Opponent opposed the application in its entirety on the basis of:

(1) Section 5(2)(b) of the Trade Marks Act 1994 (*“the 1994 Act”*); and

(2) Section 5(4)(a) of the 1994 Act on the basis that the use of the mark YANGO for the goods and services specified was liable to be prevented in the UK by way of a claim for passing off.

5. The earlier trade marks relied upon by the Opponent for the purposes of its Ground of Opposition under Section 5(2)(b) were:

(1) EU Trade Mark No 9850785 for the mark:

MANGO

registered in respect of various goods and services in classes 3, 9, 14, 18, 25 and 35 (“*Mark 1*”). The mark was applied for on 29 March 2011 and was registered on 14 June 2018. It is to be noted that at the time that the hearing took place before the Hearing Officer this EUTM was ‘*under examination*’ only proceeding to registration the week before the hearing of the Appeal.

- (2) EU Trade Mark No. 13453576 for the mark:

MANGO
MAN

registered in respect of various good and services in classes 14, 18, 25 and 35 (“*Mark 2*”). The mark was replied for on 12 November 2014 and was registered on 13 April 2015.

6. Given the status of the marks at the time that the Hearing Officer came to consider his decision neither Mark 1 nor Mark 2 were subject to the proof of use requirements under Section 6A of the 1994 Act.
7. The Opponent also relied upon the earlier unregistered trade mark:

MANGO

which it claimed had been used throughout the UK since 1 January 2000 in respect of:

Clothing; footwear; headgear; coats; jackets; dresses; jumpsuits; cardigans and sweaters; shirts t-shirts; trousers; jeans; leggings; skirts; lingerie; underwear; bras; socks; sleepwear; sportswear; office wear; maternity wear; shapewear; blazers; suits; scarves and foulards; ties; bow ties; gloves; belts; pocket handkerchiefs; pocket squares; shoes; sneakers; sandals; loafers; mules; hats; beanie hats; headbands; hairbands; hair ties; hair clips; bags; cases; document cases; tablet cases; briefcases; clutch bags; bucket bags; hand bags; sports bags; tote bags; cosmetics bags; backpacks; cross-body bags; jewellery; necklaces; brooches; brooch clasps; bracelets; braces; decorative patches; pins; decorative pins; lapel pins; key rings; tie clips; cufflinks; earrings; chokers; rings; wallets; purses; card holders; umbrellas; sunglasses; glasses cases; phone cases; retail services in connection with the aforesaid goods.

8. The Opponent went on to aver that in paragraphs 32 to 34 of Attachment 4 to its Notice of Opposition as follows:

32. As a consequence of this use the Opponent enjoys an extensive goodwill and reputation in the trade mark MANGO.
33. The adoption by the Applicant of a trade mark similar to Opponent's trade mark MANGO, namely YANGO, would constitute a misrepresentation and would cause confusion with the Opponent's trade mark and damage to the Opponent's goodwill.
34. As a consequence of the above, use of the Contested Sign is liable to be prevented by virtue of the law of passing-off in relation to the rights subsisting in the Opponent's trade mark MANGO. Accordingly, registration of the Contested Sign would be contrary to the provisions of section 5(4)(a) of the Trade Marks Act 1994.

9. On or about 24 April 2017 the Applicant filed a notice of defence and counterstatement in which it denied all the claims made.

10. The Opponent filed evidence. The Applicant filed no evidence. Both parties filed written submissions in lieu of an oral hearing of the Opposition and the Hearing Officer took his decision on the basis of the papers that were before him.

The Hearing Officer's Decision

11. Having summarised the evidence filed by the Opponent the Hearing Officer first considered the Section 5(4)(a) Ground of Opposition.

12. Having set out the principles of law that were to be applied, in respect of which there is no challenge on this appeal, the Hearing Officer went on to find in paragraphs [37] and [38] of his Decision as follows (footnotes not included):

37. The Opponent also has the burden of proof to show a false representation (intentional or otherwise). The traditional form of misrepresentation in a passing off claim is as to the 'source' of the goods or services and occurs where the defendant uses a word or name that the public associates with the claimant's business that gives rise to the impression that the business of the claimant and the defendant are in some way connected. Such a misrepresentation is objectionable because it deceives or is likely to deceive the public and attempts to ride on the back of the claimant's goodwill. Evidence of actual confusion is not

necessary, but it must be shown that a “substantial number” of the relevant public must be likely to be deceived by the defendant’s mark. The relevant public comprises the customers (actual or prospective) of the claimant.

38. In the present case I find that the distinctions between the two marks are such that there is no misrepresentation. While clearly the words YANGO and MANGO share four of their five letters - “ANGO” - the different opening letter of each word is obvious and changes not only the look and sound of the marks, but also the conceptual impression. YANGO is an invented word whereas MANGO has a readily identifiable concept (a tropical fruit / tree). The relevant public would have no reason to consider YANGO to be associated with the MANGO brand. In the absence of this second essential element a passing off action could not succeed. I therefore find that the opposition based on section 5(4)(a) must fail.

13. The Hearing Officer then turned to consider the claim under Section 5(2)(b) of the 1994 Act. The Hearing Officer began this section of his Decision with the following:

39. The sign used in the passing off claim, being simply a word without stylisation, is closer to the Applicant’s mark than is either MARK 1 or 2 relied on under section 5(2)(b). And the goods and services in which I have found the Opponent to have goodwill have, at least in many cases, directly identical counterparts in the Opponent’s registrations (for example goods in Class 25 including clothing, footwear, headgear, sportswear). Yet the passing off claim has failed on the basis of my finding that the words YANGO and MANGO are insufficiently similar to sustain a claimed misrepresentation. In these circumstances I will deal with the section 5(2)(b) ground relatively briefly, since it entails comparable relevant considerations around the visual, aural and conceptual similarity of the marks in the context of likely confusion. Given the presence of the additional word in Mark 2, I will focus on Mark 1, since it is clearly closer to the Applicant’s mark than is Mark 2.

14. The Hearing Officer then proceeded to set out the applicable law to the issue that was before him at paragraphs [40] to [41] of the Decision. No criticism on this appeal is made of the approach set out by the Hearing Officer.
15. With regard to the comparison of the respective goods and services the Hearing Officer noted that the Applicant accepted that there were similarities in the goods specified in Classes 3, 14 and 25. The Hearing Officer went on to note that there were some directly identical terms in the parties’ specifications. The Hearing Officer therefore indicated that he would proceed with his analysis of the Section 5(2)(b) ground on the basis that at least some of the goods in issue were identical (paragraph [42] of the

Decision). Again no criticism is made on this appeal of the approach taken by the Hearing Officer.

16. With regard to the average consumer and the purchasing process the Hearing Officer found as follows:

43. The average consumer for the respective goods will be a member of public. The consumer of the services may include the public, but may also include businesses. I would expect no more than a normal level of attention in the selecting and purchasing of the goods at issue; the services may attract a slightly higher level of attention.

44. The purchasing act will be visual as the goods and services are likely to be offered and branded through a range of visual communications, including images on websites and in hard copy publicity literature and the goods will be seen on display in retail outlets. However, I do not discount aural considerations which may also play a part, including as part of advertisements or word-of-mouth recommendations, so the way the marks sound will also be relevant.

17. With regard to the comparison of the marks in issue the Hearing Officer stated as follows:

Comparison of the marks

45. It is clear from *Sabel* 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. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks.

46. The respective trade marks are:

YANGO	MANGO
The Applicant's contested trade mark	The Opponent's Mark 1

47. The overall impression of the Applicant's mark is simply that it is the made-up word "YANGO". The overall impression

of the Opponent's Mark 1 is that it is the standard and well-known dictionary word MANGO. The thick uppercase font with small interruptions in each of the letters is not a negligible feature, and does contribute to the overall impression of the mark, but it is the word itself that clearly plays the most important and distinctive role in the mark.

Visual similarity

48. The marks differ in that the Applicant's mark is figurative, being presented in a particular (though not especially fancy) font, incorporating apparent breaks in each of the letters comprising the word. Both words involve five letters, which differ only in their respective first letters – Y and M. Whilst I note that each of those initial letters features a central "V"-shaped element, they are plainly the ordinary capital letters Y and M, which the average consumer will readily distinguish. It is considered a rule of thumb that in assessing similarity of trade marks the attention of the public fixes more readily on the first part of a mark than on its end. Despite the shared -ANGO component, I find the marks visually similar to no more than a medium degree.

Aural similarity

49. Again noting that the attention of the public tends to fix more readily on the first part of a mark than on its end and that the opening letters are the quite different sounding letters Y and M, I find the marks to be aurally similar to no more than a medium degree.

Conceptual similarity

50. Mark 1 depicts the word MANGO, which the average consumer will know to be the name of a fruit (and tree). YANGO has no conceptual meaning and is a made-up word. The marks are conceptually dissimilar.

18. The Hearing Officer then found that the word MANGO enjoyed a reasonable degree of inherent distinctive character for the goods and services for which it was registered; and an enhanced level of distinctiveness in relation to the range of goods and related retail services relied upon under the passing off ground to the extent that such goods and services were listed in the specification of Mark 1. The Hearing Officer went on to find that Mark 1 had a high degree of distinctiveness for essentially clothing and its retail. See paragraphs [52] and [53] of the Decision.
19. With regard to the conclusion with respect to the likelihood of confusion the Hearing Officer held as follows (footnotes not included and emphasis as in the original):

54. I now turn to make a global assessment as to the likelihood of confusion between the marks if they were used in relation to the goods and services specified. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of weighing up the combined effect of all relevant factors in accordance with the authorities I have set out in this decision (at paragraph 41).

55. Earlier in this decision I have found that at least some of the goods of the parties are identical (including clothing for example) and that the Opponent's Mark 1 has a high degree of overall distinctiveness character for clothing and its retail (its inherent distinctiveness enhanced through use). These factors clearly weigh in favour of the Opponent. I have found that the average consumer of the goods is a member of the public, who will pay no more than a normal level of attention in the purchasing process. The goods will be selected by predominantly visual means, but aural considerations may play a part in the selection process and I have found the Applicant's mark to be visually and aurally similar to Mark 1 to no more than a medium degree. However, I have also found that those marks are conceptually dissimilar and it is this point that I consider most influential in this decision. It is clear from case law that conceptual differences may counteract visual and phonetic similarities where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public.

56. Weighing in the balance all of the above factors I find in this case that there would be no likelihood of confusion on the part of the relevant UK public as to the origin of the goods, including a likelihood of association. I find this to be the case even taking account of the interdependence principle - that in assessing likelihood of confusion, a lesser degree of similarity between marks may be offset by a greater degree of similarity between the goods and services at issue.

57. Since I have found no likelihood of confusion based on identical goods, there clearly can be none for goods or services that may be only similar or where they have not been shown to have an enhanced level of distinctive character through use. The additional word "MAN" in Mark 2 is a point of difference from the Applicant's mark that is absent from Mark 1, thus the Opponent's claim under Mark 2 does not succeed either.
Consequently, the opposition also fails on its section 5(2)(b) grounds.

The Appeal

20. On 12 April 2018 an appeal against the Hearing Officer's decision was filed on behalf of the Opponent pursuant to Section 76 of the 1994 Act.

21. The Grounds of Appeal contend in substance that the Hearing Officer's decision made several distinct and material errors of principle. In particular it is said:
- (1) In making the visual comparison between the marks in issue the Hearing Officer erred by treating a word-only mark as being limited to its use in upper case letters, and by not taking into account the fact that a word-only mark covers use in all possible fonts and typefaces;
 - (2) The Hearing Officer erred in finding the marks in issue to be '*conceptually dissimilar*' rather than merely '*not conceptually similar*';
 - (3) The Hearing Officer erred in arbitrarily considering that the conceptual comparison was the '*most influential*' in his comparison of the marks in issue; and
 - (4) The Hearing Officer did not carry out a full and proper analysis of the respective goods and services and had he done so he could and would have appreciated that some such goods could include low price goods for which the level of attention of the average consumer is low and not merely '*no more than normal*'.
22. There was a suggestion in the Grounds of Appeal, as had been submitted before the Hearing Officer, that special consideration should be applied to the analysis in the present case, given the connection between the Applicant and Mr Michael Gleissner who has been referred to in a number of other decisions in the UKIPO (and in one appeal to the Appointed Person). On the basis of the Grounds of Opposition in the present case the Hearing Officer in my view quite rightly did not refer to the point in his decision. When pressed at the hearing of the appeal it was quite rightly accepted by Mr Tate that this was not a point that could or should be taken into account when considering the merits of the present appeal and I therefore say no more about it.
23. No Respondent's Notice was filed. That is to say the Applicant adopted the position that the Hearing Officer's Decision was correct for the reasons that he gave.
24. At the hearing of the appeal Mr David Tate of Maguire Boss appeared on behalf of the Opponent. The Applicant did not appear and was not represented.

Standard of review

25. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted,

it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See Reef Trade Mark [2003] RPC 5; BUD Trade Mark [2003] RPC 25; and more recently the decision of Geoffrey Hobbs Q.C. sitting as the Appointed Person in ALTI Trade Mark (O-169-16) at paragraphs [19] to [20]; the decision of Daniel Alexander Q.C. sitting as the Appointed Person in Talk for Learning Trade Mark (O-017-17) referred to by Arnold J. in Apple Inc. v. Arcadia Trading Ltd [2017] EWHC 440 (Ch); and the judgment of Daniel Alexander Q.C. sitting as a Deputy Judge in the High Court in Abanka D.D. v. Abanca Corporación Bancaria S.A. [2017] EWHC 2428 (Ch).

26. Moreover where the decision below involves the making of a value judgment the decision maker on appeal must be especially cautious about interfering with that judgment on appeal: see most recently Lewison LJ in A P Racing Limited v. Alcon Components Limited [2018] EWCA Civ 1420 at paragraph [33].
27. It is necessary to bear these principles in mind on this appeal.

Decision

28. The first Ground of Appeal is concerned with the assessment of the similarity of the marks in issue. The error of principle identified by the Opponent is that in making that assessment the Hearing Officer did not take into account that the fact that a word-only mark covers use in all possible fonts and typefaces. In this regard the Opponent is correct that as a matter of law the registration of a word mark does not prevent its use in different scripts (fonts or typefaces). See for example Case T-364/04 Sadas SA v. OHIM. There is no reference to this case law in the Hearing Officer's decision.
29. There are two points in the Decision that are relied upon in support of this contention on behalf of the Opponent. The first is in paragraph [47] of the Decision where the Hearing Officer sets out his view of the overall impression of the mark applied for and then his view of the overall impression of Mark 1. In my view this paragraph provides no support for the Opponent's contention. Quite correctly the Hearing Officer states that the mark YANGO is simply a made up word. The application has no specific graphic element and therefore there was no other point for the Hearing Officer to consider at this stage of his analysis. Again quite correctly, the Hearing Officer had to consider that Mark 1 was not simply the word MANGO and therefore had to set out the relative contribution of the word 'mango' and the particular way in which the word 'mango' was presented. Quite rightly there is no criticism of the Hearing Officer's findings with regard to his assessment of Mark 1.
30. The second point that is relied upon is there reference in paragraph [48] of the Decision in which he is making his comparison between the marks he stated with reference to the first letters of marks that (emphasis added) '*Whilst I note that each of those initial letters features a central "V"-shaped element, they are plainly **the***

ordinary capital letters Y and M, which the average consumer will readily distinguish’. From this it would seem that the Hearing Officer had not considered the rule in Sadas when making his relevant comparison.

31. In the circumstances it appears to me that the Hearing Officer made an error in his assessment of the visual similarity between the two marks that he was considering. However I do not regard this as a material error. This is because in my own view the marks are visually similar to a medium degree. That is my view whether the mark is considered in the same font as Mark 1or in the other stylised fonts as set out in Attachment 1 to the Notice of Appeal. It seems to me that notwithstanding the shared –ANGO component of the marks the first letter does make a difference. In particular the fact that it is the *first* letter that is different will in my view result in the difference being fixed on more readily by the public thereby in my view preventing there being a high level of visual similarity between the marks.
32. In this connection I do not accept the submission that was made to me on behalf of the Opponent that in assessing the similarity of the marks in issue the script or font could be such that in effect the mark applied for should be treated as one that will be or could be perceived as the word ‘mango’. That seems to me to (1) fall outside normal and fair use of the mark applied for; and (2) effectively change the very substance of the mark applied for which is the subject of the visual, aural and conceptual comparison that must be made as part of the analysis for the purposes of Section 5(2)(b) of the 1994 Act.
33. Turning to the second Ground of Appeal it is said that the Hearing Officer erred in finding the respective marks to be ‘*conceptually dissimilar*’ rather than ‘*not conceptually similar*’ in paragraph [50] and [55] of the his Decision. The basis for this Ground of Appeal is the guidance as set out by the EUIPO with regard to the how to make the conceptual comparison. That guidance is based upon the judgment of the CJEU in Case C-361/04 P Claude Ruiz Picasso v. OHIM. As was rightly accepted at the hearing the guidance from the EUIPO is not binding on me and it seems to me that the correct starting point in respect of this Ground of Appeal is the judgment in the Picasso case (above).
34. Paragraph [20] of the Judgment of the CJEU in the Picasso case stated as follows (emphasis added):

By stating in paragraph 56 of the judgment under appeal that, **where the meaning of at least one of the two signs in issue is clear and specific** so that it can be grasped immediately by the relevant public, **the conceptual differences** between them may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.

35. It is clear from this paragraph in the judgment, which is not disputed by the Opponent to be the source of the relevant law, that if the meaning of **one** of the signs is clear and specific such that the meaning may be grasped immediately, as is the position in the present case, then the marks have conceptual differences. That is to say in the present case Mark 1, which as the Hearing Officer found in paragraph [50] of his Decision would be known to the average consumer to be the name of a fruit and tree, is conceptually different to the mark applied for which is accepted to be a made up word.
36. In paragraph [55] of the Hearing Officer's decision having referred to the marks as being '*conceptually dissimilar*' he also quite correctly referred to paragraph [20] of the Judgment of the CJEU in the Picasso case and to the principle that '*conceptual differences*' may counteract visual and phonetic similarities in situations such as the present case i.e. where one mark has a clear and specific meaning.
37. It seems to me clear from the decision of the Hearing Officer, and not disputed by the Opponent on this appeal, that there are conceptual differences between the marks in issue and that this was something that the Hearing Officer was bound to take into account in his assessment of the likelihood of confusion. Whilst the way that the Hearing Officer expressed himself in certain parts of his decision might not be in line with the guidance from the EUIPO that guidance is not binding on the EUIPO, much less the UKIPO. In any event it is in my view clear that the Hearing Officer did exactly what he had to do on the basis of the guidance in the Picasso case i.e. to take into account the conceptual differences between the marks.
38. The third ground of appeal concerns the weight that the Hearing Officer gave to his findings with regard to the conceptual similarity of the marks in his assessment of the likelihood of confusion.
39. The assessment of the likelihood of confusion is a multifactorial assessment. There is no suggestion before me that the Hearing Officer did not correctly identify the guidance provided by the case law as to the assessment that he was required to make. Moreover it seems to me that the Hearing Officer in paragraphs [54] to [56] of his Decision (set out above) clearly set out the factors that weighed in favour of the Opponent and those which did not.
40. In this connection it is clear that the Hearing Officer had firmly in mind that Mark 1 has a high degree of overall distinctive character for clothing and its retail both per se and because of the use that had been made of it as is made clear in paragraphs [51] to [53] and paragraph [55] of his Decision. That is to say the Hearing Officer accepted (albeit in relation to a limited number of goods and services) the Opponent's position as set out in paragraph 29 of its Statement of Grounds set out in Attachment 4 to its Notice of Opposition. Any suggestion that the Hearing Officer did not have in mind the Opponent's extensive use of Mark 1 in his assessment is therefore unfounded and

to the extent that the case on appeal may now be presented differently on this issue it does not seem to me that the Hearing Officer can be criticised in circumstances where for relevant purposes he accepted the pleaded position of the Opponent.

41. Against this background the Hearing Officer took the view that in this case the conceptual differences between the marks was significant and counteracted the visual and aural similarities which he had identified. I consider that it was open to the Hearing Officer, having been through the balancing exercise that he did, to come to that view for the reasons that he gave.
42. With regards to the fourth Ground of Appeal I can deal with this point quite shortly. The Hearing Officer found that the level of attention of the average consumer in respect of the good in issue would be members of the general public and that he would expect member of the public to pay '*no more than a normal level of attention in the selecting and purchasing of the goods at issue*'. The Opponent's position is that the Hearing Officer only may a cursory analysis of the goods at issue which include low cost goods for which the level of attention of the relevant consumer is '*low*'.
43. It seems to me that in circumstances where: (1) no evidence or submissions were before the Hearing Officer on this issue; (2) the criticism made by the Opponent of his findings on this point were very general; and (3) at the very least in respect of some of the '*low- cost goods*' referred to by the Opponent, for example T-shirts and cosmetics, such goods may or may not be low cost and may or may not be sold in pound shops or similar that it was open to the Hearing Officer to make the findings that he did.
44. Finally, whilst there is no Ground of Appeal that directly refers to the Opposition under Section 5(4)(a) of the 1994 Act, it was maintained at the hearing of the appeal that for the same reasons set out in the Notice of Appeal the appeal against the Hearing Officer's decision should be allowed in respect of the Section 5(4)(a) Ground of Opposition – such an appeal being within the remit of the Order sought on this appeal.
45. Whilst this is an unsatisfactory way of proceeding given (1) my findings set out above; and (2) that no express criticisms have been made of the particular paragraphs of the Hearing Officer's decision on the Section 5(4)(a) ground it seems to me that it was open to the Hearing Officer to reach the conclusion that he did for the reasons that he gave on this Ground of Opposition.

Conclusion

46. To conclude, for the reasons set out above, it does not seem to me that there is any error of principle or material error in the Hearing Officer's decision. It was in my

view open to the Hearing Officer to make the decision that he did. In the result the appeal fails.

47. Neither side has asked for a special order as to costs. The Applicant has taken no part in this appeal. Nonetheless it had to consider the Notice of Appeal. I also note that the Applicant has not instructed a representative at any stage in these proceedings. In such circumstances, I direct that the Opponent to pay to the Applicant the sum of £50 as a contribution to its costs of the unsuccessful appeal. That sum is to be paid within 14 days of this decision. It is payable in addition to the sum of £450 awarded by the Hearing Officer in respect of the proceedings at first instance.

Emma Himsworth QC
Appointed Person

6 July 2018