TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3278564
BY INAM ALI

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 411745
BY ILLUME HOLDING AB

AND

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF
MS JUNE RALPH DATED 14 FEBRUARY 2019

DECISION

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1. This is an appeal from a decision of Ms June Ralph, the Hearing Officer for the Registrar, in which she rejected the opposition of Illume Holding AB ("the Opponent") to the trade mark application made by Inam Ali. The Opponent appeals against that decision.

Background

2. Trade mark application No. 3278564 was filed on 18 January 2018. The application was for a wide variety of items of jewellery in Class 14, and clothes and other individual items of clothing, footwear and headgear in Class 25. The mark was:

MISSDOPE

3. The opposition was filed by Axcez Trading AB on 26th February 2018. Its Form TM7 identified the basis of the objection as being both under sub-sections 5(2)(b) and (3) of the 1994 Act, but the body of the form contained objections based only upon sub-section 5(2)(b). It was subsequently confirmed that only s 5(2)(b) was relied upon. In late 2018 the earlier rights were assigned to Illume Holding AB ("the Opponent") which pursued the opposition.

4. Those earlier rights are 5 registered EU trade marks:

Number	**Filing date**	**Mark**
11339884	Filed on 13/11/2012	**Do.pe**
11518313	Filed on 25/1/2013	**DOPE**
11518371	Filed on 25/1/2013	DOPE
11333771	Filed on 9/11/2012	
11333895	Filed on 9/11/2012	

5. None of the earlier marks had been registered for more than 5 years at the date of publication of the application, so that they were not subject to proof of use. No evidence was filed by either side[1] but both sides filed written submissions. There was no hearing requested, and the Hearing Officer dealt with the opposition on the papers.

6. In summary, the Hearing Officer found:

   a. There was no similarity between the Opponent's goods and services in Classes 9, 28 and 41 and the Applicant's goods;

[1] Mr Ali filed a brief witness statement which did not comply with the rules, and failed to remedy the defect when invited to do so. In the circumstances, his evidence was not taken into account by the Hearing Officer.

b. The Opponent's Class 25 goods were identical to the Applicant's Class 25 goods;
c. There was no complementarity (as claimed) between the Opponent's goods and services in Classes 25 and 35 and the Applicant's Class 14 goods;
d. The average consumer is a member of the general public who will pay a reasonable degree of attention during the process of purchasing clothing, which is likely to be primarily visual;
e. There was a low level of visual, aural and conceptual similarity between the marks overall;
f. The earlier marks were of average distinctiveness;
g. There was no likelihood of confusion, direct or indirect;
h. Hence, the opposition failed.

7. The Opponent appeals from the decision. Neither party wished for a hearing before me and I must therefore decide the case upon the basis of the papers before me. These consist of the papers before the Hearing Office, which included submissions from both parties, the decision itself and the Opponent's Grounds of Appeal. Neither party made any additional submissions in writing for the appeal.

Grounds of appeal

8. Paragraph 1 of the Grounds of Appeal mentions the fact that the trade mark application included goods in Classes 14 and 25. However, it appears to me that the substance of the Grounds of Appeal relates only to the Class 25 goods in the Applicant's specification because (after raising issues about the assessment of the similarity of the marks) the Opponent addresses the issue of likelihood of confusion only by reference to the Class 25 goods which are found in both parties' specifications. I shall proceed on this basis and consider the appeal only in relation to the application to register the mark in Class 25.

9. The Grounds of Appeal allege in summary that the Hearing Officer erred in various ways:

a. in finding a low rather than an average level of visual similarity between the parties' marks;
b. in finding a low rather than a high level of aural similarity between the parties' marks;
c. in finding a low rather than a high level of conceptual similarity between the parties' marks;
d. in ignoring the importance of the identity of the parties' Class 25 goods; and
e. in failing to find that the Applicant's Mark would be seen as a brand extension of the earlier Marks, such that there was a likelihood of confusion.

Basis of the appeal

10. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she 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. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc V Arcadia Trading Limited* [2017] EWHC 440 (Ch). See also *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 at [78] to [81]. Mr Alexander QC said:

> "(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).
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> (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF*, *DuPont*).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B* and others).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF*, *BUD*, *Fine & Country* and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF*, *Henderson* and others)."

11. In addition, *Actavis* (above) shows that a decision maker on appeal must be especially cautious about interfering with a value judgment:

> "80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible: *Assicurazioni Generali SpA v Arab Insurance Group (Practice Note)* [2002] EWCA Civ 1642; [2003] 1 WLR 577, paras 14- 17 per Clarke LJ, a statement which the House of Lords approved in *Datec Electronic Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 WLR 1325, para 46 per Lord Mance."

11. I have borne those principles in mind on this appeal.

Substance of the appeal

(a) Visual similarity

12. The Hearing Officer found at paragraph 27 of her decision that the black diamond border in the Applicant's Mark was "an unremarkable device" such that the strength of the mark lay in "the repeated MISSDOPE word elements and the pink diamond device letter replacement." She also found that the words would be seen "as a conjoining of the words MISS and DOPE, giving the impression of a name." At paragraph 33 she held that the pink diamond device was clearly a replacement for the 'O' in Dope, and held that "this device/letter replacement is quite visually impactful." She compared the Applicant's Mark to each of the earlier marks (although in the rest of her decision she really concentrated upon just the word mark, DOPE). She

concluded at paragraph 36 that the impact of the inclusion of the word MISS at the beginning of the Applicant's mark (as to which she referred to Joined Cases T-183/02 and 184/02, *El Corte Ingles SA v OHIM*) and of the diamond letter device, meant that there was a low degree of visual similarity between the marks.

13. The Opponent submitted that the Hearing Officer gave too much weight to the impact of the word MISS in the Applicant's mark and not enough to the other factors mentioned above. In particular, it submitted that her finding that the pink diamond device was "quite visually impactful" meant that it would have concentrated the eyes of the consumer upon DOPE rather than MISS.

14. It seems to me that the Hearing Officer carried out a proper analysis of the visual elements of each mark, and drew a reasonable conclusion as to the impact of the two device elements of the Applicant's Mark, even if another Hearing Officer might have concluded that the level of similarity was moderate or average rather than low. It does not seem to me that the Opponent has identified any error in that analysis or in her conclusions which would justify interfering with her conclusion on this head in this appeal.

(b) Aural similarity

15. The Hearing Officer found a low level of aural similarity due to the impact of the word MISS as the first part of the Applicant's Mark, again applying *El Corte Ingles.* The Opponent submitted that this did not give sufficient weight to the Hearing Officer's own finding that MISSDOPE would be seen as a name, such that DOPE would be emphasised in aural use.

16. I do not consider that emphasis would necessarily be given to DOPE in aural use as the Opponent alleges, nor that it has identified any error in this regard in the Hearing Officer's analysis or conclusion on aural similarity.

(c) Conceptual similarity

17. The Hearing Officer accepted that DOPE may have a variety of meanings but found that both marks would bring to an individual consumer's mind the same concept attaching to the word DOPE. The use of MISS in the Applicant's Mark would also "bring to mind the notion of a female title making the whole a name. Taking that into account, although there is an identical concept of a shared element DOPE, the conceptual impact created by the addition of MISS is such that I find there to be only a low degree of conceptual similarity of the marks overall."

18. Again the Opponent submitted that the Hearing Officer had erred in that analysis because, in particular, the average consumer would see DOPE as the distinctive part of the name, whilst the addition of the word MISS would simply suggest the existence of a sub-brand aimed at women, particularly younger women. It submitted that the point was illustrated by an example such as Selfridge's/Miss Selfridge in which there is still significant similarity in the shared use of the main, distinctive brand.

19. The Opponent did not suggest that the Hearing Officer had erred in finding that the conceptual impact of the Applicant's Mark was to indicate a female name, and that there was no equivalent concept in the earlier marks. That being so, there was plainly at least some conceptual dissonance between them, although all of the marks contained the word DOPE. It does not seem to me that it is possible to say that the Hearing Officer made a mistake in balancing the conceptual identity of DOPE/DOPE against the conceptual dissonance of DOPE/MISSDOPE. Whilst another tribunal might well have found that balance to fall higher on the scale of conceptual similarity, in my view this is the sort of evaluation with which I should be reluctant to interfere in the absence of a distinct and material error of principle. I consider that the Opponent has not identified any such error and I reject this ground of appeal.

Global assessment of the likelihood of confusion

20. The remaining points in the Grounds Appeal go to the global assessment which the Hearing Officer had to carry out of the likelihood of confusion between the parties'

respective marks. The Hearing Officer had set out at paragraph 8 of her decision the standard list of principles (a) to (k) drawn from a series of well-known CJEU judgments and used both by Hearing Officers and in the Courts. At paragraph 41 she referred to the interdependency principle, the principle that the more distinctive a mark is, the greater the likelihood of confusion, and to the impact of imperfect recollection. She made no express reference to the principle that "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."

21. At paragraph 42 she set out the difference between direct and indirect confusion and cited paragraph 16 of Mr Purvis QC's decision in BL O/375/10 *L.A. Sugar*. At paragraph 43 she added a reference to *Duebros,* BL O/547/17, a decision of Mr James Mellor QC, saying that Mr Mellor had "stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. … it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion."

22. She went on at paragraphs 44-5 (with footnotes omitted):

> "44. So far, I have found that that the contested goods in class 25 are identical but that the class 14 goods have no similarity to the opponent's goods or services. So for those goods the opposition fails. For those contested goods in class 25 which I found to be identical the average consumer will be paying a reasonable degree of attention in a primarily visual purchasing process. Additionally, I have found that the earlier marks are inherently distinctive to an average degree and that the marks in this case are visually and aurally similar only to a low degree and that the marks are only conceptually similar to a low degree overall.
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> 45. Having weighed all of the relevant factors, I conclude that whilst there is at least a degree of similarity between the marks for the shared letter elements, this is outweighed by my finding that the visual, aural and conceptual similarity between the respective marks is low. In particular in relation to the level of visual similarity because the purchase of the goods and services at issue is likely to be mainly visual, and so the level of visual similarity is of particular importance. There

> is also the concept of the applicant's mark forming a name thus giving a distinct conceptual identity different from the earlier marks. Taking these factors into account, together with the average level of distinctiveness of the earlier marks, I do not consider there to be a likelihood of direct confusion between the applicant's mark and the opponent's marks, on the part of an average consumer paying a reasonable level of attention. I also do not consider that the average consumer is likely to believe that the respective goods come from the same or linked undertakings. The common element, DOPE, is not "strikingly distinctive" but merely averagely so, the applicant's mark does not "simply add a non-distinctive element to the earlier mark", the applicant's mark does not appear to me as being "entirely logical and consistent with a brand extension" of the opponent's marks and I cannot see any other reason why the marks are likely to be indirectly confused as there is a different conceptual hook for the applied for mark. I am reassured in my conclusion by the guidance given in the *Duebros* extract given above that bringing to mind the same element is more association than indirect confusion."

23. The Opponent submitted that the Hearing Officer erred in these paragraphs in two ways: she failed to take into account the identity of the goods, and she was wrong to dismiss the possibility of indirect confusion.

24. In my judgment, the Opponent is right to say that this analysis does not appear to take any account of the identity of the parties' goods. The Hearing Officer had mentioned the point in paragraph 44, but made no reference to the impact of the identity of the goods in the analysis set out in paragraph 45. In the first sentence of paragraph 45 she says that she has "weighed all of the relevant factors" but the only reasoning she sets out to justify her finding that there is no likelihood of confusion is her view that the similarity of the marks is outweighed by their differences. She does not say that she considered whether the identity of the goods was outweighed by the low level of similarity of the marks, although that would have been a necessary part of her reasoning. In the second sentence of paragraph 45, the Hearing Officer considers the impact of the low level of visual similarity of the marks, which she sees as important

because "the purchase of the goods *and services* at issue is likely to be mainly visual" (emphasis added), although her analysis of the similarity of the parties' goods/services did not extend beyond a finding of identity between the parties' Class 25 goods. She went on to mention the conceptual distinctions between the marks which she had already identified.

25. The analysis of the likelihood of confusion as recorded in the first three sentences of paragraph 45 therefore turned upon the level of similarity of the parties' marks and a reference to the average level of distinctiveness of the earlier marks. The Hearing Officer made no reference in that paragraph to any of the other factors relevant to the global assessment of likelihood of confusion in concluding that there was no likelihood of direct confusion.

26. In the circumstances, if the Hearing Officer did take due account of all of the necessary elements of the global appreciation of the likelihood of confusion, she failed to set out her reasoning, and the limited reasons she did give do not reflect a correct or complete analysis. I have reminded myself of the risk of criticising the reasoning set out in paragraph 45 merely because it could have been better expressed. However, after careful consideration, and taking into account the fact that the Hearing Officer did set out some detailed reasoning, on balance I am persuaded that her failure to express her views on other aspects of the global assessment, and in particular the question of whether the identity of the goods outweighed the low level of similarity of the marks, shows that the Hearing Officer erred in her approach in this respect.

27. The Opponent also submitted that the Hearing Officer erred in her analysis of the likelihood of confusion because the Applicant's Mark would be seen as a brand extension of its mark, in particular as a sub-brand aimed at younger women. It submitted that as a result the Applicant's Mark would lead to indirect confusion, on one of the bases identified by Mr Purvis QC in *L A Sugar*, namely*:*

> "where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS" "WORLDWIDE" "MINI" etc)"

28. The Hearing Officer referred, as I have said, both to *L A Sugar* and to the decision in *Duebros*, and summarised the latter decision in paragraph 43. It is helpful to set out the relevant passage from *Duebros* in full. Mr Mellor QC said:

> "81. I remind myself of paragraphs [16]-[17] in the Decision of Mr Iain Purvis Q.C. as the Appointed Person in L.A*. Sugar Limited v By Back Beat Inc,* Case BL-O/375/10. These paragraphs are frequently cited by Hearing Officers. Whilst I agree with the central reasoning, some caution is required lest these paragraphs start being applied akin to a statutory test. In particular, it is important that the detail of each of the sub-paragraphs does not provoke the tribunal into too detailed an analysis of what I believe should be an emulation of an instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier mark in mind.
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> 81.1. First, whilst the CJEU has discussed or adverted to the concept of indirect confusion in many judgments relating to EU trade mark law, the Court has never explained indirect confusion in as detailed a way as Mr Purvis' three categories. The furthest the Court appears to have gone is to indicate that a likelihood of indirect confusion exists where the average consumer forms the view that the goods come from economically linked undertakings. As the EUIPO Guidelines indicate, the Court has only explained what it means by economically linked undertakings in the context of cases on free movement of goods.
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> 81.2. Second, in my view it is important to keep in mind the purpose of the whole exercise of a global assessment of a likelihood of confusion, whether direct or indirect. The CJEU has provided a structured approach which can be applied by tribunals across the EU, in order to promote a consistent and uniform approach. Yet the reason why the CJEU has stressed the importance of the ultimate global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark or the mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.

81.3. Third, when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

81.3.1. The average consumer mistakes one mark for the other (direct confusion);

81.3.2. The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);

81.3.3. The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

81.3.4. For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services.

81.3.5. Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.

81.4. Fourth, I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: 'Taking account of the common element in the context of the later mark as a whole.' (my emphasis).

82. With those matters in mind, I turn to consider whether there is a likelihood of indirect confusion and I remind myself that the applicant's mark is not simply 'Eden Chocolat' and the goods do not include 'chocolate'. As I said, I am considering these marks both being used in relation to the identical goods, cocoa and a chocolate mousse. I do not consider that the common element 'Eden' is inherently strikingly distinctive, but it is a distinctive element which is present in both marks. I confess that in the course of my deliberations, I given anxious consideration as to whether the average consumer merely calls the earlier mark to mind, as opposed

> to a finding of indirect confusion, principally because the applicant's mark comprises so much more than simply the word 'Eden'. Not without considerable hesitation because I believe these circumstances are close to the line, I have come to the conclusion that the average consumer would nonetheless conclude that cocoa and a chocolate mousse bearing the Applicant's mark came from an economically linked undertaking, bearing in mind his or her imperfect recollection of the earlier mark, also used in relation to cocoa or a chocolate mousse."

29. Furthermore, I would add that as it is not a statutory test, the examples given by Mr Purvis QC in *L A Sugar* should not be taken as identifying the only circumstances in which indirect confusion may be found likely to arise, or, indeed, as dictating a finding of indirect confusion in any particular circumstances. All of these cases turn upon their specific facts, and Mr Purvis QC's reasoning in *L A Sugar* cannot displace the need for the tribunal to undertake a global appreciation of whether the average consumer is liable to make a connection between the marks and assume that the goods in question are from the same or economically linked undertakings, in the manner described by Mr Mellor QC in *Duebros*.

30. The Hearing Officer's brief summary of Mr Mellor's decision and her application of *L A Sugar* in paragraph 45 do not, in my judgment, take into account the concerns which Mr Mellor QC expressed that *L A Sugar* should not be applied as if it were a statutory test; on the contrary, it appears to me that the Hearing Officer fell into the error of applying *L A Sugar* in exactly that way, without taking the broader view required for a global assessment of the likelihood of confusion, direct or indirect. The reassurance she took from her summary of *Duebros* appears to me to have been misplaced. In particular, she found that the Applicant's Mark did not simply add a non-distinctive element to the earlier mark, without (it seems) considering what impact its addition would have upon the average consumer in terms of impression or instinctive reaction. She had found that the addition of the word MISS to DOPE would mean that the mark would be seen as a name, but did not consider whether MISS was nonetheless a less distinctive element of the mark than DOPE, as a title rather than a distinctive name, nor how adding MISS to DOPE would appear in the circumstances of this case to the

average consumer. She also gives no reason why she concluded that the Applicant's Mark was not logical or consistent with a brand extension, and does not discuss the practice of the clothing industry to use sub-brands, including sub-brands adding "Miss" to the main brand.

31. The sub-brands point was not (so far as I can see) expressly raised by the Opponent below nor did it refer the Hearing Officer to any decisions on the point. In the circumstances, its current criticism of the decision in that regard is a little unfair to the Hearing Officer.

32. However, the Hearing Officer rightly considered whether there might be indirect confusion (in the light of *L A Sugar*) but does not appear to have considered that the tendency for sub-branding of Class 25 goods has been acknowledged in numerous cases. For instance, In Case T-385/09 *Annco, Inc. v OHIM,* the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods). At paragraph 48 the Court referred to the fact that purchasers of such goods are "accustomed to the same clothing company using sub-brands that derive from the principal mark."

33. There are also a number of cases in which it has been necessary to consider the impact of adding "Miss" to the earlier mark. For instance, in *Wasabi Frog Ltd v Miss Boo Ltd* [2009] EWHC 2767 (Ch, [2010] E.T.M.R. 8, Warren J held:

> "29. The second point is that the conjunction of "Miss" with "Boo" is the conjunction of a conventional word ("Miss") with a CTM ("Boo"). Again, the consumer is likely to associate Miss Boo with whatever it is that Boo relates to. Since the applicant has a CTM for Boo, it is entitled to use that mark for its goods and may in fact have done so. Well known examples of similar use are "Miss Selfridge" and "Miss Bonwit". In similar circumstances, a likelihood of association has been found to exist in OHIM Decisions: see for example Web/Miss and Ghost/Miss Ghost. There is obviously a strong case for such an association in the present case, (i.e. Boo/Miss Boo) and a corresponding likelihood of confusion for the purposes of trade-mark infringement. ..."

34. Rather similarly, in *Miss Mac* BL O/219/11, the Hearing Officer held:

> "86. In this case, Mode expressly rely on a 'brand extension' argument, whereby although the consumer may not directly confuse one mark for the another, they may assume the later mark is simply an 'extension' of the earlier mark. This is sometimes called 'indirect confusion', and is argued on the basis that the 'MISS' word, present in Ms Macpherson's mark would, in the clothing sector, indicate that the goods are aimed at young(er) females. I think this is true, so for example, if the consumer were to see a title such as, 'Mr', 'Miss' or 'Mrs', followed by the name of a clothing brand such as, eg M&S, PEACOCKS, MONSOON , the message conveyed will be that of 'extension' or to indicate a specific range aimed at a particular group.
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> 87. Also, it is important to acknowledge this type of confusion is expressly recognised in case law, see, eg paras 16-17 of *LA Sugar*, a decision of the Appointed Person (BL O-375-10). However, I must also bear in mind that the examples I have given earlier are all of highly distinctive marks with reputations, whereas I have found that Mac Jeans has only an average level of distinctiveness. Further, because Mac is a name, the addition of 'Miss' is more natural than if were added to a word which is not a name, such as Monsoon. The addition of 'Miss' does not therefore point as strongly towards the resultant mark as being a brand extension as might be the case in other circumstances. Nevertheless, if seen in the context of identical, or highly similar goods or directly related retail services, the 'brand extension' message is likely to be taken. Taking all factors into account, the likelihood of indirect confusion is made out in respect of the goods and services which I consider to be identical, highly similar or directly related retail services."

35. In the light of my concerns as to the inadequacy of the Hearing Officer's reasoning as to the likelihood of confusion and considering the cumulative effect of these points, after careful consideration I have come to the conclusion that the Hearing Officer did commit distinct and material errors of principle in her global assessments of the

likelihood of confusion, both direct and indirect, and it is appropriate for me to reconsider the point.

36. I have not felt it right to disturb the Hearing Officer's findings on the level of similarity of the marks (low overall), and there was no appeal against her finding that DOPE is of average distinctiveness. Those factors must be weighed against the identity of the Class 25 goods as a factor which would point towards confusion, especially taking into account the potential for imperfect recollection of the earlier marks and the average level of care in buying Class 25 goods. However, neither of those factors appears to me sufficient, in light of the additional elements of the Applicant's Mark, to lead to a finding that there is a likelihood of direct confusion in terms of the average consumer confusing DOPE with MISS DOPE.

37. The position in relation to indirect confusion is different. The Hearing Officer did not consider that the common element 'DOPE' is inherently strikingly distinctive, and at paragraph 27 she said that if MISS DOPE was seen as a name it would form a distinctive concept of its own. Nevertheless, in my judgment, DOPE would be perceived as the more distinctive part of that name, because the average consumer would see the addition of MISS to DOPE as adding a non-distinctive title to an averagely distinctive brand name. Moreover as DOPE is not a common name, in my view this means that the addition of 'Miss' to it is more likely to be taken as being a brand extension than might otherwise be the case. It is well established that sub-brands are commonly used for clothing ranges, and MISS X is a natural and, in my view, logical, brand extension of X. The Applicant's Mark is also more likely to be taken as a brand extension of DOPE because the two brands are for identical goods, in each case clothing.

38. I have considered carefully whether the Hearing Officer was nonetheless right to conclude that the average consumer seeing the Applicant's Mark used on clothing would merely call the earlier mark to mind, as opposed to assuming that the goods in question are from the same or economically linked undertakings. Taking all of the factors mentioned above into account, I conclude that the average consumer would be confused into such an assumption. In my judgment, to someone familiar with the

earlier mark, the Applicant's Mark would be likely to be taken as MISS DOPE, a sub-brand of DOPE, used in relation to clothing suitable for a young woman. This would indicate that the two marks come from the same or economically linked undertakings. As a result, in my view the likelihood of indirect confusion is made out in respect of the Class 25 goods.

39. The appeal therefore succeeds in relation to all of the Class 25 goods. The Applicant's application may proceed for the goods in Class 14.

40. The Hearing Officer made no order as to the costs of the proceedings before the UKIPO. As both parties have had a measure of success at each stage, I consider that the appropriate order would also be to make no order as to costs on the appeal.

Amanda Michaels
The Appointed Person
7 October 2019