

O/658/22

TRADE MARKS ACT 1994

IN THE MATTER OF  
APPLICATION No. 3569173 IN THE NAME OF AMBER KOTRRI  
TO REGISTER



, *House of Zana*

AS A UK TRADE MARK (SERIES OF TWO) FOR GOODS IN CLASS 25

AND

OPPOSITION No. 424518

BY INDUSTRIA DE DISEÑO TEXTIL, SOCIEDAD ANONIMA

## BACKGROUND AND PLEADINGS

1. On 17 December 2020, Amber Kotrri (“**the Applicant**”) applied for a UK trade mark in respect of the series of two figurative marks shown on the cover page of this decision (and shown again in paragraph 28 below), seeking registration for goods in Class 25, specifying simply “*clothing*”.
2. The application was published for opposition on 19 February 2021. It is opposed by Industria De Diseño Textil, Sociedad Anonima (“**the Opponent**”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“**the Act**”) relying on the following registered trade marks, all of which are for the plain word mark “ZARA”:
  - A: UK TM Registration No. 1574846 Filing date: 9 June 1994  
relying on “*Articles of clothing for men, women and children; all included in Class 25*”
  - B: UK TM Registration No. 2166165 Filing date: 8 May 1998  
relying on some of its goods in Class 25 and on services in Class 35
  - C: EU TM Registration No. 000112755 Filing date: 1 April 1996  
relying on some of its goods in Class 25
  - D: EU TM Registration No. 008929952 Filing date: 5 March 2010  
relying on some of its goods in Class 25 and on services in Class 35
3. The **section 5(2)(b) claim** is that the Contested Application should be refused on the basis that it is in respect of goods that are identical to those under the Opponent’s earlier trade marks A – D above, and that the parties’ marks are highly similar (visually, aurally and conceptually), such that there is likelihood that the average consumer will be confused as to the origin of the goods. The statement of grounds claims that this is all the more likely because the Opponent’s earlier mark “ZARA” enjoys an extensive reputation in the UK and EU and thus possesses an enhanced level of distinctive character. It also claims that “relevant public of both the Contested Goods and the Earlier Goods is an average consumer with a below average to average degree of attention.”
4. The **section 5(3) claim** is that the Contested Application should be refused because:
  - (i) its “ZARA” mark enjoys an extensive reputation in relation both to clothing and other

goods in Class 25 and in relation to services in Class 35, which include the retail of, among many other things, clothing;

- (ii) the relevant consumer on encountering the Contested Mark will **bring to mind** the ZARA mark, such that use of the Contested Mark, being **without due cause**, would give rise to the following types of injury, namely that it would:
- (iii) take **unfair advantage** by **free-riding** on the coat-tails of the reputation of the ZARA mark, benefitting from its power of attraction, and gaining attention and marketability by virtue of the Opponent's marketing efforts. Furthermore, the strong reputation of the ZARA mark, will be transposed to the Contested Mark, meaning that the offering for sale of the contested goods will become easier for the Applicant;
- (iv) **cause detriment to the reputation** of the ZARA mark. This is premised on the possibility that if the goods under the contested mark were of inferior quality, it would have a negative impact on the image, prestige and huge reputation of the ZARA mark, reducing its power of attraction;
- (v) **cause detriment to the distinctive character** of the ZARA mark. This is because it will **dilute** the distinctiveness of the reputed trade mark "ZARA". This means it will weaken the ability of the ZARA mark to uniquely identify its reputed goods and services, because use of a highly similar mark by a third party would lead to **dispersion** of the captivation and hold in the public's mind of the reputed earlier mark. The ZARA mark would cease to be capable of arousing an immediate association in the eyes of the relevant public. If the contested mark brings to mind the ZARA mark in the eyes of the relevant public, its use will diminish the ability of the ZARA mark to distinguish its goods and services which is likely to lead to a **change in the economic behaviour** of the Opponent's customers.

#### *The Applicant's defence*

5. The Applicant filed a defence to the opposition and a counterstatement. The notice of defence form was ticked to indicate that the Applicant did not request proof from the Opponent of its use of the ZARA trade mark registrations relied on in this opposition. The counterstatement makes clear the Applicant's view that there are no similarities between the respective marks and that she thus denies both the grounds.

6. The counterstatement makes a number of points in relation to the Applicant's existing business and the genesis of the trade mark applied for. While such background information may (quite understandably) be significant in the mind of the Applicant (who has acted without professional representation), most of it can have no bearing in the assessment task before me.
7. The task of determining a likelihood of confusion under section 5(2)(b) requires an approach based on the perspective of the notional average consumer (as I further detail later in this decision), and on notional fair and ordinary use that either party may make of their respective trade marks. Any comparison of the marks must be on the basis of how they appear in the register; since the Opponent's earlier mark is a word-only mark, ordinary use allows for changes of case and typeface. Likewise, the goods to be compared are those as specified. Similarly, the questions arising under section 5(3) claim will need to be considered from perspective of the relevant consumer. Where I consider it helpful to clarify any of the Applicant's particular points, I do so at relevant points in this decision.
8. This decision includes references to the jurisprudence of the EU Courts. This is because the provisions of the Act on which these opposition proceedings are based (Trade Marks Act 1994) are derived from an EU Directive, and 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 31 December 2020.

### **Papers filed, the hearing and representation**

9. During the evidence rounds the parties filed evidence in chief only as I indicate below. The Applicant requested an oral hearing of the matter, which was held before me by video conference on 24 May 2022. The attorneys for the Opponent are Taylor Wessing LLP; the Applicant acts in these proceedings without professional legal representation. Ms Kotrri attended the hearing to make her own representations as the Applicant; Julia King of Taylor Wessing LLP attended on behalf of the Opponent. Ms King filed a skeleton argument in advance of the hearing. I have read all the papers filed and refer to their contents where I consider it warranted to do so.

### **EVIDENCE / SUBMISSIONS FILED**

10. The Applicant's evidence comprised a witness statement of Amber Kotrri, dated 19

January 2022, with 27 pages of exhibited material. Ms Kotrri made points relating to: (i) the Applicant's own local business reputation; (ii) the impact of the presence of the words "House of"; (iii) the meaning of Zana in Albanian; (iv) the parties' difference in branding and a lack of intention to mislead customers; and (v) that the names Zara / Zana are different, with different business focus and ethos. (I shall clarify in due course the limited extent to which the content of Ms Kotrri's evidence and submissions is relevant in the decision before me, and why much of it is simply irrelevant.)

11. I note that the day before the hearing, the Applicant requested to file evidence in the form of a petition. That request was refused on the basis that not only that it came too late in the proceedings, but more importantly because there are strict considerations as to the admissibility of survey evidence, with guidance in this area set out in Tribunal Practice Notice 2/2012. The survey of public support to which the Applicant had provided a link was cast in terms which pit the interests of the Opponent against those of the Applicant in unfavourable terms that were inevitably prejudicial. The Applicant was informed that the relevant questions such as likelihood of confusion would be taken by the tribunal based on the perceptions of the notional consumer.
12. The Opponent's evidence comprised a witness statement of Julia King, dated 15 October 2021, with Exhibits JK1 – JK5 and a witness statement of Oscar Garcia Maceiras, dated 13 October 2021, with Exhibits OGM1 – OGM16.
13. Ms King gave evidence as the representative for the Opponent to establish that:
  - i. several earlier tribunals have acknowledged the reputation of the Earlier Mark;
  - ii. the prefix "HOUSE OF" is commonly used in the marketplace in respect of the goods covered by the application;
  - iii. both ZARA and ZANA are female forenames of Hebrew origin.
14. Mr Maceiras gives evidence as General Counsel and Secretary of the Board of the Opponent, in order to show the reputation of the ZARA brand.

### **The section 5(2)(b) ground**

15. Section 5(2)(b) of the Act states:

*"... 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.”

16. The Opponent relies on four trade mark registrations, two of which are EU trade marks. These EU registered rights remain relevant because the Contested Application was filed before the end of the EU Exit implementation period of 31 December 2020.<sup>1</sup>
17. Since the trade mark registrations relied on by the Opponent were all filed before the application date of the Contested Application, each is an “earlier trade mark” as referenced in section 5(2)(b). Each of the earlier trade marks had been registered for more than five years at the filing date of the Contested Application. Consequently, they are subject to the use provisions under section 6A of the Act. The Opponent duly confirmed that its trade marks had been used in the 5-year period up to the date of application date of the Contested Application. Since the Applicant did not request proof from the Opponent of its use of the ZARA trade mark registrations the Opponent is thus formally able to rely on its specified registered goods and services without having to show that it has used its marks at all (although in the present case there is no doubt as to the use of the marks in the UK and EU).
18. The principles to be borne in mind when considering section 5(2)(b) of the Act are well established and derive from the following decisions of the Court of Justice of the European Union (“the CJEU”):

*Sabel BV v Puma AG*, Case C-251/95;

*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97;

*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97;

*Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98;

*Matratzen Concord GmbH v OHIM*, Case C-3/03;

*Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04;

*Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and

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<sup>1</sup> Pursuant to The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 and Tribunal Practice Notice (2/2020) End of Transition Period - Impact on Tribunal Proceedings, paragraph 3, it is the EU Marks rather than any UK comparable trade mark or subsequent application claiming priority from the EU Marks that may be relied upon.

19. The principles are that:
- (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**

20. The Applicant's counterstatement argues that "the products themselves are completely different" because the Applicant "hand makes its garments and focuses on wholesale". These are not relevant points. The relevant comparison to be made is on the basis of the respective specifications that the parties can rely on. The Applicant has specified simply "clothing". All of the Opponent's earlier marks have registered protection in respect of those same goods, notwithstanding that their specifications may be expressed in slightly fuller terms, such as *Articles of clothing for men, women and children*. The parties' respective goods are **identical**. Such goods may be sold both on a retail and wholesale basis, and may be hand-made or otherwise.

### **The average consumer and the purchasing process**

21. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them. 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<sup>2</sup>. In *Hearst Holdings Inc*<sup>3</sup>, Birss J. 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 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... [it] does not denote some form of numerical mean, mode or median."*

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<sup>2</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

<sup>3</sup> *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)

22. The average consumer for the goods at issue will be the general public at large (notwithstanding that clothing will also be sold wholesale and will to that extent include businesses). The purchasing process will entail the average consumer browsing the goods on shelves or rails in shops, or in images online or in a catalogue and where they will see the marks used as labelling or branding or in advertising. The purchase process is therefore a primarily visual one. Aural considerations may also play a part, such as on the basis of word-of-mouth recommendations, so I also take into account the aural impact of the marks in the assessment. However, case law suggests that visual similarity (and difference) is most important in the case of goods (such as clothing) that are self-selected or where the consumer sees the mark when purchasing the goods.<sup>4</sup>
23. Clothing varies in price, but clothes in general are not especially high-cost items, and whilst not everyday purchases, will be bought with some frequency at least in so far as items of clothing wear out, cease to fit or as fashions and preferences change. In selecting and buying clothes, the average consumer will take account of factors such as finding the right size and considering whether they like the material, colour, pattern, cut and style. I find that in general a medium level of care will be taken by the general public in buying the goods at issue in this case. Businesses buying wholesale would pay a higher level of attention, but it is the lower level of attention that must be taken into account. I note that the Opponent claims in its statement of grounds that the consumer will pay “a below average to average degree of attention.” I accept that “clothing” is a broad term, and certain items of clothing may be purchased more casually than others – Ms King suggested I consider, for example, the purchase of a cheap multipack of socks – so I will take into account that the average consumer may sometimes exercise a degree of attention between low and medium.

### **Distinctive character of the earlier trade mark**

24. The distinctive character of the earlier mark must be considered. The more distinctive an earlier mark, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*<sup>5</sup> 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*

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<sup>4</sup> See for example paragraphs 68 and 69 of the ruling of the General Court in *Quelle AG v OHIM*, Case T-88/05.  
<sup>5</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

*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 ...*

*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)."*

25. The distinctive character of a trade mark can be appraised only, first, by reference to the goods specified in the registration and, secondly, by reference to the way it is perceived by the relevant public.<sup>6</sup> With this in mind, I note the following. Ms King's witness statement quoted from paragraph 2 of Exhibit JK1, which is the decision of Daniel Alexander QC sitting as the Appointed Person in the appeal case No. O/331/12, which acknowledged ZARA as "a leading brand" (even in 2012) "well known in many countries in Europe principally in relation to clothing" and that there is "also no dispute that the mark is unique in the sense that no-one else is using that mark for any other goods or services." The paragraph continues: "Equally, however, there is no dispute that the word Zara is a reasonably well-known female name (having become familiar in the UK partly as a result of Zara Phillips, a member of the Royal Family and prominent equestrian)."
26. In my view, the average consumer will be accustomed to the use of names as badges of origin and Zara is not a particularly unusual name in the UK. On that basis, I find the mark ZARA to have no more than a medium degree of inherent distinctive character. However, it is also clear from the evidence that by 17 December 2020 – being the relevant date, on which the Contested Application was filed - the distinctiveness of the mark had been enhanced to a high degree, even very high degree in relation to clothing goods. This is readily borne out in the annual sales figures presented at paragraph 28 of the witness statement of Mr Maceiras, relating to Zara-branded clothing, footwear and

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6 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91

headgear in the UK. Since 2013 these have consistently exceeded half a billion pounds, and in 2019 for instance, exceeded £800 million. Mr Maceiras states that amongst “the most effective and authentic form of publicity for the brand” is its window displays and the architecture of its stores. The first ZARA store in the UK opened in 1998 and there are currently 58 ZARA stores across the UK. The brand has an image of affordable goods that are constantly updated according to fashion trends. Its profile and popularity are recognised in numerous articles published in national UK newspapers and other mainstream media publications. Exhibit OGM 11 includes an article dated February 2013, from The Guardian, where the headline reads: “How Zara took over the high street” and where the sub-headline reads: “From the Duchess of Cambridge and Samantha Cameron to Mary Berry and Coleen Rooney, Zara is now everyone who is anyone's favourite high-street fashion label.” A headline from The Mirror online from 21 September 2016 declares “Zara is head and shoulders above everything else on the high street- here's why we can't get enough.” The article believes “it's safe to say the Spanish high street monolith are single-handedly dressing the nation” and that “if there is such a thing as world retail domination, then Zara have achieved it.” Exhibit OGM 12 shows an article with photo from Vogue October 2020 with the headline “Zara's First-Ever Lingerie Collection Prioritizes Comfort and Style”.<sup>7</sup> Ms King also highlighted that part of the evidence filed on behalf of the Applicant, includes two witness statements that describe Zara as a “fashion giant”.

### **Comparison of the marks**

27. It is clear from *Sabel*<sup>8</sup> 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 in *Bimbo* 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

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7 Page 122  
8 *Sabel BV v Puma AG*, Case C-251/95

assess the likelihood of confusion.”<sup>9</sup>

28. 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. The marks to be compared are shown below:

<p><b>The Opponent’s earlier registered mark:</b></p>	<p>ZARA</p>
<p><b>The Applicant’s contested trade mark:</b></p>	

29. The Opponent’s earlier trade mark consists of the word-only registration “ZARA”. There are no other elements to contribute to the overall impression which lies in the single word itself.

30. The trade marks in the applied-for series are not plain word marks, but in my view the overall impression comes from the words themselves. The black circle in the first in the series is a commonplace banal background that contributes very little to the overall impression. The second in the series has no background aspect. Both marks in the series are presented in stylised handwriting-based script. The stylisation contributes to the overall impression, but is very secondary to the words themselves. Ms King made various submissions in relation to those words. She submitted that the words HOUSE

<sup>9</sup> *Bimbo SA v OHIM*, Case C-591/12P (paragraph 34)

OF are “completely descriptive and non-distinctive in respect of clothing goods”. Ms King notes that the Applicant in her counterstatement stated that the contested mark “came from 'House of', as in fashion house”. Exhibit JK4 to Ms King’s witness statement shows 14 third-party brands, connected to the fashion industry and the retail of class 25 goods in the UK, which comprise “House of” followed by another element, namely: Belle; U; Flint; The House of Foxy; cb; Loulee; Bruar; Fashion; 925; Margaux; Halima; Fraser; Maguie; and Windsor. Since the words are a common way to refer to a fashion house in the UK, Ms King submitted that they do not fulfil the origin function of a trade mark and that consumers do not look to them primarily or at all to distinguish the goods and services of one undertaking from those of another.

31. Ms King argued that the dominant and distinctive element of the Applicant's mark is “ZANA” and that “ZANA” retains an independent distinctive role, in spite of the addition of the words “House of”. Ms King acknowledged that the words “House of” are clearly present in the sign and that they are not to be ignored, but argued that they should be accorded very little weight in the overall comparison of the signs.
32. I accept that the words “House of” are not anchored to a single undertaking (especially in relation to fashion brands) and are in that sense, non-distinctive, but I do not consider them directly descriptive (as would, for example, be the case with the words “clothing manufacturer”). In my view, the words “House of” are flavoured with a gentle grandeur such that they may more fairly be considered to have a degree of distinctiveness, though still a low degree. At any rate, they are far from negligible, and I agree they are not to be ignored. The overall impression of House of Fashion or House of Windsor – two of the marks given in the Opponent’s evidence - is clearly quite different from the words Fashion or Windsor standing alone. So too, House of Zana differs in its overall impression from Zana alone. While I agree that “Zana” is much the distinctive component of the Contested Mark, the trio of words forms a unit that is more substantial than the four-letter third word alone. Since it is the third word, the second shortest of the trio, and is part of a unit (albeit a unit of conventional construction), I do not agree that the third word dominates the Contested Mark. My assessment of similarity is to be based on the overall impression of the respective marks perceived as wholes, taking account of the distinctive components of the marks.

## Visual similarity

33. In line with assumptions about how consumers perceive marks, courts have tended towards a general principle that in determining whether marks are similar, particular attention should be paid to the beginnings of marks, although this is not a hard-and-fast rule. In the present case the marks differ visually in that the Contested Mark involves eleven letters whereas the Opponent's mark has just four letters. The additional words "House of" at the beginning of the Contested Mark give rise to a significant visual difference.
34. The visual similarity arises from the third word of the Contested Mark, where three of the letters in Zana are plainly the same as, and in the same positions as three of the four letters of the Opponent's mark.
35. The Opponent's mark is a word-only mark, meaning that it enjoys exclusive trade mark protection for the word itself, which may be presented in upper case, lower case or any customary combination of the two, in any standard typeface and in any colour.<sup>10</sup> This effectively negates any difference arising from the stylised font used in the Contested Mark, since it would be open to the Opponent to use its word-only mark in a directly comparable font. The words Zara and Zana differ in their third letter, so they are different words, but between the lower-case letter 'n' in the Contested Mark and a lower-case 'r' there is visually both a degree of similarity as well as difference - a smaller visual difference than there is between, say a letter 's' and a letter 'i', since it is only the complete downstroke on the right-hand half of the lower-case letter 'n' that distinguishes it from a lower-case 'r'. That said, the average consumer is well able to recognise the difference between the letters r and n. Despite the shared opening two letters and fourth letter, since the words are short, the difference will be noticed. The Opponent's statement of grounds argued that the notional prospect of that the earlier mark may fairly be rendered in handwritten script increases the visual similarity of the words. It illustrated this point by rendering the earlier mark in two such available fonts: (i) Brush Script MT *Zara* and (ii) Palace Script MT – *Zara*. In my view, while each of those scripts demands more of the reader (not least in how one is to respond to the initial Z), the letters remain

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10 See for instance paragraph 21 of the decision of Iain Purvis QC sitting as the Appointed Person in appeal decision BL O-281-14 *Groupement Des Cartes Bancaires v China Construction Bank Corporation*

discernible, including the 'r'. The 'n' in the  is clearly an 'n'.

36. I bear in mind both that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, and that it would be wrong to dissect the trade marks artificially. In my view, the differences I have referred to are readily apparent and I find the marks are, in my highest estimation, **visually similar only to a degree between low and medium.**

#### Aural similarity

37. It is clear how the marks will be referred to in speech: as “Zar-ruh” (two syllables) and “House of Zar-nuh” . I take into account that the Zana is distinctive component of the Contested Mark. It is identical in its first syllable and similar, but different, in its second syllable. Taken with the additional two syllables that open the Contested Mark, I find the marks are **aurally similar only to a degree between low and medium.**

#### Conceptual similarity

38. The earlier mark “Zara” is a female forename, and I agree with its characterisation by the Appointed Person in the appeal decision I referred to earlier that, from the perspective of a member of the UK general public, it is a “reasonably well-known female name”.<sup>11</sup>
39. In relation to the Contested Mark, Ms Kotrri stated in her evidence that her family’s heritage and nationality is Albanian, that she is fluent in the language and that the brand has roots in Albania. She explains that ‘Zana’ signifies a type of fairy from Albanian folklore; this is borne out in extracts from reference materials exhibited as part of Ms Kotrri’s evidence.<sup>12</sup> Ms Kotrri states that the Contested Mark is not named after a girl’s name. She also states that having explored names websites to look for correlations between ‘Zara’ and ‘Zana’ she found no suggestion that the names were interchangeable or related. Within the Applicant’s exhibited material is an extract from name-doctor.com and names.org where the variants of and names related to Zana are shown as not including Zara.

<sup>11</sup> Daniel Alexander QC in Case No. O/331/12.

<sup>12</sup> See pages 17-21 of the Applicant’s exhibited material.

40. The Opponent too filed evidence from names websites, and none of those suggested that Zana and Zara were related names or variants of one another. What the evidence does show is that Zana is a female name, with Ancient Egyptian, Persian and Hebrew roots, with underlying meanings including 'woman' and 'graceful lily'. Zana is shown as a related name to others, including, in English, Suzanne, Sosanna, Susanna, Susan, Suzanna, Suzan and Suzannah. The name is shown on name-doctor.com as having usage in Bosnian, Croatian, Serbian and Slovene as well as English. The same source indicates that it is used in North America, Australia, New Zealand and in the UK (to list the English-speaking countries). In the USA its popularity ranking is #7374. The evidence offers no information as to its popularity in the UK.
41. As I have previously explained, trade mark matters must be viewed from the perspective of the average consumer. While I accept that the subjective intention behind the choice of the Contested Mark might have been to reference the magical tailoring of fairies, I find that the average consumer (a member of the UK general public) would be unaware of the significance of the word Zana in the Albanian language. The word Zana is unusual. It is certainly not a common name in English, and not one that I, as a member of the average consumer group, have ever encountered, and I therefore conclude that it is likely to be perceived as a meaningless word. It will not necessarily be seen as a name. In this regard I note that the additional element featured with the words "House of" in the Opponent's evidence, includes words that are not names. However, I accept that Zana evidently exists as a female name, and that 'House of' does lend itself to the possibility of being followed by a name; I will therefore proceed on the basis that it is possible that a significant proportion of the general public may perceive it to be a name.
42. Ms King referred me to the appeal decision BL O-276-18, where Emma Himsworth QC sitting as the Appointed Person, considered a section 5(2)(b) claim as between the marks SANDRA v SANDRO for identical clothing goods. The Appointed Person found the hearing officer had been wrong to find no overall similarity of marks, on the basis that "the conceptual differences far outweigh any visual or aural similarities." Ms King quoted the following observation by the Appointed Person: "In fact, it seems to me that members of the public could regard SANDRA and SANDRO as different versions of the same name or names derived from the same root such that it would have been open to the Hearing Officer to find that the marks were conceptually similar."
43. Ms King submitted that exactly principle may be applied in the present case because the

Opponent's evidence indicated that both ZANA and ZARA derive from the same language (Hebrew/Arabic). I disagree with that point, since I consider it unrealistic to premise the perception of the general public on knowledge of the etymology or underlying meanings of those words. I note the following further passages from BL O-276-18:

"28. It is also clear that the mere fact that the marks the subject of the comparison can be grouped under a common generic term of 'names' does not automatically lead to a finding of conceptual similarity. This is well illustrated by the examples given in Part C, Section 2, Chapter 4 Comparison of Signs of the Guidelines for Examination of European Trade Marks issued by the EUIPO on 1 October 2017 where the names FRANK and MIKE are identified as being names which would not lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words; whereas the contrary is the case where the names in issue are FRANK and FRANKIE one being a different version of the other such that the public is likely to make a conceptual link.

29. Moreover, the fact that a mark is a name does [not] automatically mean that the mark has a clear and specific semantic content for the relevant public (see for example C-361/04 P Claude Ruiz-Picasso and Others v EUIPO EU:C:2006:25).

30. It is therefore necessary to make an assessment of conceptual similarity between names on the basis of each individual case."

44. Whereas Sandro and Sandra appear obviously derived from a common base, with the former likely a male equivalent of the latter, I see no reason to suppose that ZANA and ZARA would be seen as "different versions of the same name or names derived from the same root." Of course, this does not unduly diminish the similarity between ZANA and ZARA. They are both four letter words, differing only in their third letter. Nonetheless, they are different words or names.

45. The General Court has upheld the view that a first name or a surname which does not convey a 'general and abstract idea', and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately

recognisable semantic content.<sup>13</sup>

46. In the appeal decision BL O/640/17 (Rado vs Radar) the Appointed Person wrote:

27. The approach in Case C-361/04P *Claude Ruiz-Picasso v. EUIPO* and the relevance of conceptual similarities and differences in general terms was set out by Iain Purvis Q.C. sitting as the Appointed Person in *ROCHESTER Trade Mark* (O-049-17) where he explained the position as follows (emphasis in the original):

38. Before turning to the particular issue in this case, it may be useful to consider the relevance of conceptual similarities and differences in more general terms. The case law of the European Union has recognised the self-evident proposition that where marks evoke particular, different concepts, this tends to counteract any visual or aural similarities between them and reduce the likelihood of confusion. This may be the case even where only one of the marks conveys a particular concept, and the other is concept-free. The CJEU in *Ruiz-Picasso v OHIM* [C-361/04] put it as follows:

‘55 From the conceptual point of view, the word sign PICASSO is particularly well known to the relevant public as being the name of the famous painter Pablo Picasso. The word sign PICARO may be understood by Spanish-speaking persons as referring inter alia to a character in Spanish literature, whereas it has no semantic content for the (majority) non-Spanish speaking section of the relevant public. The signs are not thus similar from the conceptual point of view.

56 Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately [Case T-292/01 *Phillips-Van Heusen v OHIM - Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54].

57 The word sign PICASSO has a clear and specific semantic content for the relevant public. Contrary to the applicants' submissions, the

relevance of the meaning of the sign for the purposes of assessing the likelihood of confusion is not affected in the present case by the fact that that meaning has no connection with the goods concerned. The reputation of the painter Pablo Picasso is such that it is not plausible to consider, in the absence of specific evidence to the contrary, that the sign PICASSO as a mark for motor vehicles may, in the perception of the average consumer, override the name of the painter so that that consumer, confronted with the sign PICASSO in the context of the goods concerned, will henceforth disregard the meaning of the sign as the name of the painter and perceive it principally as a mark, among other marks, of motor vehicles.'

39. The interesting point here is that the absence of a particular concept is said to 'counteract' confusion, by making the marks easier to distinguish. So lack of conceptual similarity is not merely a 'neutral' factor. That is the case even where one of the two marks has no particular meaning at all to the average consumer.

28. Before considering the impact of 'concept' on either the likelihood of confusion or the 'link' it is first necessary to consider what concept if any each sign conveys to the average consumer. This is an assessment of how the average consumer would perceive the signs."

47. It may ultimately be unnecessary for me to have cited the extracts under my paragraph 46 above, but the reason I have included them is that the Opponent's statement of grounds states (my underlining) "the word Zara refers either to a girl's forename or to the Opponent's reputed Zara brand. The word ZANA refers to a girl's forename too, meaning that there is a high degree of conceptual similarity between the parties' marks."
48. As is clear from the quoted passage above, in the Picasso case, that name gave rise to the concept of the famous painter, and that concept or meaning was not, in the perception of the average consumer displaced or overridden when the sign PICASSO was used as a trade mark for cars. The consumer, confronted with the sign PICASSO in the context of the goods concerned, would not henceforth disregard the meaning of the sign as the name of the painter and perceive it principally as a trade mark for cars.
49. Contrastingly, in the present case, the Opponent has not invoked a third-party concept –

such as a famous figure named Zara – but has cast *itself* as one of two alternative concepts attached to the mark.<sup>14</sup> Firstly, while I accept that through use, the Opponent’s earlier mark has enhanced its distinctive character to a very high degree, I do not find that when used as a mark for clothing goods the significance of the word as a girl’s name would be disregarded. Secondly, if the concept of Zara were taken to signify the Opponent’s reputed brand, then as a matter of perverse logic, since Zana does not have that concept, there may be said to exist a conceptual *difference* between the marks. However, the enhancement achieved by its earlier mark should not operate to disadvantage the Opponent, and for these reasons, I consider it proper to conduct the conceptual comparison on the basis that the earlier mark is a (reasonably well-known) female name and that the applied-for mark may either (i) be meaningless to the average consumer, or (ii) may convey to the average consumer the concept of a female name, though one which is different from and not related to the earlier name.

50. On construction (i) where Zana is perceived to have no meaning, a conceptual difference exists, since Zara will be understood as a female name. On construction (ii) in my view, this is an instance where the comparison may be grouped under a common generic term of ‘names’, but which does not automatically lead to a finding of conceptual similarity, since no ‘clear and immediately recognisable semantic content’ inheres in either name. Neither word conveys a ‘general and abstract idea’. While the third word of the Contested Mark is much more similar to the earlier mark than is the name FRANK to the name MIKE, I see no clear basis why the public would be likely to make a particular *conceptual* link between the two names Zana and Zara (beyond their being female names with similar spellings). In my view, the position based on a conceptual comparison of those two words may be considered neutral.
51. The additional words “House of” carry the concept, plainly, of a house of some sort, involving whatever is the subsequent element – such as House of U, House of Maguie, House of 925, House of Foxy, House of Fashion, House of Belle, to take examples from Exhibit JK4, but also for that matter House of Cards, House of Magic, House of Horror. So, in the present case the concept of “House of Zana” depends to some degree on the perception of the word Zana. For those who perceive it as a name, the words will signify

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14 See too the Appointed Person’s observations at paragraphs 68 -79 of appeal decision O/593/20 (AE), which noted that conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trade mark 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. Whilst a trade mark’s reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.

a fashion house, particularly in the context of the goods at issue. My view is that whilst as between simply the words “Zana” and “Zara” the position on conceptual similarity may be considered neutral based on construction (ii) (where they are both perceived as female names), based on the marks as wholes the additional words “House of” introduce a conceptual overlay to the applied-for mark that is absent from the earlier mark, since the earlier mark is simply a name, without the elaboration of the additional words. This is the case despite the limited distinctiveness of those additional words in respect of clothing goods. There is thus a degree of conceptual difference.

### **Conclusion as to likelihood of confusion**

52. I now turn to reach a conclusion as to the likelihood of confusion between the marks



*House of Zana*

and ZARA if

they were used in relation to clothing goods. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of making a global assessment of all relevant factors in accordance with case law principles, especially those outlined at my paragraph 19 above.

53. There are notable factors that favour the Opponent’s claim:

- the respective goods are identical and case law allows that a great degree of similarity between goods may offset a lesser degree of similarity between the marks;
- there is a greater likelihood of confusion where the earlier mark has a highly distinctive character and I have found the Opponent’s mark to have a very high level of distinctiveness based on its use in respect of the goods at issue;

- the average consumer (the public at large), will in general exercise a medium degree of attention, but since clothing may include items purchased cheaply and casually, I will also consider the possibility that the attention level may dip to a level between low and medium; and
- there is also some similarity between the marks, as I shall consider further below, and that similarity lies in the more distinctive component of the Contested Mark.

54. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public<sup>15</sup>; occasional confusion by a small minority is not sufficient to find a likelihood of confusion. The relative weight of the factors is not laid down by law, but is a matter of judgment for the tribunal on the particular facts of each case.<sup>16</sup> The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person; it involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade.<sup>17</sup>
55. Visual considerations will be particularly influential in the purchasing act and my primary finding is that the marks are visually similar only to a degree between low and medium. The earlier mark is not a complex or composite mark; it is a single four-letter word. The Contested Mark contains two additional words, so that the marks differ in their total number of letters by seven letters, and share only three letters. Notwithstanding that the words "House of" are of very low-distinctiveness they contribute to the overall impression and form a unit that is memorable. Those opening two words are absent from the earlier mark, in which brevity is part of the overall impression.
56. Zana is the distinctive component of the Contested Mark and the Opponent's mark is very highly distinctive for the goods at issue. I have considered the possibility that the visual perception of an average consumer may be skewed on the basis of reading what one expects to see. Ms King highlighted this principle from *Aveda Corporation v Dabur India Ltd.*, where Arnold J (as he then was) held "The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear. Thus it is likely that some consumers would misread or mishear UVEDA as AVEDA". However, in my view the overall impression of the Opponent's mark arises in part from its brevity.

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15 Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34  
 16 See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-079-17, (*Rochester Trade Mark*).

17 Again see comments of Iain Purvis as the Appointed Person, *ibid.*

The presence of the additional words “House of” creates quite a different visual impression, so that although those words may not be uncommon, and may of themselves be considered of very low distinctiveness, they are enough, in my view, to avoid in the average consumer a state of expectancy that would far more likely arise if the comparison were between ‘Zara’ and ‘Zana’ (alone).

57. In my view, taking all of the relevant factors into account, including the overall impression of each mark, there is not a likelihood of confusion. Even allowing for imperfect recollection, where the average consumer does not have the chance to make a direct comparison of the marks, but instead relies on the imperfect picture of them that they have kept in their mind, and notwithstanding my findings on the level of attention and the distinctiveness of the earlier mark, I am satisfied that the differences between the marks, on which I have previously set out my analysis, are sufficient to rule out the likelihood of direct confusion on the part of the average consumer (deemed reasonably well informed and reasonably circumspect and observant). (Aurally, the marks overlap only in one syllable and differ by three, such that they will not be directly mistaken, notwithstanding that the marks share a degree of aural similarity between low and medium).
58. Indirect confusion, was considered by Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,<sup>18</sup> where he noted that the average consumer “*taking account of the common element in the context of the later mark as a whole*” may conclude that it is another brand of the owner of the earlier mark. However, no likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). As emphasised by James Mellor QC, sitting as the Appointed Person in *Eden Chocolat*<sup>19</sup>: “... *it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element.*”
59. It is also clear that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion” and that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.<sup>20</sup>
60. I do not overlook that ‘Zana’ is the distinctive component of the Contested Mark. If it were

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18 Case BL-O/375/10

19 Case BL O-547-17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017) at paragraph 81.4.

20 *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16]

my view that that third word would be misperceived, there would be a “proper basis” for a finding indirect confusion. However, in my view, a reasonably well informed and reasonably circumspect and observant consumer, may be expected to read the third word correctly, as Zana, even in a casual purchase where the degree of attention may be lower than medium. Zara is undoubtedly a renowned mark, but the reputation of a mark does not give grounds for presuming a likelihood of confusion. There is no suggestion that the earlier mark has ever been amplified into the phrasal form “House of Zara”, nor even is there evidence before me to indicate that it would be typical for a fashion brand to vary its branding in that way. As I have previously indicated, it is my view that something of the overall impression of the earlier mark comes from the brevity of the single word. In those circumstances, the Contested Mark does set up the average consumer to anticipate the earlier mark. Since I find that the average consumer will perceive the word to be Zana, and nor will the average consumer imperfectly recall Zara as Zana, there is no proper basis for a finding of indirect confusion.

61. Returning to the cited analysis in the AVEDA case, I note that whereas both UVEDA and AVEDA will strike the average consumer as meaningless words without a clear concept, Zara at least will be recognised as a particular female forename giving rise to a conceptual point of difference from the word Zana. Moreover, whereas UVEDA and AVEDA are capable of being pronounced identically, there is a significantly clearer difference between the “ruh” and the “nuh” sounds of the second syllables of ‘Zara’ and ‘Zana’.
62. The perception of the marks by the average consumer of goods based on their overall impressions plays the decisive role in the global appreciation of likelihood of confusion. The Contested Mark will be seen as a phrasal whole, where its third, distinctive word is either an invented without meaning (in my view the more likely perception), or in the case of those who perceive it as a name, it will be as a name that is different from and with no apparent conceptual connection to the more familiar female name ‘Zara’. I find there is no likelihood of indirect confusion.

### **The section 5(3) ground**

63. Section 5(3) of the Act provides as follows:

*“(3) A trade mark which-*

*is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the*

*case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”*

64. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a

serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and *the court’s answer to question 1 in L’Oreal v Bellure*).

65. Success under section 5(3) does not require a likelihood that the consumer would be confused as to the origin of the goods. The purpose of section 5(3) is to afford the proprietor of a mark that has acquired a reputation a form of extended protection that guards against use of a later mark that is sufficiently similar to call to mind the reputed mark in such a way that it would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.
66. At the hearing Ms Kotrri accepted that the earlier mark “ZARA” benefitted from a reputation for clothing and for retail of goods including clothing. The necessary reputation is therefore not in issue; it is known by a significant part of the relevant public. To indicate the strength of the earlier mark’s reputation Ms King highlighted aspects from the Opponent’s evidence, much of which I have referenced earlier where I considered

the enhancement to the earlier mark's distinctive character. I find that the earlier mark has a very strong reputation for the sales of its clothing.

67. I turn therefore to consider whether the public, when confronted with the later mark



or



would call to

mind the earlier reputed mark. I bear in mind that the reputation of the Opponent's mark is very strong, the goods are identical and that there is a direct overlap between the relevant consumers. There is also some similarity between the marks, though for the reasons I have previously explained, it is my view that the marks overall are similar to a less than medium degree. Despite the third, most distinctive word of the Contested Mark sharing an undeniable similarity with the single word that is the reputed mark, I find that there will be many who will simply see the word Zana as an invented, meaningless word, which when appearing within the phrase House of Zana, fails even to call to mind the earlier reputed mark that is a female name. However, I also find that there will be at least a significant cohort for whom the similarity within the Contested Mark will bring to mind the earlier reputed mark. I therefore find that the necessary mental link may accordingly arise, at least for some.

68. Success under section 5(3) requires not only a reputation and a mental link, but also a serious likelihood that the link leads to one of the consequent types of unfair advantage or detriment.

69. Taking unfair advantage of the distinctive character or the repute of the earlier mark has been described as a form of parasitism or free-riding. The case law refers to seeking to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. It also refers to clear exploitation arising from a transfer of the image of the mark or of the characteristics which it projects to the goods.

70. I accept that the reputed mark ZARA has an image that is capable of transfer; while I may struggle to be confidently precise as to its nature, it includes at least a consistency in its prediction and reflection of fashion trends, and probably an aspect of affordability. On the other hand, I find that there is no intention on the part of the Applicant to free-ride in this way; I accept that the choice of name is prompted by Ms Kotrri's Albanian heritage and the idea of clothes manufactured with the magical delicacy of fairies, and I find no cynical motive in the use of the name. Equally, I find that it is not necessary that I find such a subjective intention if the objective effect achieves the transfer of image and the free-riding on the power of attraction. However, even for those who, based on their perception of the similar component, call to mind the word ZARA, I am not satisfied that the mental link would be more than fleeting. The similarity of the word may be noted, but they will provoke a different reaction, where ZANA will either be seen as meaningless or, if as a name, a different name. It will in any event be seen in the context of the mark as a whole, where the additional words 'House of' influence the overall impression. The mental link is in my view too insubstantial and fleeting to result in a transfer of image and an exploitation of the reputation of earlier mark. The reputation of the earlier does not, in my view, make it more likely that a consumer would be better disposed to the Applicant's goods nor ultimately more likely to make a purchase. The similarity from the overall impressions is not so strong as to provoke such an unthinking Pavlovian response in the UK general public.
71. Detriment to the distinctive character of the earlier mark has been described as dilution or whittling away. The case law refers to a weakening of the mark's ability to identify the goods/services for which it is registered as a result of the use of the later mark, and requires a serious risk that there will be a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered. I am not satisfied that this serious risk arises in this instance, not least because it is not obvious to me how the distinctive character would be undermined where the fleeting link that the relevant consumer may make between the marks is not one as to the origin of the goods / services.
72. The final potential injury is detriment to the reputation of the earlier mark - sometimes described as tarnishing. As I recorded above, this type of injury is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where

the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark. Instances where such qualities have arisen have been in conflicts between identically named jams and dog food or identically named chewing gum and cigarettes. The reducing attraction is attributable to the inherent nature of the goods of the later mark conjuring an undesirable association. There is nothing inherently disreputable or unattractive about the goods at issue in this case (clothing). I do not find the hypothetical circumstance of goods of inferior quality offered under the contested mark sufficient and I see no serious risk of injury under this heading, especially in the absence of a lack of confusion as to origin source and in the absence of evidence suggesting quality issues with the goods originating from the Applicant.

**Outcome: The opposition is unsuccessful and, subject to any successful appeal of this decision, trade mark application No. 3569173, may proceed to registration.**

## **COSTS**

73. The Applicant has succeeded in her defence of the opposition proceedings against her trade mark application. On 1 April 2022, at the end of the evidence rounds, the registry sent a letter to the parties offering the opportunity to request a hearing. The same letter informed the Applicant that if she intended to make a request for an award of costs, she would need to complete the provided form and to send a copy to the other party, including a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed, covering for instance preparing responses and evidence and preparing for and attending the hearing (although any award would tend to be discounted where a party's evidence has played little or no relevant part in a decision). In such circumstances, an award of costs (based on a rate of £19 per hour),<sup>21</sup> might have been payable to the Applicant in the event of her successful defence of the opposition. The letter informed the Applicant that if the form were not completed and returned, costs may not be paid. The Applicant responded to the letter on 14 April 2022 by requesting a hearing, but made no request for costs. I therefore make no contributory award towards the Applicant's costs.

*Matthew Williams*      **For the Registrar, 3<sup>rd</sup> August 2022**

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21 The Litigants in Person (Costs and Expenses) Act 1975 (as amended).