O/0448/25

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL REGISTRATION

NO. WO0000001740390

DESIGNATINGTHE UK

IN THE NAME OF

NANGA CO., LTD.

TO REGISTER THE TRADE MARK:

IN CLASSES

14, 16, 18, 21, 24, 25 AND 28

AND

OPPOSITION THERETO UNDER NO. OP000444638

BY

CATWALK VERTRIEB GMBH

Background and pleadings

1. Nanga Co., Ltd. ("the holder") is the holder of the international registration ("the IR") shown below. The IR was registered on 31 May 2023. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR claims a priority date of 26 May 2023.

2. The holder seeks protection of the IR in relation to the following goods:

Class 14	Key rings; key holders; key chains; clocks and watches; jewelry ornaments; earrings; necklaces; jewelry rings.
Class 16	Stationery; printed matter; posters; seals for stationery use; stickers for stationery use.
Class 18	Folding briefcases; shoulder bags; briefcases; suitcases; carry-on bags; tote bags; trunks; handbags; boston bags; schoolchildren's backpacks; rucksacks; pouches; coin purses; umbrellas and their parts; outdoor umbrellas; bags for campers; clothing for domestic pets.
Class 21	Dishware; cookware; camping grills (cooking utensils); drinking flasks for travellers; plastic water bottles sold empty.
Class 24	Bed sheets; futon quilts; quilt covers for futon; blankets; sleeping bags; towels of textile; bed blankets; cotton blankets; blankets for outdoor use.

Class 25	Clothing; outdoor clothing; clothing made of down; tee-shirts; mufflers being clothing; headwear; hats; caps being headwear; headwear made of down; down jackets; down vests; down coats; footwear, other than special footwear for sports.
Class 28	Toys; dolls; toys for domestic pets.

3. The IR was published for opposition purposes on 13 October 2023.

4. CATWALK Vertrieb GmbH ("the opponent") opposes the IR on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

5. The opponent relies upon the mark detailed below:

UK00918188656, filed on 27 January 2020, registered on 3 June 2020.

6. The opponent is reliant upon all of its goods as follows:

Class 25	Clothing; Blazers; Fleeces; Casualwear; Casual footwear; Rubbers [footwear]; Clothing for gymnastics; Gymnastic shoes; Slippers; Gloves [clothing]; Neckwear; Hooded pullovers; Jackets [clothing]; Jackets being sports clothing; Headgear; Coats; Caps [headwear]; Outerclothing; Pelerines; Polo shirts; Polo sweaters; Ponchos; Sweaters; Neck scarves [mufflers]; Leisure shoes; Footwear; Footwear soles; Sneakers; Sportswear; Athletics shoes; Headbands [clothing]; Cardigans;

Articles of knitwear; Stockings; Footless socks; Sweaters; Clothing for gymnastics; Trench coats; Kerchiefs [clothing]; Tee-shirts; folk costumes; Neckerchiefs; Cagoules; Hosiery; Footwear uppers; Heelpieces for boots and shoes; Insoles; Tips for footwear.

7. The opponent opposes some of the holder's goods, as follows:

Class 18 Folding briefcases; shoulder bags; briefcases; suitcases; carry-on bags; tote bags; trunks; handbags; boston bags; schoolchildren's backpacks; rucksacks; pouches; coin purses; umbrellas and their parts; outdoor umbrellas; bags for campers; clothing for domestic pets.

Class 24 Bed sheets; futon quilts; quilt covers for futon; blankets; sleeping bags; towels of textile; bed blankets; cotton blankets; blankets for outdoor use.

Class 25 Clothing; outdoor clothing; clothing made of down; tee-shirts; mufflers being clothing; headwear; hats; caps being headwear; headwear made of down; down jackets; down vests; down coats; footwear, other than special footwear for sports.

8. In its notice of opposition, the opponent argues that the marks are highly similar and the respective goods are identical or highly similar, resulting in a risk of confusion including a likelihood of association between the marks.

9. The holder filed a Form TM8 and counterstatement, admitting "that the opposed goods in class 25 would fall within the scope of "clothing, footwear and headgear"", but denies that the goods in classes 18 and 24 are identical or highly similar. The holder further denies that the marks are sufficiently similar to cause confusion.

10. The opponent filed evidence and submissions during the evidence rounds and the holder filed submissions in lieu of a hearing.

11. The holder is represented by Sandersons and the opponent is represented by Dummett Copp LLP.

Preliminary matter

12. In its TM7[1], the opponent relied on three earlier rights, namely UK00918188656, UK00908761207 and UK00908761314. The holder, in its TM8[2], requested evidence of proof of use in relation to two of these earlier rights, UK00908761207 and UK00908761314. On filing its evidence, the opponent, in its written submissions[3], withdrew the two earlier rights in which the holder had requested evidence of proof of use. This was acknowledged by the holder in its written submissions[4]. I will therefore proceed on the basis that the opposition is based solely in relation to the earlier right UK00918188656.

Evidence

13. The opponent's evidence comprises of a witness statement of Lewis Andrew Jones, signed and dated 22 April 2024. Lewis Andrew Jones is a Chartered Trade Mark Attorney at Dummett Copp LLP. The witness statement is accompanied by exhibits LAJ1 – LAJ8.

14. I have carefully considered this evidence and will refer to it as necessary.

DECISION

15. Section 5(2)(b) of the Act reads as follows:

   "5(2) A trade mark shall not be registered if because—

[1] Form TM7 filed 12 December 2023
[2] Form TM8 filed 19 February 2024
[3] Opponent's submissions filed 22 April 2024, paragraph 8
[4] Holder's submissions filed 28 August 2024, paragraph 3

(a)…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

16. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark for the purposes of section 6 of the Act. Further, as the opponent's earlier mark was registered less than five years before the priority date of the IR, proof of use is not relevant in these proceedings as per section 6A of the Act.

Section 5(2)(b) – case law

17. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

18. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

"23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

20. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

"365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

22. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the

observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

23. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

24. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

> "… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

25. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a

degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."
>
> While on the other hand:
>
> "… it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

26. The goods in question are as follows:

Opponent's goods	**Holder's goods**
	Class 18 Folding briefcases; shoulder bags; briefcases; suitcases; carry-on bags; tote bags; trunks; handbags; boston bags; schoolchildren's backpacks; rucksacks; pouches; coin purses; umbrellas and their parts; outdoor umbrellas; bags for campers; clothing for domestic pets.
	Class 24

	Bed sheets; futon quilts; quilt covers for futon; blankets; sleeping bags; towels of textile; bed blankets; cotton blankets; blankets for outdoor use.
Class 25 Clothing; Blazers; Fleeces; Casualwear; Casual footwear; Rubbers [footwear]; Clothing for gymnastics; Gymnastic shoes; Slippers; Gloves [clothing]; Neckwear; Hooded pullovers; Jackets [clothing]; Jackets being sports clothing; Headgear; Coats; Caps [headwear]; Outerclothing; Pelerines; Polo shirts; Polo sweaters; Ponchos; Sweaters; Neck scarves [mufflers]; Leisure shoes; Footwear; Footwear soles; Sneakers; Sportswear; Athletics shoes; Headbands [clothing]; Cardigans; Articles of knitwear; Stockings; Footless socks; Sweaters; Clothing for gymnastics; Trench coats; Kerchiefs [clothing]; Tee-shirts; folk costumes; Neckerchiefs; Cagoules; Hosiery; Footwear uppers; Heelpieces for boots and shoes; Insoles; Tips for footwear.	Class 25 Clothing; outdoor clothing; clothing made of down; tee-shirts; mufflers being clothing; headwear; hats; caps being headwear; headwear made of down; down jackets; down vests; down coats; footwear, other than special footwear for sports.

Class 18

27. At paragraph 28 of its submissions, the opponent says that "we can submit that bags, briefcases, etc. will often be made from very similar, if not identical (particularly in the case of leather), materials to Class 25 footwear in particular, along with clothing. Often the manufacturing/crafting techniques will

also be very similar." However, this alone is not a sufficient basis for a finding of similarity.

28. I compare "shoulder bags", "tote bags", "handbags" and "boston bags" to the opponent's "Clothing". In my view, these goods could all be conceived by some consumers as aesthetically complementary accessories to articles of clothing. Fashion accessories such as handbags have consistently been found to be similar to clothing based on the fact that they share a common aesthetic function, since these goods jointly contribute to the "look" of the consumers.[5] It is, in fact, a common customer behaviour to aesthetically combine those goods when purchasing them and their aesthetic coordination may also be considered at the design stage. They are likely to be sold in the same outlets as clothing and the average consumer may expect them to be produced by the same undertaking. Consequently, I find there is a low degree of similarity between the respective goods.

29. I note that the opponent has said at paragraph 28 of its submissions that, "It is very common for brands primarily regarded as footwear producers to also produce bags of some form" and has filed evidence to that effect at pages 1 to 6 of Exhibit LAJ1. As such, I should say that I would have made the same finding as above, that of a low degree of similarity, had my comparator been the opponent's "Footwear". Footwear could also share a common aesthetic function with the above-mentioned holder's goods.

30. I compare "clothing for domestic pets" with the opponent's "Clothing". While there are obvious dissimilarities arising from the intended wearer of the clothing, clothing is used for protection from the elements, whether it is meant for pets or humans. There is also a degree of similarity in nature. I do not see any other significant point of overlap. This is because, while the opponent has filed evidence to show that some human clothing brands also sell clothing for pets "often providing an air of luxury, of technically strong

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[5] See for example *Gitana SA v OHIM*, Case T-569/11, para 45

clothing”,[6] I do not consider these goods to be typically sold through the same trade channels. There is a low degree of similarity between these goods.

31. The opponent has said, at paragraph 29 of its submissions, that “bags, pouches, etc. are often designed to match, compliment, or contrast with clothing/footwear and are often paired with such”, and it has furnished evidence of such goods being sold through the same trade channels. However, I do not consider the notion of a common aesthetic function to extend to all types of bags and to pouches and so in comparing “folding briefcases”, “briefcases”, “suitcases”, “carry-on bags”, “trunks”, “schoolchildren's backpacks”, “rucksacks” and “bags for campers” to the opponent’s “Clothing” or “Footwear” I find that these goods have the primarily practical purpose of transporting particular items. I do not consider that they would be intended to be coordinated with items of clothing or footwear to present a particular image or sold as such. In my view, these goods are dissimilar.

32. In comparing “pouches” and “coin purses” to the opponent’s “Clothing” or “Footwear”, these goods have the primarily practical purpose of storing small items or coins. I do not consider that they would be intended to be coordinated with items of clothing or footwear to present a particular image or sold as such. In my view, these goods are dissimilar.

33. I compare “umbrellas and their parts” and “outdoor umbrellas” with the opponent’s Class 25 goods. I also do not consider the notion of a common aesthetic function to extend to umbrellas. The holder’s goods are different in physical nature, purpose and method of use from the opponent’s Class 25 goods. While both parties’ goods might be stocked by large retailers, they will not be sold in close proximity. They are not in competition or complementary. I find the respective goods to be dissimilar.

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[6] As per paragraph 34 of the opponent’s submissions and Exhibit LAJ5.

Class 24

34. The main commonality between the holder's "bed sheets", "futon quilts", "quilt covers for futon", "blankets", "sleeping bags", "towels of textile", "bed blankets", "cotton blankets" and "blankets for outdoor use" and the opponent's "Clothing" is that they are made of material. However, this is not enough to justify a finding of similarity. The goods have different natures and serve completely different purposes, namely that clothing is to be worn by people for protection and/or fashion, whereas the contested goods are to be used when sleeping or when drying oneself. Therefore, their uses and methods of use are different.

35. While the opponent has filed some evidence in the form of Exhibits LAJ6 and LAJ7 that some retailers sell both clothing and bedding or towels, I do not regard these goods as typically being sold together. I am also not convinced by the opponent's argument that, because the opponent's "Clothing" at large includes outdoor clothing, and that such goods are sold in the same outdoor outlets as sleeping bags (as evidenced in Exhibit LAJ8) and blankets for outdoor use, they should be considered to be similar. Even where sold through the same trade channels, these goods would be sold in entirely different parts of those shops. The goods are not complementary, nor are they in competition. These goods are dissimilar.

Class 25

36. The holder has admitted "that the opposed goods in class 25 would fall within the scope of "clothing, footwear and headgear". As such, the respective goods are to be regarded as *Meric* identical.

37. As some degree of similarity is required for there to be a likelihood of confusion[7], the opposition must fail in respect of the following goods:

[7] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Class 18	Folding briefcases; briefcases; suitcases; carry-on bags; trunks; schoolchildren's backpacks; rucksacks; pouches; coin purses; umbrellas and their parts; outdoor umbrellas; bags for campers.

The average consumer and the nature of the purchasing act

38. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he was then) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

39. The competing goods are clothing, headgear and footwear, and bags that are conceived by consumers as aesthetically complementary accessories to clothing. Such goods range in price but are not generally hugely expensive. The average consumer will be a member of the public who will consider what the goods look like as well as practical considerations such as size. Overall, I consider that the consumer will pay a medium level of attention during the purchasing process.

40. The average consumer will primarily select the goods at issue themselves from the shelves (or their online equivalent) and so the process will be primarily a visual one. However, they may also seek advice from a shop assistant and so I do not rule out verbal considerations.

Comparison of the trade marks

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

    “.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

42. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

43. The respective trade marks are shown below.

Opponent’s trade mark	**Holder’s trade mark**
nanga eco barefoot	NANGA

44. The opponent's mark is a figurative mark with the largest word being "nanga" in a stylised font with breaks in the letters, the first letter "n" being enclosed by an irregularly shaped box. There are two much smaller words below the main word, being "eco barefoot" in lower case. The word "nanga" is the dominant word, with the words "eco barefoot" playing a lesser role, the stylisation making a very minor contribution to the overall impression made by the mark.

45. The holder's mark consists of the word "NANGA" in highly stylised block capitals, but the word alone predominates in terms of the overall impression made by the mark, the stylisation making a lesser contribution.

46. Visually, the marks share the same word, "nanga"/"NANGA" albeit differently stylised and in different cases. The opponent's mark has the very small "strapline" (a short, memorable phrase that is used to describe a brand or a product) "eco barefoot" which is absent from the holder's mark. Overall, I find the marks to be of at least a medium level of visual similarity.

47. Aurally, despite the first letter of the main word being inside a box, the average consumer would pronounce the opponent's mark as "NAN-GA" but would not voice the very small strapline. The holder's mark would also be pronounced "NAN-GA". The marks are aurally identical.

48. Conceptually, the word "nanga"/"NANGA" does not give rise to a particular concept. The opponent's strapline gives rise to the lesser concepts of environmental friendliness and being barefoot, these elements having no point of comparison with the holder's mark.

Distinctive character of the earlier mark

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

50. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

51. The earlier mark contains the stylised dominant word "nanga" which is an invented word and is therefore not suggestive of the opponent's goods. The much smaller strapline "eco barefoot" is mildly suggestive of the goods being environmentally friendly and natural. I find the mark as a whole to be inherently distinctive to a medium degree. However, I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks[8], the word "nanga"/"NANGA". In that respect, that word alone is highly distinctive.

[8] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

Likelihood of confusion

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

53. Except where I found the parties' goods to be dissimilar, I found their goods to be identical or of low similarity. I found the marks to be visually similar to at least a medium degree and aurally identical. Conceptually, the shared word "nanga"/"NANGA" does not give rise to a particular concept and the opponent's strapline has no point of comparison with the holder's mark. I have identified the average consumer as a member of the public who would pay a medium level of attention during the purchasing process. The process will be primarily a visual one. However, I do not rule out verbal considerations. I have found the earlier mark as a whole to have a medium level of inherent distinctiveness, with the point of commonality between the marks, the word "nanga"/"NANGA" being highly distinctive.

54. The marks share the identical invented word "nanga"/"NANGA". Notwithstanding the different stylisation and casing of the shared words, the marks could easily be mis-recalled one for the other, with the very small

strapline “eco barefoot” being entirely overlooked. As such, there is a likelihood of direct confusion, even where the goods are only of a low level of similarity.

55. If I am wrong, and the average consumer was to notice the differences between the marks, I will now go on to consider indirect confusion.

56. In *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, by Iain Purvis Q.C. (as he then was), as the Appointed Person, explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) 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.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

57. The case before me closely fits example (a) such that the average consumer would assume that no-one else but the brand owner would be using the word "nanga"/"NANGA" in a trade mark.

58. Notwithstanding the different stylisation and casing of the respective marks, the presence of the identical highly distinctive invented word means that the average consumer would see the opponent's mark as a logical sub-brand of the holder's mark, the strapline "eco barefoot" making it the environmentally friendly and natural offering of the "NANGA" brand. The presence of the identical highly distinctive invented word would cause the average consumer to see an economic connection between the marks such that they would see the goods as coming from the same or linked undertakings. There would therefore be a likelihood of indirect confusion, even where the goods are only of a low level of similarity.

CONCLUSION

59. Subject to any appeal, the opposition has been successful in respect of the following goods for which the IR may not become protected in the UK:

Class 18	Shoulder bags; tote bags; handbags; boston bags; clothing for domestic pets.
Class 25	Clothing; outdoor clothing; clothing made of down; tee-shirts; mufflers being clothing; headwear; hats; caps being headwear;

headwear made of down; down jackets; down vests; down coats; footwear, other than special footwear for sports.

60. The IR may become protected in the UK for the following goods:

Class 18	Folding briefcases; briefcases; suitcases; carry-on bags; trunks; schoolchildren's backpacks; rucksacks; pouches; coin purses; umbrellas and their parts; outdoor umbrellas; bags for campers.
Class 24	Bed sheets; futon quilts; quilt covers for futon; blankets; sleeping bags; towels of textile; bed blankets; cotton blankets; blankets for outdoor use.

61. The IR may also become protected in the UK for the following goods which were unopposed:

Class 14	Key rings; key holders; key chains; clocks and watches; jewelry ornaments; earrings; necklaces; jewelry rings.
Class 16	Stationery; printed matter; posters; seals for stationery use; stickers for stationery use.
Class 21	Dishware; cookware; camping grills (cooking utensils); drinking flasks for travellers; plastic water bottles sold empty.
Class 28	Toys; dolls; toys for domestic pets.

COSTS

62. The parties have enjoyed a roughly equal measure of success and therefore they should bear their own costs.

Dated this 22nd day of May 2025

JOHN WILLIAMS
For the Registrar