O/0495/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4092417

IN THE NAME OF STRICTLY PIANO LTD

TO REGISTER THE FOLLOWING TRADE MARK:

STRICTLY
PIANO

IN CLASSES 16, 25 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 450993

BY

TUTO CONSULTING LIMITED

Background and pleadings

1. Strictly Piano LTD ("the applicant") applied to register the trade mark shown on the front page of this decision (UK trade mark ("UKTM") no: UK4092417) in the UK on 27 August 2024. It was accepted and published in the Trade Marks Journal on 27 September 2024 in respect of the following goods/services:

Class 16 Patterns for making clothes.

Class 25 Clothes; Clothing; Denims [clothing]; Jackets [clothing]; Shorts [clothing]; Clothes for sports; Kerchiefs [clothing]; Bottoms [clothing]; Jerseys [clothing]; Ready-to-wear clothing; Casual clothing.

Class 35 Retail services relating to clothing; Merchandising; Product merchandising; Retail services connected with the sale of clothing and clothing accessories; Mail order retail services for clothing accessories; Merchandizing; Promoting the sale of goods and services of others through the distribution of printed material and promotional contests.

2. On 25 November 2024, Tuto Consulting Limited ("the opponent") partially opposed the trade mark application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") as against all the goods in class 25. For the purposes of this opposition, it relies upon its earlier UK trade mark, 'piano' (UKTM No: UK3950742) filed on 29 August 2023 and registered on 24 November 2023. The following goods are relied upon:

Class 25 Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Garments for protecting clothing; Linen clothing; Headbands for clothing; Headbands [clothing]; Clothes; Gloves as clothing; Gloves [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Silk clothing; Clothing of leather; Leather clothing; Leather (Clothing of -); Parts of clothing, footwear and headgear; Knitted clothing; Embroidered clothing; Hoods [clothing]; Windproof clothing; Belts for clothing; Casual clothing; Rainproof clothing; Waterproof

clothing; Jackets being sports clothing; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Woven clothing; Infant clothing; Drawers [clothing]; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Clothing for children; Clothing for infants; Clothing for babies; Tops [clothing]; Beach clothing; Men's clothing.

3. Under section 5(2)(b) of the Act, the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and for those goods which it opposes, that the contested mark should be refused registration. The opponent submits as follows:

> “The applicant’s mark ‘Piano’ is identical to my registered trademark in Class 25. Given that both marks apply to clothing, which targets the same market and consumers, there is a high likelihood of confusion. Consumers will reasonably believe that the applicant’s goods originate from, or are associated with, my business”.

4. The applicant filed a counterstatement submitting as follows:

> “Strictly Piano" in Class 25 (Clothing and related services). I respectfully submit that my mark does not conflict with the previously registered trademark for "Piano" in the same class for the following reasons:
>
> 1. Distinctiveness of the Mark
>
> The applied-for mark is "Strictly Piano", not just "Piano." The inclusion of the word "Strictly" significantly alters the overall impression, making it distinct from a standalone "Piano" mark. Consumers encountering "Strictly Piano" will perceive it as a unique brand identity rather than being confused with any existing "Piano" mark.
>
> 2. Conceptual and Commercial Differences

The term "Piano" on its own is a generic or descriptive word commonly associated with musical instruments and themes. The addition of "Strictly" creates a brand identity with a different conceptual meaning. This distinction reduces the likelihood of confusion in the marketplace, as my brand represents a specific business identity under the full phrase "Strictly Piano."

Our business operates in the entertainment and events industry, and all of our goods and services are clearly branded with our unique logo. Given the distinct branding, it is unlikely that consumers would mistakenly associate our goods with those of the opponents. The presence of our logo on all our product and services ensures clear differentiation in the marketplace."

5. In accordance with section 6 of the Act, the mark relied upon by the opponent is considered an earlier mark. The mark had not been registered for five years as at the date of application for the contested mark and so, in accordance with section 6A of the Act, it is not subject to proof of use; the opponent may rely upon all the goods of its registration as claimed.

Representation

6. The opponent is represented by Brian Mazengera[1]. The applicant is self-represented. The applicant filed witness evidence dated 5 October 2023. Neither party requested a hearing nor filed written submissions in lieu. The parties' submissions will be referred to as and where appropriate in this decision. This decision is taken following a careful perusal of the papers.

Relevance of EU LAW

7. 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

[1] The opponent has appointed a representative for the purpose of the proceedings. However, I note that the addresses of the party itself and the respective representative are the same. Where applicable, I will proceed on the basis that neither party is represented by a professional legal representative.

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.

Preliminary Issues

8. It is noted that the applicant has filed a witness statement of Ms Antonia Murdoch, the Director of Strictly Piano LTD. The witness statement includes evidence of the applicant's use of the contested mark within the UK prior to the date of the application. Ms Murdoch states that the contested mark has been used within the UK since 2022. I note that within Ms Murdoch's witness statement she provides details as to the background of the company and some of its activities, as well as evidence on the matter.

9. In this instance, the applicant's evidence is not relevant as the assessment I must undertake under section 5(2)(b) is a notional one; the provisions of the Act are not merely a reflection of what is happening in the market[2]. When assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all of the circumstances in which the mark might be used if it were registered[3]. My assessment must take into account only the contested mark, its specification, and any potential conflict with the earlier marks. Therefore, I will not comment any further upon this evidence.

Decision

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

> "5(2) A trade mark shall not be registered if because-
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

[2] *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41
[3] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66

11. Section 5A of the Act states as follows:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Relevant law

12. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

> (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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

(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

13. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 25 - Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Garments for protecting clothing; Linen clothing; Headbands for clothing; Headbands [clothing]; Clothes; Gloves as clothing; Gloves [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing];	Class 25 – Clothes; Clothing; Denims [clothing]; Jackets [clothing]; Shorts [clothing]; Clothes for sports; Kerchiefs [clothing]; Bottoms [clothing]; Jerseys [clothing]; Ready-to-wear clothing; Casual clothing.

Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Silk clothing; Clothing of leather; Leather clothing; Leather (Clothing of -); Parts of clothing, footwear and headgear; Knitted clothing; Embroidered clothing; Hoods [clothing]; Windproof clothing; Belts for clothing; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Woven clothing; Infant clothing; Drawers [clothing]; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Clothing for children; Clothing for infants; Clothing for babies; Tops [clothing]; Beach clothing; Men's clothing.	

14. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market,* 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."

17. I bear in mind that it is permissible to group goods together for the purposes of the assessment.[4]

Class 25

Clothes; Clothing; Bottoms [clothing]; Clothes for sports; Jackets [clothing];

18. The opponent's mark contains all of the above terms within its specification, and these terms are therefore self-evidently identical to the applicant's above terms.

Denims [clothing]; Shorts [clothing]; Kerchiefs [clothing]; Jerseys [clothing]; Ready-to-wear clothing; Casual clothing.

19. All the aforementioned goods in the applicant's specification are items of clothing which fall within *Clothing* in the opponent's specification in class 25. The goods are, therefore, identical on the principles outlined in *Meric*.

Average consumer and the purchasing act

20. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

21. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

[4] *Separode* Trade Mark O/399/10

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

22. I also note that in *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

"50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

23. The average consumer of the goods is likely to be a member of the general public. The goods are unlikely to be particularly expensive purchases. They are not likely to be purchased every day, although will be purchased reasonably frequently. Factors such as materials, aesthetics and comfort are likely to be taken into consideration. Consequently, I consider that the average consumer will pay a medium (or average) degree of attention during the purchasing process. The goods are likely to be purchased by self-selection from the shelves of a retail outlet, or online equivalent. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and word-of-mouth recommendations may play a part.

Comparison of marks

24. 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."

25. It would be wrong, therefore, to dissect the trade marks artificially, 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.

26. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
piano	STRICTLY PIANO

Overall impression

27. The earlier mark is presented in a plain typeface and is a word only mark consisting of the word 'piano'. There are no other elements contributing to the mark and so the overall impression lies in the entirety of the word.

28. The contested mark comprises the words 'Strictly Piano' in a plain bold font. The word 'strictly' appears above piano, and the word piano is larger. In my view, the word PIANO plays the greater role in the overall impression of the contested mark due to its size. The STRICTLY element, whilst contributing, plays a lesser role.

Visual comparison

29. A word trade mark protects the notional use of the word itself irrespective of font capitalisation or otherwise and therefore the difference in casing will have little impact on the assessment. The competing marks are similar to the extent that they share the identical word PIANO. The difference in the marks comes from the addition of the word STRICTLY at the beginning of the contested mark, and the stylisation, insofar as the word placement (stacking STRICTLY above PIANO), the variation in word size and bold font. As a general rule the beginning of a mark tends to have more impact, as per the matter of *El Corte Inglés, SA v OHIM*[5], however, I have found PIANO to be the

[5] Cases T-183/02 and T-184/02

dominant element of the applicant's mark. The opponent's mark is a word only mark, whereas the applicant's mark is stylised as described above. Weighing up the differences against the similarities, I consider there to be between a medium and high degree of visual similarity between the marks.

Aural comparison

30. The earlier mark comprises of the word PIANO, which is an ordinary English word and would be pronounced as such. The contested mark contains the words STRICTLY PIANO, with STRICTLY also being pronounced in the normal way. The point of aural overlap lies in the second word of the contested mark, as PIANO will be pronounced identically in both. The first word in the contested mark, STRICTLY, has two syllables. There is no comparator in the earlier mark, and this will be a point of difference between the marks, as the word will not go unnoticed. Overall, I find the marks to be aurally similar to a medium degree.

Conceptual comparison

31. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, as highlighted in numerous judgments of the GC and the CJEU[6].

32. The applicant submits that "the term "Piano" on its own is a generic or descriptive word commonly associated with musical instruments and themes". I agree that a piano is a musical instrument and that this will be understood by the average consumer. The parties have not made any submissions regarding the word STRICTLY, save for the applicant's submissions that this creates a distinction between the two marks. STRICTLY is a dictionary word, which has several meanings[7] including:

a. in a way that would bring severe punishment if not obeyed;
b. in a very limited or limiting way;
c. exactly or correctly

[6] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29
[7] STRICTLY | English meaning - Cambridge Dictionary

33. In this instance, I consider that the average consumer is likely to interpret the opponent's mark to mean that the mark is limited to or solely focussed on the PIANO. I have also found PIANO to be the dominant element of the mark. The stylisation does not impact the concept of the applicant's mark. Given that the opponent's mark will also bring to mind a piano, I find that there is a high degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

35. 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, to those with high inherent distinctive character, such as invented words

which have no allusive qualities. No evidence has been filed in support of the opponent's mark having an enhanced degree of distinctive character, and therefore, I only have the inherent position to consider.

36. The earlier mark comprises of the word, PIANO. For the reasons that I have set out above, I consider that the average consumer would interpret the opponent's mark as referring to the musical instrument. The word PIANO is commonly understood, and in this instance, it does not allude to the goods at issue, being clothing. I consider that the earlier mark is inherently distinctive to a medium degree.

Conclusions on Likelihood of Confusion

37. 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 down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. 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 he has retained in his mind.

38. I have found as follows:

- The goods at issue are identical, either self-evidently or on the principles outlined in *Meric*;

- The average consumer will be members of the general public. They will select the contested goods by primarily visual means, although I do not discount an aural component;

- A medium degree of attention will be paid;
- The contested mark is visually similar to the earlier mark to between a medium and high degree;
- The marks are aurally similar to a medium degree;
- The contested mark and the earlier mark to be conceptually similar to a high degree;
- The earlier mark overall to be inherently distinctive to a medium degree.

39. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I do not consider that consumers would misremember or inaccurately recall which mark was which. Even though both marks share the identical word PIANO (which is not descriptive or allusive of the goods at issue), the additional element in the contested mark will not be overlooked. As a result, I do not find that consumers will be directly confused by the marks as a result of the common presence of PIANO and I do not find that the consumer is likely to mistake one mark for another. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even on identical goods.

40. This leads me to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., 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 recognised 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)."

41. In *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] 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". Arnold LJ agreed, pointing out 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.

42. The three categories set out in *L.A. Sugar* are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court

of Appeal[8]. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion[9].

43. When assessing whether, as a result of the marks' common word PIANO, consumers will be confused between the two entities, I give consideration to the parties' goods which I find to be identical. Upon encountering the applicant's mark being used in respect of those goods which are identical to the opponent's, I consider that the applicant's mark is likely to be perceived as a sub-brand or indicating goods provided by the same, or linked undertaking. Therefore, when considering the applied for mark, and taking account of the common element in the context of the mark as a whole, the consumer is likely to conclude that it is another brand of the owner of the earlier mark. As a result of this, I find a likelihood of indirect confusion.

Conclusion

44. The opposition is successful. Therefore, subject to appeal, the application will be refused in relation to the following goods:

Class 25 Clothes; Clothing; Denims [clothing]; Jackets [clothing]; Shorts [clothing]; Clothes for sports; Kerchiefs [clothing]; Bottoms [clothing]; Jerseys [clothing]; Ready-to-wear clothing; Casual clothing.

45. However, it will proceed to registration in relation to the following goods and services which were unopposed:

Class 16 Patterns for making clothes.

Class 35 Retail services relating to clothing; Merchandising; Product merchandising; Retail services connected with the sale of clothing and clothing accessories; Mail order retail services for clothing accessories;

[8] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[9] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

Merchandizing; Promoting the sale of goods and services of others through the distribution of printed material and promotional contests.

Costs

46. The opponent has been successful and is entitled to a contribution towards its costs. Given that the opponent is not represented by a professional legal representative, at the end of the evidence rounds it was invited to file a costs pro-forma should it wish to make a request for costs in respect of the proceedings. The relevant part from the official letter issued on 5 December 2025 reads as follows:

> "If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send your request by e-mail to tribunalhearings@ipo.gov.uk.
>
> If there is to be a decision from the papers, your request for an award of costs should be provided by 2 Jan 2026.
>
> …
>
> If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded."

47. No costs pro forma has been filed, however, I note that the opponent paid an official fee of £100. I therefore order Strictly Piano LTD to pay Tuto Consulting Limited the sum of £100. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of June 2026

LA Bailey

For the Registrar