O/0507/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION NO. 3663777

IN THE NAME OF PAUL VALE

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25

Aomednx

AND OPPOSITION THERETO (NO.600001970)

BY

YONGJIAN QI

AND

IN THE MATTER OF APPLICATION NO. 3658762

IN THE NAME OF YONGJIAN QI

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25

Aomednx

AND

OPPOSITION THERETO UNDER NUMBER 426961

BY

PAUL VALE

Background and Pleadings

1. On 2 July 2021, Mr Paul Vale applied to register in the UK the trade mark numbered 3663777 ("the '777 mark") Aomednx for *bath robes* in class 25. It was accepted and published in the Trade Marks Journal on 27 August 2021.

2. On 21 October 2021, Mr Yongjian Qi, opposed the application under section 5(2)(a) of the Trade Marks Act 1994 ("the Act") relying on his earlier filed UK trade mark numbered 3658762 as set out below:

> UKTM no. 3658762
>
> ("'762 mark")
>
> Aomednx
>
> Filed on 22 June 2021 and published on 20 August 2021
>
> Class 25: *Bath robes; Bathing suits; Clothing; Girdles; Footwear; Dressing gowns; Gloves [clothing]; Neckties; Outerclothing; Hats; Scarves; Socks; Waterproof clothing; Waistcoats; Trousers.*

3. Mr Qi contended that the '777 mark is an exact same copy of his trade mark and that the goods are similar, such that it would cause a likelihood of confusion. Mr Vale filed a defence and counterstatement,[1] denying the claim that the marks are similar but accepting that the goods are similar/identical. It was contended by Mr Vale that his application was genuine as opposed to Mr Qi's application which it was said was filed in bad faith.

4. Consequently, on 20 September 2021, Mr Vale issued opposition proceedings against Mr Qi's filing as set out at paragraph 2, claiming that the '762 mark was filed in bad faith under section 3(6) of the Act. Given that Mr Vale did not file any other documents in support of his claim I have set out his pleadings in full as follows:

> "We started the brand Aomednx as an entry level range for our range of SRFDRY robes. We have been selling them via our SRFDRY.com site and our

[1] Despite several attempts the TM8 form was finally filed in an acceptable format and admitted into the proceedings on 21 September 2022.

TVSC.co site since October 20. We registered the name Aomednx with Amazon in July 21 as this was our biggest market with these robes. We have branded products, social media and branded product listings within inline websites (and other third party seales [sic] platforms such as eBay and Etsy) and have built this brand for our own use over the last year and a half. The opposition have no claims to the brand. They do not brand any product with it, they have no social media for the brand, they do not sell any items under this brand. They are simply attemtping [sic] to hijack our succesful [sic] listing within Amazon and this is clearly being done in bad faith. The applicant has done so solely to hijack our listing on Amazon, they have no intention to use the trade mark."

5. Mr Qi filed a defence and counterstatement denying the claims made, pleading as follows:

"1. Trademark name:

The opponent's trademark name and the applicant's trademark name are highly similar, even the same. But the applicant's application date is 22 June 2021, while the opponent's application date is 02 July 2021. The trademark of the applicant entered the publicity period earlier than that of the opponent, and the applicant started to use the trademark very early. Please refer to the evidence we will submit later for details. We have reason to suspect that the objector is malicious against us, thus prolonging the time for us to get the certificate.

2. Trademark meaning and background

The applicant used the abbreviation of the lover as the trademark name. The applicant's wife is a fashion designer, and the applicant established this trademark brand in honor of her. The brand also sells garments on Amazon and has been selling products on the site since before the naysayers.

3.Trademark Goods

The product category of applicant's registered trademark is Class 9 and 18, which are different from the other party's. What's more, the products we sell are inconsistent with each other.

[…]

4. In addition, Yongjian Qi has been using the "Aomednx" trademark extensively in business for a long time, with very long-term effects. We have been selling this brand of clothes, garment products at our UK site for a long time."

6. Whilst the proceedings were initially commenced by way of Fast Track, given that the '762 mark relied upon as an earlier right had not as yet attained registration the proceedings were converted to a standard opposition on 28 November 2021. Mr Qi filed an amended TM7 as a result on 13 December 2021. Following the filing of the cross-opposition proceedings by Mr Vale, the proceedings were consolidated on 17 April 2023 and the parties were notified shortly thereafter.

Representation

7. Mr Qi is represented by Axis Professionals Ltd, whereas Mr Vale is unrepresented. Only Mr Qi filed evidence. Neither party filed submissions nor asked to be heard on the matter. This decision is taken following a careful perusal of all the papers.

Earlier mark

8. Mr Vale contends that he has been using his mark since October 2020 before Mr Qi started using his mark which he believes gives him a prior entitlement. However, in so far as section 6(1)(a) of the Act is concerned a trade mark qualifies as an earlier right when it is filed. Given that Mr Qi applied for registration of his '762 mark prior to that of Mr Vale, it qualifies as an earlier mark.

9. I would also refer the parties to Tribunal Practice Notice 4/2009 and in particular Ms Anna Carboni's decision (sitting as the Appointed Person) in the case of *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. In this case Ms Carboni rejected any defence, based on prior entitlement, raised in this way, as wrong in law. She determined that the proper course for any Proprietor wishing to invoke an earlier right was to oppose the application or submit an application to invalidate it. Whilst I note that Mr Vale has sought to challenge the Mr Qi's application, he has done so on the basis of bad faith and not on any ground based on a prior right or entitlement. Since there is no ground before me in which Mr Vale is able to claim a prior entitlement, by virtue of section 6 of the Act, I must consider Mr Qi's application as the earlier right for the purposes of this decision, given that it was filed first in time. This is of course

subject to the outcome of the bad faith claim. If Mr Vale's claim succeeds, then this dispenses with Mr Qi's ability to rely on his '762 mark as an earlier right for the purposes of the opposition brought under section 5(2)(a) of the Act.

Evidence

10. Only Mr Qi filed evidence by way of witness statement dated 29 May 2023, accompanied by two exhibits marked JS1-JS2. I note the following from his evidence:

- Mr Qi is the owner of the applied for mark.
- He says that he has been using the mark since March 2019.
- The brand was guided by two concepts - comfort and fashion.
- The main focus of his business is selling clothing. He states that he initially started selling coats but has since expanded into selling a variety of articles of clothing. He produces archive prints of his clothing products dated between 2019-2023 taken from "his online site".[2] The trade mark is said to be clearly visible on the website. The screenshots produced are in fact taken from "sellercentral.amazon.co.uk" and are dated 20 October and 11 November 2021. No reference to the mark is shown in the screenshots that were produced as contended. The screenshots do show a selection of 'Waterproof Hoodie poncho dry robes', in a variety of colours, having been ordered over the last 12 months. The goods/seller is identified by an 'ASIN number', but no explanation is provided that this number is attributed to Mr Qi or to products sold under the name Aomednx.
- The screenshots show that in total 873 orders have been placed since 30 September 2019.
- One screenshot shows an order for a pair of jeans, again no refence to the '726 mark is displayed.
- Two listings for jeans are produced dated 20 November 2021, taken from Amazon UK.[3] Although Mr Qi states that the images show the labels attached to his products, the images themselves are insufficiently clear for me to be able to see this. The entries are accompanied by text, showing that the jeans are

[2] Exhibit JS1.
[3] Exhibit JS2.

sold under the brand Aomednx, with the price being displayed in pounds sterling.

Relevance Of EU Law

11. 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.

Pleadings

12. The proceedings incurred several months of delay with both parties filing pleadings in unacceptable formats. This required the caseworker allocated to the case to write out to both parties on a number of occasions in order for the errors/amendments to be corrected. Furthermore, matters were compounded by the Tribunal not recording that Mr Qi had filed a defence and counterstatement in response to Mr Vale's bad faith claim which resulted in his application for the '762 mark being erroneously deemed withdrawn. Once this error came to light, the proceedings were reinstated, and the parties were notified that the bad faith ground was being defended and that the proceedings would resume.

DECISION

Bad faith

13. I shall deal with Mr Vale's claim to bad faith first given that the outcome of this ground will impact on Mr Qi's ability to rely on his '762 mark for the purposes of the opposition under section 5(2)(a).

Section 3(6)

14. The relevant section of the Act reads as follows:

> "3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

15. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening,* Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening),* Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening),* Case T-507/08, EU:T:2011:46. It summarised the law as follows:

> "68. The following points of relevance to this case can be gleaned from these CJEU authorities:
>
> 1.The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
>
> 2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
>
> 3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacilik* at [45].
>
> 4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other

sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacilik* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify

the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".

16. Mr Vale's claim of bad faith is that his use of the '777 mark predates that of Mr Qi's such that it affords him some prior entitlement, and that Mr Qi has no intention of using the mark he has applied for. Mr Vale contends that Mr Qi has simply hijacked his company's listing on Amazon to prevent him from using it on his own goods. It is claimed that Mr Qi does not brand any product with his mark, he does not possess any social media for the brand, nor does he sell any items under the brand.

17. Whether it is bad faith to apply for a trade mark without any intention to use it in relation to the specified goods and services was considered in *Sky* v *Skykick,* CJEU, Case C-371/18, EU:C:2020:45 ("*Sky CJEU*") and *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 ("*Sky CA*"). The law appears to be as follows:

a. Applying to register a trade mark without an intention to use it is not bad faith *per se*. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification: *Sky CJEU.*

b. The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application: *Sky CJEU.*

c. However, where the trade mark application is filed without an intention to use it in relation to the specified goods and services, and there is no rationale for the application under trade mark law, it may constitute bad faith. Such bad faith may be established where there are objective, relevant and consistent indications showing that the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or

of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: *Sky CJEU.*

d. A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky CJEU*.

e. It is not possible for there to be bad faith in respect of an entire category of goods or services where there was an intention to use the mark in relation to some goods or services within that category (*Sky CJEU*; *Sky CA*).

f. Each category of goods and services must be considered separately, taking into account legitimate use and factors such as an applicant's reputation, brand recognition and expansion which might justify a wide specification: *Sky CA*.

18. Mr Vale did not file evidence in support of his claim. Rule 64(1) of the Trade Marks Rules 2008 sets out the provisions as to what constitutes evidence in proceedings and the form they must take which would normally be by way of a witness statement, affidavit or statutory declaration. A witness statement must include a statement of truth and be signed and dated by the maker of that statement.

19. However in the case of *Soundunit Limited v Korval Inc.*, BL/0468/12, Mr Daniel Alexander Q.C., sitting as the Appointed Person, acknowledged that "before the High Court a pleading verified by a statement of truth may be admitted as evidence (see CPR Rule 32)."

20. The effect of this is that whilst Mr Vale has not filed a witness statement I am able to consider the contents of his statement of grounds as evidence as it has been signed by him personally and the attestation box includes a declaration of truth.

21. Notwithstanding this, given that a claim to bad faith is a serious allegation the question for me to determine is, whether Mr Vale has sufficiently raised a prima facie case in his pleadings which requires it to be rebutted by Mr Qi. The case law confirms that applying for a trade mark without an intention to use it is not in itself bad faith, without showing something else.

22. It is also clear from the caselaw that the burden of proving bad faith lies with Mr Vale. Mr Qi is not required to provide a positive case of good faith, unless and until Mr Vale has presented evidence from which 'a rebuttable presumption of lack of good faith' can be drawn. Furthermore, it is clear from the decision in *Skykick* (CJEU) that there is no requirement for Mr Qi to use or intend to use the mark for all the goods listed at the time he applied for the application.

23.The main thrust of Mr Vale's claim appears to be based on a no intention to use. Although the extent of Mr Qi's evidence is limited he has countered this in part by showing that he has listings on Amazon UK's website for clothing which for some of the goods show that they are being offered for sale under the mark 'Aomednx'. This goes to some extent to show an intention to use the mark. Whilst the evidence is not extensive it does show some sales having taken place. It is clear, therefore, that the 'no intention to use' claim is unfounded.

24.There has been no evidence filed by Mr Vale that Mr Qi has attempted to hijack his trade mark as alleged. I remind myself that an allegation of bad faith must be distinctly proved and, in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith.[4]

25.There is no evidence before me to suggest that Mr Qi was not pursuing a legitimate purpose or that he was attempting to hijack Mr Vale's listing on Amazon. The pleadings are very scant and vague with nothing more than bare assertions without anything concrete to support his contention.

26. The filing of the '762 trade mark appears entirely consistent with Mr Qi wishing to apply to protect the trade mark that he was operating in this jurisdiction. The burden of proving bad faith is on Mr Vale, and, in my view, he has failed to discharge that burden. I have nothing before me to suggest any dishonest behaviour on Mr Qi's part. Other than the allegation that Mr Qi has not promoted his brand or registered it on Amazon no further argument was put forward to suggest that he was not intending to

[4] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

commercially exploit his goods under the mark in the UK. I am not satisfied that a prima facie case of bad faith has been established, that requires rebuttal from Mr Qi.

27. As a result the opposition under section 3(6) fails.

Section 5(2)(a)

28. Section 5(2)(a) of the Act states as follows:

> "5(2) A trade mark shall not be registered if because-
>
> > (a) it is identical with an earlier trade mark and is to be registered for goods or services 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."
> >
> > […]

29. Section 5A of the Act is as follows:

> "5A 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."

Case law

30. 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 might 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

31. Both parties' specifications include the term *bath robes;* they are self-evidently identical and as such it is unnecessary to undertake any further comparison as against Mr Qi's remaining goods.

Average consumer and the purchasing process

32. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods/services in question.[5]

33. 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 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

34. Overall, I consider that the contested goods will be directed at members of the general public, who predominantly select the goods via visual means by inspection from rails or shelves of retail premises or their online equivalents. Aural considerations may also play a part, where requests/enquiries are made to sales assistants for

[5] *Lloyd Schuhfabrik Meyer*, case c- 342/97.

example.[6] Whilst accounting for variations in price, overall, the goods are neither particularly expensive nor infrequent purchases, with considerations such as price, quality and suitability/fit taken into account in the selection process. For these reasons, I consider that an average degree of attention will be undertaken in the purchasing process i.e. no higher or lower than the norm for such goods.

Identity of the marks

35. 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."

36. Both marks consist of the same word 'Aomednx', absent any stylisation. They are clearly identical, visually and aurally. Being invented words, neither mark gives rise to any clear concept and therefore they will be conceptually neutral.

Distinctiveness of the earlier mark

37. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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

[6] *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03

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)."

38. Trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods on offer, which may hold only a low degree of inherent distinctive character, to those with high inherent distinctive character such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

39. The earlier '762 mark is an invented word and therefore is inherently distinctive to a high degree. While Mr Qi has filed evidence he has not claimed any enhanced distinctive character. In any event, his evidence is very scant and does not provide sufficient detail, such as the market share held, the intensity and extent of use, sales figures and promotional activity, to support a claim that his mark has been enhanced though use. The sales referred to on the Amazon website are extremely modest taking into account the size of the clothing market. Whilst I am not privy to the market share of 'bath robes' specifically, without any specific evidence to the contrary, the sales shown of approximately 800 units since 2019 are insufficient by themselves without any further evidence, to support any claim to enhanced distinctive character.

Likelihood of confusion

40. When considering whether there is a likelihood of confusion between the marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion; where the consumer recognises that the marks are not the same but, nevertheless, puts the similarities between the marks and the respective goods down to the same or related source.

41. A number of factors must also be borne in mind when undertaking the assessment of confusion. 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 vice versa. It is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods of one undertaking from another. In doing so, I must consider 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.

42. I remind myself that I found the respective marks to be identical, visually and aurally, with the concepts being neutral. The respective goods were identical. I found that the average consumer is a member of the public paying an average degree of attention in the purchasing process, predominantly using visual means but not discounting aural considerations. I found the earlier mark to be inherently distinctive to a high degree being an invented word.

43. Given these global factors and bearing in mind the identity of the marks, the earlier mark's high distinctive character and the identity of the goods I consider that there is a likelihood of the respective marks being directly confused one for the other.

44. The opposition under section 5(2)(a) succeeds.

Overall conclusion

45. The action under section 3(6) fails and the trade mark numbered 3658762 shall proceed to registration.

46. The opposition under section 5(2)(a) succeeds and the trade mark numbered 3663777 shall be refused registration.

Costs

47. Mr Qi has been successful and is entitled to a contribution towards his costs based upon the scale published in Tribunal Practice Notice 2/2016 ("TPN"). A great deal of time, however, was spent by the respective parties correcting mistakes in their pleaded forms and getting them into the correct format. I also note that whilst Mr Qi filed evidence it was only one page in length and was accompanied by a limited number of screenshots easily accessible and printable from Amazon. I also note that Mr Vale did not file evidence. Taking these matters into account, I consider it appropriate to depart from the scale and award costs on the following basis:

Preparing and considering the notice of opposition and preparing a counterstatement and statement of grounds:	£300
Preparing evidence:	£300
Official fee:	£100
Total	**£600**

48. I order Mr Paul Vale to pay Mr Yongjian Qi the sum of £600 as a contribution towards his costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 3rd day of June 2024

Leisa Davies

For the Registrar