

O/0533/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3854442  
IN THE NAME OF KAMI DE-LIS LTD  
TO REGISTER THE FOLLOWING TRADE MARK:

**kami de-lis**

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 439987  
BY CAMI NYC, INC.

## Background and pleadings

1. Kami de-lis LTD (“the applicant”) applied to register the trade mark **kami de-lis** (“the applicant’s mark”) in the UK on 29 November 2022, under number 3854442. It was accepted and published in the Trade Marks Journal on 30 December 2022 in respect of the following goods:

*Class 25: Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Furs [clothing]; Clothes; Shorts [clothing]; Denims [clothing]; Hoods [clothing]; Woolen clothing; Gloves as clothing; Gloves [clothing]; Jerseys [clothing]; Cashmere clothing; Clothing of leather; Leather clothing; Leather (Clothing of -); Knitted clothing; Windproof clothing; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Ready-made clothing; Bottoms [clothing]; Clothing for children; Tops [clothing]; Men's clothing.*

2. CAMI NYC, Inc. (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its UK trade mark number 3265508, which is a series of two marks, **Cami NYC** and **CamiNYC**. Since the marks in the series only differ in the space between Cami and NYC, for ease of reference I will refer to them as “the opponent’s mark” unless it becomes necessary for me to distinguish between them. The opponent’s mark was filed on 23 October 2017 and became registered on 16 February 2018. It stands registered for the following goods, all of which are relied upon by the opponent:

*Class 25: Clothing, footwear, headgear.*

3. As the filing date of the opponent’s mark is earlier than the filing date of the applicant’s mark, the opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act. However, as it has not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods identified without having to establish genuine use.

4. In its statement of grounds, the opponent argues that its goods are identical or highly similar to the applicant’s goods, and that the competing marks are similar due to their

dominant and distinctive elements being aurally identical and visually similar. On this basis, it submits that there is a likelihood of confusion, which includes the likelihood of association.

5. The applicant filed a counterstatement denying the ground of opposition.

6. The opponent is professionally represented by Meissner Bolte (UK) Limited and the applicant is represented by Victorious Egbu. Only the opponent filed evidence in these proceedings. No hearing was requested. Only the opponent filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

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 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.

### **Evidence**

8. The opponent's evidence consists of the witness statement of Alexander Pickles, dated 11 June 2024, and two exhibits (AJP1-AJP2). Mr Pickles is a Chartered Trade Mark Attorney with the opponent's representatives. He gives evidence on the meanings of "NYC" and "de-lis". I have taken the evidence into account in reaching my decision and will refer to it below where necessary.

### **Section 5(2)(b)**

9. 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".

10. Section 5A states: [...] “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.”

11. I am guided by the following principles which 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.

#### *The principles*

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

12. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 fur 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.”

13. The goods to be compared are shown in the table below:

The opponent's goods	The applicant's goods
<u>Class 25: Clothing, footwear, headgear</u>	<u>Class 25: Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Furs [clothing]; Clothes; Shorts [clothing]; Denims [clothing]; Hoods [clothing]; Woolen clothing; Gloves as clothing; Gloves [clothing]; Jerseys [clothing]; Cashmere clothing; Clothing of leather; Leather clothing; Leather (Clothing of -); Knitted clothing; Windproof clothing; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Ready-made clothing; Bottoms [clothing]; Clothing for children; Tops [clothing]; Men's clothing.</u>

14. In its statement of grounds, the opponent argues that the goods are identical or, in the alternative, similar to a high degree to the opponent's *clothing, footwear, headgear* in class 25. In its defence, the applicant has not specifically commented on the similarity of the goods. Arguably, the applicant's silence is tantamount to a tacit acceptance of the opponent's pleaded position. However, it is not necessary for me to determine that point as I agree with the opponent that the goods are identical. The applicant's term *clothing* is identical to the opponent's term *clothing* on a literal basis. It is my view that the opponent's wider term *clothing* incorporates the applicant's remaining goods, which are all types of clothing. I therefore I find that the applicant's narrower clothing goods are identical to the opponent's broader term *clothing* under the principle in *Meric*.

15. Whilst I have considered the opponent's arguments in relation to *footwear* and *headgear*, neither of these puts the opponent in a more favourable position than outlined above.

## **Average consumer and the purchasing act**

16. 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 in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

17. 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 then was) 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.”

18. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased on a reasonably frequent basis. Several factors may influence the average consumer when purchasing the goods, such as, inter alia, the type of material, the quality, and the aesthetic appearance. I therefore consider that that the average consumer will pay a medium level of attention when selecting the goods.

19. The goods are likely to be self-selected from shelves within retail outlets, via online retailers, or in catalogues. 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.”

20. Visual considerations are therefore likely to be the primary factor when purchasing the goods. However, I do not discount the role that aural selection may play when purchasing, such as through word-of-mouth recommendations or when placing telephone orders.

### **Comparison of marks**

21. 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 Court of Justice of the European Union (“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.”

22. 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.

23. The respective trade marks are shown below:

<b>The opponent's marks</b>	<b>The applicant's mark</b>
Cami NYC	kami de-lis
CamiNYC	

24. In its written submissions, the opponent submits that 'Cami' is the dominant and distinctive element within its mark, and 'kami' is the dominant and distinctive element within the applicant's mark. In the witness statement, the opponent argues that "the comparison of the marks should be between CAMI v KAMI". It argues this on the basis that "the average consumer will be accustomed to non-identifiers such as "NYC" being user in the context of the goods", and that consumers are "accustomed to the use of foreign language words such as "de lis" being used in the context of "fashion" items and is liable to attribute them only with secondary importance".

25. The opponent's mark is a plain word mark with the first word 'Cami' written in title case and the second word 'NYC' written in uppercase, with the only difference between the two marks in the series being that the first has a space between the words and the second does not. The space between the words makes no impact on the overall impressions, since both "Cami" and "NYC" are recognisable and will be identified in both marks. The Cambridge Dictionary defines "cami" as "a light piece of clothing that covers the top part of the body, with thin straps that go over the shoulders, usually worn by women under other clothes". The word "Cami" in the opponent's mark would be understood as designating the type of goods either where "cami" directly describes them, or for categories of clothing goods which may include camis (such as women's clothing or tops). Where the term "cami" does not directly describe the goods, it remains allusive of other clothing goods. The second term "NYC" would be understood as an abbreviation for "New York City", as per the dictionary definition provided in AJP1 (which is consistent with my own understanding of the term). I agree with the opponent that the element "NYC" is not distinctive when used in relation to clothing, as it may be viewed as designating the place of manufacture or where the company is based. On this basis, I do not consider either word to be more dominant in the overall impression than the other when used in relation to clothing goods for which the word "cami" is directly descriptive. Instead, it is my view that both words provide an equal contribution to the overall impression of the opponent's mark for these types of clothing goods. However, for other types of clothing for which the word "cami" is only allusive, the word "cami" will make a slightly greater contribution to the mark's overall impression than the term "NYC".

26. The applicant's mark is a plain word mark with the first word "kami" and the second hyphenated term "de-lis" both written in lower case. It is considered that the word 'kami' has no obvious meaning in English, and is likely to be seen as an invented word. I accept that some consumers will be aware of the term "fleur-de-lis" which, as the opponent's evidence in Exhibit AJP2 shows, is a term imported from French and refers to a type of heraldic symbol. This translation from vocabulary.com provided by the opponent is consistent with my own understanding and with the definition in the Cambridge Dictionary. However, it is considered that the average consumer would not be able to translate the French words 'de-lis' in isolation from the complete French phrase 'fleur-de-lis'. This is because, unlike 'fleur-de-lis', the latter part 'de-lis' on its own has no specific meaning in English. Whilst I accept that there will be a number of individuals in the UK who speak/understand French, these speakers will not constitute a significant portion of average consumers within the UK. Moreover, whilst French is considered one of the more commonly understood European languages, the term 'de-lis' is unlikely to be a term that UK consumers would be familiar with, such as 'bonjour'. In addition to this, whilst some consumers may know that the term 'fleur-de-lis' is the name of a symbol, they may not know the exact meaning of the term. On this basis, it is my view that the average consumer would view 'kami de-lis' in totality as being formed of elements which are either non-English or invented words. Consequently, the overall impression is not dominated by either 'kami' or 'de-lis'. Furthermore, there is no evidence to support the opponent's argument that consumers are accustomed to seeing words such as "de-lis" on fashion items and that they would view them as having secondary importance. I therefore disagree with the opponent that 'kami' is the (only) distinctive and dominant element within the applicant's mark, and instead I find that both 'kami' and 'de-lis' contribute to the applicant's mark's overall impression equally.

#### Visual comparison

27. The opponent argues that the marks are visually similar as they both contain the same three letters "AMI". Although the opponent acknowledges that the applicant's mark has a "K" rather than a "C" as the first letter, it argues that this is "liable to go unnoticed by the average consumer "as the letters "K" and "C" are regularly transposed in the marketplace". The opponent also submits that "the first word element

of a mark generally catches the consumer's attention" and cites *Trubion*, Case T-412/08, in support of this. The applicant argues that a "substantial dissimilarity exists between the majority of the characters in both trade marks, resulting in distinctly different looks".

28. The competing marks are similar as they both contain the letters "AMI" as their second, third, and fourth letters in the first word of each mark. In the opponent's mark, the first element "Cami" is written in title case then the second element "NYC" is written in uppercase. The applicant's mark is all written in lowercase. However, in *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, the GC held at [39] that word-only marks protect the word or words contained in the mark in whatever case, colour or typeface. The difference in case between the opponent's marks and the applicant's mark is therefore not significant.

29. They differ as the C in the opponent's mark is a K in the applicant's mark. The opponent's marks also have "NYC" following "Cami", whereas "Kami" in the applicant's mark is followed by "de-lis". Whilst the opponent has argued that "the letters "K" and "C" are regularly transposed in the marketplace", it has not submitted any evidence to demonstrate this. Furthermore, the cited case *Trubion* states at [40] that "consumers generally pay greater attention to the beginning of a word sign than to the end". As the difference of the "C" and "K" in the competing marks is at the very first part of the first word, the initial visual difference between the "C" and "K" will have a greater impact and therefore is more likely to be noticed. Taking into account my previous finding in relation to the competing marks' overall impressions, it is my view that the marks are visually similar to a low degree when the word "cami" is descriptive in relation to the clothing goods, or a low to medium degree when "cami" does not directly describe the clothing goods.

#### Aural comparison

30. The opponent argues that the marks are highly similar due to the same pronunciation of "C" and "K" followed by the same letters "AMI". It submits that the competing marks are therefore "phonetically identical in terms of their notional dominant and distinctive characteristics".

31. The opponent's mark will be pronounced as five syllables, namely "Cam-ee N-Y-C", whereas the applicant's mark will be pronounced as four syllables, namely "cam-ee duh liss". Although a number of individuals in the UK may pronounce it as "duh lee", they will not constitute a significant proportion of consumers because it is my view that the average consumer would not see "de-lis" as being from the total term "fleur-de-lis" or know necessarily that it is French, or how it is pronounced in French. The competing marks are therefore similar as the first two syllables are identical. The competing marks are different as the opponent's mark is slightly longer than the applicant's mark, and the syllables beyond the first two within the competing marks are phonetically different. Taking into account my earlier finding in relation to the marks' overall impressions, it is my view that the marks are aurally similar to a medium degree where the word "cami" is directly descriptive, and a medium to high degree where it is not.

#### Conceptual comparison

32. In its written submissions, the opponent argues that the marks as a whole have no meaning in the English language and therefore the conceptual assessment is irrelevant.

33. As stated earlier, the word "Cami" is a type of clothing as per its dictionary definition. Exhibit AJP1 filed by the opponent shows a screenshot of the Collins English Dictionary, which shows "NYC" to be the dictionary-defined initialism for "New York City". It is therefore my view that the opponent's mark will be perceived as being a combination of the descriptive/allusive word "Cami" and a reference to New York City. Although there may be some clothing goods at issue which are not described by the word "cami", it is my view that the conceptual meaning of "cami" remains the same. This is on the basis that whilst "cami" may not describe them, the average consumer of clothing is aware of what a "cami" is and would still understand the term as referring to that type of clothing. I disagree with the opponent that the conceptual assessment is irrelevant, because the average consumer will extrapolate the two separate conceptual meanings of "Cami" and "NYC" from the mark.

34. The applicant's mark contains the words "kami" and "de-lis". Exhibit AJP2 filed by the opponent shows a screenshot of vocabulary.com, which states that "fleur-de-lis" is a symbol commonly used as decoration. The Oxford English Dictionary suggests that

“Kami” is a dictionary-defined term relating to the Japanese Shinto religion, although it is unlikely that the average consumer of clothing would be aware of this meaning given that Shinto does not have a widespread following in the UK. To the best of my knowledge, Kami is also a female name, although I recognise that this is unlikely to be known by a significant proportion of average consumers. As stated above, it is my view that the average consumer is unlikely to understand “de-lis”, particularly when it is used separately from the phrase “fleur-de-lis”. It is considered that the average consumer will instead view the two elements “kami” and “de-lis” as being invented or non-English words. As such, the average consumer is unlikely to assign a meaning to the mark as a whole and therefore the applicant’s mark is conceptually neutral. Insofar as the marks convey any concept, they are conceptually dissimilar.

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

35. 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).”

36. Registered trade marks possess various 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.

37. Although the distinctiveness of a mark can be enhanced through use on the market, the opponent has filed no evidence of use. As such, I have only the inherent position to consider.

38. In its submissions, the opponent argues that “Cami” is the distinctive element of the opponent’s mark, whereas it submits that “the use of a geographical indication such as “NYC” is unlikely to have ‘trade mark’ significance”.

39. As stated earlier, the word “Cami” is a dictionary-defined term for a type of clothing, so this word would designate the type of goods when used in relation to a cami, or clothing categories which are narrower than the opponent’s wide term *clothing* (such as *women’s clothing, tops* etc.) but encompass camis. The word “cami” would also be allusive of other clothing items. “NYC” is an abbreviation for “New York City”. It would be perceived either as a descriptive geographic reference such as the place of manufacture or where the company is based. It is my view that the impact of these two descriptive or allusive (where “cami” cannot be said to describe the goods directly) words is the same as when the words are interpreted separately. In *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU found that:

“41. ....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is

filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

40. As the opponent’s mark is not subject to counter cancellation proceedings, its validity is not in issue in these proceedings and it cannot be said to have no distinctive character, even when used in relation to clothing goods which are described by the word “cami”. I therefore find that the opponent’s mark has a very low level of distinctiveness in relation to these types of clothing goods.

41. However, I have also identified that there are some types of clothing for which “cami” is not directly descriptive. For these types of goods, the word “cami” may still evoke the idea of a cami as a type of clothing, but may be deemed by the average consumer to be slightly more fanciful in relation to them. For these types of clothing goods, I find that the earlier mark has a low to medium level of distinctiveness.

### **Global assessment – conclusions on the likelihood of confusion**

42. 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 set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

43. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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.

44. The opponent submits that there is a likelihood of confusion, particularly because "the high degree of visual and aural similarity offsets the low degree of conceptual similarity".

45. The applicant submits that there are a number of trade marks in class 25, such as UK00003511857 'KAMI' and UK00918279085 'Camey Liu', which it claims are similar and registered after the opponent's trade mark. On the basis of the existence of these other marks, it argues that it should not be prevented from registering its mark. At paragraph 73 of *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

"As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71). "

46. As there is no evidence that the registered marks are in use or that consumers have become accustomed to differentiating between them, they cannot have any

bearing on whether there exists a likelihood of confusion between the opponent's mark and the applicant's mark. Moreover, the mere fact that the other marks are on the register cannot be taken as evidence per se that they are peacefully coexisting.

47. Earlier in this decision I found that the applicant's goods are identical to the opponent's goods. The average consumer will be a member of the general public. The average consumer will pay a medium degree of attention when purchasing the goods. The goods will primarily be selected through visual means, although I do not discount an aural element to the selection process. I have found the marks to be visually similar to a low degree and aurally similar to a medium degree for clothing goods where the term "cami" is descriptive. For other clothing goods, the marks are visually similar to a low to medium degree and aurally similar to a medium to high degree. Insofar as the marks convey any concept, they are conceptually dissimilar. The opponent's mark is a word-only mark, and both "Cami" and "NYC" play roughly equal roles in its overall impression, though where the word "Cami" is not directly descriptive it has slightly more impact. The applicant's mark is also a word-only mark, and "kami" and "de-lis" contribute equally to the applicant's mark's overall impression. The opponent's mark has a very low level of inherent distinctive character for goods which can be described as camis, but a low to medium level for the other clothing goods.

48. It is considered that the average consumer, when paying a medium degree of attention, would not overlook the points of difference between the competing marks. Although the competing marks share the letters "ami" at their beginnings, there are visual, aural, and conceptual differences between the marks which will not go unnoticed by the average consumer. The very first letters of the competing marks and their respective second words are entirely different. The second words contribute to the overall impressions of the marks (an equal amount in some circumstances) and are not likely to be entirely overlooked. This is particularly the case, given that the opponent's mark possesses a low to medium level of distinctive character, at best. I therefore find that there is no likelihood of direct confusion, notwithstanding the identical nature of the goods.

49. This leaves indirect confusion to be considered. 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 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).”

50. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

51. It is not sufficient that a mark merely calls to mind another mark (as per *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17). This is mere association not indirect confusion. A finding of indirect confusion should not be made merely due to a shared element within marks. As per *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 (set out above), indirect confusion should be identified in cases where the average consumer is likely to notice the differences between the competing marks but assume an economic link between the two undertakings based on their similarities.

52. It is my view that the average consumer, paying a medium level of attention, would notice the differences between the marks but would not assume an economic link between the two undertakings. This is on the basis that the word ‘Cami’ is a dictionary-defined word which is descriptive or allusive in relation to clothing, so it cannot be described as so strikingly distinctive that the average consumer would assume that only the opponent was using it. Furthermore, the visual, aural, and conceptual differences between the marks are not consistent with a brand extension or sub-brand of a house mark, so I do not consider that it is likely that the average consumer would interpret it in this manner. I see no reason why an undertaking would use a descriptive/allusive word in relation to clothing combined with a specific geographic reference, and then alter the first letter (resulting in a different word) and replace the geographic reference with an invented term, resulting in a completely different mark. Whilst I acknowledge that the categories in *L.A. Sugar* are not exhaustive, I can see no other basis for concluding that the average consumer would perceive the marks to be from the same, or economically linked, undertakings. I therefore find that there is no likelihood of indirect confusion between the competing marks.

## **Final remarks**

53. The opposition under section 5(2)(b) has failed in its entirety. Subject to any successful appeal, the application will proceed to registration.

## **Costs**

54. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I note that, whilst the applicant did not file any evidence of its own, it is likely to have spent time considering the evidence filed by the opponent. However, given how brief the opponent's evidence was and that the relevant part of the scale is for "preparing evidence and considering and commenting on the other side's evidence", I have awarded a below-scale figure for this activity. In the circumstances I award the applicant the sum of £350 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the other side's statement: £250

Considering the opponent's evidence £100

55. I therefore order CAMI NYC, Inc. to pay kami de-lis LTD. the sum of £350. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 16<sup>th</sup> day of June 2025**

**K SERRAVALLE**

**For the Registrar**