O/0843/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3988649

IN THE NAME OF TAIZHOU LANCHOU GARMENT CO., LTD

TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 3, 9, 18, 25, 28 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 445987

BY

BUNSHA

Background and pleadings

1. Taizhou Lanchou Garment Co., Ltd. (“the applicant”) applied to register the trade mark as produced on the cover page of this decision in the UK on 7 December 2023 (UK Trade Mark (UKTM) No: UK00003988649). It was accepted and published in the Trade Marks Journal on 22 December 2023 in respect of the following goods/services:

Class 3 — After sun creams; Baby suncreams; SPF sun block sprays; Waterproof sunscreen; Eau de parfum; Make-up removing preparations; Bathing lotions; Body deodorants [perfumery]; Cleansers for intimate personal hygiene purposes, non medicated; Cosmetic masks; Depilatory creams; Facial washes; Hair gels; Self tanning preparations.

Class 9 — Eye glasses; Sun glasses; 3D eye glasses; Eyeglass lanyards; Swim goggles; Clips for divers and swimmers (Nose -); Safety life jackets; Life buoys; Headgear for protection against accident; Boxes [cases] for glasses; Diving equipment; Divers' goggles; Diving suits.

Class 18 — Beach parasols; Beach umbrellas; Umbrellas; Beach bags; Waterproof bags; Traveling bags; Traveling sets; Backpacks for carrying babies; Cosmetic purses; Garment bags.

Class 25 — Athletic clothing; Yoga tops; Childrens' clothing; Beach clothing; Baselayer bottoms; Clothing; Swimwear; Clothing for gymnastics; Swim caps; Water-resistant clothing; Beach wraps; Sandals and beach shoes; Bikinis; Aloha shirts; Footwear; Bonnets; Sports pants; Swim trunks; Yoga bottoms.

Class 28 — Kites; Pool bumpers; Water toys; Sportballs; Sports training apparatus; Toys for use in swimming pools; Flippers for swimming; Swim rings; Swimming gloves; Inflatable swimming pools for recreational use [toys]; Swimming webs [flippers]; Swimming floats for recreational use; Surf boards; Sand toys; Beach balls.

Class 35 — Advertising; Advertisement and publicity services by television, radio, mail; Advertising services relating to clothing; Preparing promotional and

merchandising material for others; Advertising and marketing services provided by means of social media; Export-import agency services; Consultancy relating to the selection of personnel; Business management of resort hotels; Display services for merchandise; Merchandising.

2. On 22 February 2024, BUNSHA ("the opponent") opposed 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 earlier UK Trade Mark: KIABI (UKTM No: UK00918190483), which was filed on 30 January 2020 and registered on 7 July 2020.[1] The goods and services relied upon are set out in Annex 1 to this decision.

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 that the contested mark should be refused registration.

4. The applicant filed a counterstatement denying the claims made. I will refer to their submissions throughout my decision as and when appropriate.

5. In accordance with section 6 of the Act, the mark relied upon by the opponent is considered an earlier mark. The earlier 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/services of its registration as claimed.

Representation

6. The opponent is represented by Stobbs. The applicant is represented by Pablo Albert Catala. No evidence was filed in these proceedings. Neither party requested a hearing, but the opponent filed written submissions in lieu dated 31 October 2024. These submissions will not be summarised but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

[1] A seniority date of 15 October 2009 is claimed.

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 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.

Decision

Section 5(2)(b)

8. 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".

9. 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

10. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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

C120/04, *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

11. The goods and services in issue can be found in paragraph 1 and Annex 1 of this decision. I undertake my comparison below.

12. The opponent submits “the goods and services relied upon in the opposition and those contained in the IABI Application are identical or in the alternative highly similar.” They have also made specific submissions regarding the goods/services in each class, which I will refer to where appropriate.

13. The applicant has not made any specific submissions regarding the similarity of the goods/services save to say that “because it has been demonstrated that there is no similarity between the trademarks in conflict from the phonetic, visual and conceptual perspectives, the necessary double identity or similarity is not met. Therefore, there would be no risk of confusion or association regardless of whether the trademarks coincide in classes 3, 9, 18, 25, 28 and 35. Thus, the mark should not only [sic] be granted for all classes applied for”.

14. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

"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."

16. 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.

17. 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 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."

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the General Court stated that "complementary" means:

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

19. In *Sanco SA v OHIM,* Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the

goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

> ".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

20. I bear in mind that it is permissible to group goods together for the purposes of the assessment[2].

Class 3

After sun creams; Baby suncreams; SPF sun block sprays; Waterproof sunscreen;

21. The opponent submits:

> "The Applicant's "After sun creams; Baby suncreams; SPF sun block sprays; Waterproof sunscreen" are highly similar to the Opponent's class 3 goods "Cosmetics;" in the Earlier Mark. These are all goods which used [sic] to improve, protect or preserve one's appearance. Therefore, whilst the physical nature of the goods differs, the users are the same as are the intended purpose and method of use. The goods are also sold in close proximity to one another in supermarkets and department stores. This finding was made by the Hearing Officer in *ELLEY Trade Mark*, BL O-784-19, at [58] and the Opponent submits that Hearing Office [sic] should take the same approach to the facts of this case"

While offering protection from the sun, sun-protecting preparations can be defined as a cosmetic and can, therefore, still have beautification qualities such as those that

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

contain bronzing ingredients. As such, I find that the above term is identical under the principle outlined in *Meric* with the opponent's *cosmetics*. However, if I am wrong about that, then I find that they are still similar. I agree with the opponent's submissions that the applicant's terms include goods which are used to preserve or protect one's appearance as well as providing sun protection, and therefore I find that they overlap in purpose with the opponent's term. Further, even if that is not the case, the goods may move via the same trade channels and be sold in the same or similar establishments, though not necessarily on the same shelves. The goods are not complementary, nor do I consider them competitive. There may be an overlap in method of use (with both goods being applied to the skin) and there may be an overlap in nature (where both goods take the form of a liquid). The user of the goods would overlap. I therefore find the goods to be similar to a medium degree.

Eau de parfum; Body deodorants [perfumery];

22. The opponent submits that the "Applicant's "Eau de parfum; body deodorants [perfumery]…" are identical to the Opponent's "Perfumery; Cosmetic kits; Cosmetics" in class 3 of the Earlier Mark". I bear in mind paragraph 34 of *Biologische Heilmittel Heel GMBH v BESTWAY PANACEA HOLDINGS LIMITED, 'DERMAWELL*[3] which sets out that the "ordinary meaning of perfumery would be a scent applied to the body, hair, or to a product or room to emit an aroma" which I consider applies to the applicant's terms. I note that the opponent's specification includes the term *"perfumery"* which I consider is a broad term which encompasses the applicant's above terms. I therefore find these to be identical on the principles outlined in *Meric.*

Make-up removing preparations; Depilatory creams; Cosmetic masks; Hair gels; Self tanning preparations.

23. The opponent submits that the above goods:

> "Are identical or in the alternative, highly similar to the Opponent's class 3 "Cosmetic kits; Cosmetics; Cotton buds, and cotton used for cosmetic purposes; Tissues impregnated with cosmetic lotions" and class 35 "Online retailing of cosmetic, beauty and make-up preparations" in the Earlier Mark.

[3] O-753-18

> The contested goods are used for either personal hygiene, enhancing or protecting the appearance of the hair and body or body cleaning preparations, and the same can be said for Opponent's cosmetic and beauty care preparations covered by the Earlier Mark, and they are aimed at the face or body. The goods are distributed through the same channels of trade which may be found in relatively close proximity in a supermarket or retail outlet, and there is an overlap in end users. Furthermore, the goods under comparison could coincide in further relevant criteria such as nature, purpose, method of use or complementarity."

Cosmetics are substances that you put on your face or body that are intended to improve your appearance[4]. I consider that the applicant's goods are all types of cosmetic products. The opponent's specification includes the term *Cosmetics* which is a broad term which I consider encompasses all of the additional aforementioned goods on the principles outlined in *Meric*. They are identical. If I am wrong in that finding, there will be an overlap in nature, method of use, user and trade channels resulting in at least a medium degree of similarity.

Bathing lotions; Cleansers for intimate personal hygiene purposes, non medicated; Facial washes;

24. The applicant's goods are all products which are used to wash your face and body. I would consider these to be types of toiletries, which can serve several purposes from cleaning to enhancing personal appearance. The opponent's goods include *soaps*, which are "a substance used for washing the body or other things"[5] and can take the form of both a bar and liquid. I consider that the aforementioned goods can be considered as different types of soap and are therefore identical to the applicant's terms on the principles outlined in *Meric*. If I am wrong about that, I consider that the products overlap in nature, purpose, end user and channels of trade, and would appear side by side, or in close proximity to each other, in stores. They would also be in competition, given their overlapping purpose. I do not find complementarity. I therefore find the goods to be similar to a high degree.

[4] COSMETIC | English meaning - Cambridge Dictionary
[5] SOAP | English meaning - Cambridge Dictionary

Class 9

Eye glasses; swim goggles; boxes [cases] for glasses; divers' goggles;

25. The opponent submits that "The Applicant's "Eye glasses; sun glasses; 3D eye glasses; Swim goggles; boxes [cases] for glasses; divers' goggles" are identical to the Opponent's class 9 "Spectacles [optics]; Cases for spectacles and sunglasses; Swim goggles; Diving goggles; Sports glasses" of the Earlier Mark". I agree with the opponent's submissions in respect of the applicant's above terms and consider that the same are self-evidently identical to the opponent's terms as set out in their submissions.

Sun glasses;

26. The opponent submissions regarding these goods are set out above. I consider that sunglasses are a form of protective eyewear designed to prevent the eyes from being damaged in bright light. I do not consider that these are identical to the opponent's 'spectacles', as spectacles are usually worn to correct eyesight, although they can be worn without prescription lenses as a fashion accessory, whereas sunglasses are worn to protect the eyes from sunlight and therefore have a different purpose. However, both eye glasses and sunglasses are used in the same way, i.e. with a pair of lenses set into a frame which is worn by resting on the nose and ears. The method of use is, therefore, the same and the nature overlaps. I consider that the goods may be sold through the same trade channels, as it is foreseeable that both eye glasses and sunglasses may both be sold in the same store, for example, an opticians. I do not consider that there will be competition as the goods will have different purposes. The user is the same. I therefore consider that there is a high degree of similarity between the goods.

3D eye glasses;

27. In the absence of submissions, I consider that 3D glasses are a special type of eyewear designed to create the illusion of depth and three-dimensional images from two-dimensional images. They are used in conjunction with 3D-enabled devices such as TVs, projectors, and computer monitors to provide an immersive viewing

experience. I consider that their purpose is specific, and this is different to the terms in the opponent's specification, such as *Spectacles [optics]*. That being said, the goods will be worn in the same way as described above, meaning that the method of use overlaps. 3D eye glasses would normally be sold alongside the technology that they accompany and therefore I consider that trade channels will differ. I do not consider that the goods are in competition, nor are they complementary. The user will, of course, be the same. Whilst I acknowledge some tenuous and extremely limited overlap in the goods, I am conscious of the comments in paragraph 24 of the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese*[6], in which he stipulated that "any finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question" rather than by engaging "in a box-ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied". Therefore, I find that the goods are dissimilar.

Eyeglass lanyards;

28. The opponent submits that:

> "the Applicant's "eyeglass lanyards" is identical or in the alternative highly similar to the Opponent's class 3 "Spectacle frames; Spectacles [optics]; Cases for spectacles and sunglasses" of the Earlier Mark. The contested good are accessories for spectacles and glasses and the same can be said of the Opponent's goods. The goods are therefore distributed through the same channels of trade found in a supermarket or retail outlet, and there is an overlap in end users."

I agree with the opponent that *eyeglass lanyards* are accessories for spectacles and glasses. I consider that the parties' goods can be used in combination with each other. I consider that the goods are complementary, as eyeglass lanyards cannot be used without glasses and therefore one is indispensable and important for the use of the other[7] and I consider that the average consumer would assume that the goods would come from the same undertaking. However, the goods can have the same end user

[6] [1][2024] EWHC 1098 (Ch)
[7] *Everest Dairies Limited v Everest Food Products Private Limited* [23] O/0107/23

and may coincide in distribution channels. The method of use, nature and purpose of the goods differ. I therefore find that these goods are similar to a medium degree.

Clips for divers and swimmers (nose-); diving suits.

29. The opponent submits that the above terms:

> "Would be found similar to the Opponent's class 3 "Swim goggles; Diving goggles; Sports glasses", class 14 "Divers' watches", class 25 "Swimming costumes" of the Earlier Mark. The contested diving equipment and diving suits cover a broader category and includes the earlier diving goggles. The Opponent's earlier goods could be used by users in the practice of diving who at the same time would also use swimming costumes, diver's watches and diving goggles. Therefore, both sets of goods share the same distribution channels and target the same relevant public. Some of them are often produced by the same undertakings and, in addition, some can be complementary."

I consider that clips for divers and swimmers' noses would be used to prevent water entering the nose when diving / swimming. Diving suits would include wetsuits and drysuits which keep the body warm and offer protection. The opponent's specification includes *diving goggles* and *swimming costumes*. I consider that the purpose of the goods would be the same, i.e. to protect oneself from water when taking part in water sports. All of the goods will be worn on the person and therefore the general method of use will be similar, although each of the goods will be used on different parts of the body. Users will be the same (being those who partake in diving), and the goods will likely be sold through the same trade channels. The goods may be used in combination; however, I do not find complementarity. I therefore find the goods to be similar to a medium degree.

Safety life jackets; life buoys;

30. I consider that the above items in the applicant's specification to be safety equipment for those on or near the water. Safety jackets and life buoys are flotation devices and would likely be sold by specialist companies and are likely to be purchased by companies who need to offer them to customers or to individuals with

an interest in water sports. The opponent's specification includes water sports-related goods such as *diving goggles* and *swimming costumes*, but I do not consider these share the same purpose as the safety equipment listed in the applicant's specification. Whilst I accept that the goods may be used in combination, I do not find complementarity as one is not important or indispensable for other, nor would you expect the same undertaking to be responsible for both. I consider that the equipment above will be sold in specialist stores, and although in some circumstances there may be a crossover with the opponent's goods, I believe that this will be at a low level and they will be sold in distinct sections. I therefore find the goods to be dissimilar.

Diving equipment

31. The applicant's term is broad and may encompass a variety of different items including the opponent's *diving goggles*, such as the type used for scuba diving or snorkelling. I therefore find that the applicant's term will encompass the identified terms within the applicant's specification and are therefore identical on the principles outlined in *Meric.*

Headgear for protection against accident;

32. The opponent submits that these goods:

> "Would be found similar to the Opponent's class 3 "Swim goggles; Diving goggles; Sports glasses", class 20 "Baby head support cushions" and class 25 "headgear" of the Earlier Mark because they coincide in distribution channels, relevant public and producers. Some undertakings may produce and sell protective headgear in class 9 as well as ordinary headgear in class 25. There will be some overlap on the basis that a user of the Applicant's class 9 goods will also seek to buy the Opponent's class 25 goods. The Hearing Officer made an identical finding in relation to his finding in relation to the comparison of the Applicant's class 9 "Safety clothing for protection against accidents or injury" and the Opponent's class 25 "headgear" goods in Boss Trade Mark, BL-O-0109-24, at [52]. The Opponent's submits that the Hearing Officer should apply the same reasoning to the goods at issue in the Opposition. Furthermore, protective and safety headgear equipment includes goggles for sporting

activities. For example, ski gear typically encompasses helmets, goggles and boots for skiing. These goods are commonly manufactured under the control of the same entity, they are offered for sale in the same specialised shops or sports departments in stores and satisfy the needs of the same public."

The applicant's term covers protective headgear. I note that the opponent's specification includes the class 25 term *headgear*, which I accept is a wider term and on the face of it, appears to be identical. However, it is my understanding that the goods in class 25 include things such as caps and bobble hats, whereas the opponent's specification in class 9 includes protective headgear which I understand would include items such as protective helmets for sports[8]. Therefore, whilst the method of use of the goods will be the same, i.e. to be worn on the head, the purpose of the goods will be different. The nature is also likely to differ as they are likely to be made of different materials (with the class 9 goods made of materials with protective qualities). I accept that there may be some overlap in user. I do not consider that trade channels are likely to overlap, and I do not find complementarity. I therefore find the terms to be similar to a low degree. I do not consider that any of the other terms in the opponent's specification puts it in a stronger position.

Class 18

Beach bags; Traveling bags;

33. The opponent submits that: "The Applicant's "beach bags; backpacks for carrying babies; travelling bags; umbrellas; beach umbrellas; Beach parasols; cosmetic purposes" are identical to the Opponent's class 18 "Beach bags; Backpacks; Travelling bags; Umbrella; Purses" of the Earlier Mark as these are broad terms which encompass the contested goods." I consider that the terms *beach bags* and *travelling bags* are self-evidently identical.

Backpacks for carrying babies;

34. The opponent's specification includes the term *backpacks* which is a wide term that I consider will include a multitude of backpacks/rucksacks which are used for the

[8] In accordance with the explanatory notes accompanying the nice classification system

purpose of carrying a person's belongings on their back. I note that the applicant's term includes *backpacks for carrying babies*, which I consider to be a child carrier in the form of a rucksack. I consider that the opponent's term is a wider term which could encompass all forms of backpack and therefore I find the terms to be identical on the principles outlined in *Meric*. If I am wrong about that, I consider that the purpose of the goods may overlap at a very general level, as is the nature (likely to be made of the same materials and take similar forms) and method of use (because they will be used in much the same way). There may be some overlap in trade channels as it is foreseeable that a specialist hiking store may stock various types of backpacks, however, I do not find competition as backpacks for carrying babies have a distinct use and would not be chosen by someone who is looking to purchase a more general hiking backpack. I find the goods to be similar to a medium degree.

Cosmetic purses;

35. In the absence of submissions to the contrary, I consider a *cosmetic purse* to be a type of makeup bag. The opponent submits that this is identical to their term *purses* as per the principles outlined in Meric, as *purses* is a wider term. I agree with this submission, however, if I am wrong about that, a purse would usually be understood to be a small container for money, usually used by a woman. Therefore, whilst the nature of a purse is to carry things, I consider that the specific purpose may be different, with one being to carry money and the other to carry cosmetics. I consider that trade channels and users are unlikely to overlap as a result of this, and there will not be competition. The method of use and nature may overlap. I do not find complementarity. I find the goods to be similar to a medium degree.

Beach parasols; Beach umbrellas; Umbrellas;

I note the opponent's submissions that the above terms are encompassed within their wider term *Umbrella* and are therefore identical as per *Meric.* I consider that the applicant's term *umbrellas* to be self-evidently identical to the opponent's equivalent term, and would also encompass the term *beach umbrellas,* as it is a wider term under the principles outlined in *Meric.* The terms *beach parasol* and beach umbrella are used interchangeably, and I would therefore consider these to be identical to the opponent's term *umbrella* for the same reasons.

Waterproof bags;

36. The opponent submits

> "The Applicant's "waterproof bags; garment bags" are identical or in the alternative highly similar to the Opponent's class 18 "Backpacks; Handbags; Travelling bags; Book bags; Shoulder bags; Souvenir bags; Satchels; Bags for campers; Gym bags; Beach bags; Sport bags; Roll bags; Wheeled shopping bags" of the Earlier Mark. The goods all belong to the category of bags and therefore coincide in end use, distribution channels, method of use and target the same relevant public."

I understand that *waterproof bags* in the applicant's specification are types of bags which will be used to carry a person's possessions and which are made of a waterproof material. In the absence of submissions, I consider that waterproof bags will come in a variety of forms and are made to resist water and keep possessions dry. The opponent's specification includes a number of different types of bags, and I consider that it is foreseeable that terms such as *backpacks, travelling bags, bags for campers, gym bags sport bags* and *roll bags* may all be made from a waterproof fabric to allow the bag additional protection from the elements. The purpose of the items will be the same, as will the uses. I consider that it is foreseeable to waterproof bags may feature in stores alongside items such as backpacks and therefore there will be competition. I find the goods to be similar to a high degree.

Garment bags

37. I understand that *garment bags* in the applicant's specification are types of bags which will be used to carry and protect items of clothing, and that garments are sometimes hung within the bags to prevent the clothing from creasing. The opponent's specification includes a number of different types of bags, as set out above, and that their specification includes *travelling bags*, which may encompass terms such as *garment bags*. As such, I find them to be identical on the principle outlined in *Meric.* If I am wrong in that finding, I find that there will be an overlap in purpose, method of use and nature. Users may overlap, as may trade channels. I find the goods to be similar to a high degree.

Traveling sets;

38. The opponent submits that “the Applicant’s “travelling sets” is identical or in the alternative, highly similar to the Opponent’s class 18 “Travelling bags; Travel cases; Traveling trunks” of the Earlier Mark”. I understand *traveling sets* to be matching sets of luggage in different sizes and styles which would normally be used for travel, such as matching suitcases in different sizes. I note that the opponent’s specifications includes *travelling bags* and *travel cases* which, whilst not a set of luggage, would share the same purpose and use as the goods in the opponent’s specification. I consider that trade channels would overlap, and the goods would be in competition. The nature and method of use is the same. I find the goods to be similar to a high degree.

Class 25

Athletic clothing; Yoga tops; Childrens' clothing; Beach clothing; Baselayer bottoms; Clothing; Swimwear; Clothing for gymnastics; Swim caps; Water-resistant clothing; Beach wraps; Sandals and beach shoes; Bikinis; Aloha shirts; Footwear; Bonnets; Sports pants; Swim trunks; Yoga bottoms.

39. The opponent submits that:

> “The Applicant’s “Athletic clothing; yoga tops; children’s clothing; beach clothing; baselayer bottoms; clothing; swimwear; clothing for gymnastics; swim caps; waterresistant clothing; beach wraps; sandals and beach shoes; bikinis; aloha shirts; footwear; bonnets; sports pants; swim trunks; yoga bottoms” are identical to the Opponent’s class 25 “Clothing; Footwear; Headgear” as these represent the broad terms within which the Applicant’s contested goods are included.”

I agree with the opponent’s submissions and find that the opponent’s terms *Clothing; Footwear;* and *Headgear* are broad terms which encompass the various types of clothing, footwear and headgear included in the applicant’s specification. I therefore find the terms to be identical on the principles outlined in *Meric*.

Class 28

40. The opponent makes the following submissions regarding the goods in class 28:

> "The Applicant's "Kites; Water toy; Sand toys; Toys for use in swimming pools; inflatable swimming pools for recreational use [toys]; beach balls; sports balls" are identical to the Opponent's class 28 "Toys; Games; Inflatable balls" of the Earlier Mark as these represent the broad terms within which the Applicant's contested goods are included. The Applicant's "pool bumpers; swim rings; swimming floats for recreational use; surf boards; flippers for swimming; swimming gloves; swimming webs [slippers]" are similar to the Opponent's class 9 "swim goggles", class 25 "swimming costumes", class 28 "Gymnastic and sporting articles" in the Earlier Mark because they coincide in purpose, distribution channels, relevant public and are complementary. Undertakings that sell swimming equipment would also produce and sell swimming accessories and articles such as swim goggles in class 9, swimming costumes in class 25 and more broadly sporting articles in class 28. There will be some overlap on the basis that a user of the Applicant's class 28 goods will also seek to buy the Opponent's classes 9, 25 and 28 goods".

Kites; Water toys; Sportballs; Toys for use in swimming pools; Inflatable swimming pools for recreational use [toys]; Sand toys; Beach balls.

41. I agree with the opponent's submissions that *Toys; Games;* and *Inflatable balls* are broad terms which would encompass the applicant's terms above. I therefore find the terms to be identical on the principles outlined in *Meric*.

Pool bumpers; Flippers for swimming; Swim rings; Swimming gloves; Swimming webs [flippers]; Swimming floats for recreational use; Surf boards;

42. The opponent submits that the above are similar to the Opponent's class 9 *swim goggles*, class 25 *swimming costumes*, class 28 *Gymnastic and sporting articles* in the earlier mark. I consider *gymnastics and sporting articles* to be a broad term which will span a number of different sporting activities, including the swimming items listed. I therefore consider that the above terms are identical under the principles outlined in *Meric.* If I am wrong about that, I consider that *Gymnastic and sporting articles* will have a similar purpose as they will all be equipment used to partake in different sports.

The use of the equipment may differ, but the goods will share trade channels and there may be an overlap in users. There is likely to be competition. I therefore find that the goods will be highly similar.

Sports training apparatus;

43. The opponent submits that "the Applicant's "sports training apparatus" is highly similar to the Opponent's class 9 "Sports glasses", class 14 "Sports watches", class 18 "Sport bags" and class 28 "Gymnastic and sporting articles" in the Earlier Mark because they coincide in end user, are complementary and would be sold through the same distribution channels". In the absence of any submissions in regard to what items this would include, I understand sports training apparatus to cover a vast range of equipment used to partake in different sports. I consider this to be a wide term which will encompass a number of items. I do not agree with the opponent's submissions that this will be highly similar to their goods in class 9, 14 or 18 as identified in their submissions, all of which are accessories that a person may use when carrying out a sport, but none of which are essential to partake in sports.

44. I consider that the opponent's *Gymnastic and sporting articles* and the applicant's *Sports training apparatus* are both broad terms which would encompass the same items. I therefore find that the terms are identical on the principles outlined in *Meric.* If I am wrong about that, I consider that there will be an overlap in goods within these terms and that these goods will share the same purpose, nature and user. Trade channels will overlap as the goods are likely to be sold in the same stores and will be in direct competition. I therefore find these goods to be highly similar.

Class 35

Advertising; Advertisement and publicity services by television, radio, mail; Advertising services relating to clothing; Preparing promotional and merchandising material for others; Advertising and marketing services provided by means of social media; Export-import agency services;

45. The opponent submits that:

> "The Applicant's "Advertising; advertisement and publicity services by television, radio, mail; advertising services relating to clothing; preparing promotional and merchandising material for others; advertising and marketing services provided by means of social media; export-import agency services" are either identically covered by (including synonyms), included in, or overlap with, the Opponent's class 35 "Advertising; Import-export agencies; Marketing services" in the Earlier Mark".

I agree with the opponent's submissions in respect of these terms, in that, they are either self-evidently identical or encompassed within the principles outlined in *Meric* with the opponent's terms "*advertising", "import-export agencies"* and *"marketing services".*

Consultancy relating to the selection of personnel;

46. The opponent submits that "these services are identical or at least similar to the Opponent's Advertising; marketing; Rental of advertising space; demonstration of goods; Business management and organization consultancy; office functions". I note that the opponent's specification also includes the term *personnel recruitment*. I consider this to be a wide term which would involve the process of identifying, interviewing, selecting, hiring and onboarding employees. I understand a consultant to be someone who gives specialist advice within their field, in this instance, such as a HR professional. I consider that the opponent's term *personnel recruitment* would encompass the selection of personnel, and therefore the purpose and use would be the same. I consider that there would be overlap in trade channels and the services would be competitive. I find them to be similar to a high degree.

Display services for merchandise; Merchandising

47. The opponent submits that:

> "The Applicant's "Display services for merchandise; merchandising; display services for merchandise…comprise a wide range of services that belong to the market sector of advertising, marketing and promotional services. Therefore, these services are identical or at least similar to the Opponent's

Advertising; marketing; Rental of advertising space; demonstration of goods; Business management and organization consultancy; office functions".

In the absence of submissions to the contrary, I consider that merchandising is a part of marketing and would focus on the presentation and promotion of products. Merchandising also focuses on creating in-store or online displays which are attractive to the consumer and drive sales. I consider that the term *marketing* is broad and would encompass the applicant's terms *display services for merchandise* and *Merchandising* and I therefore find these terms to be identical on the principles outlined in *Meric*.

Business management of resort hotels;

48. The opponent submits that "the Applicant's "business management of resort hotels" falls under the Opponent's broad terms: Business management; Business administration; Business management and organization consultancy covered by the Earlier Mark since they share, at least, the same purpose and can coincide in provider and relevant public". I agree with the opponent's submission and consider the opponent's term *business management* to be a wide term which would encompass *business management of resort hotels* within the principles outlined in *Meric.*

49. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods and services that I have found to be dissimilar will fail[9]. Therefore, the opposition under section 5(2)(b) fails for the following goods and services:

Class 9 3D eye glasses; safety life jackets; life buoys.

Average consumer and the purchasing act

50. It is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which the goods/services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U*

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

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

51. The opponent submits as follows:

> "31. The average consumer of the overlapping goods at hand being cosmetics, eyewear, bags, clothing, footwear and headgear, games and toys will be the general public who would pay no more than a low level of attention when accessing or selecting the goods (eg. Clothing goods in class 25), since these are ordinary consumer goods which do not require a higher level of attention at the point of purchase. Consumers will therefore pay only a low level of attention, at most a medium level when selecting the goods. The goods at issue are ordinary consumer goods and will, therefore, be selected relatively frequently. In terms of cost, this will vary from cheap goods such as socks to more expensive clothing items such as designer leather jackets, for example. Regardless of the price paid, it is generally acceptable (see *This Girl Came Trade Mark* BL O-0572-24 [2024] at [50]) that consumers will give consideration to ordinary factors such as fit, style and materials used. The Opponent submits that the level of attention paid will be mostly medium although this will be lower for more casual purchases such as socks or tee shirts.
>
> 32. The Opponent submits that the average consumer of the overlapping services, namely advertising, marketing and promotional services will be business customers with specific professional knowledge or expertise, as well as the general public and therefore would pay no more than a medium to low level of attention when accessing or selecting the services. This level of

attention by the average consumer was found by the Hearing Officer in HEPSY Trade Mark BL O-0861-24 at [55].

33. The goods are sold through a range of channels including department stores and supermarkets, via physical stores and online. The overlapping goods are likely to be self-selected from the shelves of such stores and will be a predominantly visual purchase. Therefore, a low degree of attention will be paid during the purchase of the goods at issue. The advertising, marketing and promotional services are directed at the general public but may attract a higher level of attention but no higher than medium.

34. Overall, the public's degree of attention may vary from average to low, depending on the price, specialised nature or terms and conditions of the goods and services purchased."

52. The applicant has made no specific submissions regarding the average consumer, save to say that the average consumer of the products in these classes is likely to be capable of distinguishing between the trade marks.

53. I agree with the opponent's submissions. I consider that the average consumer for the goods and services is likely to be a member of the general public in respect of the goods on offer, or a business user for services, such as business management. The goods are unlikely to be particularly expensive purchases, whereas the costs of the services to business users will be higher. They are not likely to be purchased every day, although will be purchased reasonably frequently. For the goods such as clothing, factors such as materials, aesthetics and comfort are likely to be taken into consideration, as will safety features for some of the equipment. For the services, factors such as location, range of products and market reach are likely to be taken into consideration. Consequently, I consider that the average consumer will pay either a medium degree of attention or a high degree of attention during the purchasing process, depending on the goods and services in issue.

54. The goods are likely to be purchased by self-selection from the shelves of a retail outlet, or online equivalent. Similarly, the services are likely to be purchased following perusal of a website or signage on physical premises. 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

55. 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 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."

56. 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.

57. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark

KIABI	

58. The applicant submits that "due to the differences in visual, phonetic and conceptual form between the respective signs, it is evident that the contested application is entirely different from the opponent's earlier mark, the applicant disagrees with the grounds set out by the opponent in their statement of grounds. Visually, aurally and conceptually, the differences between the signs are sufficient to render the marks dissimilar upon an overall comparison". At this stage I will address the applicant's submission regarding the opponent's mark being used as follows:

KIABI
la mode à petits prix

The applicant submits that that this is how the opponent's respective mark should be assessed because "the mark is known for its logo, which is hereby represented. The logo is an essential part of KIABI's brand identity. The KIABI logo features a unique and easily recognisable design, which includes the brand name in bold letters along with a distinctive graphic element".

59. The applicant also makes reference to the use that has been made of the opponent's mark and that the average consumer will be capable of distinguishing between the marks due to the "strong brand recognition and distinctive branding of the KIABI brand". In *Devinlec Développement Innovation Leclerc SA v OHIM,* Case C-171/06P, the CJEU stated that:

> "59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

60. Insofar as the applicant's submissions regarding the mark in use, the claim under section 5(2)(b) and the assessment as to a likelihood of confusion is one to be taken on a notional and fair basis in relation to the marks as registered/applied for and not in fact how they are being used in the marketplace[10]. Therefore, I will only consider the opponent's registered mark during this assessment.

Overall Comparison

61. The earlier mark is a word only mark, consisting solely of the word KIABI. There are no other elements to contribute to the overall impression of the mark, which lies in this word.

62. The contested mark is figurative and comprises of a series of shapes that may be understood as representing the word IABI in a black font. Whilst the letters 'I' at the beginning and end of the mark are presented in the normal way, the letter 'A' appears as two separate lines on either side of the letter, with no adjoining line in the middle. The line on the left-hand side is shorter and does not meet the line on the right at the apex of the letter, leaving a gap. The letter 'B' is represented by what appears to be a stylised number '3'. Whilst the mark may be read as IABI, it also could appear to some to be made up of a mixture of letters and symbols. The distinctiveness of the mark comes from the combination of the elements.

Visual Comparison

63. The opponent submits:

[10] *Roger Maier and Another v ASOS,* [2015] EWCA Civ 220

> "The Applicant's mark consists of the word "IABI", while the Opponent's mark consists of the word "KIABI", presented as a single word. The Applicant's mark is encompassed entirely within the Opponent's mark. The stylization and font of the 'A' and 'B' letters in the Applicant's mark does not impact the visual similarities between the marks. In addition, the stylization of the IABI mark does not detract from the fact that the letters are recognizable as 'I' 'A' 'B' 'I' Considering the marks as a whole, there is a high degree of visual similarity between them."

64. The applicant submits:

> "The conclusion about visual dissimilarity must also be taken into account if the common element is dominant (stands out visually, in this case, the graphic representation of the words "AB" which has a very distinctive representation in the logo) or, at least, co-dominant in the overall impression with the Earlier Mark, where the dominant part of the trade mark is the simple name "KIABI" and the letter "K" is dominant".

65. It is necessary to consider that the opponent's mark is a word only mark and is, therefore, capable of being presented in the any typeface. A word trade mark protects the notional use of the word itself, irrespective of font, capitalisation or otherwise. However, this would not extend to use of graphical elements that may (or may not) be seen as representing those letters. The applicant's mark is a figurative mark, and I consider that it is so heavily stylised that some consumers may consider it to be made up of a mixture of letters and symbols, as I have said above. Alternatively, it may be perceived as representing the letters IABI.

66. In terms of similarity, if the average consumer does understand the applicant's mark to read IABI, it would be apparent that the whole of the applicant's mark is reproduced within the opponent's mark, and that the letters appear in the same order. I bear in mind that the beginnings of marks tend to make more of an impact than the ends, and in this case, the beginning of the marks is where the difference lies.[11] I also bear in mind that differences in shorter marks tend to have more of an impact, and the

[11] *El Corte Inglés, SA v OHIM,* Cases T-183/02 and T-184/02

marks in this case are only 4 or 5 letters in length.[12] Taking all of this into account, in my view, there is between a low and medium degree of visual similarity. I bear in mind that for those consumers who do not recognise the contested mark as a word, the level of similarity will be even lower.

Aural Comparison

67. As both marks are not obvious dictionary words, it is not clear how they will be pronounced. The opponent submits:

> "Given its presentation and if articulated in full, the Applicant's mark would most logically be pronounced as "I" "ABI". The commonality with the Opponent's mark would therefore be in the elements "I" and "ABI", with the Opponent's mark voiced in its entirety as two syllables, "KI-ABI", the same as the two syllables of the Applicant's mark, "I-ABI". The additional letter "K" in Applicant's mark does create a different first syllable but the end of both marks are pronounced identically, in whichever order the last syllable is articulated. On this basis, the marks are similar to an above average degree".

The applicant submits:

> ""IABI" starts with the vowel sound / ai, followed by the sound /er. "KIABI" starts with the consonant sound /k/, followed by the vowel sound /ill, and then the vowel sound //. The primary aural difference between the two is the initial consonant sound: "IABI" starts with a vowel sound, while "KIABI" starts with a consonant sound. This not only supports the dissimilarity between the respective marks but also demonstrates the lack of likelihood of confusion in the present case, including the lack of likelihood of association"

68. In respect of the earlier mark, I consider that KIABI is likely to be pronounced by the average consumer as KEY-ABEE or KAI-ABEE. There is also the possibility that the mark will be pronounced letter by letter. In respect of the contested mark, I consider that the mark is so heavily stylised that some consumers may not read the mark as IABI and will consider it to be made up of a mixture of letters and symbols. If a

[12] See, for example, *F1T*, BL O/013/21

consumer does read the mark as IABI, it is likely to be pronounced by the average consumer as EYE-ABEE, or it will be pronounced letter by letter.

69. Both marks begin with a different letter, and this does draw attention to the aural differences at the beginning of the mark, as per *El Corte Inglés, SA v OHIM*[13]*,* particularly given that both marks are short. Therefore, I find that there is between a low and medium degree of similarity between the marks. I bear in mind that it will be even lower for those who do not recognise the contested mark as a word.

Conceptual Comparison

70. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*[14]. The assessment must be made from the point of view of the average consumer.

71. The Opponent submits that "the words 'IABI' and 'KIABI' have no meaning and therefore, it is not possible to make a conceptual comparison between the marks". The applicant submits "the conceptual differences between the trade marks "KIABI" and "IABI" lie primarily in their associations and the impressions they create. Whilst "KIABI" is associated with a well-known fashion brand known for its affordability and accessibility, "IABI" does not have any established associations and would rely on branding and marketing to establish its own identity and conceptual associations".

72. I agree with the opponent's submissions. Conceptually, both marks are invented words and have no meaning. As neither mark has a meaning that is immediately graspable to the average consumer, the marks are conceptually neutral.

Distinctive character of the earlier trade mark

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

[13] Cases T-183/02 and T-184/02
[14] [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

> “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).”

74. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it, but as the opponent has not filed any evidence of use, I have only the inherent position to consider. The opponent submits that “its earlier “KIABI” mark is an invented word and has no allusive qualities and is not suggestive of a characteristic of the goods and services. It therefore possess [sic] high inherent distinctive character. The Earlier Mark neither describes nor alludes to the goods and services for which the mark is registered. Considering the Earlier Mark as a whole, it is inherently distinctive to a high degree”. As the opponent has not filed any evidence, I only have the inherent position to consider.

75. The earlier mark is an invented word which does not allude to or describe the goods/services provided. Therefore, I am of the view that the earlier mark is inherently distinctive to a high degree.

Conclusions on Likelihood of Confusion

76. 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/services down to the responsible undertakings being the same or related.

77. 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/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/services 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.

78. I have found as follows:

- That the goods/services at issue range from being identical to similar to a low degree (except where I have found them to be dissimilar);
- I have identified that the average consumer will be members of the general public or business users. They will select the goods/services primarily by visual means, although I do not discount an aural component;
- I have concluded that either a medium or high degree of attention will be paid during the purchasing process, depending on the goods/services in issue;

- The contested mark is visually similar to the earlier mark to between a low and medium degree (or lower for those who do not perceive the contested mark as a word);

- The contested mark is aurally similar to the earlier mark to between a low and medium degree (or lower for those who do not perceive the contested mark as a word);

- I have found the contested mark and the earlier mark to be conceptually neutral;

- I have found the earlier mark overall to be inherently distinctive to a high degree;

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 four letters which appear in the same order, I do not consider that the 'K' at the beginning of the earlier mark will be overlooked. I also note the heavy stylisation of the contested mark and consider that consumers are likely to focus upon this when attempting to recall the mark, which acts as a significant point of difference when compared to the opponent's word only mark. There is even less likelihood of them being misremembered for those consumers who do not view the contested mark as a word. As a result, 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/services.

79. 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 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)."

80. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[15]. 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[16]. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.

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

81. For indirect confusion to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods/services provided under one are regarded as a brand extension or sub brand of the other, for example.

82. I appreciate that both marks share the overlapping element IABI, which forms the whole of the contested mark (for the consumers who view it as a word) and shares four out of five letters of the earlier mark, KIABI. Whilst I appreciate that the earlier mark is highly distinctive, the distinctiveness comes from the word as a whole. In my view, none of the categories set out in *LA Sugar* apply in this case and I can see no other basis upon which the average consumer would conclude that there is an economic connection between the marks; the removal of one letter to create a different invented word is not consistent with a sub-brand or brand extension. This is even more so for consumers who consider the applicant's mark to be made up of a mixture of letters and symbols.

83. Taking all of the above into account, I do not consider that there exists a likelihood of indirect confusion between the marks, even when used on identical goods/services.

Conclusion

84. The opposition fails in its entirety. Therefore, subject to appeal, the application may proceed to registration for all goods/services.

Costs

85. The applicant has been successful and therefore, is entitled to a contribution towards their costs based upon the scale published in Tribunal Practice Notice 1/2023 which governs costs in proceedings issued after 1 February 2023. In the circumstances, I award the applicant the sum of £600.00 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Considering notice of opposition and preparing a counterstatement:	£250.00
Preparing written submissions	£350.00

Total: **£600.00**

86. I therefore order BUNSHA to pay Taizhou Lanchou Garment Co., Ltd. the sum of £600.00. 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 15th day of September 2025

LA Bailey

For the Registrar

Annex 1

Class 3 Bleaching preparations and other substances for washing; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery; Essential oils; Cosmetics; Hair lotion; Dentifrices; Cotton buds, and cotton used for cosmetic purposes; Tissues impregnated with cosmetic lotions; Cosmetic kits.

Class 9 Personal stereos and personal multimedia players; Pre-recorded DVDs; DVDs; DVD drives; Containers and cases for compact discs and DVDs; Luminous signs; Compact discs featuring music; Prerecorded music compact discs; Interactive compact discs and CD-ROMs; Spectacles [optics]; Cases for spectacles and sunglasses; Swim goggles; Diving goggles; Snow goggles; Sports glasses; Children's eyeglasses; Spectacle frames; Snow goggles.

Class 18 Backpacks; Handbags; Travelling bags; Bookbags; Shoulder bags; Souvenir bags; Satchels; Bags for campers; Gym bags; Beach bags; Sport bags; Roll bags; Wheeled shopping bags; Small pouches (handbags); Travel cases; Suitcases; Traveling trunks; Trunks [luggage]; Valises; Sling bags for carrying infants; Wallets; Purses; Card cases [notecases]; Brief bags; Satchels; Umbrellas; Bumbags; Boxes made of leather; Key cases.

Class 25 Clothing; Footwear; Headgear; Shirts; Leather clothing; Belts [clothing]; Furs [clothing]; Gloves [clothing]; Scarves; Neckties; Hosiery; Socks; Slippers; Beach shoes; Ski boots; Athletics shoes; Underwear; Lingerie; Bibs of cloth; Shoe soles; Swimming costumes; Tights; Teddies [underclothing]; Pyjamas; Sleepsuits; Gowns; Skirts; Jumper suits; Combinations (clothing); Coats; Snowsuits (clothing); Tee-shirts; Polo-neck jerseys; Tunics (clothing); Overalls (clothing); Jumpers; Waistcoats; Hooded tops; Trousers; Leggings; Caps [headwear]; Bathwraps; Shorts; Polo shirts; Jackets [clothing]; Aprons [clothing]; Costumes; Sneakers; Trainers [footwear]; Boots (footwear); Booties;

Boots; Pumps [footwear]; Ankle strap ballet pumps (footwear); Sandals; Maternity bands (clothing).

Class 28 Games; Toys; Mobiles [toys]; Teddy bears; Plush toys; Dolls and clothing accessories for dolls (clothing); Puppets; Gaming balls; Gymnastic and sporting articles; Games (Apparatus for -); Portable games with liquid crystal displays; Card games; Building games; Parlour games; Toy animals; Hand-held electronic video games; Party articles in the form of small playthings; Sling shots [sports articles]; Paper party favours; Decorations and ornaments for Christmas trees; Novelty jokes; Baby rattles; Baby rattles incorporating teething rings; Infants' playthings; Inflatable balls.

Class 35 Advertising; On-line advertising on a computer network; Television advertising; Dissemination of advertising matter; Direct mail advertising; Sample distribution; Publicity columns preparation; Rental of advertising time on communication media; Rental of advertising space; Updating of advertising material; Publication of publicity texts; Assistance in management of business activities; Commercial or industrial management assistance; Business management; Business administration; Business management and organization consultancy; Commercial administration of the licensing of the goods and services of others; Business research; Bill-posting; Import-export agencies; Commercial information agencies; Office functions; Outsourcing services [business assistance]; Marketing services; Marketing consultancy; Market research; Business project management; Project studies for businesses; Business and commercial consultancy; Business organization and sales consultancy; Consultancy relating to sales techniques and sales programmes; Demonstration of goods; Opinion polling; Personnel recruitment; Administrative processing of purchase orders; Consumers (Commercial information and advice for -) [consumer advice shop]; Demonstration of goods; Management of customer loyalty, incentive or promotional schemes; Sales promotion (for others); Presentation of goods on communication media, for retail purposes;

Online retailing of clothing, underwear, lingerie, belts, scarves, gloves, footwear, caps, hats, costumes, jewellery, jewellery boxes; Online retailing of bags, handbags, backpacks, luggage, travelling sets, cosmetic, beauty and make-up preparations, watches, articles for the hair, hair slides; Online retailing of toys, games, plush toys, dolls, costumes, articles for baby care, bed linen, household linen, bathroom linen, table linen, travelling blankets, baby grows (sleeping bags), bed blankets, curtains, upholstery fabrics, optical goods and spectacles, furniture, stationery, frames, utensils and containers for household or kitchen use, carpets; Organisation of exhibitions for commercial and publicity purposes; Fashion show exhibitions for commercial purposes; Production of advertising films; Modelling for advertising or sales promotion; Research for sponsorship; shop widow dressing; Organising home meetings for commercial or advertising purposes; presentation of goods on communication media, for retail purposes; Provision of an online marketplace for buyers and sellers of goods and services; Organising exhibitions and tests of sports products for commercial or advertising purposes.

Class 40 Clothing alteration

Class 42 Dress designing