O/1007/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK APPLICATION NUMBER 4011578

BY NALA COUTURE LTD

FOR THE FOLLOWING TRADE MARK:

NALA

IN CLASSES 25 AND 35

AND

IN THE OPPOSITION THERETO UNDER NUMBER 447709

BY NALAS BABY LIMITED

BACKGROUND & PLEADINGS

1. On 6 February 2024, Nala Couture Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision in the United Kingdom ("the contested mark"). The contested mark was published for opposition purposes in the Trade Marks Journal on 23 February 2024 in respect of the following goods:

   Class 25: Embroidered clothing.

   Class 35: Retail services connected with the sale of clothing and clothing accessories.

2. On 23 May 2024, the contested mark was opposed by Nalas Baby Limited ("the opponent"). The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition was initially brought under Section 5(2)(b), 5(3) and 5(4)(a) of the Act. However, by email on 28 November 2024, the opponent confirmed that it was withdrawing its opposition under section 5(3) and 5(4)(a), and that its opposition would proceed solely under section 5(2)(b) of the Act.

3. For the purposes of its opposition, the opponent relies upon the following two marks (together the "earlier marks"):

   NALA'S BABY

   Trade mark number: UK00003539934
   Filing Date: 2 October 2020
   Registration Date: 29 January 2021
   ("the first earlier mark")

nala's
baby

Trade mark number: UK00003539951
Filing Date: 2 October 2020
Registration Date: 29 January 2021
("the second earlier mark")

4. The opponent relies upon all of the goods for which its earlier marks are registered, namely those goods listed in paragraph 17 of this decision.[1]

5. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"(6)(1) In this Act an "earlier trade mark" means –
a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

6. The marks identified in paragraph 3 qualify as earlier trade marks under the above provisions. As the earlier marks had not completed their registration process more than five years before the relevant date, they are not subject to proof of use requirements. Consequently, the opponent may rely on all of the goods listed in paragraph 17 for the purpose of this opposition.

7. The opponent claims that the marks in issue are "highly similar", and that the applicant's goods and services are similar or identical to the opponent's goods. Consequently, the opponent submits that "there is a likelihood of confusion on the part of the public".

[1] It is noted that both earlier marks are registered for identical goods.

8. The applicant filed a counterstatement denying the claims made against it. Specifically, the applicant submits that there is “no basis for the opposition”.

REPRESENTATION

9. The opponent is represented by Trademark Eagle Limited.

10. The applicant is self-represented.

EVIDENCE AND SUBMISSIONS

11. Only the applicant filed witness evidence in support of its claim, which I have discussed in further detail in paragraph 21 below. This witness statement was signed by Kulvinder Chumber, dated 4 February 2025, in their capacity as director of Nala Couture Ltd, and was filed with seven exhibits, Exhibits 1 - 7. The opponent did not file evidence in reply.

12. No hearing was requested, and neither party filed written submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers that have been filed by the parties, which will not be summarised but will be referred to as and where appropriate during this decision.

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the United Kingdom (“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)

14. The opponent's opposition is based upon section 5(2)(b) of the Act which stipulates the following:

> "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".

15. Section 5A of the Act stipulates that 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."

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*,[2] *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* ("Canon"),[3] *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*,[4] *Marca Mode CV v Adidas AG & Adidas Benelux BV*,[5] *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*,[6] *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,[7] *Shaker di L. Laudato & C. Sas v OHIM*[8] and *Bimbo SA v OHIM*[9]:

[2] Case C-251/95
[3] Case C-39/97
[4] Case C-342/97
[5] Case C425/98
[6] Case C-3/03
[7] Case C-120/04
[8] Case C-334/05P
[9] Case C-591/12P

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

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

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

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

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

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

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

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

i. mere association, in the strict sense that the later mark brings 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 services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods and Services

17. The competing goods and services are as follows:

The opponent's goods	**The applicant's goods and services**
Class 3: Skin care preparations; make-up; moisturisers; body cleaning and beauty care preparations; cosmetics and cosmetic preparations; cosmetic kits; compacts containing make-up; sunscreen creams; hair treatment preparations; soaps and gels; perfumery and fragrances; deodorants and antiperspirants; dentifrices and mouthwashes. **Class 5:** Pharmaceuticals and natural remedies; dietary supplements and dietetic preparations; nutritional supplements; disinfectants and antiseptics; anti-viral agents; anti-bacterial preparations; anti-viral and anti-bacterial gels; medicated and sanitising soaps and	**Class 25**: Embroidered clothing. **Class 35:** Retail services connected with the sale of clothing and clothing accessories.

detergents; sanitizing wipes; hygienic preparations and articles; medicated soaps and detergents; sanitary preparations and articles; infants' foods; nappies for babies and incontinents; feminine hygiene products; breast-nursing pads; babies' diaper-pants; disposable training pants of paper for infants; petroleum jelly (for medical purposes); skin care creams for medical use; medicated creams; teething gel; teething (preparations to facilitate); medicated nipple creams. **Class 8:** Food preparation implements; cutlery; manicure sets; pedicure sets; nail buffers for use in manicure; pedicure implements; manicure implements; Hand tools and implements (hand operated); hair cutters; hair clippers for personal use; scissors; fingernail files; hair styling appliances; parts and fittings for all the aforesaid goods. **Class 25:** Clothing; footwear; headgear.	

18. The opponent submits that its class 25 goods are identical to the applicant's class 25 goods. The opponent also submits that the opponent's goods in classes 3,5 and 8 are similar to the applicant's class 25 goods because they are complimentary, and that the applicant's class 35 services are identical or similar to the opponent's class 25 goods, as retail clothing is complimentary to the goods in class 25.

19. The applicant's position in respect of the similarity, or lack thereof between its goods and services and the opponent's goods is not overly clear in its

counterstatement. However, the applicant expressly denies that the goods in issue are identical or that "there is an overlap between the goods in classes 25 and 35".

20. The applicant submits that the opponent's goods are all baby related, whereas its goods are "niche" with a specific target consumer (specifically, "ethnic embroidered clothing" for adult women).

21. In furtherance of this point, as outlined above, the applicant also filed a witness statement signed by Kulvinder Chumber. The witness statement includes evidence of the applicant's use of the contested mark within the UK. Specifically, the witness statement includes the following:

- Evidence of use of the contested mark on the applicant's social media pages;[10]
- Evidence of how the second earlier mark and the contested mark are used by the parties;[11]
- Evidence of payments made by applicant for Facebook marketing;[12]
- An invoice evidencing advertising charges for the applicant between 13 October 2023 and 13 October 2024; [13]
- Evidence of use of the contested mark on the applicant's website;[14]
- Evidence of use of the second earlier mark on the opponent's website;[15]
- Confirmation that the applicant has "never had any messages or enquiries regarding baby products", which the applicant submits are sold by the opponent, and copies of a sample of enquiries received by the applicant, which it submits demonstrates a "clear target audience seeking specific goods".[16]

[10] In the form of screen shots of the applicant's Instagram page, exhibit 1
[11] Exhibit 2
[12] Exhibit 3
[13] Exhibit 4
[14] Exhibit 5
[15] Exhibit 6
[16] Exhibit 7

22. As a preliminary point, there is no requirement for the applicant to evidence proof of use of the contested mark, or for me to consider the extent of the applicant's use of the contested mark, for the purposes of this opposition because section 5(2)(b) of the Act requires me to carry out a notional assessment based upon all the ways in which the parties respective marks could be used.

23. Despite the above, it is noted that the applicant has sought evidence from the opponent showing that there has been confusion between the marks in issue on the part of the public, and that the applicant has submitted that, to date, "there is no evidence (no complaints) of any confusion given both marks have been running simultaneously for years". Whilst not necessary, evidence of a lack of confusion by consumers over an extended period of time may point towards there being no likelihood of confusion.[17] In this instance, whilst the applicant has filed some evidence to show how both parties have used their respective marks in practice, I have no evidence before me to indicate how long the parties have been using the marks shown in exhibit 2 of Kulvinder Chumber's witness statement. Further, I note that the mark actually used by the applicant is different to the contested mark (which is word only) and the applicant actually offers bridal clothing (as opposed to embroidered clothing more generally) which is not apparent from its specification. With this in mind, I am unable to make an accurate determination as to why there is no evidence of confusion between the marks, and whether that is because there is genuinely no likelihood of confusion between the marks or whether another factor has resulted in there being no actual confusion to date.

24. In this instance, the applicant seeks to differentiate between the goods the applicant submits that it actually sells (i.e., "ethnic embroidered clothing of lehengas and sarees to adult women") and the opponent's goods. It is also important to note that I must compare the goods and services in the parties' specifications on the basis of the 'notional' coverage of the goods and services listed in the specifications, not those currently provided. Any differences between

[17] Paragraphs 34 and 35 of the decision of Dr Brian Whitehead in Azumi Limited v Nick Robinson, Case No. O/078/22

the actual goods and services offered by the parties or the parties' marketing/trading styles will, as a matter of law, have no bearing on the outcome of this opposition, unless those perceived differences are apparent from the specifications. This is because a trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion, and the scope of protection afforded to that mark will be identified in its specifications. As outlined above, once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark within the UK. Until that point, however, the earlier marks are entitled to protection in the UK in respect of the full range of goods and services for which it is registered.

25. In *Canon*,[18] the Court of Justice of the European Union ("CJEU") stated (at paragraph 23) that, when making the comparison, "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".

26. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case[19], for assessing similarity were:

    a. The uses of the respective goods or services;

    b. The users of the respective goods or services;

    c. The physical nature of the goods or services;

[18] Case C-39/97
[19] [1996] R.P.C. 281

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 in the same or different sectors.

27. As per the case of *Separode,*[20] I also bear in mind that it is permissible to group the goods together, for the purpose of comparison, where they are sufficiently comparable to be assessable in essentially the same way for the same reasons.

28. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*,[21] 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".

[20] BL O/399/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person
[21] Case T- 133/05

Embroidered clothing

29. I am of the view that the applicant's "embroidered clothing" would fall within the opponent's wider term of "clothing". Consequently, I agree with the opponent that these goods are identical in line with the *Meric* principle.

Retail services connected with the sale of clothing and clothing accessories

30. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

31. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said that:

> "9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

32. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case

T105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

(i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

(ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

(iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

(iv) The GC's findings in Oakley did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered)

33. In this case, I compare the applicant's class 35 "Retail services connected with the sale of clothing and clothing accessories" and the opponent's class 25 "Clothing" and "headgear". I consider that all of the opponent's goods will be sold through the same trade channels as the applicant's services, and to the same users (i.e., members of the general public), who may perceive the goods and services as emanating from the same undertaking. I also consider that the opponent's "Clothing" and "headgear" are important/indispensable to the provision of the applicant's class 35 services in that they are clothing or clothing accessories. Consequently, I do consider these goods and services to be complementary and similar to a medium degree.

Average consumer and the purchasing act

34. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 and services in question (see *Lloyd Schuhfabrik Meyer*[22]).

35. 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,*[23] Birss J. held:

> "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."

36. It is noted that the applicant submits that the average consumer for its goods and services would be Indian members of the general public, given that it sells Indian fashion and embroidered clothing. However, as previously discussed, I must consider the goods and services for which the applicant seeks protection of its mark. Consequently, I do not accept that the average consumer of the goods in issue would be limited to Indian members of the general public. I am of the view that the average consumer for all of the parties' goods and services will be members of the general public at large.

[22] Case C-342/97
[23] [2014] EWHC 439 (Ch)

37. The cost of the goods and services in issue is likely to vary considerably, and the goods/services will be purchased/utilised relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as price, quality and suitability of the product. In relation to the class 25 goods, the average consumer is likely to also consider factors such as materials used, available sizes, cut, aesthetic appearance and durability for the goods during the purchasing process. In addition, when selecting the class 35 services, the average consumer is likely to consider things such as stock, price of goods offered in comparison to other retailers, expertise/knowledge of staff and delivery time. Overall, I consider that a medium degree of attention will be paid by the average consumer when selecting both the goods and the services in issue.

38. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, or an online or catalogue equivalent. As for the retail services at issue, I consider that these are most likely to be selected having considered, for example, promotional material (in hard copy and online), signage appearing on the high street (for physical retailers only) or web content from retailers' websites. Visual considerations are, therefore, likely to dominate the selection process for the goods and services. However, I do not discount that there will also be an aural component, as a result of word-of-mouth recommendations, or advice being sought from a sales assistant or representative.

Comparison of marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and

dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*,[24] 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."

40. 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.

41. It is noted that the applicant has conceded that the "word 'nala'" (and, therefore, by implication, the contested mark) is "aurally/phonetically similar" to the earlier marks. However, in any event, I will proceed to make my own determination of the level of similarity between the marks in the usual manner.

42. It is also noted that the applicant has made submissions comparing the parties' marks as used rather than as registered/applied-for.[25] However, I am required to consider the marks as registered/applied-for, and it is on this basis that I will assess the similarity between the marks in issue.

43. The respective trade marks are shown below:

Earlier marks	Contested Mark
NALA'S BABY (the "first earlier mark")	**NALA**

[24] Case C-591/12P
[25] As shown in Exhibit 2 of Kulvinder Chumber's witness statement

 (the "second earlier mark")	

Overall Impression

44. The first earlier mark is a word only mark, consisting of the words "Nala's baby". There are no other elements in the mark which contribute to its overall impression, so the overall impression lies in the words themselves. I consider the word "baby" to be descriptive, or at least non-distinctive, in relation to the opponent's goods on the basis that it signals the intended purpose of the goods (i.e., for babies or for pregnancy). I am also conscious that the GC noted in *El Corte Inglés, SA v OHIM*,[26] that the beginnings of words tend to have more visual and aural impact. Consequently, I consider the word "Nala's" will make the greatest contribution to the overall impression of the first earlier mark, with the word "baby" playing a lesser role, although I do not consider that it will go unnoticed.

45. The second earlier mark is a figurative mark consisting of the words "nala's baby". The word nala's is stylised in a lower case and in a script style typeface. Whilst I do not consider that the stylisation would be overlooked, I note that the level of stylisation is fairly limited, and therefore I consider that it plays a lesser role in the overall impression of the mark than the words themselves.

46. Within the second "a" in the word "nala" is a device reminiscent of a paw print. However, given its positioning within the "a", rather than as a standalone device, I consider that it plays a lesser role in the overall impression of the mark than the words themselves.

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

47. Immediately below the word “nala’s” is the word “baby”, which is in a less stylised and much smaller font. Given its positioning, limited stylisation, reduced size, and the fact that the word baby is descriptive or non-distinctive of the goods in the opponent’s specification, I am of the view that the word “nala’s” plays the dominant role in the overall impressions of the word, with “baby” playing a lesser role.

48. The contested mark is also a word mark consisting of the word “NALA”. There are no other elements in the mark which contribute to its overall impression, so the overall impression lies in the word itself.

Visual Comparison

49. Visually, the marks overlap to the extent that they all contain the same first four letters (“NALA”). The earlier marks also contain an additional apostrophe and “S”, which has no counterpart in the contested mark. I recognise that the earlier marks also contain the additional word “baby”, and that there are differences created by the presentation of the word in the second earlier mark (i.e., the stylisation of the word “Nala’s”, and the paw print device), but as I have found these elements to play a lesser role in the overall impression of the earlier marks, I do not consider these to be of significant impact. Taking all of this into account, I consider the marks to be visually similar to a medium degree.

Aural Comparison

50. I consider that only the word elements within the marks in issue will be pronounced, the additional device element in the second earlier mark will not be articulated.

51. As outlined above, the marks share the same first four letters (“NALA”), which I consider will be pronounced identically in each of the marks as “na-la”. I note the applicant’s submissions that the applicant would pronounce Nala as “na-la”, whereas the opponent would pronounce it “naala”. However, I can see no basis for finding that the average consumer would pronounce the first four letters in

each of the marks ("NALA") any differently when articulating the respective marks. However, there is a phonetic difference created by the presence of the apostrophe and "S" in the earlier marks, which does not have a counterpart in the contested mark. The word "baby" in the earlier marks also acts as a point of aural difference between the earlier marks and the contested mark.

52. Taking all of this account and noting that the beginning of the marks tends to have more aural impact than the ending,[27] I consider the marks to be aurally similar to a medium degree.

Conceptual Comparison

53. 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*.[28] The assessment must, therefore, be made from the point of view of the average consumer.

54. I am also conscious of the findings of the GC in *Usinor SA v OHIM,*[29] *that "*as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him".

55. In this instance, both marks utilise the word "Nala". I note Kulvinder Chumber's evidence that Nala is Punjabi for "drawstring in garments". However, I consider it unlikely that the average UK consumer will be familiar with that meaning. In fact, it is my view that the average consumer would identify the word "Nala" as being a name, particularly given the fact that it is the name of a main character in the widely known children's story/film, Lion King.

[27] *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02
[28] [2006] ECR I-643; [2006] E.T.M.R
[29] Case T-189/05

56. Unlike the contested mark, the earlier marks both utilise the word “Nala” in a possessive form, i.e., as “Nala’s”, and the word “baby”. Read together, the words in the earlier marks convey that “Nala” is a parent, or that “Nala” is the brand name and the brand’s baby range is “Nala’s baby”. In any event, this therefore acts as a point of conceptual difference between the earlier marks and the contested mark.

57. I note that the paw print device in the second earlier device is not present in the contested mark. However, given my finding that the average consumer would identify Nala as a name on the basis that it is the name of one of the main characters (specifically a Lion) in the Lion King, I consider that this device simply reinforces the conceptual meaning I have identified from the word Nala in any event.

58. Taking all of this into account, and on the basis that I have found the words Nala and Nala’s to be the dominant elements of all of the marks, I consider all three marks to be conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

59. In *Lloyd Schuhfabrik Meyer* 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49)
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> 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)."

60. Whilst the distinctiveness of a mark may be enhanced as a result of it having been used in the market, in this instance the opponent has filed no evidence of use. Consequently, I have only the inherent position to consider.

61. Distinctiveness is a scale along which marks of various types sit. A mark which is allusive of the goods/services will have less distinctive character than one that is not; dictionary words will also be less distinctive than words which are entirely fanciful. However, all will turn on the particular facts. For example, there are "invented" words which are really just composites of two allusive words and only distinctive as a result, and dictionary words which are more or less common than others.

62. As outlined above, I consider the word "baby" to be descriptive, or at least non-distinctive, in respect of the opponent's goods. Consequently, I consider that the distinctive character in the earlier marks predominantly lies in the word "Nala's" and, to a lesser extent, in the presentational elements of the second earlier mark.

63. The common element of all of the marks in issue is the word "Nala" which is presented with an apostrophe and an "s" in both of the earlier marks. The presence of the apostrophe and the "s" in the earlier marks results in the word "Nala" being possessive of "baby", which reinforces the meaning I have found will be attributed to the word "Nala" by the average consumer (i.e., that Nala is a name, and that "Nala" is a parent, or that "Nala" is the brand name and the brand's baby range is "Nala's baby".

64. In *Harman International Industries, Inc v OHIM*,[30] the CJEU found that:

> "Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common".

65. Whilst I therefore recognise that, as a general rule, forenames are considered to be less distinctive, I also recognise that Nala is not a common name in the UK.

66. I also bear in mind my finding that the stylisation and use of the device in the second earlier mark play a lesser role in the overall impression of the earlier marks than the words themselves, and I do not consider that these elements materially increase the level of distinctive character of the second earlier mark as a whole. Consequently, I find the earlier marks to be inherently distinctive to a medium degree.

67. It should also be noted that it is the distinctiveness of the common element (i.e., the word "Nala") which is key when assessing the likelihood of confusion: In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

[30] Case C-51/09P

> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

68. In other words, simply considering the level of distinctive character possessed by the earlier marks is not enough. It is important to ask 'in what does the distinctive character of the earlier marks lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out. In my view, the common element is distinctive to a medium degree.

Likelihood Of Confusion

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst 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.

70. 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 (see *Sabel*[31]). The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*[32]). It is necessary for me to keep in mind the distinctive character of the earlier marks, 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.

[31] C-251/95, para 22
[32] C-39/97, para 17

71. I have found the applicant's goods and services to be identical or similar to a medium degree to the opponent's goods. I have also found that the marks are visually, aurally and conceptually similar to a medium degree.

72. I have found the earlier marks to have a medium level of distinctive character. I have also identified that the average consumer of the goods and services would be members of the general public, who will pay a medium level of attention during the purchasing process for the goods and services in issue, and I have determined that the purchasing process for all of the goods/services in issue would be primarily visual in nature, although I do not discount aural considerations.

73. Weighing up all of the above, and noting the principle of imperfect recollection, that consumers rarely have the opportunity to compare marks side by side, I am satisfied that there are sufficient differences between the marks to prevent the average consumer from mistaking them from one another. My determination is also bolstered by the fact that I only consider the marks to be aurally, visually and conceptually similar to a medium degree. I therefore consider that these differences between the marks will offset the fact that some of the goods in issue are identical.

74. I will now go on to consider whether there is a likelihood of indirect confusion.

75. Indirect confusion was described in the following terms by Iain Purvis KC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[33]

"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

[33] BL O/375/10

other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI", etc.).

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

76. I am of the view that these marks would fall within the second or third category identified by Iain Purvis KC. I note my finding that the word "Nala" has a medium level of distinctive character, and that the main differences between the marks (i.e., the word baby, the additional stylisation and device in the second earlier mark) are non-distinctive or play a lesser role in the overall impression. It is my view that the average consumer would consider these differences to be entirely logical, consistent and expected with the type of differences one would see between a brand and its sub-brand, or in any brand extension. Specifically, I

consider that the average consumer would understand the contested mark ("Nala") to be the brand's mark for its clothing goods and services generally, and that the earlier marks relate to the brand's baby specific goods. Alternatively, I consider that the average consumer would believe that the contested mark reflects a brand extension for its adult specific goods and services. In any event, as a consequence, I do therefore consider that there is a likelihood of indirect confusion between the goods and services in issue.

CONCLUSION

77. The opposition succeeds in full, and the contested mark is hereby, subject to any successful appeal of my decision, refused registration in its entirety.

COSTS

78. As the opponent has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 1/2023. In the circumstances, I award the opponent the sum of £350 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a notice of opposition & considering the other side's statement:	£250
Total:	**£350**

79. I therefore order Nala Couture Ltd to pay Nalas Baby Limited the sum of £350. 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 30th day of October 2025

B Hartland
For the Registrar