

O/169/18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3199516
BY YANGO INTERNATIONAL LTD
TO REGISTER THE TRADE MARK**

YANGO

**FOR GOODS AND SERVICES
IN CLASSES 3, 14, 16, 25, 26, 38 and 41**

AND

**THE OPPOSITION THERETO UNDER NO. 408493
BY CONSOLIDATED ARTISTS B.V.**

BACKGROUND AND PLEADINGS

1. Yango International Limited ("the Applicant") applied on 30 November 2016 to register the word "YANGO" as a UK trade mark for the following goods and services in seven classes as follows:

Applicant's Goods & Services	
Class	Wording
3	Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.
14	Precious metals; jewellery; precious stones; chronometric instruments.
16	Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging; printing blocks.
25	Clothing; footwear; headgear; swimwear; sportswear; leisurewear.
26	Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.
38	Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.
41	Production of radio and television shows and programmes; film production services; education, teaching and training; entertainment services; presentation of movies; film distribution; provision of non-downloadable films and television programs via a video-on-demand service; arranging and conducting of workshops and seminars; arranging and conducting of congresses; organization of exhibitions for cultural and educational purposes; publication of electronic books and journals online.

2. The application was published for opposition purposes in the Trade Marks Journal on 9 December 2016. Registration of the Applicant's mark is opposed by Consolidated Artists B.V. ("the Opponent"), relying on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"), each ground opposing the entirety of the application.

The Opponent's claim under section 5(2)(b)

3. The basis of the section 5(2)(b) ground is a claim that the Applicant's mark is similar to earlier marks of the Opponent and is for goods or services that are identical with or similar to the earlier marks, such that there exists a likelihood of confusion on the part of the public, including a likelihood of confusion. The Opponent here relies on its ownership of the registrations shown below, which in this decision I refer to as Mark 1 and Mark 2:

Mark 1
<p>EU Trade Mark No. 9850785 registered in classes 3, 9, 14, 18, 25 and 35</p> <p>MANGO</p> <p>Application filing date: 29 March 2011 Registration status: not yet registered (see explanation below)</p>
Mark 2
<p>EU Trade Mark No. 13453576 registered in classes 14, 18, 25 and 35</p> <p>MANGO MAN</p> <p>Application filing date: 12 November 2014 Registration Date: 13 April 2015</p>

4. A full list of the goods and services under Mark 1 and Mark 2 is set out in an Annex at the end of this decision.
5. It is worth remarking on two initial points arising from Mark 1. Firstly, at the launch of these opposition proceedings, its registered goods and services were published on the EUIPO website in French only. Within an annex to its Form TM7 notice of opposition, the Opponent provided an English translation of that list of goods and services, although the quality of the translation suggests that it was achieved by some automated means. I have recently checked the EUIPO website, where the goods and services are now given in English – it is that version that is set out in the Annex to this decision.
6. Secondly, and more significantly, at the launch of these opposition proceedings Mark 1 was shown on the website of the EUIPO as having been refused for registration, with an appeal against that decision by the EUIPO pending. As a preliminary issue in the present opposition, the Applicant requested that the present opposition be suspended to wait for a final decision from the EUIPO in relation to Mark 1 relied on by the Opponent. The UK IPO refused that request because the opposition is based additionally on Mark 2 for the section 5(2)(b) ground, as well as on the additional ground of section 5(4)(a). I note from my more recent checking of the EUIPO website that Mark 1's status is currently described as "application under examination".
7. Since both Mark 1 and Mark 2 have dates of application for registration earlier than the trade mark applied for by the Applicant, they constitute "earlier marks" as defined by section 6(1)(a) of the Act. In relation to Mark 1 it should be noted that section 6(2) of the Act provides that an earlier mark includes "a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."
8. Mark 2 had not been registered for five years or more when the Applicant's mark was published for opposition. Although the filing date of Mark 1 reaches back to March 2011, given its current status it does not appear that Mark 1 has ever yet completed its registration procedure. This accords with the tick box indications in the Opponent's

Form TM7. Consequently, neither Mark 1 nor Mark 2 is subject to the proof of use requirements under section 6A of the Act.

9. The Opponent's statement of grounds claims that the Applicant's goods and services are in some cases identical to the Opponent's registered goods and services, and in some cases similar in various degrees, although in comparing the parties' goods and services the Opponent does not explicitly distinguish between Mark 1 and Mark 2.
10. The Opponent claims that the parties' respective goods in Classes 3, 14 and 25 are identical or closely similar as they have the same nature, purpose and/or method of use, and can coincide in their producers, end users and distribution channels.
11. I note that Mark 1 has goods registered in Class 3, but that Mark 2 does not. The Opponent also claims that the Applicant's Class 3 goods are similar to the Opponent's retail services relating to perfumery and cosmetics in Class 35. Both Marks 1 and 2 have the same registered services in Class 35, which the Opponent claims are similar to the Applicant's Class 3 goods as they coincide in their end users and distribution channels, and are complementary. The Opponent uses those same bases (end users, trade channels, complementarity) to claim similarity between the Opponent's retail services in Class 35 and some of the Applicant's other goods. Thus it claims:
 - that the Applicant's Class 14 goods are similar to the Opponent's retail services relating to jewellery and watches;
 - that the Applicant's Class 16 goods are similar to the Opponent's retail services relating to stationery; and
 - that the Applicant's Class 25 goods are similar to the Opponent's retail services relating to clothing, footwear and headgear.
12. The Opponent claims that the Applicant's Class 26 goods are similar to the Opponent's jewellery, decorative charms and ornaments in Class 14 and to the Opponent's goods in Class 25. Similarity is claimed between these respective goods on the basis that they coincide in their end users and distribution channels, and are complementary or in competition.

13. The Opponent claims that the Applicant's Class 38 services are similar to the Opponent's retail services relating to mobile phone accessories in Class 35. It states that "such accessories include telecommunication application software, and the like, and the respective services coincide in their end users and distribution channels, and are complementary."
14. The Opponent claims that "the Applicant's Class 41 services are similar to the Opponent's photographic and cinematographic apparatus and instruments, radio and television apparatus, instructional and teaching materials, entertainment apparatus, electronic publications, cinematographic films, and recorded media in Class 9, and television commercials in Class 35. The respective goods and services coincide in their end users and distribution channels, and are complementary."
15. The Opponent's statement of grounds also makes the following claims in relation to the comparison of the marks:
 - The dominant element of Mark 1 and Mark 2 is the word MANGO and their figurative elements are minimal;
 - The word MAN in Mark 2 is significantly smaller than the word MANGO and therefore significantly less noticeable;
 - The words YANGO and MANGO are the same length and contain the same number of letters;
 - YANGO contains 4 of the 5 letters of MANGO, in the same order;
 - Both words contain the same number of consonants and the same "unusual and distinctive suffix sound – ANGO";
 - The opening letters Y and M "are visually similar to some extent, in that they both feature a "V"-shaped element in the centre of the letter".
 - The Opponent claims that "in light of the above, the respective trade marks are closely similar visually and phonetically."
16. The Opponent claims that "the earlier trade marks have a highly distinctive character, both per se and because of the use that has been made of them." It also states that "a lesser degree of similarity between goods or services may be offset by a greater degree of similarity between the marks, and vice versa, where in the present case the respective goods are identical or closely similar this offsets any differences between the respective marks."

The Opponent's section 5(4)(a) claim

17. The Opponent claims in its statement of grounds that “*since at least 2000 the Opponent and its predecessors in title have used the trade mark MANGO throughout the UK in respect of the following goods and services:*

Clothing; footwear; headgear; coats; jackets; dresses; jumpsuits; cardigans and sweaters; sweatshirts; shirts; t-shirts; trousers; jeans; leggings; skirts; lingerie; underwear; bras; socks; sleepwear; sportswear; office wear; maternity wear; shapewear; blazers; suits; scarves and foulards; ties; bow ties; gloves; belts; pocket handkerchiefs; pocket squares; shoes; sneakers; sandals; loafers; mules; hats; beanie hats; headbands; hairbands; hair ties; hair clips; bags; cases; document cases; tablet cases; briefcases; clutch bags; bucket bags; hand bags; sports bags; tote bags; cosmetics bags; backpacks; cross-body bags; jewellery; necklaces; brooches; brooch clasps; bracelets; braces; decorative patches; pins; decorative pins; lapel pins; key rings; tie clips; cufflinks; earrings; chokers; rings; wallets; purses; card holders; umbrellas; sunglasses; glasses cases; phone cases; retail services in connection with the aforesaid goods.

As a consequence of this use the Opponent enjoys an extensive goodwill and reputation in the trade mark MANGO. The adoption by the Applicant of a trade mark similar to Opponent's trade mark MANGO, namely YANGO, would constitute a misrepresentation and would cause confusion with the Opponent's trade mark and damage to the Opponent's goodwill.”

The Applicant's counterstatement

18. The Applicant filed a notice of defence, with a 23-page counterstatement, resisting both grounds of the opposition. The Applicant acknowledges “there are some similarities in the specifications of the two marks” but does not specify which¹, or to what extent. It also extensively challenges the Opponent's claimed bases for similarity between the

¹ Elsewhere in its counterstatement the Applicant accepts that there are similarities in the goods specified Class 3, Class 14 and Class 25.

respective goods and services, but for reasons that will become clear, I do not consider it necessary to set out those points in this decision.

19. The Applicant also makes points denying that its applied-for mark is similar to Mark 1 or Mark 2. It states that the respective marks are not visually similar, highlighting the presence of stylisation in the earlier marks, and to the additional word “MAN” in Mark 2. It contends that the marks are not phonetically similar, pointing out the different syllables “YAN-GO” and “MAN-GO”. It states that “the differences between the first syllables of the marks is of particular importance, as the relevant consumer will read a mark from left to right and, therefore, will instantly perceive these differences in the signs.” The Applicant also highlights the third syllable “MAN” in Mark 2, adding an alliterative aspect to that mark.
20. The Applicant also states: “Conceptually, the first word of the earlier marks, 'MANGO', has a meaning. The English-speaking public would perceive the sign as referring to the 'fruit of the mango tree'. It means 'a fleshy, oval, yellowish-red tropical fruit with a hard central stone and juicy aromatic pulp'. The additional word of one of the earlier marks, 'MAN' refers to an adult human male and also has conceptual meaning. In direct contrast, the subject mark, 'YANGO' has no conceptual meaning and is a made-up word. As such, no conceptual comparison can be made between the respective marks, and they are dissimilar.”
21. In response to the Opponent’s claim under section 5(4)(a), the Applicant argues - among various contentions in its counterstatement – that “there is no relevant degree of similarity between the marks in question” to establish a link or connection between the trade marks “let alone likelihood of confusion, due to the significant differences between the marks at hand. The relevant consumer circles will not recognise any earlier unregistered mark or alleged brand in the subject mark but will consider the subject mark as a different and clear badge of origin for the services provided by the Applicant in the marketplace.” The Applicant contends that “consumers will not experience a misrepresentation of the earlier marks [sic] when seeing the subject mark.”

Papers filed and representation

22. The Opponent filed evidence, which I summarise below. The Applicant filed no evidence. Both parties filed written submissions in lieu of an oral hearing which I have read and considered but to which I refer only as necessary in this decision.
23. The Applicant is self-represented in these proceedings and the Opponent is represented by Maguire Boss. Neither party requested a hearing and I take this decision based on a careful reading of the papers received and taking into account relevant jurisprudence.

The Opponent's Evidence

24. The Opponent's evidence is a witness statement of David Tate, dated 5 July 2017, plus Exhibits DT1 – DT9. Mr Tate states he has been a trade mark attorney with Maguire Boss since November 2005 and his statement describes the contents of the exhibits. **Exhibit DT1** presents extracts from the 2015 "Sustainability Report" for the Opponent's MANGO group of companies, showing that its principal corporate purpose is "the design, manufacture, distribution and marketing of clothing garments and accessories through the MANGO/MNG fashion distribution chain". It also shows that in 2015:
 - the MANGO group had 61 stores/outlets in UK, 2730 stores in 109 countries, over 16,000 employees worldwide and a worldwide turnover of 2,327 million EURO;
 - its advertising campaigns featured Kate Moss, Cara Delevingne and Zinedine Zidane and www.mango.com received 343 million visits.
25. **Exhibit DT2** shows the annual turnover for MANGO UK in the years 2004 – 2016 ranged from nearly 24 million to nearly 42 million pounds sterling.
26. **Exhibits DT3** and **DT4** are extracts from Interbrand reports, which show the MANGO brand ranked in the top twenty top performing European retail brands in 2008 and 2014. These exhibits include both Mark 1 and the plain word mark;
27. **Exhibit DT6** are website screen shots showing that in the UK, the MANGO group's products are sold by the likes of Debenhams, ASOS, House of Fraser and Next. The exhibit shows various clothing, including women's tops, dresses and jackets.

28. **Exhibit DT7** shows copies of web pages from the UK section of the MANGO website showing the general types of products sold under the brand MANGO in the UK - Mark 1 is clearly shown on the web pages. The categories of items listed include: dresses; jumpsuits; shirts; t-shirts and tops; cardigans and sweaters; sweatshirts; jackets; coats; trousers; jeans; shorts; skirts; lingerie; sleepwear; beachwear; sport; shoes; bags; wallets and cases; jewellery; scarves; sunglasses; belts; other accessories; beachwear; office wear; maternity.
29. **Exhibit DT8** shows copies of web pages from the UK section of the MANGO website showing examples of the specific types of products sold under the trade mark MANGO in the UK from the Autumn / Winter 2016 collection – again Mark 1 is clearly shown on the web pages.. Those goods include pictures of jackets, jewellery, bags, various tops, sunglasses, scarves, belts, skirts, trousers, underwear, shirts, coats and dresses.
30. **Exhibit DT9** is a selection of online articles relating to the MANGO brand from the UK Press, including a short profile in The Telegraph online from July 2016, an article from The Guardian in 2011, from The Independent from 2017 and from The Mirror in 2015.

My approach in this decision

31. The Opponent's MARK 1 is clearly closer than its MARK 2 to the Applicant's mark, and the (more extensive) coverage of the goods and services under MARK 1 also better matches those under the Applicant's mark. However, MARK 1 appears to have been refused for registration at EUIPO, and although it currently appears to remain subject to examination, it is possible that MARK 1 may never be registered. Any finding I may make on the basis of MARK 1 could at this stage therefore only be provisional, pending the outcome at the EUIPO.
32. The Opponent also claims under section 5(4)(a) of the Act to have earlier unregistered rights in the sign MANGO in relation to certain goods and their related retail services. Since MARK 1 is simply a stylised version of that same word, and since there is a good deal of commonality between the goods and services claimed under MARK 1 for the section 5(2)(b) ground and the goods and services claimed in respect of the

unregistered sign, I consider it efficient in this case to deal initially with the section 5(4)(a) claim, returning to the section 5(2)(b) claim only to the extent necessary.

Section 5(4)(a) decision

33. Section 5(4)(a) of the Act states: “A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

34. Case law sets out the elements required to be present to succeed in an action for passing off. In *Reckitt & Colman v Borden*², Lord Oliver reduced the five guidelines laid out by Lord Diplock in *Erven Warnink v. Townend*³ to three elements, to the effect that the Opponent must demonstrate that:

i. its goods or services must have acquired goodwill or reputation in the mind of the purchasing public and be known on the market by some distinguishing feature;

ii. there is a misrepresentation by the applicant leading or likely to lead the public to believe that the goods or services offered by the applicant are the goods or services of the opponent; and

iii. the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

35. The above three conditions are cumulative and a passing off action cannot succeed where there is a failure to satisfy any one of them.

36. In the present case I am satisfied that there clear evidence of a strong retail presence in the UK under the MANGO sign for clothing and accessories, which certainly covers

² *Reckitt & Colman Products Ltd v Borden Inc* [1990] WLR 491; [1990] 1 All ER 873; [1990] RPC 340, HL

³ *Erven Warnink v. Townend & Sons Ltd.* [1979] AC 731, 742 (HL)

most (and quite possibly all) of the goods claimed under the passing off ground. In relation to that UK trade I note in particular its numerous high street stores, its online presence and its annual turnover in the tens of millions of pounds since at least 2004. I find that the Opponent has satisfied the burden of proving goodwill in relation to the goods and retail services relied on for its section 5(4)(a) claim.

37. The Opponent also has the burden of proof to show a false representation (intentional or otherwise). The traditional form of misrepresentation in a passing off claim is as to the 'source' of the goods or services and occurs where the defendant uses a word or name that the public associates with the claimant's business that gives rise to the impression that the business of the claimant and the defendant are in some way connected. Such a misrepresentation is objectionable because it deceives or is likely to deceive the public and attempts to ride on the back of the claimant's goodwill. Evidence of actual confusion is not necessary, but it must be shown that a "substantial number"⁴ of the relevant public must be likely to be deceived by the defendant's mark. The relevant public comprises the customers (actual or prospective)⁵ of the claimant.
38. In the present case I find that the distinctions between the two marks are such that there is no misrepresentation. While clearly the words YANGO and MANGO share four of their five letters - "ANGO" - the different opening letter of each word is obvious and changes not only the look and sound of the marks, but also the conceptual impression. YANGO is an invented word whereas MANGO has a readily identifiable concept (a tropical fruit / tree). The relevant public would have no reason to consider YANGO to be associated with the MANGO brand. In the absence of this second essential element a passing off action could not succeed. I therefore find that the opposition based on section 5(4)(a) must fail.

Section 5(2)(b) decision

39. The sign used in the passing off claim, being simply a word without stylisation, is closer to the Applicant's mark than is either MARK 1 or 2 relied on under section 5(2)(b). And the goods and services in which I have found the Opponent to have goodwill have, at

⁴ Again per Lord Oliver in *Reckitt & Colman v Borden*.

⁵ *Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd)* [2012] EWHC 2230 (Ch)

least in many cases, directly identical counterparts in the Opponent's registrations (for example goods in Class 25 including clothing, footwear, headgear, sportswear). Yet the passing off claim has failed on the basis of my finding that the words YANGO and MANGO are insufficiently similar to sustain a claimed misrepresentation. In these circumstances I will deal with the section 5(2)(b) ground relatively briefly, since it entails comparable relevant considerations around the visual, aural and conceptual similarity of the marks in the context of likely confusion. Given the presence of the additional word in Mark 2, I will focus on Mark 1, since it is clearly closer to the Applicant's mark than is Mark 2.

40. Section 5(2)(b) of the Act states:

"... 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."

41. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

Sabel BV v Puma AG, Case C-251/95;

Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97;

Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97;

Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98;

Matratzen Concord GmbH v OHIM, Case C-3/03;

Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04;

Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P; and

Bimbo SA v OHIM, Case C-591/12P.

The principles are that:

- (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 the respective goods and services

42. I have noted the parties' claims and submissions as to the extent to which their respective goods and services are identical or similar, including an acceptance by the Applicant that there are similarities in the goods specified Class 3, Class 14 and Class 25. There are directly identical terms in the parties' specifications – for example *perfumery* and *cosmetics* in Class 3 and *clothing*, *footwear* and *headgear* in Class 25. I shall therefore decide this ground on the basis that I find that at least some of the respective goods at issue are identical.

The average consumer and the purchasing process


43. The average consumer for the respective goods will be a member of public. The consumer of the services may include the public, but may also include businesses. I would expect no more than a normal level of attention in the selecting and purchasing of the goods at issue; the services may attract a slightly higher level of attention.

44. The purchasing act will be visual as the goods and services are likely to be offered and branded through a range of visual communications, including images on websites and in hard copy publicity literature and the goods will be seen on display in retail outlets. However, I do not discount aural considerations which may also play a part, including as part of advertisements or word-of-mouth recommendations, so the way the marks sound will also be relevant.

Comparison of the marks

45. It is clear from *Sabel* 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. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks.

46. The respective trade marks are:

YANGO	
The Applicant's contested trade mark	The Opponent's Mark 1

47. The overall impression of the Applicant's mark is simply that it is the made-up word "YANGO". The overall impression of the Opponent's Mark 1 is that it is the standard and well-known dictionary word MANGO. The thick uppercase font with small interruptions in each of the letters is not a negligible feature, and does contribute to the overall impression of the mark, but it is the word itself that clearly plays the most important and distinctive role in the mark.

Visual similarity

48. The marks differ in that the Applicant's mark is figurative, being presented in a particular (though not especially fancy) font, incorporating apparent breaks in each of the letters comprising the word. Both words involve five letters, which differ only in their respective first letters – Y and M. Whilst I note that each of those initial letters features a central "V"-shaped element, they are plainly the ordinary capital letters Y and M, which the average consumer will readily distinguish. It is considered a rule of thumb that in assessing similarity of trade marks the attention of the public fixes more readily on the

first part of a mark than on its end. Despite the shared -ANGO component, I find the marks visually similar to no more than a medium degree.

Aural similarity

49. Again noting that the attention of the public tends to fix more readily on the first part of a mark than on its end and that the opening letters are the quite different sounding letters Y and M, I find the marks to be aurally similar to no more than a medium degree.

Conceptual similarity

50. Mark 1 depicts the word MANGO, which the average consumer will know to be the name of a fruit (and tree). YANGO has no conceptual meaning and is a made-up word. The marks are conceptually dissimilar.

Distinctive character of earlier trade mark

51. The more distinctive the earlier mark, either by its inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer* the Court of Justice of the European Union (CJEU) stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the

proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

52. The word MANGO does not directly describe or allude to the Opponent's goods or services and therefore enjoys a reasonable degree of inherent distinctiveness for its goods and services.
53. I find that the Opponent's evidence, which I summarised earlier in this decision, is certainly sufficient to show an enhanced level of distinctiveness in relation to the range of goods and related retail services relied on under the passing off ground. I find that the distinctiveness of the earlier mark is therefore enhanced to the extent that those goods and services find counterparts in the specification of goods and services under Mark 1. Combined with the degree of inherent distinctiveness of the mark, I find the Mark 1 has a high degree of distinctiveness for those goods and services (essentially clothing and its retail).

Conclusion as to likelihood of confusion

54. I now turn to make a global assessment as to the likelihood of confusion between the marks if they were used in relation to the goods and services specified. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of weighing up the combined effect of all relevant factors in accordance with the authorities I have set out in this decision (at paragraph 41).
55. Earlier in this decision I have found that at least some of the goods of the parties are identical (including clothing for example) and that the Opponent's Mark 1 has a high degree of overall distinctiveness character for clothing and its retail (its inherent distinctiveness enhanced through use). These factors clearly weigh in favour of the Opponent. I have found that the average consumer of the goods is a member of the public, who will pay no more than a normal level of attention in the purchasing process. The goods will be selected by predominantly visual means, but aural considerations may play a part in the selection process and I have found the Applicant's mark to be

visually and aurally similar to Mark 1 to no more than a medium degree. However, I have also found that those marks are conceptually dissimilar and it is this point that I consider most influential in this decision. It is clear from case law⁶ that conceptual differences may counteract visual and phonetic similarities where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public.

56. Weighing in the balance all of the above factors I find in this case that there would be no likelihood of confusion on the part of the relevant UK public as to the origin of the goods, including a likelihood of association. I find this to be the case even taking account of the interdependence principle - that in assessing likelihood of confusion, a lesser degree of similarity between marks may be offset by a greater degree of similarity between the goods and services at issue.
57. Since I have found no likelihood of confusion based on identical goods, there clearly can be none for goods or services that may be only similar or where they have not been shown to have an enhanced level of distinctive character through use. The additional word “MAN” in Mark 2 is a point of difference from the Applicant’s mark that is absent from Mark 1, thus the Opponent’s claim under Mark 2 does not succeed either. **Consequently, the opposition also fails on its section 5(2)(b) grounds.**

Costs

58. The opposition has failed and the Applicant is entitled to a contribution towards its costs. I take account of the scale published in Tribunal Practice Notice 2/2016 and award the Applicant the sum of £450 as a contribution towards the cost of the proceedings, calculated as follows:

Considering the other side’s statement of grounds and preparing a counterstatement	£250
Consideration of the Opponent’s evidence	£200
Total:	£450

⁶ See ruling of the Court of Justice of the European Union in *The Picasso Estate v OHIM*, Case C-361/04 P, at paragraph 20.

59. I therefore order Consolidated Artists B.V. to pay Yango International Ltd the sum of £450 (four hundred and fifty pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of March 2018

Matthew Williams

For the Registrar, the Comptroller-General

ANNEX A

List of goods and services specified in respect of the Opponent's Mark 1 and Mark 2

Mark 1


Opponent's Mark 1 (EUTM No. 9850785)		MANGO
Class	Goods	
3	<p>Soaps, cakes of soap, toilet soaps; Perfumery, perfumes, toilet water, eau de Cologne; Perfume water; Essential oils, oils for toilet purposes, almond oil; Cosmetics, oils and lotions for cosmetic purposes; Cosmetic creams, cosmetic preparations for skin care; Almond milk for cosmetic purposes; Cosmetic preparations and salts for the bath (not for medical purposes); Creams, milks, lotions, gels and powders for the face (not for medical purposes), body and hands; Tissues impregnated with cosmetic lotions; Moisturising emulsions; Cosmetic masks; Sun-tanning and after-sun creams, milks, gels and oils for cosmetic purposes; Tanning preparations; Sun tanning preparations (cosmetics); Shampoo; Hair lotion; Mousses and balms for hair care; hair gels and hair wax; Shaving preparations, aftershaves; Personal deodorants; Deodorants for personal use; Potpourris [fragrances]; Nail varnish and polish; Hair spray; False nails; Adhesives for fixing false nails; make-up and make-up re-moving products; Cosmetic pencils; Lipliner pencils, eyeliner pencils; Corrector pencils; pencils for eye lining; Lipstick; Lip gloss (shine); Mascara; Cosmetics for eye-lashes; Eyelashes (False -); Eyelashes (Adhesives for affixing false -); under eye cover; Make-up; Blusher, eye shadow, eye shadow base; Make-up powder; Make up foundations; Adhesives for cosmetic purposes; Cosmetic preparations for slimming purposes; Shampoos for pets [non-medicated grooming preparations]; Cotton wool for cosmetic purposes; Cotton sticks for cosmetic purposes; skin whitening; Hair dye; Hair-waving preparations; Depilatory preparations; Wax (Depilatory -); Transfers (Decorative -) for cosmetic purposes; Cosmetic kits; Bleaching preparations [decolorants] for cosmetic purposes; Incense; Nail varnish removing preparations; Sachets for perfuming linen; Dentifrices; Dental bleaching gels; Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Polishing stones; Pumice stone; Smoothing stones.</p>	
	<p>Sunglasses, eyeglasses for sports practice; Frames (casings) for spectacles and sunglasses; Spectacle and sunglasses cases; Camcorders; Scientific (other than for medical purposes), nautical, surveying, photographic, cinematographic, weighing,</p>	

9	<p>measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus for recording, transmission or reproduction of sound or images; cameras (cinematographic cameras); Photography screens; Projection screens; Fluorescent screens; Video screens; Monitors (computer hardware); Radio, including for vehicles; receivers (audio, video); Television apparatus; Video recorders; Cassette players; Compact disc players; Readers (data processing equipment); DVD players; Optical character readers; Timetables (Electronic -); Pocket calculators; Electronic pocket translators; Satellite navigational apparatus; Navigation apparatus for vehicles (on board computers); Batteries, electric; Magnetic cards; Smart cards with chips; Compact discs (audio-video), Optical discs, Compact discs [read-only memory]; Compact discs with read-only memory and interactive compact discs; Optical and magnetic data media; Audio-visual teaching apparatus; Instructional and teaching material, in the form of CD-ROMs; Software [programas grabados]; Downloadable software; Electronic publications, downloadable; Exposed cinematographic film; Transparency projection apparatus; Transparencies [photography]; Data-processing apparatus and equipment; Computers; Peripherals adapted for use with computers; Computer memory devices; Modems; Automatic vending machines and mechanisms for coin-operated apparatus; Cash registers; Calculators; Clothing and footwear for protection against accidents, irradiation and fire; Protective helmets and masks; Diving suits, gloves for divers and divers' masks; Magic lanterns; Juke boxes, musical; Personal stereos; Headphones; Walkie-talkies; Telephone receivers; Telephones including mobile telephones; Carrying cases for portable telephones; Cases adapted for mobile phones; Battery chargers for portable telephones; Battery chargers for portable telephones for use in vehicles; Covers for mobile phones; Portable telephones including large keys and numbers intended to help people with sight and dexterity problems; Computer applications software for portable telephones; Computer software designed to enable the transmission of photographs to portable telephones; Devices for hands-free use of mobile phones; Digital cellular phones; Hands free kits for phone; Keyboard for cellular phone; Laptop computers; Straps for portable telephones; Radio pagers; Video telephones; Answering machines; Hands free kits for phones; Loudspeakers and cabinets for loudspeakers; Amusement apparatus adapted for use with an independent display screen or a monitor; Apparatus for games adapted for use with an external display screen or monitor; Facsimile machines; Make-up removing appliances electric; Electrical irons.</p>
	<p>Timepieces, watches, alarm clocks, clocks and chronometric instruments; Jewellery, rings, bracelets, chains, necklaces, pendants, brooches, earrings, medals, medallions</p>

14	(jewellery), cufflinks, tie pins, jewel brooches; Precious stones; Key rings [split rings with trinket or decorative fob]; Ornaments for mobile phones; Novelty accessories for mobile phones, namely decorations for mobile phones, jewels for mobile phones, mobile phone charms; Precious metals and their alloys (except for dental use) and goods made of these materials (precious metals and their alloys) or coated therewith not included in other classes, namely: figurines, works of art, statues, statuettes, boxes, jewellery boxes, cases, badges for wear, coins; Cases for watches.
18	Leather and imitation leather; Leatherware of leather or imitation leather (except cases adapted for the goods they are designed to carry, gloves and belts); Trunks and travelling bags; Cases and boxes of leather or leatherboard; Traveling trunks; Attaché cases; Briefbags; Handbags; briefcases; School satchels and school bags; Shopping bags and net bags for shopping; Bags [envelopes, pouches] of leather, for packaging; Sling bags for carrying infants; Backpacks; Wheeled shopping bags; Bags for climbers; Bags for campers; Beach bags; Travelling bags; Bags (Garment —) for travel; Card cases (notecases); Wallets; purses(not of precious metal); Purses; Mesh bags not of precious metals; Key cases (leatherware); Hat boxes of leather; Vanity cases (not fitted); leather shoulder belts; Cords, strapping, wires, thongs, tapes and bands of leather; Collars and clothing for animals; Dog collars; Leads, muzzles; Coverings of skins which made of furs; Animal skins, hides; Umbrellas, parasols and walking sticks; Umbrella covers; Whips, harness and saddlery.
25	Outerclotthing and underwear for men, women and children; Clothing of leather or imitations of leather; Clothing made of fur; Sportswear (other than for diving); Blousons; Gabardines (clothing); Rainproof clothing; Coats; Mantillas; Fingerless gloves; Topcoats; Trench coats; Parkas; Pelerines; Pelisses; Stuff jackets [clothing]; Suits; Masquerade costumes; Jackets [clothing]; Overalls; Aprons (clothing); Jumpsuits (clothing and underwear); Crop tops; Cardigans; Sweaters; knitted goods (clothing); Vest tops; Waistcoats; Skirts; Petticoats; Trousers; Gowns; Saris; Shirts; Short-sleeve shirts; Tee-shirts; Sweat shirts; Shorts; Bermuda shorts; Ready-to-wear clothing; Paper clothing; Muffs [clothing]; Pyjamas; Robes; Pants, including bathing trunks; bathing and beach suits; Jerseys, including swimsuits; Bathwraps; Underwear; Bodies (teddies); Bustiers; Knickers; Briefs; Brassieres; Corsets; Stocking suspenders; Socks; Stockings; Tights; Hosiery; Bandanas [neckerchiefs]; Scarves; Shawls; Collars for clothing; Sashes for wear; Stoles (fur); Gloves; Belts [clothing]; Suspenders; Neckties; Bow ties; Pocket handkerchiefs (clothing); Collar protectors; Footed pyjamas, brassieres, layettes; Bibs, not of paper; napkins (babies' —) of textile; Babies diapers of textile; Shoes; Footwear, including beach footwear; Sports shoes and ski

	boots; Boots; Booties; Clogs (footwear); Espadrilles; Sandals; Bath sandals; Slippers; Headgear; Hats; Veils [clothing]; Caps [headwear]; Visors (hatmaking); Berets; Caps, including swimming caps; Headbands (clothing); Turbans.
35	Advertising, including online advertising on a computer network; Rental of advertising space; Organisation of exhibitions and trade fairs for business and promotional purposes; Bill-posting; Dissemination of advertising matter, direct mail advertising (including leaflets, prospectuses, printed matter and samples); Publicity columns preparation; Updating of advertising material; Sales promotion; Shop window dressing; Demonstration of goods; Distribution of advertising samples; Modelling for advertising or sales promotion; News clipping services; Television advertising; Business management; Business administration; Office functions; Consumers (Commercial information and advice for -) [consumer advice shop]; Business management of hotels; Retailing of clothing, footwear, headgear, perfumes, cosmetics, table linen, household and bed linen, stationery, tableware, candles, mobile phone accessories, spectacles, jewellery, watches and leatherware; Import-export agencies; Presentation of goods, namely of clothing, footwear, headgear, perfumery, cosmetics, table linen, household linen, bed linen, stationery, tableware, except forks, knives and spoons, candles, mobile telephone accessories, spectacles, jewellery, watches and leatherware, on all kinds of communications media, for retail purposes; Sales promotion for others; Retailing online, retailing by mail order, sales depots and teleshopping all offering sale of clothing, footwear, headgear, perfumes, cosmetics, table linen, household and bed linen, stationery, tableware, candles, mobile phone accessories, spectacles, jewellery, watches and leatherware.

Mark 2

Opponent's Mark 2 (EUTM No. 13453576)		
Class	Goods	
14	Timepieces; Watches; Watch straps, clasps and buckles; Alarm clocks; Pendulum clocks; Time instruments; Cases for clock and watch-making, cases for watches (presentation); Jewellery; Jewellery; Rings (jewellery, jewelry (am.)); Bracelets; Chains; Necklaces; Pendants; Broaches; Earrings; Medals; Medallions (jewellery); Cufflinks; Tie pins; Clasps; Jewellery stones; Ornaments for mobile phones; Charms and pendants for mobile phones; Key rings [trinkets or fobs].	
18	Leather and imitations thereof; Imitation leather; Trunks [luggage]; Baggage; Cases and boxes of leather or leatherboard; Baggage; Baggage; Travelling sets (leatherware); Vanity cases (not fitted); Briefcases; Briefcases; Briefcases; Card cases (notecases); Baggage; Coin purses; Satchels; Bags and sacks (envelopes, pouches) of leather for packaging; Rucksacks; Wheeled shopping bags; Beach bags; Bags for climbers; Bags for campers; Bags (Game -) [hunting accessories]; Luggage garment bags for travel; Baggage; Chain mesh purses; Key cases (leatherware); Hat boxes of leather; Shoulder belts of leather; Cords, strapping, wires, thongs, tapes and bands of leather; Coverings of skins (furs); Animal skins, hides; Parasols; Parasols; Umbrellas; Umbrella covers; Umbrella sticks; Walking sticks; Whips, harness and saddlery.	
25	Outerwear and underwear; Gabardines (clothing); Rainsuits; Jackets; Mittens; Topcoats; Trench coats; Blousons; Parkas; Pelerines; Hoods(clothing); Pelisses; Jackets (Stuff -) [clothing]; Ponchos; Suits; Masquerade costumes; Uniforms; Jackets [clothing]; Overalls; Aprons for wear; Combinations (clothing); Cardigans; Pullovers; Pullovers; Knitwear (clothing); Vest tops; Waistcoats; Pants (Am.); Sarongs; Shirts; Short-sleeve shirts; Tee-shirts; Sweat shirts; Shorts; Bermuda shorts; Clothing of leather and of imitations of leather; Clothing made of fur; Sportswear (other than for diving); Ready-to-wear clothing; Paper clothing; Pyjamas; Dressing gowns; Dressing gowns, including bathrobes; Pants, including bathing trunks; Jerseys, including swimsuits; Underwear; Underwear; Pants (Am.); Socks; Hosiery; Bandanas [neckerchiefs]; Scarves; Neckerchieves; Sashes for wear; Gloves [clothing]; Belts (clothing); Garters; Ties; Bowties; Pocket handkerchiefs (clothing); Collar protectors;	

	Footwear; Footwear, including beach footwear; soles for footwear; Non-slipping devices for footwear; Sports shoes; Ski boots; Boots; Ankle boots; Clogs (footwear); Espadrilles; Sandals, Including bath slippers; Slippers; Slippers; Headgear; Headgear; Caps [headwear]; Peaks (cap -); Berets; Caps, including swimming caps; Birettas (headwear); Headbands (clothing); Turbans; Ear muffs (clothing).
35	Advertising, including online advertising on a computer network; Mail advertising (including by electronic means); Television commercials; Rental of advertising space; Organisation of exhibitions and trade fairs for commercial or advertising purposes; Bill-posting services; Dissemination of advertising matter, direct mail advertising; Publicity columns preparation; Updating of advertising material; Shop window dressing; Demonstration of goods; Distribution of advertising samples; Modelling for advertising or sales promotion; News clipping services; Business management; Business administration; Consumers (Commercial information and advice for -) [consumer advice shop]; Price comparison services; Telemarketing services; Administrative management of promotional gifts; Organisation of promotional and advertising operations to encourage customer loyalty; Business management of hotels; Retailing, in shops or on a retail website, of clothing, footwear, headgear, perfumery, cosmetics, table linen, household linen, stationery, tableware, candles, mobile phone accessories, spectacles, jewellery, watches and leatherware; Import-export agency services; Presentation of clothing, footwear, headgear, perfumery, cosmetics, table linen, household linen, stationery, tableware, candles, mobile phone accessories, spectacles, jewellery, watches and leatherware on communications media of all kinds, for retail purposes; Sales promotion (for others).