

O/616/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3563043

**IN THE NAME OF
ZHIMENG PAN**

**TO REGISTER THE FOLLOWING TRADE
MARK:**

MISFAY

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425395
BY TOD'S S.P.A**

Background and pleadings

1. On 2 December 2020, Zhimeng Pan ('the applicant') applied to register the trade mark MISFAY. It was accepted and published in the Trade Marks Journal on 9 April 2021 in respect of the following goods:

Class 25: Dress, Coat, Vest, Underpants, Pullovers, Jumpers (pullovers), Tights, Leggings, Knitwear, sports singlets, shirts, pants, leggings [trousers].

2. On 6 July 2021, TOD'S S.p.A. ("the opponent") filed a notice of opposition against the application. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the applied for goods. This is on the basis of its earlier rights, the details of which are set out below (and in annexes at the end of this decision):

Earlier Mark	Registration no.	Filing/Registration date	Goods relied upon
FAY	EU 010158996 ¹	28 July 2011 12 January 2014	Goods in class 25 as set out in paragraph 32
	EU 018026127	22 February 2019 24 July 2019	Goods in class 25 as set out in Annex A

¹ Although the UK has left the EU and the EUTM relied upon by the applicant enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application.

	UK00003074932	1 October 2014 26 December 2014	Goods in class 25 as set out in Annex B
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3. In its notice of opposition, the opponent contends that the competing trade marks are highly similar and that the respective goods are identical or similar, giving rise to a likelihood of confusion.

4. By virtue of their earlier filing dates, the opponent's trade marks are earlier marks, in accordance with section 6 of the Act. The first and third earlier marks had completed their registration processes more than five years before this date and are therefore subject to the proof of use provisions contained in section 6A of the Act.

5. Initially, the opponent only relied upon its '127 and '932 marks. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of its earlier '932 mark, and also requesting proof of use for the '127 mark.² On 26 October 2021, the opponent requested to rely upon the additional '996 mark under section 5(2)(b). The registry allowed this and, in its letter, dated 11 November 2021 requested the applicant to file an amended TM8 and counterstatement to address the additional claim.

6. Despite several reminders from the registry, the applicant did not file an amended TM8 and counterstatement. As a result, the registry wrote to the applicant on 23 March 2022, the contents of which are as follows:

² This mark was not yet subject to proof of use provisions in accordance with 6A of the Act, and the applicant was informed its TM8 should be amended accordingly on this basis within its letter dated 24 February 2022.

I refer to the official letter dated 24 February 2022 in which you were given a final opportunity to file an amended Form TM8. As no response has been received, the Tribunal intends to proceed as following:

(i) In the original Form TM8, the applicant asked for Proof of Use for EU18026127. As this trade mark has not been registered for 5 years, it cannot be subject to Proof of Use, therefore the reference to EU18026127 shall be struck out.

(ii) The later added trade mark, EU10158996, which was allowed into the proceedings on 11 November 2021, shall be treated as if Proof of Use has not been sought.

(iii) The applicant will be treated as denying the opponent's claim in relation to the likelihood of confusion with EU10158996.

*If either party disagrees with the preliminary view, you may request a hearing within 14 days of the date of this letter, that is on or before **06 April 2022**.*

7. On 31 March 2022, the applicant filed an amended TM8 and counterstatement however, no hearing was requested. Both parties were informed in the registry's letter dated 29 April 2022 that the amended form would not be admitted into the proceedings. Consequently, my decision shall proceed as set out in the previous paragraph above.

8. The opponent is represented by Boulton Wade Tennant LLP whereas the applicant is represented by Weilin Xiao. Both parties filed evidence. Neither party requested a hearing however, the opponent did file written submissions in lieu. I now make this decision after careful consideration of the papers before me.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

10. The opponent filed its evidence in the form of two witness statements. The first witness statement dated 18 November 2021 is in the name of Emilio Macellari a member of the board of directors and special proxy holder of the opponent's company. The witness statement is accompanied by four exhibits. The second witness statement dated 22 November 2021 is from Daniela Paull, a chartered trade mark attorney and senior associate at the opponent's representative's firm. The witness statement is accompanied by one exhibit.

11. In the first witness statement, Mr. Macellari explains that the Fay brand's history dates back to the early 1980s in the US when Diego and Andrea Della Valle (the company's chair and vice chair) discovered the work jackets worn by the Maine fire department. They took over the Fay brand, a specialist producer of technical garments and brought it to Italy with the idea to adapt workwear to the urban environment. The work jacket was soon elevated to cult status in capitals worldwide and is now accompanied by a clothing range which focuses on outerwear.³

12. Mr. Macellari has provided sales figures for Fay branded products in the UK between 2016 and 2020. The figures have been provided in Euros (rounded to the nearest ten) however, an approximation in GBP has also been provided:

Year	Gross sales EURO	No of items	Approximation in GBP
2016	-3,130	-20	-£2,720
2017	330	2	£280
2018	94,790	1,562	£82,460
2019	-13,970	-63	-£12,150
2020	3,420	23	£2,970

13. Further, Mr. Macellari has also provided advertising expenditure figures for the Fay brand in the UK from 2016 to 2020, the figures are as follows:

³ See paragraph 4 of the witness statement of Emilio Macellari

Year	Advertising spent (EURO)	Approximation in GBP
2016	15,100	£13,130
2017	17,400	£15,130
2018	4,900	£4,260
2019	1,800	£1,560
2020	5,900	£5,130

14. Exhibit EM01 provides screenshots from FAY’s YouTube channel showing several fashion show launches and advertising videos between 2016 and 2018. Exhibit EM02 includes screenshots of the company’s Instagram pages displaying images of FAY clothing. Exhibit EM03 comprises of press articles of celebrities wearing FAY clothing and exhibit EM04 shows screenshots from FAY’s Facebook and Instagram pages taken on 16 November 2021.

15. In the second witness statement from Daniela Paull, a single exhibit is provided which includes screenshots from websites illustrating fashion brands using the term “miss” to denote fashion brands or sub-brands targeted at a younger female audience. The brands shown include Miss Selfridge, Miss KG, Miss Levi’s, Missguided and Lee and Wrangler featuring a “Misses” size for some items of their clothing.

16. Turning to the applicant’s evidence, one witness statement dated 22 January 2022 and eight exhibits were provided by Weilin Xiao, the appointed representative of the applicant. They explain in their witness statement that their company has been using the name MISFAY for selling their products in the UK and European Union since 17 December 2020.

17. Exhibits WX1-5 comprises of VAT invoices, exhibit WX6 is an advertising invoice from Amazon and exhibits WX7-8 include screenshots from MISFAY’s Amazon website.

DECISION

Proof of use

18. The opponent's '966 had been registered for a period of over five years at the date that the application was filed and may ordinarily be subject to use provisions under section 6A of the Act. However, as outlined above, an amended TM8 and counterstatement was not received in the specified time following the introduction of this earlier mark into proceedings, and the parties were informed that the proceedings would therefore continue on the basis that proof of use has not been requested by the applicant in respect of this mark. The opponent may therefore rely on this earlier mark in respect of all of the goods relied upon as set out within its pleadings.

19. The opponent's '932 mark is also subject to use requirements under section 6A of the Act, and proof of use has been requested by the applicant in respect of the same. However, I note the opponent has identified its '996 word mark FAY as its strongest case. In its submissions in lieu, the opponent states that the '996 mark is the main focus of their submissions, and should the opposition based on this mark fail, the opposition based on the two stylised marks ('932 and '127) is also likely to fail. Considering the opponent's '996 mark and applicant's mark are both word marks, I agree with the opponent's assertions, and I will focus my assessment under section 5(2)(b) on the opponent's '996 mark. I do not consider that assessing the remaining marks would improve upon the opponent's position, and as such, I do not consider it necessary to establish if the opponent has made genuine use of its '932 mark at this stage.

Section 5(2)(b)

20. Section 5(2)(b) of the Act is as follows:

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is

protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

My Approach

22. For the reasons identified under the proof of use section of this decision above, I will consider the 5(2)(b) ground based on the opponent's '966 mark as its best case within this opposition.

Comparison of Goods

23. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

24. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

25. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, 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”.

26. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux- Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

27. The goods to be compared are as follows:

Opponent's Goods	Applicant's goods
'996 Mark Class 25: Coats of leather, jackets of leather, trousers of leather, skirts of leather, tops of leather, waterproof clothing of leather, long coats of leather, overcoats of leather, belts of leather, shoulder belts for clothing of leather, belts, clothing, stuff jackets, jackets, greatcoats, jumpers, trousers, jeans, skirts, dresses, coats, overcoats, cloaks, parkas, jerseys of wool, shirts, tee-shirts, blouses, cardigans, underwear, nightdresses, bath robes,	Class 25: Dress, Coat, Vest, Underpants, Pullovers, Jumpers (pullovers), Tights, Leggings, Knitwear, sports singlets, shirts, pants, leggings [trousers].

bathing suits, negligees, bathing suits, dressing gowns, eveningwear, one-piece clothing, two-piece clothing, evening gowns, shawls, sashes for wear, neckties, bow ties, clothing for men, clothing for women, shirts, Hawaiian shirts, sweatshirts, underwear, polo shirts, bodysuits, blazers, shorts, sport shirts.	
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28. I consider that all of the terms in the applicant’s specification are encompassed within the opponent’s *clothing*. Consequently, these goods are, therefore, identical in line with the principles set out in *Meric*.

The average consumer and the nature of the purchasing act

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

30. The average consumer for the parties’ goods will be a member of the general public. The goods may vary in price, but none are likely to be prohibitively expensive

and all will be purchased reasonably frequently. Even where the cost of the goods is low, various factors will be considered such as aesthetics, durability, and material. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

31. The goods are likely to be self-selected from the shelves of a retail outlet or their online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought from retail assistants, I do not discount an aural component to the purchase.

Comparison of marks

32. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

33. 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 trade 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.

34. The marks to be compared are as follows:

Opponent's '996 mark	Applicant's mark
FAY	MISFAY

Overall impression

35. The opponent's first earlier mark consists of the word FAY. The overall impression resides in the mark as a whole. The applicant's mark consists of the word MISFAY. There are no other elements to contribute to the overall impression, which lies in the mark itself.

Visual comparison

36. The marks coincide in their use of the letters FAY. This forms the entirety of the opponent's mark and is wholly contained in the applicant's mark; however, the applicant's mark also contains three additional letters (MIS) at the beginning of their mark which has no counterpart in the opponent's mark. The addition of these three letters also results in the applicant's mark being noticeable longer. Overall, I find the marks to be visually similar to a medium degree.

Aural comparison

37. The opponent's mark will be pronounced in one syllable as FAY whereas the applicant's mark will be pronounced in two syllables as MIS-FAY. I find that there is some similarity as both marks include the term FAY however, the addition of MIS at the beginning of the applicant's mark creates a point of difference. I find that the marks are aurally similar to a medium degree.

Conceptual comparison

38. In their statement of grounds, the opponent contends that FAY will be considered as the common female first name by UK consumers. They go on to state that the additional MIS in the applicant's mark may be misread as MISS and aurally

the mark will be understood as MISS FAY. This may lead to the applicant's mark being perceived as a sub brand of the opponent, providing clothing to a younger audience resulting in a strong conceptual similarity between the marks⁴.

39. The opponent has supported this argument in their second witness statement which provides screenshots from websites illustrating examples of the term MISS being used by various brands to denote fashion aimed at younger women. The examples provided include brands such as Miss Selfridge, Miss KG, Miss Levi and Missguided.⁵

40. I agree with the opponent that the mark FAY will be perceived as a female name and the term MISS has been used in the fashion industry for brands aimed at younger women. I am reminded however, that the applicant's mark is presented as one word (MISFAY) rather than MISS FAY and while I accept that a small minority may perceive the mark as meaning MISS FAY, I find this to be unlikely and I do not believe these consumers will make up a significant portion, and as such I do not need to consider this further. However, I do find that a significant proportion and the vast majority of relevant consumers will perceive MISFAY as an invented word with no attributable meaning. Consequently, I find there is no conceptual similarity between the marks.

Distinctive character of the earlier mark

41. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, the CJEU stated that:

⁴ See paragraph 10 of the opponent's statement of grounds.

⁵ See Exhibit DP1 of the witness statement of Daniela Paull.

“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).”

42. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

43. The earlier ‘966 mark consists solely of the word FAY. As previously stated, this will likely be perceived as a female name. I consider that female first names are not particularly distinctive in respect of clothing however, the word is neither descriptive nor allusive of the goods for which it is registered. Consequently, I find the mark to be inherently distinctive to no more than a medium degree.

44. I now turn to consider whether the distinctiveness of the earlier '996 mark has been enhanced through use.

45. Previously in paragraphs 12 and 13 of this decision, I outlined the opponent's UK sales and advertising figures. The figures appear to fluctuate and are fairly limited. Although information regarding the opponent's market share in the UK has not been provided, when considering the sales and advertising figures provided in relation to the scope of the fashion industry in the UK, it would be reasonable to assume that opponent holds only a minimal amount of the UK market share.

46. Further, I note that the articles provided by the opponent in exhibit EM03 are dated within a narrow timeframe from January to March 2017 and five of the seven articles relate to socialite Olivia Palermo and advertise the same coat in each press article.

47. The opponent has also provided screenshots from their Facebook and Instagram pages⁶ however, the screenshots were taken on 16 November 2021 outside of the relevant period. Even if I were to consider these screenshots, it is unclear as to what proportion of the opponent's followers and interactions are from the relevant UK public.

48. In this particular case, I do not consider that the evidence provided by the opponent is sufficient to show that the distinctiveness of their earlier '996 mark has been enhanced through use.

Likelihood of confusion

49. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind that the average consumer rarely has the opportunity

⁶ See exhibit EM04 of the witness statement of Emilio Macellari

to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

51. Earlier in my decision, I found the respective goods to be *Meric* identical. I identified the average consumer to be a member of the general public who will purchase the goods predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that a medium degree of attention will be paid during the purchasing process.

52. I found the marks to be visually and aurally similar to a medium degree and found there to be no conceptual similarity between the marks. I also found the opponent's '996 mark to have no more than a medium level of inherent distinctiveness.

53. When making my decision, I bear in mind that as a general rule the beginning of marks make more impact than the endings⁷. When considered as a whole, there is a clear difference between the marks in the presence of the letters MIS at the beginning of the applicant's mark which also results in the mark being noticeably longer than that of the opponents. In this case I find that this difference will not go unnoticed, and the average consumer will first notice the MIS element of the applicant's mark which has no counterpart in the opponent's mark. I do not find that the opponent's mark will be mistaken for the applicant's and as such, I do not consider there to be a likelihood of direct confusion.

54. I now go on to consider indirect confusion.

⁷ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

55. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

56. These examples are not exhaustive but provide helpful focus.

57. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

58. I note that the respective marks share a common element and the fact that the goods are identical is a factor weighing in the opponent's favour. Nonetheless, I have carefully considered if the marks may be perceived as a sub brand or brand extension of one another, or for them to be considered to represent economically linked undertakings and I can see no logical reason for this. I am reminded that when making a global assessment, the visual, aural and conceptual aspects of the marks do not always hold the same weight⁸. In relation to the goods, I have found that visual aspects will dominate during the purchasing process so even in the event that consumers first hear the mark as "MISS FAY", once faced with the mark, I find that the average consumer will recognise that MISFAY is presented as one word with one S as opposed to MISS FAY. This leads me to believe that consumers are unlikely to consider that MISFAY would be a sub brand of FAY targeted to a younger female audience and at best the contested mark may bring the earlier mark to mind. I am not satisfied that these circumstances give rise to a likelihood of indirect confusion, and as such, the opposition on section 5(2)(b) must fail.

Conclusion

59. The opposition under section 5(2)(b) of the Act has failed in its entirety. As previously outlined in their submissions, the opponent identified its '996 word mark as its strongest case and acknowledged that should the opposition based on this mark fail, the opposition based on its two remaining marks is also likely to fail. As such, I do not consider an assessment of the opponent's remaining marks will improve their position. Subject to any successful appeal against my decision, the application will proceed in the UK for the full range of goods applied for.

⁸ See *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

COSTS

60. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide and having considered the applicant's evidence, I found that the applicant's evidence did not assist them in this case however, I acknowledge that the applicant would have also spent time considering the opponent's evidence. On that basis, I award the applicant the sum of £400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£200
Filing evidence and considering the other side's evidence:	£200

61. I therefore order TOD'S S.p.A. to pay the sum of £400 to Zhimeng Pan. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of July 2022

Catrin Williams
For the Registrar

Annex A- EU018026127 Goods

Class 18: Wallets; purses; trunks; suitcases; beach bags; cosmetic bags sold empty; Boston bags; Handbags; traveling bags; briefcases; leather briefcases; leather credit card holders; leather document briefcases; key cases of leather and skins; sports bags namely, all-purpose sport bags, athletic bags, and bags for mountain climbing, namely, backpacks and rucksacks; evening and shoulder bags for ladies; leather shopping bags; school bags; garment bags for travel; shoe bags for travel; diaper bags; traveling trunks; duffel bags; overnight bags; carry-on bags; satchels; opera bags; unfitted vanity cases; animal hides; leather cases and boxes; bags made of leather for packaging; leather straps; umbrellas; leather leashes.

Class 25: Jackets; jumpers; trousers; skirts; dresses; coats; overcoats; parkas; shirts; underwear; swim suits; dressing gowns; shawls; scarves; ties; shoes; heels; beach shoes; gymnastic shoes; boots; ski boots; half boots; sandals; bath sandals; visors (headwear); leather jackets; leather trousers; leather belts; belts; padded jackets; stuff jackets; jeans; sweaters; evening dresses; aloha shirts; sweat shirts; undershirts; polo shirts; blazers; sport shirts; rubber shoes; galoshes; golf shoes; basketball shoes; rugby shoes; boxing shoes; baseball shoes; track-racing shoes; work shoes; field hockey shoes; handball shoes; winter gloves; Leather coats; leather skirts; leather tops; leather raincoats; leather long coats; leather overcoats; leather braces for clothing; suits; cloaks; raincoats; pullovers; T-shirts; blouses; baby doll pajamas; bathrobes; bathing costumes; negligees; nightgowns; one-piece dresses; two-piece dresses; neckties; gentlemen suits; dress shirts; body suits; shorts; athletic shoes; slippers; overshoes; low heel shoes; leather shoes; wooden clog; angler shoes; dress shoes; hiking shoes; lacquered shoes; inner soles; soles for footwear; footwear upper; heelpieces for shoes and boots; non-slipping pieces for shoes and boots; tips for footwear; rain shoes; straw shoes; arctic boots; football boots; laced boots; esparto shoes or sandals; gloves; leather gloves; mittens; hats and caps; leather hats and caps.

Annex B- UK00003074932 Goods

Class 25: Leather coats; leather jackets; leather trousers; leather skirts; leather tops; leather raincoats; leather long coats; leather overcoats; leather belts; leather braces for clothing; belts; suits; padded jackets; jackets; stuff jackets; jumpers; trousers; jeans; skirts; dresses; coats; overcoats; cloaks; raincoats; parkas; pullovers; shirts; T-shirts; blouses; sweaters; underwear; baby-dolls being nightwear; bathrobes; bathing costumes; negligée; swim suits; dressing gowns; nightgowns; one-piece dresses; two-piece dresses; evening dresses; shawls; scarves; ties; neckties; gentlemen suits; dress shirts; aloha shirts; sweat shirts; under shirts; polo shirts; body suits; blazers; shorts; sport shirts; gloves; gloves for protection against cold; leather gloves; mittens; hats and caps