

O/062/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3417763

BY

DONGGUAN BREATHWALKER SHOES CO., LTD

TO REGISTER THE TRADE MARK:

足行健

IN CLASS 25

AND

OPPOSITION THERETO UNDER NO. 418095 BY

BEIJING XIAOXIYANG TECHNOLOGY DEVELOPMENT CO.,
LTD

Background and pleadings

1. Dongguan Breathwalker Shoes Co., Ltd (“the applicant”) applied to register the trade mark below in the UK on 31 July 2019.

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2. It was accepted and published in the Trade Marks Journal on 16 August 2019 in respect of the following goods:

Class 25 Outerclotthing; underwear; sandals; shoes; sports shoes; insole; hats; hosiery; scarves; Leather belts [clothing].

3. Beijing Xiaoxiyang Technology Development Co., Ltd (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods in the application. The opponent relies upon its trade mark, shown below, number 3219034, which has a filing date of 16 March 2017 and was registered on 4 August 2017.

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4. The following goods and services are relied upon in this opposition:

Class 25 Clothing; Ready-made clothing; Underwear; Suits; Inner soles; Shoes; Hats; Hosiery; Gloves [clothing]; Girdles.

Class 35 Television advertising; Modelling for advertising or sales promotion; Advertising by mail order; Presentation of goods on

communication media, for retail purposes; Commercial information and advice for consumers [consumer advice shop]; Commercial administration of the licensing of the goods and services of others; Sales promotion for others; Procurement services for others [purchasing goods and services for other businesses]; Marketing; Provision of an on-line marketplace for buyers and sellers of goods and services.

5. In its notice of opposition, the opponent argues that the respective goods and services are identical or similar and that the marks are similar.
6. The applicant filed a counterstatement denying the claims made.
7. Neither party filed any evidence in this case.
8. No hearing was requested and so this decision is taken following a careful perusal of the papers. Both parties filed written submissions.
9. The applicant is represented by ip21 Ltd and the opponent is represented by Boulton Wade Tennant LLP.

DECISION

10. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

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

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

...”

12. Given the respective filing dates, the trade mark upon which the opponent relies qualifies as an earlier trade mark. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

13. Although the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks 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.

14. 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:

(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 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Relevant case law for words only understood by a minority ethnic group

15. Given that the marks in this case feature Chinese characters, I am guided by the relevant case law. While it is permissible to take into account the meaning of words that would only be understood by a minority ethnic group,¹ this is only likely to make a material difference where the ethnic group in question makes up a significant proportion of the average consumers of the goods/services in question.² In this case, the goods in question are clothing and footwear and the number of Chinese speakers in the population of UK consumers of these goods as a whole would be too small to be able to be taken into account. The vast majority of relevant UK consumers would not understand the meaning of the words and so the perception of those in the group that would understand the meaning of the foreign words is unlikely to be a decisive factor in the assessment of the likelihood of confusion.³

Comparison of goods and services

16. The goods and services in question are as follows:

Opponent's goods and services	Applicant's goods
<u>Class 25</u> Clothing; Ready-made clothing; Underwear; Suits; Inner soles; Shoes;	<u>Class 25</u> Outerclotthing; underwear; sandals; shoes; sports shoes; insole; hats;

¹ See the judgment of 25th June 2015 by the CJEU in *Loutfi Management Propriete Intellectuelle SARL v AMJ Meatproducts NV & Halalsupply NV*, CJEU, Case C-147/14

² See, by way of analogy, *Aranynektár Termégyártó és Kereskedelmi KFT v EUIPO*, General Court, Case T-503/15

³ See, for example, *J.W. Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290 [37] where the court described the test as being one of whether a "sufficiently significant" percentage of relevant consumers would be confused

Hats; Hosiery; Gloves [clothing]; Girdles.	hosiery; scarves; Leather belts [clothing].
<u>Class 35</u> Television advertising; Modelling for advertising or sales promotion; Advertising by mail order; Presentation of goods on communication media, for retail purposes; Commercial information and advice for consumers [consumer advice shop]; Commercial administration of the licensing of the goods and services of others; Sales promotion for others; Procurement services for others [purchasing goods and services for other businesses]; Marketing; Provision of an on-line marketplace for buyers and sellers of goods and services.	

17. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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.”

18. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert

sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

20. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

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

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

24. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

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

While on the other hand:

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

25. The applicant denies that all the its goods are identical or similar to the opponent’s class 25 goods or that its goods are similar or related to the opponent’s class 35 services.
26. The opponent contends that the applicant’s goods are identical and/or similar to its class 35 goods. If any of them were found not to be identical, it argues that they are extremely similar. It also considers there to be a similarity between the applicant’s goods and its associated services in class 35 which include clothing related services.
27. I will now make my comparison with reference to the applicant’s goods.
28. I find the applicant’s “Outerclotthing” to be *Meric* identical to the applicant’s “Clothing” in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
29. The applicant’s “underwear” and the opponent’s “Underwear” are identical.
30. “Sandals” are *Meric* identical to the opponent’s “Shoes” in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark. If I am wrong, and sandals were regarded as a separate type of footwear from enclosed shoes, the goods are highly similar in that they are both footwear. They have the same average

consumer, the same trade channels and they are in competition in that the consumer could choose sandals over enclosed shoes and vice versa.

31. "Shoes" are identical to the opponent's "Shoes".
32. "Sports shoes" are *Merix* identical to the opponent's "Shoes" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
33. "Insole" is identical to the opponent's "Inner soles".
34. "Hats" is identical to the opponent's "Hats".
35. "Hosiery" is identical to the opponent's "Hosiery".
36. "Scarves" are *Merix* identical to the opponent's "Clothing" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark. If I am wrong and scarves are seen as accessories outside the definition of clothing, they are highly similar. They are sold through the same trade channels, purchased by the same consumers, and are complementary in that a scarf would not be worn without clothing and the average consumer would see them as emanating from the same or linked undertakings.
37. "Leather belts [clothing]" are *Merix* identical to the opponent's "Clothing" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark. If I am wrong and belts are seen as accessories outside the definition of clothing, they are highly similar. They are sold through the same trade channels, purchased by the same consumers, and are complementary in that clothing is indispensable to belts and the average consumer would see them as emanating from the same or linked undertakings.
38. None of the opponent's class 35 services put it in a stronger position than its class 25 goods.

The average consumer and the nature of the purchasing act

39. 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. 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.”

40. In respect of clothing and footwear (and the related accessories if they were to be seen as separate from the definition of clothing), they are consumer items that would warrant more than a cursory degree of attention in that clothing and footwear would normally require an amount of scrutiny that would be necessary to determine size and fit, as well as style. Attention would also be paid to cost and quality. However, only at the top end of the market would the consumer pay a high degree of attention. Although there might be some verbal interaction when requesting a particular brand of clothing or footwear, visual considerations would usually predominate. Overall, I consider that the average consumer, a member of the general public, would pay a medium degree of attention.

Comparison of the trade marks

41. 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 Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

42. It would be wrong, therefore, to artificially dissect the trade marks, 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.

43. The respective trade marks are shown below.

Opponent's trade mark	Applicant's trade mark
<p style="text-align: center;">zulijian 足力健</p>	<p style="text-align: center;">足行健</p>

44. The applicant argues that its mark is figurative whereas the opponent's mark consists of a word and a figurative element and that the public will focus on the verbal element of the opponent's mark. It contends that the marks are visually and phonetically dissimilar and that a conceptual comparison is not possible. It states that the first and third figurative characters in both marks will not be understood to be the same by the public, being non-Roman characters, and that they will see them as different figurative symbols. It also states that the middle character of the figurative characters in the two marks is clearly different.

45. The opponent contends that the three Chinese characters in its mark are the largest element of it and that that the word that transliterates the characters serves to reinforce the sound of the three Chinese characters. It argues that the characters will be seen as three characters in sequence, of which the first and last are identical. It states that the marks are conceptually, visually and aurally very similar. It contends that the differences between the fonts used for the Chinese characters are slight and that the first and third characters in the two marks will still be recognisable as the same characters. It states that the three characters translate respectively as "foot" – "force, power, strength" – "health, healthy, sturdy" (opponent) and "foot" – "go" or "walk" – "health, healthy, sturdy" (applicant). The opponent also refers to statistics on the number of people in the UK who have Chinese as their first or second language and argues that many more people than this group will recognise the characters. It states that the presence of the transliteration in its mark makes the first and third characters in the two marks phonetically identical.

46. I set out my analysis below.

47. The marks contain Chinese characters. Chinese characters will not be understood by the average UK consumer and, given that Chinese characters are non-Roman, the average consumer will simply see them as figurative elements.

48. The opponent's mark consists of the word "zulijian" in lower case bold black type, the dots on the "i"s and "j" being in grey, placed above three Chinese characters in what I regard as a "printed" font. The letters in the word "zulijian" are slightly compressed while the three Chinese characters are spaced out and align with the word above. The word is perhaps a fraction smaller than the Chinese characters in terms of the relative space they take up, but one's eye is drawn to the word given that it can be read. I consider the two elements (the word and the characters) to play an equal role in the overall impression of the mark.
49. The applicant's mark consists of three Chinese characters in what I regard as a "paintbrush" font – as if the characters have been rendered with a paintbrush.
50. Visually, although the applicant states that the first and third Chinese characters in both marks are identical, I do not consider that the average consumer would see them as such given that they are in different fonts and are spaced differently. As non-Chinese speakers, they would not form the patterns in their minds that would cause them to see the same Roman characters if they were presented in different fonts or stylisations or spacings. The average consumer will simply see them as figurative elements – Chinese characters. The second Chinese characters in both marks are different and will be seen as such. The word "zulijian" is present in the opponent's mark and there is no word present in the applicant's mark. Overall, the marks are of low visual similarity.
51. In terms of aural comparison, the opponent's mark would be verbalised as "zulijian". The average consumer would not look beyond this word and seek to give a name to the figurative element of the mark. The average consumer would not give a name to the applicant's mark, considering it to be purely visual. There is no aural similarity between the marks.
52. The Chinese characters in the marks do not give rise to a particular concept. They have no semantic meaning to non-Chinese speakers. For Chinese-

speaking consumers of clothing and footwear in the UK and that the characters, if they were to be translated by the Chinese-speaking public, they would give rise to similar concepts relating to feet and health,. This just leaves any concept that might be attached to the word “zulijian” in the opponent’s mark. Again, the average consumer would not attach a particular meaning to the word. They would not be aware that it was a transliteration of the three Chinese characters below it. They would see it as a “foreign” or invented word. I regard the word “zulijian” as conceptually neutral. I consider the marks as not capable of conceptual interpretation. If I am wrong, there is no conceptual similarity between the marks.

Distinctive character of the earlier mark

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

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

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

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

55. I must make an assessment of the inherent distinctive character of the earlier mark. The word “zulijian” is not descriptive or suggestive of the goods and services for which the mark is registered. What is considered to be the figurative element of the mark – the three Chinese characters – is also not suggestive or allusive of the opponent’s goods and services, unless they are understood, in which case they consist of non-distinctive or descriptive words in relation to the goods. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks⁴. There are three Chinese characters present in both marks. However, while non-descriptive, non-allusive elements are generally regarded as high in inherent distinctive character, these are intricate elements that would not be easy to recall and I therefore place the distinctive character at no more than average.

Likelihood of confusion

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

⁴ See, *Kurt Geiger v A-List Corporate Limited*, BL O-075- 13

to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and 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 they have retained in their mind.

57. I have found the parties' marks to be visually similar to a low degree, of no aural similarity, and not being capable of conceptual interpretation. If I am wrong about the latter point, the marks are conceptually dissimilar. The average consumer is a member of the public who does not speak Chinese and who gives a medium degree of attention during the process of purchasing clothing and footwear. I do not deny that there are Chinese-speaking consumers of clothing and footwear in the UK, but for them the characters are descriptive or non-distinctive words in relation to the goods. Visual considerations would ordinarily predominate in the purchasing process. I have found the parties' goods and services to be identical, or in the instances where I have considered the possibility that I am wrong, highly similar.

58. I consider that there is a sufficient difference between the marks to avoid them being mistakenly recalled as each other. The opponent's mark contains the word "zulijian", while the applicant's mark does not contain a word at all. That is a stark difference. I am therefore satisfied that there is no likelihood of direct confusion, even allowing for that fact that the goods in this case are identical (or in those instances where I have considered the possibility that I am wrong, highly similar).

59. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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 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.”

60. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case

law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

61. I have found the parties’ marks to be visually similar to a low degree, of no aural similarity, and not being capable of conceptual interpretation. Taking account of the average consumer having a medium degree of attention, I do not think that they would conclude that the parties’ marks indicate goods and services sold by the same or economically linked undertakings.

62. A word that has no obvious meaning placed above three Chinese characters, considered in conjunction with another set of three Chinese characters, is not a sound basis for a finding of perceived brand variation. The average consumer would not regard the marks as emanating from the same or linked undertakings. Even for Chinese-speaking consumers, there would be no

likelihood of confusion as the common elements are descriptive/non-distinctive for the goods. They will put them down to co-incidence of use of descriptive and non-distinctive elements and differentiate between undertakings by way of the additional word element in the earlier mark. I consider that there is no likelihood of indirect confusion.

CONCLUSION

63. The opposition has failed. The application will proceed to registration, subject to appeal.

COSTS

64. The applicant has succeeded. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to the applicant as below.

Considering the opposition and preparing the counterstatement:	£200
Preparing written submissions:	£300
Total:	£500

65. I order Beijing Xiaoxiyang Technology Development Co., Ltd to pay Dongguan Breathwalker Shoes Co., Ltd the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of January 2021

JOHN WILLIAMS
For the Registrar