

O-597-21

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3533517
BY SHENZHEN ZHENZHI NETWORK TECHNOLOGY CO.,LTD.
TO REGISTER



AS A TRADE MARK IN CLASS 25

AND

OPPOSITION THERETO

UNDER NO. 422968

BY THE NET-A-PORTER GROUP LIMITED

Background and pleadings

1. On 15 September 2020, Shenzhen Zhenzhi Network Technology Co.,Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 30 October 2020 for the following goods in Class 25:

Athletic clothing; Athletic uniforms; Baby doll pyjamas; Bath robes; Beachwear; Bottoms [clothing]; Clothing; Footwear; Gloves; Hats; Head bands; Headwear; Loungewear; Menswear; Night shirts; Pajama bottoms; Rainwear; Scarfs; Shapewear; Shoes; Sleep masks; Sleeping garments; Sleepwear; Socks; Sportswear; Swimwear; Thermal clothing; Thermal underwear; Tops [clothing]; Underwear .

3. The Net-a-Porter Group Limited (“the opponent”) filed a notice of opposition on 29 January 2021. The opposition which is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) is directed against all the goods in the application. For its claims under sections 5(2)(b) and 5(3), the opponent relies upon the following United Kingdom (“UK”) and European Union (“EU”) trade marks:

Mark 1: MR P

UK registration no. 3384549

Filing date: 19 March 2019

Registration date: 28 June 2019

Goods relied upon:

Class 25 Clothing in particular jumpers, knitwear, sweatshirts, t-shirts, shorts, jackets, blazers, coats, blouses, shirts, pullovers, dresses, skirts, pants, trousers, jeans, jumpsuits, playsuits, beachwear, sweaters, evening wear, waistcoats, suits, scarves, shawls, swimwear, beachwear, lounge wear, sleepwear, pyjamas, sleep masks, leisurewear, sportswear, lingerie, camisoles, bodices,

underwear, underclothing, garters, garter belts, suspender belts, suspenders; Clothing in particular bathrobes, ties, neckties, bow ties, cravats, pocket squares, belts, braces, gloves, hosiery, stockings, tights, socks, active wear; footwear in particular shoes, espadrilles, boots, ankle boots, sandals, sport shoes, leisure shoes, canvas shoes, slippers, loafers, moccasins; headgear in particular hats, caps, fascinators, beanies, berets, flat caps.

Mark 2: MR P

EU registration no. 017184839

Filing date: 7 September 2017

Registration date: 12 June 2019

Goods relied upon:

Class 25 Clothing in particular jumpers, knitwear, sweatshirts, t-shirts, shorts, jackets, blazers, coats, blouses, shirts, pullovers, dresses, skirts, pants, trousers, jeans, jumpsuits, playsuits, beachwear, sweaters, evening wear, waistcoats, suits, scarves, shawls, swimwear, beachwear, lounge wear, sleepwear, pyjamas, sleep masks, leisurewear, sportswear, lingerie, camisoles, bodices, underwear, underclothing, garters, garter belts, suspender belts, suspenders; Clothing in particular bathrobes, ties, neckties, bow ties, cravats, pocket squares, belts, braces, gloves, hosiery, stockings, tights, socks, active wear; footwear in particular shoes, espadrilles, boots, ankle boots, sandals, sport shoes, leisure shoes, canvas shoes, slippers, loafers, moccasins; headgear in particular hats, caps, fascinators, beanies, berets, flat caps.



Mark 3:

EU registration no. 013716147

Filing date: 5 February 2015

Registration date: 3 July 2015

Goods relied upon:


Class 25 Jumpers, knitwear; sweatshirt, t-shirt, shorts, jackets, blazers, coats, shirts, polo shirts, pullovers, pants, trousers, sweatpants, shorts, jeans, jumpsuits, beachwear, sweaters; evening wear; waistcoats, suits; scarves; swimwear, beachwear; active wear; lounge wear; sleepwear; leisurewear, sportswear; underwear; underclothing; garters; garter belts; bathrobes; ties, neckties, bow ties, cravats, belts; gloves; hosiery, stockings, tights, socks; footwear, namely shoes, boots, ankle boots, sandals, sport shoes, leisure shoes, loafers, canvas shoes, slippers; headgear namely hats and caps.

4. The opponent claims that the goods in the application are identical to the goods covered by the earlier marks and that the marks are similar. As a consequence, the opponent claims that there is a likelihood of confusion including a likelihood of association under section 5(2)(b).
5. Under section 5(3), the claim is that the use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the earlier marks by benefitting on the opponent's advertising expense. The opponent further claims that detriment to its reputation would be caused by potentially poor-quality goods provided by the applicant. The opponent's claim of detriment to the distinctive character is on the basis that the concurrent use of the applicant's mark would dilute the earlier marks' capacity to indicate the exclusive origin of their goods.
6. Under section 5(4)(a), the opponent claims that it has used the sign MR P in the UK since 2017 in relation to clothing, footwear, headgear, belts, ties, scarfs and undergarments. It claims that it is entitled to prevent the use of the applicant's mark under the law of passing off, because it has goodwill in relation to its sign and the use of the applicant's mark would result in misrepresentation and damage to the opponent's goodwill.
7. The applicant filed a counterstatement denying the grounds of opposition.

8. Given their filing dates, all of the marks the opponent relies upon are earlier trade marks in accordance with section 6 of the Act. Although a statement was made in the notice of opposition that the opponent's figurative mark had been used in the five year period ending on the application date of the contested mark, the applicant chose not to put the opponent to proof of use.
9. The opponent is represented by HGF Limited and the applicant is represented by Ákos Süle, LL.M. Both parties filed written submissions in lieu of hearing. Only the opponent filed evidence. I make this decision after a careful reading of all the papers filed by the parties.

Evidence

10. The opponent's evidence consists of the witness statement of Sarah Fellows dated 13 April 2021 with fourteen exhibits. Ms Fellows is the Head of Intellectual Property of the opponent company.
11. Ms Fellows states that MR Porter was launched in 2011 and sells over 450 leading menswear brands worldwide through www.mrporter.com. Ms Fellows further states that MR P was launched in November 2017 as an in-house label of MR Porter and a range of goods comprising of clothing, footwear, headgear and belts are sold under that mark.
12. Extracts from the webpage www.mrporter.com are in evidence. Most of the web pages were printed either on 10 January 2020 or 27 July 2020. Prints are also provided from web.archive.org dated between November 2017 – April 2019.

The pages show the word mark MR P and the sign  (as sewn-in labels) applied to men's shoes and menswear such as shirts and sweaters. The archived pages show merchandise priced in dollars.¹

¹ Exhibits SF2 and 3

13. Ms Fellows provides the following turnover figures for November 2017 – 31 December 2019 recorded under the mark MR P and claims that the opponent received over 29,000 orders from the UK and EU during the same period:²

Country	Year	Gross Turnover (GBP)
UK	2017 (since Nov.)	More than 147,000
	2018	More than 727,000
	2019	More than 1,100,000
France	2017 (since Nov.)	More than 10,000
	2018	More than 49,000
	2019	More than 100,000
Spain	2017 (since Nov.)	More than 6,000
	2018	More than 19,000
	2019	More than 37,000
Germany	2017 (since Nov.)	More than 18,000
	2018	More than 110,000
	2019	More than 210,000

Although Ms Fellows states that the products comprising clothing, footwear and headgear are sold under the mark MR P, I am unable to establish the sales figures for the individual categories of goods being relied upon.

14. A selection of more than 60 invoices issued under the name MRPORTER.COM to recipients based in various locations in the UK and EU are provided as Exhibits SF4 and 5. The invoices are dated between November 2017 - July 2020 and show the sale of mainly clothing such as shirts, sweaters and jackets which are described as MR P goods. There is also some evidence of the sale of footwear such as sneakers and shoes, which are also described MR P. Examples of description of goods listed on the invoices include Mr P. Camp-Collar Cotton-Blend Seersucker Shirt, Mr P. Slim-Fit Merino Wool Sweater and Mr P. Larry Leather Sneakers.

15. Ms Fellows states that the opponent's website www.mrporter.com received over 34.7 million visits between 2017-2019. Bearing in mind Ms Fellows statement that over 450 leading menswear brands are sold through the opponent's website, how many of those visits were made to view and purchase goods bearing the mark MR P are unknown.

² Witness statement, para 14.


16. Ms Fellows provides that following advertising expenditure in the UK for 2017 - 2019:

Calendar Year	Advertising expenditure for MR P
2017 (Nov-Dec 2017)	More than £7,500
2018	More than £87,000
2019	More than £13,500

While most of the expenditure was recorded in 2018, I note that there was a considerable dip in the expenditure for 2019 compared to 2018.

17. The opponent's Facebook, Twitter, and Instagram pages from 2017 – 2019 under the username MR Porter are in evidence.³ A Facebook post from 17 October 2017 describes MR P as a new menswear brand created by MR PORTER. Exhibits SF8 and SF9 are a collection of Instagram pages under the username mrp. The Instagram account has 84.8k followers as of 10 February 2020. The pages show images of men's footwear such as shoes and menswear such as jackets and sweaters.

18. The mark is also promoted on YouTube. Ms Fellows provides screengrabs of YouTube videos dated between November 2017 and May 2019.⁴ The word

mark MR P and the sign  are seen on the pages filed in evidence.

19. Ms Fellows provides examples of media coverage of the mark MR P. Prints from Vogue, GQ, Esquire, Men's Health and The Times are in evidence. Out of nine reports filed in evidence, eight are from 2017 and 2018 and mainly cover the launch of menswear under the mark MR P by the online retailer MR Porter. However, in the absence of evidence on the circulation figures/online views, I am unable to ascertain how many of the customers or potential customers of the opponent have come across those reports.⁵

³ Exhibit SF7

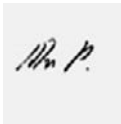
⁴ Exhibits SF10 and SF13

⁵ Exhibit SF14

20. That concludes my summary of the opponent's evidence to the extent I consider necessary.

My approach to the opposition under section 5(2)(b)

21. The opponent relies on two word only marks for MR P and the figurative mark



. The opponent submits that the registrations for MR P in standard characters represent its strongest case in the opposition.⁶ I agree. The word marks are closest in terms of similarity to the applicant's mark and cover the broadest term "clothing". I will proceed on the basis of the word only marks.

Section 5(2)(b)

22. 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".

Case law

23. The following principles are gleaned from the judgments 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 C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-

⁶ Opponent's written submissions dated 21 May 2021, para 22.

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 the 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.

Comparison of goods

24. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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”.

25. In *Gérard Meric v OHIM*, the General Court held that goods can be considered as identical when the goods designated by the earlier mark are included in a

more general category, designated by the trade mark application - and vice versa.⁷

26. The competing goods are given below:

Applicant's goods	Opponent's goods
<p>Class 25</p> <p>Athletic clothing; Athletic uniforms; Baby doll pyjamas; Bath robes; Beachwear; Bottoms [clothing]; Clothing; Footwear; Gloves; Hats; Head bands; Headwear; Loungewear; Menswear; Night shirts; Pajama bottoms; Rainwear; Scarfs; Shapewear; Shoes; Sleep masks; Sleeping garments; Sleepwear; Socks; Sportswear; Swimwear; Thermal clothing; Thermal underwear; Tops [clothing]; Underwear .</p>	<p>Class 25</p> <p>Clothing in particular jumpers, knitwear, sweatshirts, t-shirts, shorts, jackets, blazers, coats, blouses, shirts, pullovers, dresses, skirts, pants, trousers, jeans, jumpsuits, playsuits, beachwear, sweaters, evening wear, waistcoats, suits, scarves, shawls, swimwear, beachwear, lounge wear, sleepwear, pyjamas, sleep masks, leisurewear, sportswear, lingerie, camisoles, bodices, underwear, underclothing, garters, garter belts, suspender belts, suspenders; Clothing in particular bathrobes, ties, neckties, bow ties, cravats, pocket squares, belts, braces, gloves, hosiery, stockings, tights, socks, active wear; footwear in particular shoes, espadrilles, boots, ankle boots, sandals, sport shoes, leisure shoes, canvas shoes, slippers, loafers, moccasins; headgear in particular hats, caps, fascinators, beanies, berets, flat caps.</p>

⁷ case T-133/05

27. For the following reasons, I find that the competing goods are identical:

28. *Bath robes; beachwear; clothing; gloves; hats; pajama bottoms; shoes; sleep masks; sleepwear; socks; sportswear; swimwear and underwear* are identically contained in both specifications.

29. I find that *athletic clothing; athletic uniforms; baby doll pyjamas; bath robes; beachwear; bottoms [clothing]; head bands; headwear; loungewear; menswear; night shirts; rainwear; scarfs; shapewear; sleep masks; sleeping garments; sportswear; swimwear; thermal clothing; thermal underwear; tops [clothing]* are identical to clothing covered by the earlier mark under the *Meric* principle.

30. *Footwear* in the applicant's specification is identical to shoes in the earlier mark under *Meric* principle.

The average consumer and the nature of the purchasing act

31. It is necessary for me to determine who the average consumer is for the respective parties' goods.

32. 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”.

33. The average consumer of the competing goods is a member of the general public.

34. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) commented upon the manner in which articles of clothing are selected. It stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

35. The goods are neither an infrequent nor a daily purchase. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) may be considered. These factors suggest that the average consumer will pay a medium level of attention when making their selection.

Comparison of marks


36. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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.”

37. It would be wrong, therefore, artificially to 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.

38. The trade marks to be compared are as follows:

Applicant's trade mark	Opponent's trade mark
	MR P

39. The applicant's mark contains a winding ribbon-like device on a circular background. On its left are the letters "MR" and "PJ", separated by a dot. The letters are presented in capital letters. The opponent argues that the contribution of the device element to the overall impression of the applicant's mark is small. I disagree. The device element is larger in size than the letters and is at the beginning of the mark. Given the size and presentation, I am of the view that both the device and the letters make an equal contribution to the overall impression of the applicant's mark.

40. The opponent's mark consists of the letters "MR" and "P". The overall impression and the distinctiveness of the opponent's mark lie in the combination of the letters of which it is composed.
41. Visually, both marks contain the letters "MR" and "P". In terms of differences, the applicant's mark is marginally longer than the opponent's mark. In the applicant's mark, the letter "P" is in the penultimate position and is followed by the letter "J". A dot separates MR and PJ. The applicant's mark also contains a device element before the verbal elements. Weighing up the similarities and differences and considering my assessment of the overall impression of the mark, I find that the marks are visually similar to a medium degree.
42. I now turn to the aural comparison. The device element and the dot in the applicant's mark will not be verbalised. The applicant's mark will be pronounced as mister p-j, while the opponent's mark will be pronounced as mister-p. The marks coincide in the pronunciation of "mister p". Articulation of the letter j at the end of the applicant's mark introduces the aural difference between the marks. Considering these factors, I find that the marks are aurally similar to between a medium and high degree.
43. On conceptual comparison, the General Court ("GC") in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)* held:

83. [...] In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the 'concepts' that the signs at issue convey. The term 'concept' means, according to the definition given, for example, by the *Larousse* dictionary, a 'general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it'.

....

85. Therefore, a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is

lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.”⁸

44. While the above-referenced decision concerns forename and surname, the reasoning applies to this case. The opponent's mark MR P is likely to indicate a male trader whose name (more likely the surname) starts with P. In contrast, the applicant's mark is likely to be perceived in more than one way. I am of the view that there may be some average consumers who would as rightly noted by the opponent, see MR PJ as “identifying an individual with initials ‘PJ’”. However, I do not consider that neither MR P nor MR PJ is likely to invoke any concept the average consumer could associate with. Certainly, there is no evidence or submissions to the contrary. On that basis, I find the conceptual position to be neutral. It seems that there may be another group of average consumers who would, as the applicant submits, consider “pj” as a common abbreviation for pyjamas, particularly in the context of the applicant's goods that include pyjamas and sleepwear. Where the average consumer ascribes such a meaning to the applicant's mark, I find that the marks are conceptually dissimilar.

Distinctiveness of the earlier mark

45. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

⁸ Case T-268/18

“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).”

46. The earlier mark consists of a single letter "P" preceded by "MR", a title used before a man's full name or surname. It is common in the clothing and footwear sector to supply goods under the trader's name.⁹ MR P, therefore, gives the impression that the letter P corresponds to the initial letter of a trader's surname. In my view, the mark is inherently distinctive to a low degree. The opponent has filed evidence of use of the earlier mark and has claimed enhanced distinctiveness.

47. Enhanced distinctiveness is a measure of how strongly the mark identifies the goods of the opponent. As mentioned, the inherent distinctiveness of the earlier mark is low. Therefore, the opponent faces a very high evidential hurdle to

⁹ See *Oska's Ltd's Trade Mark Application* [2005] R.P.C.20

prove enhanced distinctiveness. Most of the evidence demonstrates the use of the mark in relation to menswear. The breakdown figure indicates that between November 2017 – 2019, the turnover accounts for nearly 2 million pounds in the UK. To my understanding, the UK market for clothing is huge; it must be measured in billion pounds. The opponent's share of the clothing market for the UK, therefore, appears to be small in that context. Similarly, when compared to the market for clothing, I think the total amount spent on promoting the mark is also low. The evidence does not indicate any extensive media coverage nor intensive advertising or promotional activities. Taking the evidence in the round, I find that the length and extent of use of the earlier mark in relation to menswear, to the extent that I can make a finding from the evidence provided, is insufficient to have enhanced the distinctiveness of the mark.

Likelihood of confusion

48. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a greater degree of similarity between the respective goods may be offset by a lesser degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them they have retained in mind (*Lloyd Schuhfabrik* at [26]).

49. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

50. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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”.

51. 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 another mark to mind. This is mere association not indirect confusion.

52. Earlier in this decision, I concluded:

- That the competing goods are either identical;
- That the goods will be selected primarily by visual means, with a medium degree of attention by the general public;
- That the marks are visually similar to a medium degree, aurally similar to a degree that is between medium and high and the conceptual position is neutral or dissimilar depending on how the average consumer perceive the applicant’s mark;

- That the opponent's mark is inherently distinctive to a low degree and the distinctiveness has not been enhanced through use.

53. I first consider the position in relation to direct confusion. I am of the view that the device element at the beginning of the applicant's mark and the difference in the verbal elements are prominent enough to dispel a likelihood of direct confusion.

54. I now turn to the assessment of indirect confusion. Although I acknowledge that there is a degree of similarity arising from the presence of MR P in the competing marks, I bear in mind that I must assess the marks as a whole. As the evidence indicates, the mark MR P is used, in almost every instance, along with the sign MR Porter, triggering a connection between MR P and MR Porter. On the other hand, PJ in the applicant's mark is likely to be considered as a person's initials.¹⁰ In any event, the respective marks will be considered to refer to different individuals, possibly individuals with different surnames. Moreover, clothing is predominantly a visual purchase. Therefore, visual perception of the applicant's mark includes the device element which is not present in the earlier mark. Taking into account all these factors, the average consumer will not put the similarity between the marks arising from a common initial down to an economic connection. I also find that there is no likelihood of confusion even for those consumers who perceive the applicant's mark as a reference to pyjamas. As there is a clear conceptual hook for the applicant's mark, the difference between the competing marks would not be seen as logical or consistent with a brand extension. Accordingly, I find that there is no likelihood of confusion, either direct or indirect.

55. The opposition, therefore, fails under section 5(2)(b).

Section 5(3)

56. Section 5(3) states:

¹⁰ See opponent's written submissions, para 25.

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

57. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

58. The relevant case law can be found in the following judgments of the CJEU:

Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas Saloman*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

- a. The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- b. The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- c. It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

- d. Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.
- e. Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.
- f. Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.
- g. The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.
- h. Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

- i. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

59. In order to succeed under section 5(3) ground, the opponent must demonstrate by way of evidence that the earlier mark is known by a significant part of the relevant public for the goods relied upon. For the purpose of a claim on reputation, I will focus on the word only mark for MR P registered in the UK.

60. The opponent has claimed reputation in relation to all the goods it relied upon. However, the evidence in the form of invoices and product images on the opponent's website indicates that the opponent is predominantly engaged in the sale of menswear. Although the opponent's turnover of more than 2 million pounds recorded in the UK between November 2017 – 2019 was small in relation to the overall size of the clothing market, I note from Ms Fellows statement that the income during that period was generated from just over 18,000 orders. Menswear sold under the mark, thus, appears to be relatively expensive. Whilst the advertising figures dipped in 2019, I note that during the same year sales increased substantially, it was recorded over one million pounds.¹¹ Although no turnover figures have been provided for 2020, my own

¹¹ The opponent spent just over £13,000 pounds in 2019 in advertising the earlier mark, while it was recorded at £87,000 in 2018.

calculation from the figures provided in Ms Fellows statement shows that the opponent received more than 10,000 orders between January - September 2020. For a mark launched not long ago, the sales appear to have increased substantially between November 2017 until the relevant date, i.e. 14 September 2020. Considering the evidence in round, I am satisfied that the earlier mark had a qualifying reputation in the UK, for menswear goods; however, it could not have been more than a modest one.

Link

51. The next step is to assess whether the relevant public confronted with the later mark will make a link with the earlier reputed mark. This is a multifactorial exercise taking account of various factors including the strength of the earlier mark's reputation and the degree of similarity between the conflicting marks.

61. I have already concluded that the earlier mark has only a modest reputation in the UK. I also found that the earlier mark is inherently distinctive to a low degree, and the distinctiveness has not been enhanced through the use of the mark. Even though the competing goods are identical, I have also concluded that the marks are likely to indicate different individuals. The device element in the applicant's mark also add to further visual difference between the marks. In the circumstances, I do not consider that a significant proportion of consumers are likely to link the contested mark to the earlier mark. I come to the same conclusion where the letters PJ in applicant's mark is likely to be perceived as reference to pyjamas.

62. In the absence of requisite link between the marks, the section 5(3) ground of the opposition fails. This is because in the absence of such a link, the use of the contested mark would not take unfair advantage of, or be detrimental to, the reputation or distinctive character of the earlier mark.

Section 5(4)(a)

63. Section 5(4)(a) of the Act reads as follows:

“5(4) 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”.

64. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

65. As there is no evidence that the applicant’s mark was used prior to the application date, the relevant date for assessment of the opponent’s claim under section 5(4)(a) of the Act is the date of application for registration, being 15 September 2020.

52. The first hurdle for the opponent is that they need to show that they had the necessary goodwill in the sign MR P at the relevant date. There is evidence that the opponent has been trading under the sign since November 2017. Reputation constitutes a knowledge threshold and, therefore, reputation of the earlier mark in the UK is helpful in establishing goodwill. Accordingly, I am prepared to accept that the opponent has actionable goodwill in the mark. However, as evidence suggests, this goodwill resides only in menswear.

53. In relation to the assessment of misrepresentation, which is the second limb of the passing off claim, I am not convinced that there is a misrepresentation that the applicant's goods provided under the mark Mr PJ are sourced from the opponent. Bearing in mind my assessment of the similarities between the marks already made, while recognising the difference in legal tests between likelihood of confusion and misrepresentation, the opponent is in no better position with regard to this ground under section 5(2)(b).¹²

66. This means that the opposition under section 5(4)(a) fails.

Conclusion

67. The opposition is unsuccessful. The application will proceed to registration.

Costs

68. Under cover of a letter dated 23 April 2021, a costs proforma was sent to the applicant's agent on record on a mistaken belief that the agent was not a legal representative. However, as it transpired that that is not the case, I am minded to award the costs on the scale in accordance with Tribunal Practice Notice ("TPN") 2/2016. I award costs to the applicant on the following basis:

¹² Both tests are intended to be normative measures to exclude those who are unusually careful or careless (as per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40). Therefore, there are parallels between the two.

Considering the statement of case and
filing the counterstatement: £200

Considering and commenting on the
other party's evidence: £500

Total: £700

69.I order The Net-a-Porter Group Limited to pay Shenzhen Zhenzhi Network Technology Co.,Ltd. the sum of £700. 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 11th day of August 2021

**Karol Thomas
For the Registrar
The Comptroller-General**