

**O/755/22**

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3586115

BY

Shanghai ZhaoNuo Trade Co.Ltd.

TO REGISTER THE TRADE MARK:

**MUSIER PARIS**

IN CLASS 14

-AND-

THE OPPOSITION THERETO UNDER No. 425354

BY

IT COLLECTION

## **Background and pleadings**

1. Shanghai ZhaoNuo Trade Co.Ltd. (“**the Applicant**”) applied to register the trade mark ‘MUSIER PARIS’ (“**the Contested Mark**”) in the UK on 28 January 2021. It was accepted and published in the Trade Marks Journal on 2 April 2021 in respect of the following goods in Class 14:

*Ankle bracelets; Bracelets; Bracelet charms; Cufflinks; Earrings; Jewellery chain of precious metal for bracelets; Jewellery charms; Jewellery foot chains; Jewelry; Jewelry chains; Key chains for use as jewelry; Neck chains; Necklaces; Rings [jewellery]; Tie clips.*

2. IT COLLECTION (“**the Opponent**”) opposes the Contested Mark under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The Opponent relies on its UK Trade Mark ‘musier’ (“**the Earlier Mark**”), which is registered in respect of Classes 3, 14, 18 and 25. For the purposes of this opposition, the Opponent relies solely on its Class 14 goods which are as follows:

*Jewellery; Precious stones; Horological and chronometric apparatus and instruments; Precious metals and their alloys; Works of art of precious metal; Jewellery boxes; Boxes of precious metals; Watch cases [parts of watches]; Watch bands; Watch chains; Watch springs; Watch glasses; Key rings [split rings with trinket or decorative fob]; Statues of precious metals; Figurines (statuettes) of precious metals; Cases for clock- and watchmaking; Cases for watches [presentation]; Medals.*

3. Details of the Earlier Mark’s registration are below:

UK Trade Mark Registration Number:	3651223
Filing Date (of UK application):	4 June 2021
Filing Date (of original EUTM):	15 July 2020
Registration Date:	17 December 2021

4. The application to register the Earlier Mark in the UK was filed pursuant to Article 59 of the 'Withdrawal Agreement'.<sup>1</sup> As a consequence, it is deemed to have the same filing date as its corresponding trade mark application filed in the EU, which is 15 July 2020. Given the respective filing dates, the Opponent's mark is an earlier trade mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. Consequently, the Opponent may rely upon all the Class 14 goods for which the Earlier Mark is registered without having to show any use at all.
  
5. The Opponent claims that on account of the high degree of similarity between the marks and identity (or at least high similarity) between the respective Class 14 goods, "*there is a serious risk that the average consumer would believe that the goods applied for originate from the Opponent or an economically linked undertaking such that there would be a likelihood of confusion, which includes the likelihood of association*". In particular in its statement of grounds accompanying its form TM7, the Opponent argues that:

*"the earlier mark is not only contained within the later mark, but it is the dominant and distinctive element of that mark playing an independent distinctive role within it. This is because - musier - is the first element of the later mark and is entirely distinctive having been coined by the Opponent and because the second element - Paris - is entirely non-distinctive for the goods applied for. Paris being the Capital City of France, which is known for its close links to fashion and jewellery. [...] the average consumer would focus on, recall and remember the first identical element of the later mark, musier, i.e. the earlier mark.*
  
6. The Applicant filed a defence and counterstatement denying the claims made. It included material that was evidential in nature, which I have addressed in the 'Preliminary Issues' of this decision below. The Applicant requested that the

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<sup>1</sup> 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)', also known as the 'Withdrawal Agreement'

Opponent provides proof of use of its trade mark relied upon, but ‘proof of use’ does not apply to these proceedings for the reasons detailed in my paragraph 4.

7. Only the Opponent filed formal evidence in these proceedings which I will refer to in the Preliminary Issues of this decision.
8. Only the Opponent filed written submissions which will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
9. In these proceedings the Opponent is represented by Dentons UK and Middle East LLP and the Applicant is represented by AXIS PROFESSIONALS LTD.
10. 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

### **Preliminary Issues**

#### **The Applicant’s Form TM8 ‘Notice of defence and counterstatement’**

11. In its counterstatement, the Applicant claims to have used its trade mark “*extensively [...] for a long time*” via its “*UK site*” (the Applicant has listed the “*brand website*” as ‘<http://www.mymusierparis.com/>’). In order to demonstrate this, the Applicant filed materials that are evidential in nature. Whilst no formal evidence has been submitted by the Applicant, this material, described as “*screenshots of sales and orders from the website*” has nonetheless entered into proceedings via Form TM8 which was verified by a statement of truth.
12. I have carefully reviewed the material submitted and conclude that it merely shows that the Applicant has demonstrated some use of the Contested Mark in relation to items of jewellery which dates back to 27 June 2021, therefore such use post-dates the Opponent’s notice of its intention to oppose the application (dated 28 May 2021), and I note that none of that use is in relation to sales made via the Applicant’s “*brand website*”, only sales made via the online marketplace

www.amazon.co.uk. This is inconsistent with not only the claim of long standing use, but the claim of long standing use via the brand website.

13. To this end, I acknowledge that the Opponent filed the witness statement of Ryan Kellingray of Dentons UK and Middle East LLP, accompanied by one exhibit marked RK1, which evidences that the domain name www.mymusierparis.com was registered on 10 March 2021. This serves to demonstrate to me that any sales via this website could only have been made after the domain was registered, which echoes my previous finding that this is inconsistent with the claim of long standing use.<sup>2</sup>
14. The Applicant has not expressly framed a defence under the Act, still less attacked the Earlier Mark on the basis of any claimed prior rights. However, with its contention that it has used the sign 'MUSIER PARIS' "*extensively [...] for a long time*", and the supporting material provided, the Applicant appears to allude that there is honest concurrent use. Whilst honest concurrent use can be a relevant defence in determining whether there is a likelihood of confusion, I find that the use the Applicant has shown cannot assist them in this regard.

#### Variation of the Opponent's mark in use

15. The Opponent filed submissions together with two witness statements, one which is referred to in my paragraph 13, and the other is of Dorothée Rubinski, the President of IT COLLECTION, which was accompanied by eleven exhibits marked XY1 to XY11 ("**the Rubinski Evidence**"). The purpose of the Rubinski Evidence, it is said, is to "*bring the Tribunal's attention to the fact that the Opponent very often presents its brand as MUSIER PARIS, and has done since, at least, 2019*" and to "*demonstrate [the Opponent's] use of the MUSIER mark in the UK [in] connection with the word PARIS*".
16. Dorothée Rubinski acknowledges that "*whilst [the Opponent] owns a UK Trade Mark Registration for musier, the brand is very often presented and recognised*

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<sup>2</sup> Had I not been presented with this evidence, I would have still reached the same conclusion on long standing use.

as *MUSIER PARIS*”, and throughout the witness statement, reference is made to ‘MUSIER PARIS’ as the Opponent’s brand.

17. The exhibits, briefly, comprise of print-outs (dated 31 July 2020) from the Opponent’s website [www.musier-paris.com](http://www.musier-paris.com), with listings for clothing and footwear and evidence of UK visitors to this website (between 1 January 2020 and 25 June 2020); an extract from the Opponent’s e-commerce dashboard showing orders from UK-based customers (I note that this image is poorly reproduced and is not clear, in addition to it being in French with no translation provided); two redacted customer invoices, which, whilst written in French (with no translation provided) I have been able to deduce are for sales of two items of clothing to UK-based private individuals; print-outs (dated 3 December 2021) from the UK retailer Selfridges’ website, listing items of clothing and footwear under the brand ‘MUSIER PARIS’, and one invoice of sale to the same retailer, dated 26 October 2020 with a value in Euros of 23,814 for items of clothing. The invoice shows ‘MUSIER PARIS’ on the letterhead; extracts from social media accounts managed by or connected to the Opponent displaying ‘MUSIER PARIS’ in relation to articles of clothing and footwear; and articles published online from two UK-based magazines, referring to the brand as ‘MUSIER PARIS’ accompanied with listings of clothing and footwear items available to buy under the brand ‘MUSIER PARIS’ and ‘MUSIER’.
18. Having carefully reviewed the Rubinski Evidence, I can conclude that, as was the Opponent’s intention, it has merely served to bring to my attention that the Opponent *“often presents its brand as MUSIER PARIS”* and that some of that use dates back to 2019 i.e. it pre-dates the date of filing of the Earlier Mark. As an aside, I note that it only shows use in relation to clothing and footwear and that none of it relates to the use of ‘MUSIER PARIS’ in relation to the Opponent’s Class 14 goods.
19. ‘MUSIER PARIS’ is not the mark for which the Opponent holds a trade mark registration. The Earlier Mark is simply ‘musier’. Evidence of this nature may potentially be relevant were it necessary to make an assessment as to the form of the mark that is in fact in use for the purposes of establishing proof of use, but there is no proof of use requirement in these proceedings. Evidence of use may

also be required to make out a claim of enhanced distinctiveness, or for a claim based on reputation. However, the Rubinski Evidence is not relevant for the comparison of the marks and the assessment of likelihood of confusion under section 5(2)(b) of the Act.

20. In the decision before me, assessment with regards to the similarity of the marks at issue is to be undertaken based on a notional and fair basis of those marks as they appear in the register, and not how they are actually used in the market. The comparison will therefore be undertaken between the Contested Mark and the Opponent's mark as it appears in the register i.e. the Earlier Mark, and not any other variation put forward by the Opponent. For the avoidance of doubt, I will compare 'musier' with 'MUSIER PARIS' and not 'MUSIER PARIS' with 'MUSIER PARIS'.

## **DECISION**

### **Legislation and Case Law**

21. 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."

22. I am guided by the following principles which 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 great degree of similarity between the marks, and vice versa;



- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

**Comparison of goods**

23. The goods to be compared are:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<p><u>Class 14</u></p> <p><i>Jewellery; Precious stones; Horological and chronometric apparatus and instruments; Precious metals and their alloys; Works of art of precious metal; Jewellery boxes; Boxes of precious metals; Watch cases [parts of watches]; Watch bands; Watch chains; Watch springs; Watch glasses; Key rings [split rings with trinket or decorative fob]; Statues of precious metals; Figurines (statuettes) of precious metals; Cases for clock- and watchmaking;</i></p>	<p><u>Class 14</u></p> <p><i>Ankle bracelets; Bracelets; Bracelet charms; Cufflinks; Earrings; Jewellery chain of precious metal for bracelets; Jewellery charms; Jewellery foot chains; Jewelry; Jewelry chains; Key chains for use as jewelry; Neck chains; Necklaces; Rings [jewellery]; Tie clips.</i></p>

<p><i>Cases for watches [presentation]; Medals.</i></p>	
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24. “*Jewelry*” in the Applicant’s specification is self-evidently identical to “*Jewellery*” in the Opponent’s specification. The difference in spelling does not alter this finding.
25. “*Ankle bracelets; Bracelets; Bracelet charms; Cufflinks; Earrings; Jewellery chain of precious metal for bracelets; Jewellery charms; Jewellery foot chains; Jewelry chains; Key chains for use as jewelry; Neck chains; Necklaces; Rings [jewellery]; Tie clips*” are all items of jewellery and therefore fall within the general category of “*jewellery*” in the Opponent’s specification. These goods are identical on the principle outlined in the case of *Gérard Meric*,<sup>3</sup> in which the General Court held to the effect 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 later mark, and vice versa.
26. I have therefore found that the Applicant’s goods are identical to the Opponent’s goods.

**The average consumer and the nature of the purchasing act**

27. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical,<sup>4</sup> which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.<sup>5</sup>
28. It is therefore necessary to determine who the average consumer of the respective goods is, and how the consumer is likely to select those goods. It must

<sup>3</sup> *Gérard Meric v OHIM*, Case T- 133/05

<sup>4</sup> *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), paragraph 60

<sup>5</sup> *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.<sup>6</sup>

29. The average consumer of the goods at issue will be a member of the general public.
30. The goods are likely to be sold through a range of retail outlets (and their online equivalents) such as accessory retailers, jewellers and fashion retailers. The goods are likely to be kept in display cases or on stands or rails, where they will be viewed and self-selected by the consumer. A similar process will apply online where the consumer will select the goods having viewed an image displayed on a webpage. The selection of the goods is therefore primarily visual as the average consumer is most likely to encounter the trade marks on the goods themselves or on their packaging, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants. However, even where the goods are selected by making requests to staff, the selection process prior to purchase would be visual in nature. Accordingly, visual considerations dominate.
31. The goods will vary greatly in price, influenced by factors such as the materials from which they are made or whether they are handcrafted pieces or mass produced and how intricate the design is for example. The factors that influence the price are also the factors that the average consumer is likely to consider when purchasing the goods, in addition to things such as size, fit and aesthetic, these factors will be relevant even in relation to the goods that are at the lower end of the price spectrum.
32. The average consumer will tend to pay more attention when selecting the goods because the goods are items that are intended to be worn for adornment, re-used and retained for a period of time. In such circumstances I would expect a consumer to pay at least a medium degree of attention during the selection process. As the cost of the goods increases, so too will the degree of attention that is paid to their selection.

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<sup>6</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

## Comparison of marks

33. It is clear from established case law that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.<sup>7</sup> The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks in the mind of the average consumer, bearing in mind the distinctive and dominant components of the marks.<sup>8</sup> Then, in light of the overall impression, and all factors relevant to the circumstances of the case, it is necessary to assess the likelihood of confusion.<sup>9</sup>
34. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.
35. The respective trade marks are shown below:

<b>Earlier Mark</b>	<b>Contested Mark</b>
musier	MUSIER PARIS

## Overall impression

36. The Earlier Mark is a word-only mark consisting of the word ‘musier’. The overall impression rests purely in the word ‘musier’.
37. The Contested Mark is a word-only mark consisting of the words ‘MUSIER PARIS’. The Opponent has submitted that ‘PARIS’ *“is entirely non-distinctive for the goods applied for. Paris being the Capital City of France, which is known for its close links to fashion and jewellery”* and it is *“world-renowned as a centre for design and style. It is clear, therefore, that the average consumer would ascribe very little (if any) distinctive character to the use of PARIS at the end of a mark*

<sup>7</sup> *Sabel BV v. Puma AG*, Case C-251/95, paragraph 23

<sup>8</sup> *Sabel BV v. Puma AG*, paragraph 23

<sup>9</sup> *Bimbo SA v OHIM*, Case C-591/12P, paragraph 34

*insofar as that mark is applied to jewellery goods in class 14, which are commonly designed in Paris. As a result, the Opponent submits that its mark MUSIER clearly plays an independent distinctive role within the Applicant's mark and the average consumer would clearly understand MUSIER to be the dominant and distinctive element of both marks."*

38. I agree, Paris does indeed have a reputation for fashion. I note that accessory items such as items of jewellery can still be considered as fashion items by the average consumer.
39. It is not uncommon for undertakings in the fashion industry to use their house mark in conjunction with a geographical indication that has a reputation for fashion items such as Paris, Milan, London and New York. The geographical indication in these instances merely serves to suggest that the goods are produced or designed in that place. The word 'Paris' does not distinguish a particular undertaking providing the goods. Indeed the Opponent's own use of 'Paris' in conjunction with its registered mark 'musier' seems entirely consistent with those common practices.
40. Even in instances where a place has no specific reputation for the goods, it is likely that consumers would expect those goods to originate from or have a connection to that place/area when that place name is applied to the goods.
41. Nonetheless, 'PARIS' in the Contested Mark does contribute to the overall impression of the mark i.e. it is not negligible. In relation to the applied-for goods, the presence of 'PARIS' adds a certain cachet, and it would not simply be overlooked, but that cachet is one of geographical prestige and reputation and not one of trade origin. The average consumer will rely on the word 'MUSIER' as an indication of trade origin, therefore the overall impression of the Contested Mark is dominated by the word 'MUSIER'.

#### Visual comparison

42. The Earlier Mark comprises solely of the word 'musier' which is identical to the first word of the Contested Mark. Whilst the Earlier Mark is in lowercase letters and 'MUSIER' in the Contested Mark is presented in upper case letters, this is

not a point of difference since fair and notional use of word marks would allow for use in upper or lower case.<sup>10</sup>

43. 'PARIS' has no counterpart in the Earlier Mark and represents a point of visual difference between the marks. However, the whole of the Earlier Mark is contained in and is the dominant and distinctive component of the Contested Mark, and sits at the beginning of the Contested Mark (where the average consumer tends to focus their attention).<sup>11</sup> I find the marks are visually similar to at least a medium degree.

#### Aural comparison

44. The word 'MUSIER', present in both marks, would be pronounced identically. As the word 'PARIS' has no counterpart in the Earlier Mark, overall, I find the marks to be aurally similar to a medium degree.

#### Conceptual comparison

45. The parties have both made submissions with regards to the concept of the marks, the Applicant's submissions are as follows:

*"Brand meaning: Committed to creating a jewellery brand with Paris romance.*

*Brand creation background: The founder of the brand, when he was travelling in Paris, he saw musicians playing music freely in the square, and suddenly he was inspired by the creation and wrote the "musier paris" brand."*

The Opponent contends that the Applicant's submissions "*explain only why the word PARIS was chosen*" and submits that "*MUSIER is a made up word with no significance*".

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<sup>10</sup> *Bentley Motors Limited v Bentley 1962 Limited* BL O/158/17, paragraph 16

<sup>11</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81

46. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>12</sup> Based on the Applicant's submissions, it would appear that the Applicant is implying that the word 'MUSIER' has some conceptual link to musicians however, it is unlikely the average consumer will make any such connection. There is no evidence before me as to the meaning of the word and it is not a word with which the average consumer would be familiar.
47. I find that the word 'MUSIER' has no immediately graspable concept and that overall the average consumer is unlikely to attribute any meaning to it therefore the concept of the word is neutral. Even if it had a concept, when comparing the two marks, that concept would be deemed identical.
48. With regards to 'PARIS', it is an indication of geographical origin that carries a certain cachet in relation to the goods at issue, however beyond that simple function it does not add or alter the concept of 'MUSIER'. That said, whilst it is conceivable that when seen in conjunction with the word 'MUSIER', the average consumer may assume that 'MUSIER' is a word or a name of French origin, it does not alter my finding that 'MUSIER' has no immediately graspable concept that is relevant.

### **Distinctive character of the Earlier Mark**

49. The degree of distinctiveness of the Earlier Mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the Earlier Mark, the greater the likelihood of confusion may be, although it is the distinctive character of a component that is similar between the marks that is particularly relevant.
50. 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.

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<sup>12</sup> This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

51. 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).”*

52. The Opponent has not made any express claim to enhanced distinctiveness, although it has submitted evidence of use (albeit to demonstrate that it often uses ‘musier’ in conjunction with ‘Paris’ – an issue which I have dealt with in the Preliminary Issues to this decision). This evidence however would be insufficient to establish enhanced distinctiveness, and in any event, none of the use shown relates to the goods on which it relies for the purposes of this opposition. As such, I only have the inherent distinctiveness of the mark to consider.
53. The word ‘musier’ does not have any apparent meaning. It appears to be an invented word that has no allusive qualities in relation to the goods and consequently it enjoys a high degree of inherent distinctiveness.



## **Conclusions on Likelihood of Confusion**

54. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.<sup>13</sup> I must also keep in mind the average consumer of the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.<sup>14</sup>
55. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the Contested Mark with an imperfect recollection of the Earlier Mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.<sup>15</sup> The relative weight of the factors is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case.<sup>16</sup>
56. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.<sup>17</sup>
57. Given the identity between the shared element 'MUSIER' (which I have found has a high degree of distinctiveness on an inherent basis), whilst factoring in the role 'PARIS' plays in the overall impression of the Contested Mark and in relation to the goods at hand, and finally, taking into consideration that the goods are

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<sup>13</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

<sup>14</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

<sup>15</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

<sup>16</sup> See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O/049/17, (*Rochester Trade Mark*).

<sup>17</sup> See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion

identical, I find that a significant proportion of the average consumer would be confused as to the trade origin of the goods.

58. Indeed, I find that the average consumer, who is paying a medium level of attention, may directly confuse one mark for the other, recalling only the distinctive word 'MUSIER'. Alternatively, they would anyway note that the marks share the identical common element 'MUSIER' and would conclude that they originate from the same or related undertaking, where the inclusion of the word 'PARIS' merely signifies a non-distinctive indication of geographical origin.

### **OUTCOME**

59. The opposition succeeds under section 5(2)(b) of the Act.

### **COSTS**

60. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £600 as a contribution towards the cost of the proceedings. The costs awarded include no contribution in relation to the preparation of evidential content, as it was not pertinent to the grounds of opposition before me and did not materially assist in the decision. The sum is calculated as follows:

Official fee	£100
Preparing the Statement of Grounds and considering the Counterstatement	£200
Preparing written submissions	£300
<b>TOTAL</b>	<b>£600</b>

61. I therefore order Shanghai ZhaoNuo Trade Co.Ltd. to pay the sum of £600 to IT COLLECTION. 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 2nd day of September 2022**

**Daniela Ferrari**  
**For the Registrar**