

O/904/22

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL TRADE
MARK REGISTRATION NO. 1577972
IN THE NAME OF KOKKA CO., LTD. FOR THE TRADE MARK**



IN CLASS 24

AND

**OPPOSITION THERETO UNDER NO. 425798
BY KOCCA S.R.L.**

Background and pleadings

1. KOKKA Co., Ltd. (“the holder”) applied to protect International Trade Mark no. 1577972 shown on the cover page of this decision in the UK on 24 November 2020. It was accepted and published in the Trade Marks Journal on 30 April 2021 in respect of the following goods:

Class 24: Printed woven fabrics; other woven fabrics; knitted fabrics; felt and non-woven textile fabrics; mosquito nets; bedsheets; futon quilts; quilt covers for futon; futon ticks [unstuffed futon]; pillowcases [pillow slips]; blankets; seat covers of textile; wall hangings of textile; curtains; tablecloths, not of paper; draperies [thick drop curtains]; upholstery fabrics; textile material; cloth; towels of textile; Japanese cotton towels [Tenugui]; handkerchiefs.

2. KOCCA S.R.L. (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier EU¹ trade mark registration set out in the table below:

Trade mark	Application date	Registration date	Services
KOCCA	16/10/2018	27/02/2019	Class 35: Retailing and wholesaling, including online, of perfumery, cosmetics, make-up, soaps, cosmetic hair care preparations, deodorants for personal use, potpourris (fragrances), air fragrancing preparations, perfumed candles; Retailing and wholesaling, including online, of spectacles and accessories therefor, spectacle frames and cases, protective

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

			<p>helmets, protective covers and cases for mobile telephones and tablet computers, blank USB flash drives; Retailing and wholesaling, including online, of jewellery, imitation jewellery, clocks and watches; Retailing and wholesaling, including online, of stationery, printed matter, adhesives, photographs; Retailing and wholesaling, including online, of textiles, bed covers and table covers, towels, cushions; Retailing and wholesaling, including online, of luggage, bags, backpacks, valises, pocket wallets, umbrellas; Retailing and wholesaling, including online, of clothing, bath robes, underclothing, stockings and tights, footwear, headgear; Retailing and wholesaling, including online, of games and playthings; Advertisement services.</p>
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3. By virtue of its earlier filing date, the above mark constitutes an earlier mark in accordance with section 6 of the Act.

4. The opponent argues that the respective goods and services are similar and that the marks are similar, and that as such there will be a likelihood of confusion between the marks.

5. The holder filed a counterstatement denying there will be a likelihood of confusion between the marks. The holder claims that the marks are visually similar to only a low degree, and that the goods and services have different origins and trade channels.

6. Both sides filed evidence in these proceedings. This will not be summarised but has been fully considered.

7. A Hearing took place on 4 October 2022, with the opponent represented by Matthew Dick of the opponent's representatives D Young & Co LLP. The holder did not attend the hearing, and instead filed written submissions in lieu, which will not be summarised but will be referred to as and where appropriate during this decision. The holder is represented in these proceedings by Bromhead Johnson LLP.

8. 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.

Evidence

9. Whilst I do not intend to summarise the evidence, I note here that the opponent filed its evidence in the form of a witness statement in the name of Matthew James Dick, Partner and Solicitor at D Young & Co LLP. The statement introduces four exhibits, namely Exhibit MJD1 – Exhibit MJD4 and is dated 28 February 2022.

10. The holder filed its evidence in the form of a witness statement in the name of Misa Motoda of Kokka Co. Ltd (the holder). The statement introduces four exhibits, namely Exhibit MM1 – Exhibit MM4 and is dated 27 April 2022.

Proof of use

11. As the earlier mark relied upon had not been registered for a period of five years on the designation date of the applied for International trade mark, it will not be subject to proof of use in accordance with section 6A of the Act.

Section 5(2)(b)

12. 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”.

Section 5A

13. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

15. The goods and services for comparison are as follows:

Earlier services	Contested goods
<p>Class 35: Retailing and wholesaling, including online, of perfumery, cosmetics, make-up, soaps, cosmetic hair care preparations, deodorants for personal use, potpourris (fragrances), air fragrancing preparations, perfumed candles; Retailing and wholesaling, including online, of spectacles and accessories therefor, spectacle frames and cases, protective helmets, protective covers and cases for mobile telephones and tablet computers, blank USB flash drives; Retailing and wholesaling, including online, of jewellery, imitation jewellery, clocks and watches; Retailing and wholesaling, including online, of stationery, printed matter, adhesives, photographs; Retailing and wholesaling, including online, of textiles, bed covers and table covers, towels, cushions; Retailing and wholesaling, including online, of luggage, bags, backpacks, valises, pocket wallets, umbrellas; Retailing and wholesaling, including online, of clothing, bath robes, underclothing, stockings and tights,</p>	<p>Class 24: Printed woven fabrics; other woven fabrics; knitted fabrics; felt and non-woven textile fabrics; mosquito nets; bedsheets; futon quilts; quilt covers for futon; futon ticks [unstuffed futon]; pillowcases [pillow slips]; blankets; seat covers of textile; wall hangings of textile; curtains; tablecloths, not of paper; draperies [thick drop curtains]; upholstery fabrics; textile material; cloth; towels of textile; Japanese cotton towels [Tenugui]; handkerchiefs.</p>

footwear, headgear; Retailing and wholesaling, including online, of games and playthings; Advertisement services.	
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16. I also note at this stage that the holder chose to provide a 'fall-back' specification at the close of proceedings. This is as follows:

Class 24: Printed woven fabrics; other woven fabrics; knitted fabrics; felt and non-woven textile fabrics; textile material.

17. I will consider whether the holder's fall-back specification is required and whether it should be applied at the end of this decision.

18. 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 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".

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

20. 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 General Court (“GC”) stated that goods may be considered “complementary” where:

“...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 that the responsibility for those goods lies with the same undertaking”.

21. Both parties made reference to case law concerning the comparison to be made between the retailing of goods vs the goods themselves. The opponent made reference to *Oakley, Inc v OHIM*, Case T-116/06. In *Oakley*, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

22. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs K.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

23. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*², and *Assembled Investments (Proprietary) Ltd v. OHIM*³, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁴, Mr Hobbs K.C. concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the holder’s trade mark;

² Case C-411/13P

³ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁴ Case C-398/07P

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

24. Within its submissions in lieu of a hearing, the holder referenced the findings of the Advocate General in *Prakiter Bau*, Case C-418/02, referring particularly to paragraphs 89, 90 & 95 as follows:

"7. That leaves: "Retailing and wholesaling, including online, of textiles, bed covers and table covers, towels, cushions." In *Prakiter Bau*, Case C-418/02, the Advocate General said in paragraph 89:

"I agree with the Bundespatentgericht that it is desirable to avoid giving the proprietor of a mark registered for services supplied in connection with the retail sale of goods very extensive protection which would cover other services that may be offered in connection with selling goods, as well as all the goods sold by such proprietor."

In paragraph 90:

"In my opinion, therefore, in trade-mark law it is essential that the protection of the method of selling, by the registration of marks for the services provided in connection with the retail sale of goods, should not have an adverse effect on the value of the marks designating the actual goods sold."

And in paragraph 95:

"It will be possible to find a likelihood of confusion only if, having regard to all the circumstances of the particular case, the consumers concerned

might believe that the goods or services designated by the third party mark have the same origin as the services supplied by the retailer in connection with the retail sale of goods, that is to say, according to the case-law cited by the Bundespatentgericht, that the goods or services of the third party were supplied or manufactured under the control of the retailer to whom the responsibility for their quality may be attributed.”

25. Within its written submissions, the holder argues “The Holder’s evidence shows that the goods of the International Registration (in particular those of the fall-back specification) are sold wholesale, not retail. The Holder’s trade customers constitute a different public from the retail consumers of the retail services of the Opponent’s registration”. The opponent disagreed with this submission within its skeleton arguments, and I agree with the opponent’s position. Whilst it may be that the holder itself only sells its goods wholesale, I must consider the goods as applied for and all circumstances in which the mark may be used if registered, and not simply the particular circumstances in which the holder currently chooses to sell its own goods.⁵ Goods including the textiles featured in the fall-back specification provided by the holder will all generally share users with the retail services provided for those goods. The general public will often buy fabric in lengths in a retail situation for using at home for craft projects, or for making curtains or cushions. Whilst professional consumers may also use the retail services, I note they may be more likely to purchase the goods from wholesales. However, as both the retail and wholesale services are covered by the earlier services, in both instances users and channels of trade may be shared with the goods themselves.

26. I also note at this stage that the opponent has provided in its evidence at Exhibit MJD1 webpages from a number of large stores, including John Lewis, Next and Argos. The opponent put forward arguments that these stores sell a whole range of goods as shown, and that retail services will be similar to the goods, even where these are not covered by the same. However, the opponent did accept that this would not *a/ways* be the case, for example where the goods are very different. The opponent stated as an

⁵ See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

example, that the retail of lawnmowers is unlikely to be similar to the contested goods. I have considered the evidence filed and the submissions made in this respect.

27. The earlier services include *retailing and wholesaling, including online, of textiles, bed covers and table covers, towels, cushions*. It is my view that the retailing and wholesaling of textiles includes the retailing and wholesaling of the following goods in the holder's specification:

Printed woven fabrics; other woven fabrics; knitted fabrics; felt and non-woven textile fabrics; upholstery fabrics; textile material; cloth

28. In addition, the opponent's retailing/wholesaling of towels includes the retailing/wholesaling of the holder's following goods:

Towels of textile; Japanese cotton towels [Tenugui]

29. Further, the retailing/wholesaling of bedcovers includes the retailing/wholesaling of the holder's following goods:

Bedsheets; futon quilts; quilt covers for futon; pillowcases [pillow slips]; blankets

30. Finally, the retailing of table covers will include the retailing of the following goods covered by the holder:

Tablecloths, not of paper

31. With consideration to the services and the goods covered in this instance, and keeping in mind the case law above, it is my view that the retail services are different in nature, purpose and method of use to goods applied for. However, I find that the goods are important or indispensable for the services. Further, it is my view that with consideration to the particular goods and services at play, that the consumer would be likely to believe the goods are offered from the same entity as the retail services and vice versa, and as such I find these to be complementary. I also find it likely that they would indeed be offered by the same entities, and I find that trade channels and users

would be shared. Overall, I find the above goods which are directly covered by the holder's specification are identical to those covered by the opponent's retail and wholesale services in this instance and that the respective goods and services are similar to a medium degree.

32. This leaves the following goods for consideration:

mosquito nets; futon ticks [unstuffed futon]; seat covers of textile; wall hangings of textile; curtains; draperies [thick drop curtains]; handkerchiefs

33. I consider that *futon ticks* are covers for mattresses or large cushions which will be used on a futon, which itself will serve as an occasional bed. It is my view that these will be sold with the other goods such as bedcovers and cushions. I find the consumer would expect an entity offering retail and wholesale services for bedcovers and cushions would also offer of futon ticks, and they are likely to do so, and as such the trade channels will be shared. I also find the users will often be shared, by way of the general public in retail stores and the professional consumer purchasing the goods wholesale to stock retail stores. Overall, I find there to be a low degree of similarity between the goods and the opponent's retail services for bedcovers and cushions.

34. In respect of the holder's *curtains, draperies [thick drop curtains], and seat covers of textile*, it is my view these will commonly be offered both in retail stores selling textiles, and those selling bedcovers and cushions. I find the trade channels and users will be shared. In respect of the retail of textiles, I find there may be a slight element of competition with these goods, with consumers choosing between using retail store services to purchase textiles to make their own curtains or seat covers or choosing to purchase ready-made curtains and seat covers themselves. I find the goods to be in the same business sector as the services, all being in relation to home textiles and interior furnishings, and I find the consumer would expect the same entity to offer the retail services of textiles and cushions and also offer these goods, and that in fact they are likely to do so. Overall, I find the goods to be similar to the services to a low degree.

35. In respect of *mosquito nets*, I find that in the UK these are likely to be sold in outdoor equipment stores selling goods for camping and travel. I do not consider it to be normal for these goods to be sold alongside home furnishings such as bedding. Whilst I note the earlier mark offers retail services for backpacks, which may also feature in outdoor stores, it seems unlikely that the consumer would assume an entity offering the retail services for backpack would also produce mosquito nets under its own mark. Overall, I do not consider these goods to be similar to those covered by the earlier mark.

36. In respect of the goods *wall hangings of textile*, whilst I note these will be made of textiles, I find these are likely to be sold in decorative home accessories stores. These are more akin to art pieces rather than general practical home furnishings. Whilst I note the opponent's evidence of wall hangings being sold at Exhibit MJD1, I note these are featured within the 'decorative accessories' section of the John Lewis website, and 'wall art' on the Next website. Whilst these stores are also evidenced to offer retail services for other goods such as bedding and curtains on their website, these are shown to be in completely different categories. I do not consider the fact that a large department store which sells a range of disparate goods may offer both retail services for bedding and textiles (for example), and may also offer wall hangings, is sufficient to render these goods and services similar. I do not consider the retail services covered by the opponent to normally be associated with the sale of these goods. I do not consider it likely these goods will be produced and sold by the more focused retailers of textiles. Further, I do not consider they would normally be produced and sold by retailers of the more practical home furnishing items such bedding and tablecloths and towels. Overall, I do not consider these goods to be similar to the opponent's earlier retail services.

37. The final goods for comparison are *handkerchiefs*. At the hearing, Mr Dick for the opponent stated these goods were identical or highly similar to the clothing element of its earlier services *retailing and wholesaling, including online, of clothing*. Mr Dick argued these may be used to blow one's nose, but also, they may be used as pocket squares for fashion. I do not agree that handkerchiefs and pocket squares are interchangeable, and I do not believe it would be common for a handkerchief to put on display as a fashion accessory, although I accept from the evidence provided at Exhibit

MJD1 that these may be sold together by retailers. I do not accept that handkerchiefs are themselves clothing items. However, I nonetheless consider the earlier services relied upon as highlighted by the opponent, in addition to the relied upon services *retailing and wholesaling, including online, of underclothing, stockings and tights*. It is my view that the retail services that may normally be offered alongside the goods handkerchiefs will likely be the retail of services of clothing including these smaller clothing goods such as underwear. Whilst the retail services for these goods do not directly cover the sale of handkerchiefs, it is my view that trade channels will be shared, and the consumer will expect that an entity offering the opponent's retail services may also provide these goods. Users will be shared by way of the general public, and overall I find these goods to be similar to the opponent's earlier services to a low degree.

38. At the hearing, Mr Dick for the opponent advanced the argument that the goods are also similar to its earlier advertising services. When questioned on this, Mr Dick stated this was a fallback finding of sorts, if similarity was not found with the retail services notwithstanding that fact that he believed a finding of this nature would be wrong. Mr Dick stated that confusion may occur where an advertising agency specialising in the promotion of textiles goods for example, put out an advert for textiles goods on a billboard and also had its own name on that billboard. The opponent did not provide any reasoning in line with the factors set out in the case law to support its position on similarity, and said that these should not always apply, for example where goods are clearly similar or where there are other reasons for similarity. For completeness, I find the opponent's argument that the advertising services are similar to the goods filed to be fundamentally flawed. It is difficult to think of a category of goods or services that will not be subject to advertising. If advertising services were similar to the goods and services they advertised for this reason alone, this would undoubtedly apply to at least the vast majority of goods and services. I do not find the opponent's evidence showing that some advertising agencies specialise in the advertisement of textiles or textile goods to assist the opponent. In the absence of any sound reasoning for why I should find advertising services similar to the holder's goods, I find these to be dissimilar.

39. In order for an opposition to succeed under section 5(2)(b) of the Act, there must be some similarity between the goods and services. The opposition therefore fails in respect of the following goods:

mosquito nets; wall hangings of textile

40. I will proceed with the decision under section 5(2)(b) in respect of the remaining goods.


Comparison of 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 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.

43. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
<p style="text-align: center;">KOCCA</p>	<div style="text-align: center;">  </div> <p>Colours claimed The mark contains the colours Gold and green-blue (DIC-N860).</p> <p>Colour indication The stylized letters are in gold. Background is colored in green-blue (DIC-N860).</p>

44. The earlier mark is the five letter word mark KOCCA. The overall impression of the mark resides in this single element.

45. The contested mark comprises the five letter word KOKKA, which is displayed in gold lettering and is presented on a rectangular green-blue background. The word element is by far the most dominant and distinctive element of the contested mark, however, whilst the rectangular background, slight stylisation and colour combination play a far lesser role in the overall impression they are not negligible.

Visual comparison

46. Visually, the marks coincide through the use of the first two letters ‘KO’ and the last letter ‘A’. The dominant word element is the same length in each mark, the main visual similarities are at the beginning of the marks and the differences are in the

middle of the marks where the consumer tends to pay less attention.⁶ The earlier mark is a word mark and so it may be used in a range of standard fonts and colours, and so the very slight stylisation and the gold colour font make little difference to the marks visually. The use of the blue-green rectangle is a point of visual difference, but it is purely ornamental. Overall, I find the marks to be visually similar to between a medium and high degree.

Aural comparison

47. In respect of the aural comparison, the holder submits:

“The aural similarity between the marks is questionable. A consumer may think that the double “c” in the Opponent’s mark is pronounced as “tch” (as “c” is sometimes pronounced in Italian) so the pronunciation would be “Kotcha”. Even if this is not, in fact, how the mark would be pronounced by an Italian speaker, it might be the erroneous pronunciation by a UK consumer. The “kk” in the Holder’s mark would always be hard, so the two marks could sound different

48. Whilst I have noted the holder’s submissions on the aural difference between the marks, it is my view that to at least the vast majority of consumers, both marks will be pronounced identically as COK-AH, or alternatively as COH-KAH. For these consumers, the marks will be aurally identical. I accept however, that some consumers may land on an alternative pronunciation for each of the marks on the basis that they are not known in the English language.

Conceptual comparison

49. I do not consider either mark to have a meaning within the English language, and it is my view that neither mark will convey a meaning to the UK consumer. The marks are therefore conceptually neutral.

Average consumer and the purchasing act

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

50. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

51. 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.”

52. The relevant consumer of the goods and services will comprise two groups. There will be the professional consumer of the services such as the wholesale services and the goods, that will use these services to purchase goods for the purpose of either selling on or creating finished goods to sell on to end consumers. These professional consumers will pay additional attention to the quality, aesthetics and the price point of the goods purchased, and the reliability and reputation of the services. They will likely purchase the goods and use the services on a larger scale, and overall I find at least an above medium level of attention will be paid.

53. In respect of all of the retail services and also the goods, the general public will be the primary user group, although I accept professional consumers may also occasionally engage with retail services for textiles. The general public will consider factors such as the quality and aesthetics of the goods and the reliability of the services, and I consider a medium level of attention will be paid in respect of the same,

whilst the professional consumer will maintain an above medium level of attention as with the wholesale services above.

54. The purchasing process will be primarily visual, with goods purchased in physical and online retail and wholesale stores, and the services offered via the same. However, I note there may be word of mouth recommendations, in addition to assistance from retail staff, and in respect of the wholesale of goods telephone orders may be placed, and so I cannot completely discount the aural considerations.

Distinctive character of the earlier trade mark

55. 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

56. The earlier mark is not allusive nor is it descriptive of the services offered. Further, it appears to have no meaning for the average consumer. Within its skeleton arguments, the opponent submitted the earlier mark holds an above average degree of distinctive character. I accept this submission, although I prefer to characterise this as an above medium degree of inherent distinctive character.

57. The opponent has not filed any evidence of use of its earlier mark. I am therefore not in a position to consider if the distinctive character has been enhanced above its inherent level.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

58. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 14 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the relevant consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion, and that the distinctiveness of the common elements is key.⁷ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are selected will have a bearing on how likely the average consumer is to be confused.

59. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or an economically linked undertaking.⁸

60. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor K.C. (as he then was), 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

⁷ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis K.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

⁸ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

61. I found there is either a low or medium degree of similarity between the majority of the contested goods and the earlier services. Where the goods were found to be dissimilar to the earlier services, the opposition will fail. I found the relevant consumer comprised of the general public would likely pay a medium degree of attention to the goods and services, and I found the level of attention paid by the professional consumer will be above medium. I found the earlier mark to hold an above medium degree of distinctive character, and I found the marks to be visually similar to between a medium and high degree, to be aurally identical (for most consumers), and to be conceptually neutral.

62. Considering all of the factors, and considering the similarities between the use of the letter 'c' and the letter 'k' in the English language, in addition to the lack of a conceptual hook in either mark, and the fact that the differences fall in the middle of the marks, it is my view that at least a significant portion of consumers are likely to misremember the use of the 'kk' in the later mark or the 'cc' in the earlier mark, and will imperfectly recollect one mark for the other in this instance. I therefore find there is likely to be a likelihood of direct confusion between the marks in respect of the similar goods filed, even where the similarity is low.

63. For completeness, I also consider that if there will be a likelihood of indirect confusion between the marks. It is my view that in all instances where the consumer fails to recall the use of the 'CC' in the earlier mark and the 'KK' in the later mark, there will be confusion, even for the portion of consumers that may notice and remember the additional differences, for example, where the blue-green rectangle is recalled. In those circumstances the earlier mark will be imperfectly recollected as the dominant element of the later mark (or vice versa), with the addition or omission of a simple rectangle behind the mark and will appear to the consumer to be a simply stylised version of the same, and indirect confusion will follow in respect of all of the similar goods. I find this to be a likely outcome for a further significant portion of consumers.

64. As I have found direct and indirect confusion for the similar goods in respect of at least a significant portion of consumers, the opposition based on section 5(2)(b) succeeds in respect of all of the goods found to be similar to the earlier services.

Final Remarks

65. For completeness, I now consider the holder's fall-back specification as follows (showing amendments):

~~Class 24: Printed woven fabrics; other woven fabrics; knitted fabrics; felt and non-woven textile fabrics; mosquito nets; bedsheets; futon quilts; quilt covers for futon; futon ticks [unstuffed futon]; pillowcases [pillow slips]; blankets; seat covers of textile; wall hangings of textile; curtains; tablecloths, not of paper; draperies [thick drop curtains]; upholstery fabrics; textile material; cloth; towels of textile; Japanese cotton towels [Tenugui]; handkerchiefs.~~

66. I do not consider that this amendment will be sufficient to overcome the likelihood of confusion, which I have found to exist in respect of goods remaining in the specification above. I therefore do not find it appropriate in this instance to apply this proposed amendment to the applied for goods to overcome this opposition.

67. Subject to any successful appeal, the application will be refused in respect of the following goods:

Class 24: Printed woven fabrics; other woven fabrics; knitted fabrics; felt and non-woven textile fabrics; bedsheets; futon quilts; quilt covers for futon; futon ticks [unstuffed futon]; pillowcases [pillow slips]; blankets; seat covers of textile; curtains; tablecloths, not of paper; draperies [thick drop curtains]; upholstery fabrics; textile material; cloth; towels of textile; Japanese cotton towels [Tenugui]; handkerchiefs.

68. Subject to any successful appeal, the application will proceed to registration in respect of the following goods:

Class 24: wall hangings of textile; mosquito nets

COSTS

69. The opponent has been considerably more successful in the opposition than the holder and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1260 as a contribution towards the cost of the proceedings, including for a 10% reduction to account for the holder's partial success. The sum is calculated as follows:

Official fee:	£100
Preparing and filing the TM7 and considering the counterstatement:	£200
Filing evidence and considering the holder's evidence:	£500
Preparing for and attending the hearing:	£600
10% reduction for the holder's partial success:	-£140
Total:	£1260

70. I therefore order KOKKA Co., Ltd. to pay KOCCA S.R.L. the sum of £1260. 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 18th day of October 2022

**Rosie Le Breton
For the Registrar**