

**O/0227/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3729527  
IN THE NAME OF ULBRRY LTD  
IN RESPECT OF THE TRADE MARK**

**Ulbrry**

**IN CLASSES 18 & 25**

**AND**

**OPPOSITION THERETO UNDER NO. 431343  
BY MULBERRY COMPANY (DESIGN) LIMITED**

## **Background and pleadings**

1. ULBRRY LTD (“the applicant”) applied to register the trade mark no. 3729527 for the mark Ulbrry in the UK on 6 December 2021. It was accepted and published in the Trade Marks Journal on 31 December 2021. Following an amendment, the specification now stands as follows:

*Class 18: Bags; Nose bags [feed bags]; Bags (Nose -) [feed bags]; Belt bags and hip bags; Makeup bags; Work bags; Game bags; Toilet bags; Courier bags; Diplomatic bags; Flight bags; Changing bags; Diaper bags; Camping bags; Athletics bags; Roll bags; Barrel bags; Umbrella bags; Crossbody bags; Grips [bags]; Drawstring bags; Cabin bags; Cosmetic bags; Duffel bags; Duffle bags; Hunting bags; Toiletry bags; Knitted bags; Evening bags; Shoulder bags; Cloth bags; Souvenir bags; Waterproof bags; Hiking bags; Book bags; School bags; Travelling bags; Travel bags; Bum bags; Carrying bags; Wheeled bags; Knitting bags; Roller bags; Beach bags; Sling bags; Shoe bags; Boot bags; Garment bags; Suit bags; Gladstone bags; Overnight bags; Gym bags; Sport bags; Athletic bags; Traveling bags; Tote bags; Luggage bags; Attaché bags; Hip bags; Belt bags; Key bags; Clutch bags; Leather bags; Bucket bags; Feed bags; Shopping bags; Weekend bags; Messenger bags; Canvas bags; Boston bags; Kit bags; Casual bags; Towelling bags; Nappy bags; Hand bags; Sports bags; Waist bags; Music bags; Nose bags; Reusable shopping bags; Tool bags, empty; Grocery tote bags; Frames for bags [structural parts of bags]; frames for bags [structural parts of bags].*


*Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Layettees [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing;*

*Ladies' clothing; Latex clothing; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.*

2. Mulberry Company (Design) Limited (“the opponent”) oppose 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 UK and UK comparable Trade Marks outlined in the table below:<sup>1</sup>

<b>Mark</b>	<b>Registration no.</b>	<b>Filing date/ Registration date</b>	<b>Goods relied upon</b>
MULBERRY	2484516	9 April 2008/2 January 2009	Class 18: Articles made of leather or imitation leather; articles of luggage, tote bags, travel bags, suitcases, grips, hold-alls, trunks and valises; handbags, attache cases, briefcases, shopping bags, purses, pocket cases, pocket wallets, sports bags, school bags, backpacks, umbrellas.
Mulberry	914906391	14 December 2014/9 August 2016	Class 18: Bags; handbags; shoulder bags; satchels; tote bags; clutch bags; backpacks; pouches of leather; articles of luggage; travel bags; suitcases; hold-alls; trunks and valises; attache cases; briefcases; shopping bags; purses;

<sup>1</sup> The opponent originally relied upon a further earlier mark, namely UK registration no. 2490951. However, the opponent only relied on this mark to oppose the applicant's goods in class 14, which have subsequently been removed from the application. This earlier mark is therefore no longer relevant within these proceedings.

			<p>wallets; pocket cases; pocket wallets; sports bags; school bags; leather cases for personal planners and diaries; make-up bags; wash bags; folio cases; travelling cases of leather; dog collars; dog leads; key cases; key pouches; umbrellas</p> <p>Class 25: Clothing, footwear, headgear; hats; gloves; jackets; shirts; blouses; belts; jumpers; scarves; dresses; coats; shoes; ties; boots; rainwear; sports clothing; trousers; polo shirts; headscarves.</p>
 MULBERRY	902313674	24 July 2001/10 October 2002	<p>Class 18: Articles made of leather or imitation leather; articles of luggage, tote bags, travel bags, suitcases, grips, hold-alls, trunks and valises; handbags, attaché cases, brief cases, shopping bags, purses, pocket cases, pocket wallets, sports bags, school bags, back packs, umbrellas</p> <p>Class 25: Clothing, footwear, headgear.</p>

3. By virtue of their earlier filing dates, the above marks constitute earlier marks in accordance with section 6 of the Act.

4. The opponent argues that the respective goods are identical or similar and that the marks are similar. The opponent claims to hold an enhanced level of distinctive

character in respect of its earlier marks and submits that there exists a likelihood of confusion between its earlier marks and the contested marks.

5. The applicant filed a counterstatement denying that there will be any confusion between the marks. Although the earlier marks had been registered for a period of over five years at the date on which the application was filed, the applicant did not request that the opponent file proof of use of its earlier marks.

6. Both sides filed evidence in these proceedings. This will not be extensively summarised at the outset of these proceedings but has been considered and will be referred to where appropriate.

7. Both sides filed written submissions which will not be summarised but 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.

8. The opponent is represented in these proceedings by Withers & Rogers LLP. The applicant is unrepresented in these proceedings.

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

## **Evidence**

10. As mentioned above, I do not intend to extensively summarise the evidence filed at this stage, however, I will briefly outline the statements and exhibits filed by the parties. The opponent filed its evidence in the form of a witness statement in the name of Kate Anthony Wilkinson, General Counsel and Company Secretary for the opponent since May 2011. The statement is dated 15 August 2022 and introduces 12 exhibits, namely Exhibit KAW1 to Exhibit KAW12. The evidence filed goes towards showing the use and promotion of goods under the earlier marks in the UK.

11. The applicant filed its evidence in the form of a witness statement in the name of Ayesha B Jalal, company director of the applicant since 22 November 2021. The statement introduces four exhibits, namely Exhibit JS1 to Exhibit JS4. The statement is dated 21 October 2022. The exhibits filed provide details of the search results from the UK Intellectual Property Office which did not cite the earlier marks, a certificate of incorporation for the applicant, in addition to pages showing use made by the applicant and the opponent of the marks.

## **Decision**

### **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”.

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**

15. Within its TM8, the applicant has not denied the opponent's claim that the goods are similar or identical to those under its own mark. In addition, I note that some of the contested goods, i.e. *bags* in class 18 and *clothing* in class 25 are clearly identical to goods registered by the opponent, such as its *bags* in class 18 and its *clothing* in class 25 registered under its earlier mark number 914906391. In the circumstances, I intend to proceed with this opposition on the basis that the contested goods are identical to those covered by the earlier trade marks. If the opposition fails even where the goods are identical, it follows that the opposition will also fail where the goods are only similar. If the opposition succeeds on this basis, I will return to conduct a full comparison of the goods as required.

### **Comparison of marks**

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions





created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice (“CJEU”) of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

17. 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.

18. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
MULBERRY	Ulbrry
	
	

### **My approach**

19. I am proceeding in this opposition on the basis that the earlier goods are identical to the contested goods. Further, even if I were not proceeding on this basis, I do not consider that the goods covered under the third earlier mark relied upon by the opponent put it in a better position than those relied upon under its first and second earlier marks. In addition, having reviewed the evidence, which I will summarise in more detail later in this decision, it is my view that the vast majority of the use shown is in relation to the opponent’s first and second marks relied upon. I also note that the

third earlier mark relied upon includes a device element which has no counterpart in the contested mark, which can only act to reduce its similarity with the same. It is clear that the opponent's first and second earlier mark therefore put it in the strongest position within this opposition moving forward. If there is no likelihood of confusion based on these two earlier marks, it follows there will be no likelihood of confusion based on the third earlier mark relied upon. I therefore intend to consider this opposition based on the first and second earlier mark only from this point onwards.

20. The first earlier mark in the table above comprises the single word MULBERRY. The overall impression resides in the mark as a whole.

21. The second earlier mark also comprises the word 'Mulberry' displayed in a slightly stylised font. The word 'Mulberry' is the most dominant and distinctive element of this mark, and the font used makes only a minimal contribution to the overall impression of the same.

22. The contested mark is the single, invented word Ulbrry. The overall impression resides in the mark as a whole.

### **Visual comparison**

23. Visually, both earlier marks coincide with the contested mark through the use of the letters ULB-RRY. They all differ by way of the inclusion of the letter 'M' at the beginning of the mark, and the letter 'E' between the B-RRY in the earlier marks.

24. These are the only differences present in respect of the first earlier mark and the contested mark. Whilst the additional 'E' in the earlier mark alone does not make a big impact visually being placed in the middle of the word, the 'M' is placed at the very beginning of the mark where the consumer generally attaches more importance,<sup>2</sup> and does create a fairly significant point of visual difference. In addition, the exclusion both the 'M' and 'E' in the later mark make it appear visually shorter than the earlier mark. Overall, I find the marks to be visually similar to a medium degree.

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<sup>2</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

25. Whilst I note the second earlier mark is very mildly stylised, I note the contested mark is filed as a word mark which protects the words contained in the mark, whatever form, colour or typeface are used: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39. For this reason, I do not consider the slight stylisation of the earlier mark to add to the visual differences between the marks, and again I find this mark visually similar to the contested mark to a medium degree.

### **Aural comparison**

26. Within its submissions, the opponent submits that the 'M' in its marks will be silent. I disagree with this submission. When the consumer pronounces the earlier marks, it is my view they will begin by forming the 'Mmm' sound present at the beginning of this known English word. Aurally, the earlier marks will be pronounced as the known three-syllable word MUL-BEAR-RIE. It is my view the contested mark will most likely be pronounced as two syllables, namely UL-BRIE. However, as the contested mark appears to be an invented word, and as it is unusual to find the letters 'BRRY' together within the English language, I also find some consumers may pronounce this element using the two syllables BEAR-RIE or BURR-RIE, meaning the whole mark will be pronounced as UL-BEAR-RIE or UL-BURR-RIE. Where the contested mark is pronounced as two syllables, the earlier marks will be aurally similar to a medium degree. Where it is pronounced as three syllables, I find there to be a high degree of aural similarity between the marks.

### **Conceptual comparison**

27. Collins dictionary defines the word MULBERRY in the earlier marks as follows:<sup>3</sup>

#### ***VARIABLE NOUN***

*A **mulberry** or a **mulberry tree** is a tree which has small purple berries which you can eat.*

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<sup>3</sup> <https://www.collinsdictionary.com/dictionary/english/mulberry> [accessed 16 February 2023]

***Mulberries are the fruit of a mulberry tree.***

28. This is also my understanding of what the word Mulberry means, and it is my view that consumer will know this meaning.

29. The contested mark appears to be an invented word, and it is my view it will convey no concept to the consumer.

30. Within its final written submissions, when addressing the concept of the marks the opponent submits as follows:

“The Applicant’s Mark has no conceptual meaning and therefore a conceptual comparison cannot be made. Although the word Mulberry has a definition as stated above, the Opponent submits that the use of the Opponent’s Marks has been so substantial and widespread that consumers, when presented either visually or aurally with the word Mulberry, think immediately of the Opponent, as opposed to a tree. Whereas, the Applicant’s Mark contains no meaning whatsoever which would enable the average consumer to sufficiently distinguish it from the Opponent’s Mark.”

31. I have considered the opponent’s submissions above. Firstly, I note here it is well established that where at least one of the marks to be compared holds a clear concept, the marks can be compared conceptually. Where this concept is not held by the other mark, even if that other mark appears to hold no concept itself, the marks may still be found to be conceptually dissimilar.

32. Next, I consider the opponent’s argument that instead of conveying to the consumer a type of tree, the mark will immediately convey to the consumer the opponent. In *Retail Royalty Company v Harringtons Clothing Limited*, Phillip Harris, as the Appointed Person, considered the argument that the letters “AE” had, through their use, acquired an independent conceptual significance which would mean that the average consumer would always perceive them as meaning “AMERICAN EAGLE”. He said:

“74. The Opponent is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean different things, and in trade mark law the term is sometimes used loosely, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public as a *trade mark* [original emphasis].

75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trademark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken. Whilst a trade mark’s reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.

76. It is true that there are cases where an extensive reputation has been parlayed into conceptual meaning (for example C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*) but these are the exception rather than the rule and depend on their own facts. Furthermore, the “reputation” element in those cases related to the fame attached to the names of the individuals for their roles in society, rather than specifically to a trade mark function. In other words, it was a different sort of reputation.”

33. It is my view that in this case, the opponent is, as above, trying to equate a claim to hold a reputation under the trade mark, with the concept conveyed by the mark itself. Whilst this case is pleaded on the basis of section 5(2)(b) of the Act and as such I have not been required to consider if the mark holds a reputation at this point, I have nonetheless considered the evidence filed with the opponent’s comment on the conceptual meaning of the mark in mind. Whilst I note the opponent has made extensive use of its marks in the UK prior to the relevant date and in my view will undoubtedly hold a reputation under its marks (I will outline this use in more detail later on in this decision), it is my view that this reputation is attached specifically to the mark in a trade mark function. It does not, such as in the case of *Messi* and *Picasso*, convey to the consumer an alternative concept beyond mere trade mark acknowledgement, whether that be related to the role of an individual in society or otherwise. Further, I do

not consider that the opponent's reputation will undermine the fact that the marks convey the immediately graspable concept of MULBERRY as a type of tree, or that it will prevent this concept from being acknowledged by the consumer.

34. I therefore confirm my original view that the earlier marks will immediately convey to the consumer the concept of a type of tree, whereas the contested mark will convey no concept at all. By virtue of these differences, I find the marks to be conceptually dissimilar.

### **Average consumer and the purchasing act**

35. 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.

36. 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. (as he then was) 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.”

37. The primary group of consumers for the majority of the goods in this instance will be members of the general public. I consider these are goods that will be purchased fairly frequently, although they are unlikely to be every day purchases. The price point of the goods will vary considerably, and whilst in some instances the price of the goods will be high, I do not consider this will raise the level of attention paid towards the

categories of goods as a whole. In respect of the class 18 and class 25 goods, the general public will consider factors such as the aesthetics, quality, practicality, materials used, and possibly the sustainability of the same. Overall, I find the general public will pay a medium level of attention when purchasing the goods.

38. I consider there will also be a group of professional consumers, who will purchase the goods in order to stock retail stores for example. These consumers are likely to pay a higher degree of attention to the goods than the general public, due to the responsibility of their position and the impact the purchases may have on their business. I consider these consumers will pay at least an above medium level of attention.

39. In respect of the contested goods *frames for bags [structural parts of bags]* I consider consumers will primarily comprise professionals, such as bag manufacturers seeking these parts to use in creation and completion of the finished goods. It is my view that these consumers will also pay an above medium level of attention to the goods, on the basis that the quality and shape of the same will have an impact on the quality and design of the finished products, and as such on the saleability and success of the same.

40. All of the goods will primarily be purchased visually. The bulk of the goods such as bags and clothing will likely be purchased in either online or physical retail stores, although the professional consumer may purchase these from online or physical wholesale stores, or via brochures and catalogues. The goods *frames for bags [structural parts of bags]* are also likely to be purchased visually by professionals in this way. However, I note that there may be a verbal element to the purchasing process. For example, verbal assistance may be sought from retail or wholesale staff. I therefore cannot completely discount the aural comparison.

### **Distinctive character of the earlier trade mark**

41. 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).”

42. The earlier marks comprise the single known English word MULBERRY. As mentioned, this conveys to the consumer the concept of a type of tree. The marks hold no meaning in respect of the goods relied upon, and overall I find the earlier marks to be inherently distinctive to a medium degree. I do not find the mild stylisation of the second mark increases its inherent distinctiveness above this level.

43. The opponent has pleaded that its marks hold an enhanced degree of distinctive character. Within its TM8, the applicant does not deny this claim or put the opponent to proof of the same, and so I do not find this to be in dispute. However, I note it is nonetheless for me to determine the extent to which the distinctiveness of the opponent’s mark has been enhanced.



44. When considering the extent to which the distinctiveness of the opponent's marks has been enhanced through use, I note it is the perception of the UK consumer at the relevant date, that being the date that the application was filed, that is key.

45. Within her witness statement, Ms Wilkinson explains that the opponent was established in 1971, and that it designs, manufactures and retails a range of goods including (by way of example) bags, hats, womenswear and shoes, amongst a number of other goods listed within her statement.<sup>4</sup> Ms Wilkinson explains that the opponent is the largest manufacturer of luxury leather goods in the UK,<sup>5</sup> and confirms that in 2019 it held 12% of the UK's luxury leather goods market.<sup>6</sup> UK turnover figures for the period 2016 – 2021 are provided in Ms Wilkinson's statement as below:<sup>7</sup>

Annual Sales (in excess of GBP)	
2016-2017	120,000,000
2017-2018	120,000,000
2018-2019	110,000,000
2019-2020	95,000,000
2020-2021	65,000,000
2021-2022	90,000,000

46. Further, details of UK advertising spend are provided in Ms Wilkinson's statement as follows:

"18. Mulberry has invested substantial sums in the promotion of its Class 18 and 25 goods bearing the MULBERRY marks. Mulberry's promotional spend under the MULBERRY marks in relation to the UK alone for each financial year was as follows (figures in GBP):

2014-2015 – in excess of 5,500,000

2015-2016 – in excess of 7,000,000

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<sup>4</sup> See paragraph 5 of the witness statement of Ms Wilkinson

<sup>5</sup> See paragraph 7 of the witness statement of Ms Wilkinson

<sup>6</sup> See paragraph 33 of the witness statement of Ms Wilkinson

<sup>7</sup> See paragraph 12 of the witness statement of Ms Wilkinson

2016-2017 – in excess of 8,500,000  
2017-2018 – in excess of 10,000,000  
2018-2019 – in excess of 10,500,000  
2019-2020 – in excess of 9,000,000  
2020-2021 – in excess of 4,500,000  
2021-2022 – in excess of 12,000,000”

47. Sales figures are not broken down by the goods sold, however, a number of invoices are provided at Exhibit KAW3. These display the opponent’s second mark *Mulberry*, which in accordance with fair and notional use, I find to also constitute use of the first earlier mark, namely the word mark relied upon. The invoices are dated between mid-2016 and the relevant date. The invoices show the sale of handbags, in addition to other goods such as backpacks, card cases, wallets, purses, phone cases and keyrings. Further, they reference the sale of goods including gloves, scarfs and hats, in addition to women’s jackets, blouses, sweatshirts, skirts, trousers, jumpers and dresses. The invoices are addressed to a number of UK addresses.

48. In her statement, Ms Wilkinson explains that Exhibit KAW9 includes pages from ‘look books’ dated between 2016 – 2019. These show goods including bags, scarfs, purses/wallets, shoes and keyrings clearly displaying the second earlier mark relied upon. Exhibit KAW10 provides pages from magazines including Cosmopolitan, ES Magazine, Grazia, Harpers Bazaar, Harrods Magazine, Heat, Hello!, Marie Claire, Porter by Net-a-Porter, Style, the Stylist, Town and Country, Vogue, You, OK!, Hello! Fashion, Stella, Arcadia, Attitude, Country and Town House, The Sunday Times Style, Conde Nast, Elle, Notebook, FT How To Spend It, the Telegraph Magazine, Red, Woman and Home and Glamour. It also provides online articles from publications such as the Mail Online. Whilst a small number of these do not provide a clear date, the majority are clearly dated between 2016 and the relevant date. Most of these are promotional pieces showing the opponent’s goods including bags, shoes and various woman’s clothing items with prices provided in GBP. Some are articles about celebrities including Meghan Markle and Kate Middleton, within which they are wearing Mulberry items such as bags and coats. This is identified for the reader on the pages provided. Reference in the articles is consistently made to ‘Mulberry’, and the

second earlier mark can sometimes be seen on the goods themselves such as in the image below:



49. One article provided in Exhibit KAW10 from The Times dated 2 March 2013 is entitled “Why we all love Mulberry”. The articles by-line states “Not long ago it was a little leather factory in Somerset. Now it’s the label we can’t get enough of. World Domination can’t be far off”.

50. Ms Wilkinson explains that the opponent sells goods “bearing the Mulberry marks in Classes 18 and 25” from its website [www.mulberry.com](http://www.mulberry.com) and from third party websites such as [johnlewis.co.uk](http://johnlewis.co.uk), [harrods.com](http://harrods.com), [selfridges.com](http://selfridges.com) and [farfetch.com](http://farfetch.com),<sup>8</sup> from its standalone stores<sup>9</sup> and from its own concessions in stores including those such as House of Fraser, Selfridges, Flannels, Fenwick’s and John Lewis, and that its goods are also sold in Harrods and Selfridges.<sup>10</sup> She confirms that these concessions are located across the UK including in Belfast, Bristol, Cardiff, Cambridge, Chelmsford, Chester, Glasgow, Guilford, High Wycombe, Kent, Kingston, Liverpool, London, Manchester, Milton Keynes, Norwich, Nottingham, Southampton and Welwyn.<sup>11</sup> A list of these are also provided from the opponent’s website at Exhibit KAW4. However, I note I have not been provided with the date each concession (or the standalone stores)

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<sup>8</sup> See paragraph 15 of the witness statement of Ms Wilkinson

<sup>9</sup> See paragraph 15 of the witness statement of Ms Wilkinson

<sup>10</sup> See paragraph 17 of the witness statement of Ms Wilkinson

<sup>11</sup> See paragraph 17 of the witness statement of Ms Wilkinson

opened, and the web print out provided is dated after the relevant date on 28 July 2022. I also note I have not been provided with the date sales began via the websites mentioned.

51. Ms Wilkinson explains in her witness statement that Exhibit KAW8 comprises a selection of photographs of swing tags, internal labels, compliments slips and headed paper featuring the Mulberry marks.<sup>12</sup> Whilst some of these images show the use of the third earlier mark relied upon, they are not dated either by Ms Wilkinson or on the exhibit itself.

52. Whilst I have not detailed all of the evidence filed, this has all been carefully considered. With consideration to the sum of the evidence provided, it is my view that it shows there has been substantial use of the earlier marks within the UK prior to the relevant date. By virtue of the use in the UK of the opponent's first and second mark over a number of years in relation to at least bags, purses and wallets, in addition to women's shoes and clothing, the very large turnover figures provided, the share of the market held in relation to the UK's luxury leather goods market in 2019, the large amount of promotional material provided and the and significant promotional spend in the UK, I find that the distinctiveness of the opponent's marks has been enhanced to a high degree in respect of the aforementioned goods.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

53. 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 average 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

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<sup>12</sup> See paragraph 28 of the witness statement of Ms Wilkinson

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. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.<sup>13</sup> I must keep in mind that a lesser degree of similarity between the goods 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 obtained will have a bearing on how likely the consumer is to be confused.

54. 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 economically linked undertakings.<sup>14</sup>

55. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.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 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.

56. In this instance, I found the goods to be identical, and the marks to be visually similar to a medium degree. I found the marks to be aurally similar to either a medium or a high degree, depending on how the consumer pronounces the same. I found the marks to be conceptually dissimilar. I found the earlier marks to be inherently distinctive to a medium degree, but that the level of distinctive character held by the earlier marks has been enhanced to a high degree by virtue of the use made of the same in respect of a number of the goods relied upon. I found the consumers will

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<sup>13</sup> See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.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.

<sup>14</sup> *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

primarily comprise members of the general public paying a medium degree of attention to the goods, but that there will also be a group of professional consumers paying an above medium level of attention in respect of the same.

57. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... 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.”

58. In this instance, I found that the goods will primarily be purchased visually, and I consider the visual comparison to be of greater weight than the aural comparison when

considering the likelihood of confusion between the marks. Whilst I found that the aural comparison should not be completely ignored, its relative weight is considerably lower. In addition, I note in this case the clear conceptual differences between the marks will help the differences stick in the consumer's mind, and I note in certain circumstances conceptual differences alone may counteract visual and aural similarities between marks.<sup>15</sup> Whilst I note the factors pointing towards a likelihood of confusion in this instance, including the identity of the goods, the high aural similarity and the high level of distinctiveness held by the earlier marks, it is my view that in this instance these will not outweigh the visual and conceptual differences between the earlier marks and the contested mark, and it is my view that the consumer will not misremember or fail to notice these differences. I therefore find no likelihood of direct confusion in this instance.

59. I therefore consider if there will be a likelihood of indirect confusion between the marks in this instance. In *L.A. Sugar* Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

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

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

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

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<sup>15</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

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

60. I do not consider that the marks fall directly into one of these categories, but I note that the examples above were intended to be illustrative and are not exhaustive. However, I also note *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

61. Whilst the opponent submits there is a likelihood of association between the marks, it has not provided the basis on which it believes a likelihood of indirect confusion will occur. Having again considered all of the factors in this case, it is my view that there is no logical reason for the consumer to believe the applicant’s mark is a sub-brand or brand extension of the opponent’s earlier marks, or that it is otherwise associated with it economically. I note that the use of the contested mark may well for some consumers bring the opponent’s earlier marks to mind due to the similarities between them. However, I do not find there is a proper basis for finding they will actually be confused into thinking the marks derive from the same economic undertaking, and as such the opposition under section 5(2)(b) of the Act must fail.

62. As I have found no likelihood of confusion between the opponent’s two strongest earlier marks and the contested marks, for the reasons previously set out it follows there will also be no likelihood of confusion between the opponent’s third earlier mark relied upon and the contested mark.



## **Final Remarks**

63. The opposition has failed in its entirety, and subject to a successful appeal, the mark will proceed to registration in respect of all of the goods applied for.

## **COSTS**

64. The applicant has been successful and would normally be entitled to a contribution towards its costs. On 22 November 2022, the Tribunal wrote to the applicant attaching a costs pro-forma and stating as follows:

### **“What to do if you intend to request costs”**

If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to [tribunalhearings@ipo.gov.uk](mailto:tribunalhearings@ipo.gov.uk).

If there is to be a “decision from the papers” this should be provided by **15 December 2022**

...

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

65. The applicant did not provide a completed costs pro-forma, and in the circumstances, I make no cost award in relation to this opposition.

**Dated this 2<sup>nd</sup> day of March 2023**

**Rosie Le Breton  
For the Registrar**