

O-381-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION  
FOR A DECLARATION OF INVALIDITY UNDER NO 84523  
BY DEBONAIR TRADING INTERNACIONAL LDA  
OF REGISTRATION NO 2564118  
IN THE NAME OF THE PRETTY DRESS COMPANY LONDON LTD**

## Background

1. Registration No. 2564118 stands in the name of The Pretty Dress Company London Ltd (“the registered proprietor”). Details of the registration are as follows:

Mark	Filing/Registration dates	Specification of goods
socouture	12 November 2010/4 February 2011	Dresses

2. On 16 August 2012 an application to declare the registration invalid was filed by Debonair Trading Internacional Lda (“the applicant”). The application, made under the provisions of section 47 of the Act, relies on grounds under section 5(2)(b) of the Act. The applicant relies on the following registrations:

Mark	Filing/Registration dates	Specification of goods relied on
2482729 SO...?	18 March 2008/ 1 August 2008	Clothing; footwear; headgear; T-shirts; caps
CTM 4630406 SO...? CHIC	5 September 2005/ 9 January 2008	Clothing; footwear; headgear; t-shirts; caps

3. The registered proprietor filed a counterstatement in which it accepted the respective goods to be identical but otherwise denied the claims made.

4. Both parties filed evidence as well as written submissions but neither requested to be heard. I therefore give this decision after a careful review of all the papers before me.

## The evidence

5. On behalf of the applicant, a witness statement was filed by Deborah Anne Selden who is an employee with Beck Greener, its legal representatives in these proceedings. Ms Selden’s witness statement serves as a vehicle to introduce a number of exhibits as follows:

DS1: copies of references taken from the Collins Dictionary of the English Language, 2<sup>nd</sup> ed. (1986) and Chambers Twentieth Century Dictionary (1972) showing entries for the word *couture*. The former defines it as *high fashion designing and dressmaking*, the latter as *dressmaking or dress designing*;

DS2: some 56 pages of printouts from a number of websites each downloaded on 3<sup>rd</sup> or 16<sup>th</sup> November 2010. They contain references to e.g. “London’s couture fashion industry”, a designer’s “most exquisite couture dresses” “English couture” and a business’s “couture collection” of clothes. The pages are taken from a number of sources including the *Telegraph* and *Independent* and the BBC websites.

DS3: some 30 pages downloaded on the same dates as DS2. One shows an article published on 14 March 2010 announcing “Tesco’s Terry Green to launch ‘couture’ clothing range for supermarket’s online store” which is described as a “high fashion-led range...”

DS4: pages stated to have been downloaded from the registered proprietor’s and other parties’ websites showing the sale of its dresses under So Couture and So Couture!

6. Evidence on behalf of the registered proprietor was filed by Lucy Mills. Ms Mills is an employee of Potter Clarkson LLP, the registered proprietor’s legal representatives in these proceedings. Her witness statement serves to introduce three exhibits as follows:

Exhibit A:

Consisting of five pages. The first two were taken from the pushkafashion.co.uk website on 20 March 2013. The first page shows a number of pictures of dresses being modelled. The accompanying text, whilst very difficult to make out, refers to “So Couture clothing by The Pretty Dress Company”. The second page has not been fully downloaded and does not appear to have any relevance. The last three pages were taken from the whoworeitbetter.co.uk website on 21 March 2013. They show an article entitled “Amy Childs vs Jodie Marsh in So Couture” which is dated June 4, 2011.

Exhibit B:

10 pages containing details of 9 trade mark registrations which contain the word SO.

Exhibit C:

A single page which appears to show two screenshots; undated and very poorly printed, I cannot make out what the first of the screenshots shows. The second screenshot bears the words “sO mlNe” and a star device; refers to “Nomads Land Nature Love” and has menu options “Home, Lookbooks(?), Shop, About, Stockists, Blog, Contact, Subscribe” but gives no indication of what, if anything, is being offered for sale via the site.

7. That completes my summary of the evidence filed in these proceedings.

## **Decision**

8. The application is brought under the provisions of section 47 of the Act, the relevant part of which states:

“47.-(1) ....

(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) ...

(4) ...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

### **The objections under section 5(2)(b) of the Act**

9. Section 5(2)(b) of the Act states;

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

- (a) ...
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

“6.-(1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark

in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) .....

(c) .....

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

11. The applicant relies on the two registrations shown above. Each is an earlier mark within the meaning of section 6(1) of the Act, however, given the dates that each completed its registration process, neither is subject to any requirement for the applicant to prove use of them in respect of the goods relied upon. The applicant is therefore entitled to rely on them for all of the goods as is set out above.

12. The test for determining whether there is a likelihood of confusion is well established. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd - BL O/330/10* (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### **The CJEU cases**

*Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

### **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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

13. In essence, the test under section 5(2)(b) is whether there are similarities in marks and goods or services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

14. In its statement of grounds of invalidity, the applicant refers me to an earlier decision of the registrar involving the same parties. It was issued in respect of an opposition to the registration of the mark So Couture! in a cursive script based on the same earlier rights as here. The opposition was successful and the applicant submits that “the same conclusion must be reached” in these proceedings. For its part, the registered proprietor submits:

“Given the extent of the differences between the contested registration of the current proceedings, and the contested application of the above mentioned opposition proceedings, it cannot be held true that the outcome of this decision is applicable to the present case.”

15. In *Special Effects* [2007] RPC 15, the court stated:

“71 It seems to us that the co-existence of the provisions for opposition and for a declaration of invalidity has the result that opposition proceedings are inherently not final. They exist at the first stage of the process, before registration. By itself that would not be conclusive, but it seems to us that the fact that, at least, any unconnected third party could challenge the validity of the registration despite an unsuccessful opposition by another, and that, if that challenge were successful, there would be nothing which would bind the unsuccessful opponent (in contrast with the position of a party which had unsuccessfully applied, at any rate to the court, for a declaration of invalidity), shows that the decision of the Registry on opposition proceedings, or more generally a decision to register despite opposition, is not a final decision so as to be capable of being the basis for an issue estoppel. This is true both as regards the grounds of invalidity and as regards the issue of prior use more generally, as relevant to a passing off claim. The same would be true of cause of action estoppel if, contrary to our view expressed above, there was a cause of action at that stage.”

Whilst there may be some degree of overlap between the respective proceedings, I have to consider matters afresh and based on the earlier marks relied on and the registration now before me.

### **Comparison of goods and services**

16. I bear in mind that goods can be considered identical when those covered by an earlier mark are included in a wider term by a later mark (and vice versa); see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (MERIC)* Case T- 133/05. The registered proprietor accepts that *Dresses*, for which its mark is registered, are included within the term *clothing* as appears in both earlier marks and that the respective goods are, therefore, identical.

### **Average consumer and the nature of the purchasing process**

17. Each of the respective goods is clothing which is a general consumer item likely to be bought by the general public. The goods are likely to be a fairly regular purchase. They are goods which are widely available, from specialist stores on the high street or from department stores or supermarkets (or their internet or mail order equivalents).

18. As to the manner in which the goods are likely to be selected by the average consumer, this is most likely to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see for example the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285).

19. In *New Look Ltd v Office for the Harmonization in the Internal Market* (Trade Marks and Designs) Joined cases T-117/03 to T-119/03 and T-171/03 the General Court considered the level of attention paid when purchasing goods in the clothing sector:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

20. As the *New Look* case acknowledges, the cost of clothing can vary considerably, however, as neither of the competing specifications in class 25 is limited in this respect, I must keep in mind goods across the whole price spectrum. Whilst I agree the average consumer’s level of attention is likely to be heightened when selecting, for example, a bespoke evening dress, it is also likely that the same average consumer’s level of attention will diminish when selecting, for example, an inexpensive dress for wearing as a cover-up on the beach. While these examples demonstrate that the average consumer’s level of attention is likely to vary considerably given the cost and nature of the particular item being bought, I consider that even when selecting routine items, the average consumer is likely to be conscious of factors such as the size, colour, material and price of the article concerned and its suitability for purpose and ease of being laundered. Overall, I think the average consumer is likely to pay at least a reasonable degree of attention to the selection of the goods at issue.

### **Comparison of the respective marks**

21. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, the average consumer rarely has the chance to make direct comparisons between trade marks but must, instead, rely on the imperfect picture of them he may have kept in mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on to compare each of the respective trade marks from the visual, aural and conceptual perspectives.



22. For ease of reference, the marks to be compared are as follows:

Applicant's earlier marks	Registered proprietor's mark
2482729 SO...?	socouture
CTM 4630406 SO...? CHIC	

23. In its statement of grounds, the applicant states:

“1.2. The word “couture” is French for “dressmaking”. It is, and was at the date of application for the contested registration, a well-known term in English as a contraction of “haute couture” implying high quality made to measure clothing by top designers. Thus, the word “couture” in the applied for mark, used in respect of class 25 goods, would have been seen by the average consumer at the date of application for the contested registration as descriptive of the quality or kind of goods offered under the mark. The consumer would interpret the word “couture” as an indication that the goods are of high quality and well-designed. Alternatively or additionally, the consumer would interpret the word “couture” as a laudatory statement regarding the goods, as the word “couture” is also used in a laudatory sense by clothing manufacturers to imply that their goods are high fashion goods, rather than in a strictly descriptive sense to mean that the goods are made to measure. Thus, the consumer would interpret goods offered under the contested mark as So goods of a very high quality, or designer So goods, or high fashion So goods.

1.3. Further, the word Couture appears at the end of the mark, and the element So at the beginning. It is well established that the average consumer directs greater attention to elements appearing at the beginning of a mark.

1.4. Thus, the average consumer with imperfect recollection of the mark would have his attention drawn predominantly to the element So found at the beginning of the mark.

1.5. The lack of a space between the words SO and COUTURE in the contested mark as registered would not prevent the average consumer from perceiving the two well known English words contained in the mark. As no particular stylisation of the mark is claimed, it must also be considered that the mark may be used in a form that emphasises the separate words making up the mark, such as in the form soCouture or SoCouture...”

24. In its counterstatement, the registered proprietor states:

“It is submitted that since the contested registration consists of the word ‘SO’ conjoined with the word ‘COUTURE’, an average consumer would not separate the word ‘COUTURE’ from the mark ‘SOCOUTURE’ when reading

or pronouncing the mark. Therefore it is submitted that an average consumer would not interpret the mark as offering 'So goods of a very high quality' as submitted by the applicant for invalidity. It is also not considered that goods would be described in this manner by the average consumer....

The Registrant strongly disagrees that the average consumer would have his attention drawn predominantly to the element SO, at the beginning of the mark, given the non-distinctive nature of this term alone..."

25. Earlier mark No. 2482729 consists of a number of elements. There is the word SO, followed by an ellipsis, itself followed by a question mark. The word SO has no meaning in relation to the goods at issue and is distinctive of them. Given that it appears at the beginning of the mark, I consider the word SO to be the dominant element of the mark. That is not to say that the punctuation is negligible or that it does not add to the mark or that it would be ignored but it is the word SO that is the memorable part of the mark for the average consumer.

26. Earlier CTM No. 4630406 consists of the same elements followed by the word CHIC. CHIC is a well-known dictionary word used to describe clothing that is fashionable or elegant and thus it is not distinctive in relation to the goods at issue. But the word SO is used as an intensifier and it therefore has a direct relationship with the word CHIC which follows it, despite the two words being separated by the punctuation, so neither word really dominates the other.

27. With regards to the registered proprietor's mark, this consists of a single word. Whilst recognising that the average consumer perceives a mark as a whole and does not pause to analyse its various details, the mark does, however, naturally break down into the two words SO and COUTURE. This is because the consumer will seek to "make sense" of an otherwise unfamiliar word and the word COUTURE, which makes up by far the largest proportion of the mark and, as the evidence shows, is commonly used to refer to clothing which is fashionable, has a meaning with which (s)he will be familiar in relation to the goods for which the mark is registered.

28. The registered proprietor submits that the respective marks:

"do not share any degree of visual similarity"

and that its mark is:

"a lexical invention bestowing distinctive character on the mark. Whilst each of the elements in the combination *may* form part of expressions used in everyday language in respect of the goods concerned, their syntactically unusual juxtaposition is not a familiar expression in the English language."

It further submits that the respective marks:

"do not share the same number of syllables, aural rhythm, or intonation, and for these reasons, the respective marks are not phonetically similar. It is also

submitted that in the contested mark, the stress falls on the last syllable, and this serves to phonetically distinguish the respective trade marks.

It is further submitted that since the contested trade mark is a lexical invention, an average consumer would not perceive, or read, the mark as “So COUTURE”, but rather would pronounce the mark as “SOC-OU-TURE.

The element ‘SO’ in the contested registration is not strongly, or independently, pronounced as it is in the Applicant’s earlier registration, but is rather lost in the overall pronunciation of the contested sign.”

In respect of the conceptual comparison of the respective marks, it submits:

“Since the element ‘SO’ forms part of the contested registration as opposed to being a separate element of the contested registration, it will not be seen as an intensifier as it is in the Applicant’s registration. Therefore an average consumer will not read the elements ‘SO’ and ‘COUTURE’ separately. The contested registration is a lexical invention created by conjoining the elements ‘SO’ and ‘COUTURE’ together as a single word mark.

It is further submitted that the relevant public will not perceive the respective trade marks as having the same semantic content.

The respective trade marks do not share a common meaning which will be understood by a significant part of the relevant public, and it is therefore submitted that the respective marks are not conceptually similar.”

29. I compare, first, the registered mark with earlier mark no 2482729. I have set out above, the applicant’s submissions. The only point of visual similarity between the respective marks is that each begins with the same two letters SO. Given the differences between the remainders of the respective marks, the degree of visual similarity is relatively low. From an aural perspective, only the single syllable word element SO of the earlier mark is likely to be pronounced. As I indicated above, in its submissions the registered proprietor indicates that its mark “consist[s] of the word ‘SO’ conjoined with the word ‘COUTURE’ ” and further describes it as a combination of elements. In my view, and despite it being presented as a single word, this is how the mark is likely to be seen, given the goods for which it is registered. It is a mark made up of three syllables, the first of which is also SO and thus there is a degree of similarity between the respective marks, although again, one which is relatively low. From a conceptual perspective, the word SO is used as an intensifier and, whilst the average consumer is unlikely to analyse the mark to any significant degree, the inclusion of the ellipsis is highly suggestive that something has been omitted though what that omission might be is a matter of speculation. This speculation is emphasised, to some degree, by the inclusion of the question mark at the end of the mark. I do not consider the average consumer will give the mark any particular meaning other than it begging a question. The registered proprietor’s mark brings to mind something that is highly fashionable. In my view, the respective marks are not similar from a conceptual perspective.

30. I go on to compare the registered mark with earlier mark no CTM 4630406. Again, the registered proprietor denies the respective marks have any visual, aural or conceptual similarity.

31. From the visual perspective, each begins with the same two letters SO and, therefore, there is a degree of similarity between them. Given the differences between the remainders of the respective marks, the degree of visual similarity is relatively low. From an aural perspective, and given that the ellipsis and question mark in the earlier mark is unlikely to be articulated, as each of the respective marks begins with the same two letters SO, there is a reasonable degree of aural similarity between them. As I indicated above, the word SO is an intensifier and therefore it has a direct relationship with whatever follows it. In the case of the earlier mark, this is the non-distinctive word CHIC. The word CHIC, like the word COUTURE, is an ordinary dictionary word of French origin and the mark brings to mind something that is highly fashionable and thus the respective marks have a degree of conceptual similarity.

### **The distinctive character of the earlier marks**

32. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which it has been used and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade 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 *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

33. No evidence of any use of the earlier marks has been put before me and therefore I have only the inherent distinctive character of them to consider. Earlier mark No 2482729 has a high level of inherent distinctive character given that it consists of the distinctive word SO coupled with the ellipsis and question mark, the whole being a somewhat unusual presentation and being neither allusive nor descriptive of the goods. Earlier CTM No 4830406 consists of the same elements coupled with the word CHIC which is non-distinctive for the goods at issue and I consider it to have a reasonably high level of inherent distinctive character.

### **Likelihood of confusion**

34. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade

marks and must instead rely on the imperfect picture of them he has retained in mind.

35. The registered proprietor has identified a number of registered trade marks which include the word SO. It claims that others are using such marks and has filed evidence in support of such claims (witness statement of Lucy Mills and exhibits). I am not persuaded by the evidence filed that such marks are in use but, in any event, the fact that other parties may use a mark which includes the word SO does not assist the registered proprietor. As Floyd J stated in *Nude Brands Limited v Stella McCartney and Ors* [2009] EWHC 2154 (Ch):

“59(2) It is irrelevant that there may be other signs similar to the opponent’s earlier trade mark being used in the market place as trade marks.”

36. As far as earlier mark No 2482729 is concerned, I have found that it has a high level of inherent distinctive character, that identical goods are involved, that the respective marks have a relatively low degree of visual and aural similarity and have no conceptual similarity. On a global appreciation, I find that there is no likelihood of direct confusion between the respective trade marks i.e. where one mark will be mistaken for the other.

37. I have also to consider whether there is a likelihood of indirect confusion i.e. whether the average consumer would consider that the goods come from the same or an economically linked undertaking. In BL O/375/10, Mr Ian Purvis Q.C. sitting as the appointed person, stated:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning –it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark, It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “*The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark*”.

38. In *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-505/11* it was stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal’s taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM-nfon (nfon)*, not published in the ECR, paragraph 69).”

39. Taking all matters into account, I find that there is a likelihood of indirect confusion between the respective marks. The application based on this earlier mark succeeds.

40. As for CTM 4630406, I have found this mark has a reasonably high level of inherent distinctive character, that identical goods are involved, that the respective marks are visually similar to a relatively low degree, aurally similar to a reasonable degree and, from a conceptual perspective, similar. Taking all matters into account, I find that there is no likelihood of direct confusion between the respective marks but that there is a likelihood of indirect confusion i.e. the average consumer will consider the goods come from the same or an economically linked undertaking. The application based on this earlier mark succeeds.

### **Summary**

41. The application, founded on grounds under section 5(2)(b) of the Act, succeeds.

### **Costs**

42. The application having succeeded, the applicant is entitled to a contribution towards its costs. I make the award on the following basis:

Preparation of a statement and considering the other side's statement:	£300
Invalidation fee:	£200
Preparation of evidence and submission and reviewing that of the other side:	£400
Total:	£900

43. I order The Pretty Dress Company London Ltd to pay Debonair Trading Internacional Lda the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period, or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17th day of September 2013**

**Ann Corbett**

**For the Registrar  
The Comptroller-General**